Panel Decision for dispute CAC-ADREU-002235

Case number	**CAC-ADREU-002235**
Time of filing	**2006-07-10 13:32:50**
Domain names	**palmerscocoabutter.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**E.T Browne (UK) Limited, Mr. Rob Neil White**

Respondent

Organization / Name	**Fienna Limited, Fienna Limited bruceg**

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

1. The Complainant is ET Browne (UK) Limited, which is a company registered in the United Kingdom. The Complainant has a registered company address in the UK and has provided a contact address in the UK.

2. The Complainant forms part of a group of companies owned by a US parent company, ET Browne Drug Co. Inc, which claims to have been trading for more than 160 years. The Complainant claims that this group of companies markets the number one brand of cocoa butter products worldwide.

3. The Complainant's US parent company is the registered proprietor of both UK and Community trade marks for the brand name PALMER'S. It is also the registered proprietor of Community trade marks which contain the words BUTTER FORMULA (but not COCOA BUTTER FORMULA). The Complainant claims to be the exclusive licensee of these trade marks in Europe.

4. On 7 April 2006, the first day of the Land Rush period, the PALMERSCOCOABUTTER.eu domain name was registered in the name of the Respondent, Fienna Limited.

5. On 6 July 2006, the Complainant issued its complaint in these ADR proceedings. The Respondent did not submit a response to the complaint by the required deadline, or at all. The Czech Arbitration Court issued a notification of the Respondent's default on 31 August 2006.

A. COMPLAINANT

The Complainant contends as follows:

(a) The Complainant is the exclusive licensee of the following earlier registered UK and Community trade marks (registered in the name of the Complainant's US parent company, E.T Browne Drug Co. Inc).
- UK Regn No. 1175713 of 26.5.1982 for PALMER'S covering inter alia 'creams and ointments all for the care of the skin' in Class 3
- UK Regn No. 1302763 of 4.3.1987 for PALMER'S (stylized) covering inter alia 'creams and ointments all for the care of the skin' in Class 3
- CTM Regn No. 141846 for PALMER'S of 1.4.1996 covering inter alia 'personal care products for the hair, lips and skin' in Class 3
- CTM Regn No. 2228690 of 23.5.2001 for PALMER'S SHEA BUTTER FORMULA covering inter alia 'soaps; cosmetics' in Class 3

- CTM Regn No. 4246278 of 20.1.2005 for PALMER'S OLIVE BUTTER FORMULA covering inter alia 'soaps; cosmetics' in Class 3

(b) The Complainant forms part of a group of companies which market the number one brand of cocoa butter products worldwide, have been trading for over 160 years, and have a reputation in the PALMER'S name and the cocoa butter products sold under that trade mark.

(c) The domain name contains the registered trade mark of the Complainant, PALMER'S. Furthermore, the parent company's registered trade marks include the words BUTTER FORMULA, being descriptive trade mark matter but informing the consumer of the precise cosmetic products on offer under the banner of the PALMER'S house mark.

(d) The main products of the Complainant consist of cocoa butter and it is clear that a consumer typing in the domain name will expect to be directed to a website of the Complainant selling the cocoa butter cosmetic products. Furthermore, the addition of the descriptive words 'cocoabutter' in the domain name does not serve to remove the risk of confusion, as the core distinctive element of the domain name is clearly the house mark PALMER'S. Consequently, the domain name palmerscocoabutter.eu is plainly confusingly similar to the earlier registered trade mark rights established by national UK and Community law, of the parent company and the Complainant wholly owned subsidiary.

(e) Such likelihood of confusion is exacerbated by the fact that the Complainant has registered a number of .eu domain names including palmers.eu and cocoabutter.eu where official websites of the Complainant will eventually be available. Therefore, if consumers become aware of these official .eu websites, they are very likely to believe that palmerscocoabutter.eu is an official website of the Complainant when it is not.

(f) The authorized representative of the Complainant wrote to the Respondent on 23 May 2006. This letter explained the rights of the Complainant and demanded the transfer of the domain name under threat of an ADR action, thus providing the Respondent with ample time to comply without the need to resort to the ADR proceedings and put both parties to unnecessary cost. No response of any kind was received to the above referenced letter and therefore, the ADR proceedings have now been filed.

