Panel Decision for dispute CAC-ADREU-002381

Case number	**CAC-ADREU-002381**
Time of filing	**2006-07-25 12:09:58**
Domain names	**haji.eu**

Case administrator

Name	**Kateřina Fáberová**

Complainant

Organization / Name	**Haji GmbH**

Respondent

Organization / Name	**Ovidio 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

An action is pending in Brussels brought by EURid against the registrar who registered all domain names held by the Respondent.
The parties are not part of this pending court proceeding.
In connection with its action the Registry placed the domain names registered by the registrar of the Respondent - including the disputed domain name - on hold.
The Respondent's registrar filed a lawsuit against EURid seeking among other remedies that the « on hold » status be raised.
The Respondent has joined this court action.
A provisionnary decision issued by the Brussels Court of First Instance ordered EURid to unblock the domain names.

FACTUAL BACKGROUND

The domain name HAJI.EU (the Domain Name) has been registered in the name of OVIDIO Limited (the Respondent) on the first day of the « Landrush Period », on April 7, 2006.

Previously during the « Sunrise » period, HAJI GmbH (the Complainant) had filed two applications for the Domain Name, on the