(g) The Respondent clearly has no legitimate rights or interests in the domain name and as the PALMER'S COCOA BUTTER FORMULA products of the Complainant are readily available throughout Europe both in commerce and via the Complainant's website, the Respondent has taken advantage of the Complainant's reputation and registered this valuable domain name speculatively with a view to holding the Complainant to ransom or selling the domain name on to an unconnected third party. Alternatively, the Respondent may use the domain name to divert business away from the Complainant to its own cosmetics website, thus causing damage and confusion to the Complainant's established reputation in its PALMER'S COCOA BUTTER FORMULA products.

(h) In addition to having no legitimate rights or interests in the domain name, as a result of the massive reputation of the Complainant in its PALMER'S COCOA BUTTER FORMULA products, we submit that the Respondent registered the domain name in bad faith. The domain name is an instrument of fraud and thus a tool for committing the common law tort of passing-off at least in respect of any use of the domain name on an active website available in the UK. In order to satisfy the legal requirements of passing-off in the UK, the Complainant would firstly need to prove it has a reputation in its PALMER'S COCOA BUTTER FORMULA trade mark and products which is clearly evident from the Complainant's website and longstanding reputation. Secondly, the domain name in the hands of the Respondent must amount to a misrepresentation, whether or not deliberate, that it relates to, derives from or is approved by the Complainant and finally, that such a misrepresentation has caused or is likely to cause damage to the Complainant.

(i) The Complainant submits that all three criteria can be satisfied in this instance and that therefore, in addition to offending against the earlier registered trade mark rights of the Complainant, the domain name registration amounts to the common law tort of passing off and would be likely to cause damage to the established goodwill and reputation of the Complainant.

In light of the above, the Complainant hereby requests the transfer of the domain name from the Respondent to the Complainant.

B. RESPONDENT

The Respondent has not responded to the Complaint.

DISCUSSION AND FINDINGS

1. The Respondent has not responded to the Complaint. Article 22.10 of Commission Regulation (EC) No 874/2004 and Paragraph B10(a) of the ADR Rules are clear that, in a situation where the Respondent does not respond to the Complaint, this may be considered by the panel as grounds to accept the claims of the Complainant.

2. This does not mean a Complaint should be upheld whenever a Respondent fails to respond. In order to succeed on its complaint, the Complainant is still required to demonstrate that the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) the ADR Rules are satisfied.

3. The Complainant must, in accordance with Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules, demonstrate that the PALMERSCOCOABUTTER domain name is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognised or established by national and/or Community law and either: (A) the Respondent has registered the domain name without rights or legitimate interests in the name; or (B) the domain name has been registered or is being used in bad faith.

4. The Complainant has provided evidence that its US parent company is the registered proprietor of trade marks which include the name “Palmer’s” and the words “Cocoa Butter”. The US parent company is not the registered proprietor of a trade mark which includes all words used in the domain name. However, after commencing this complaint, the panel notes that the US parent company has applied to register a Community trade mark for PALMER’S COCOA BUTTER FORMULA.

5. The Complainant claims to be the exclusive licensee in Europe of the US parent company’s trade marks. However, the Complainant has not provided any evidence of this, other than a letter on the US parent company’s headed notepaper which merely states that the Complainant is “authorized” to use the trade marks.

6. Despite this, the panel is persuaded that the Complainant has ‘rights’ to use the name Palmer’s Cocoa Butter which are recognised in English and/or Community law. It appears to be a licensee of the US parent company’s registered trade marks in the PALMER’S name and, as advanced by the Complainant, it also appears to have significant unregistered rights (e.g. goodwill in the UK) to use the name Palmer’s Cocoa Butter. The Complainant asserts that it has a reputation in the name Palmer’s Cocoa Butter which, in the absence of a Response from the Respondent, the panel accepts.

7. The existence of unregistered rights in the trade mark “Palmer’s Cocoa Butter” means that the domain name is identical to the name in which the Complainant has rights. As a result, the Complainant is not required to demonstrate confusion. However, even if the Complainant did not have such unregistered rights, the panel is persuaded that the use (in the domain name) of the Complainant’s registered trade mark PALMER’S, together with a well known product of the complainant, namely Cocoa Butter, means that the domain name is confusingly similar to the registered trade marks.

8. The Complainant has not provided any evidence that “the Respondent has registered the domain name without rights or legitimate interests in the name”. However, the Complainant has provided evidence that it wrote to the Respondent and claims not to have received a response to that letter. It also asserts that the Respondent does not have any rights or legitimate interests in the name. In the absence of a response from the Respondent, either to the Complainant’s earlier letter or the Complaint, the panel finds that the Respondent accepts the Complainant’s assertion that it does not have rights or legitimate interests in the name Palmer’s Cocoa Butter.

9. The above finding that the Respondent does not have rights or legitimate interests in the domain name is enough to satisfy the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules. However, for completeness, it is necessary to consider whether the domain name was registered or is being used in bad faith.

10. The Complainant has also not provided any evidence that “the domain name has been registered or is being used in bad faith”. However, the domain name is not in use and the Respondent has not responded to the letter written by the Complainant. It would therefore have been impossible (or at least exceedingly difficult) for the Complainant to obtain any evidence that the Respondent registered or intends to use the domain name in bad faith. The Complainant has asserted that the Respondent registered the domain name in bad faith and, in the absence of a response from the Respondent, the panel again finds that the Respondent has accepted the Complainant’s assertion.

11. Given the Complainant’s rights to the use the name “Palmer’s Cocoa Butter” in Europe, there are only a limited number of ways in which the Respondent could use the domain name that would not be in bad faith. In this respect, Article 21.3(d) of Commission Regulation (EC) No 874/2004 and Paragraph B11(f)(4) of the ADR Rules are relevant, which include, as an example of bad faith, the use of a domain name to attract Internet users for commercial gain by creating a likelihood of confusion with a name on which a right is established. If the domain name was used for any commercial purpose (including the offering of the domain name for sale, or for sponsored links or affiliate sales) this would therefore be evidence of bad faith.

12. The Complainant has satisfied the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules. It is therefore entitled to obtain revocation of the domain name. The Complainant has additionally requested the

transfer of the domain name. The Complainant is a UK registered company and is based in the UK and therefore satisfies the criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002. It is therefore also entitled to transfer of the domain name.

DECISION

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

PANELISTS

Name	CMS Cameron McKenna, Isabel Davies

DATE OF PANEL DECISION 2006-09-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought ADR proceedings against the Respondent on 6 July 2006, claiming that the Respondent's registration of the domain name PALMERSCOCOABUTTER.eu should be annulled and that it was entitled to a transfer of the domain name.

The Complaint maintained that the Complainant was the exclusive licensee of registered trade marks, including a trade mark for PALMERS. The Complaint also maintained that the Complainant had significant unregistered rights to use the name Palmer's Cocoa Butter, which was manufactured and sold by the Complainant.

The Respondent had registered the domain name on the first day of the Land Rush period of registration. The Complaint asserts that the Respondent does not have any rights or legitimate interests in the name. The Complaint also asserts that the Respondent registered the domain name in bad faith. No evidence was provided by the Complainant to support either assertion.

The Respondent failed to file a Response. As a result, and in accordance with Article 22.10 of Commission Regulation (EC) No 874/2004 and Paragraph B10(a) of the ADR Rules, the Panel was entitled to consider this grounds to accept the claims of the complainant. However, the Panel still required the Complainant to demonstrate that the requirements of Commission Regulation (EC) No 874/2004 and the ADR Rules were satisfied.

The Panel held:

(1) The Complainant is licensee of the registered trade mark PALMERS in the EU and is owner of unregistered rights in the trade mark PALMER'S COCOA BUTTER. The domain name is identical to the Complainant's unregistered rights and confusingly similar to the Complainant's (licensed) registered rights.

(2) The Respondent appears not to have rights or legitimate interests in the name PALMER'S COCOA BUTTER. The Complainant asserted this is the case both in its complaint and in a letter to the Respondent, which was provided as evidence by the Complainant. The Respondent has not responded to the Complaint or the letter.

(3) The Respondent also appears to have registered the domain name in bad faith. Again, this was asserted by the Complainant in both the letter to the Respondent and in the Complaint, neither of which were responded to.

(4) The Complainant is a UK registered company and therefore satisfied the criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002.

Accordingly, the Panel ordered the transfer of the domain name to the Complainant.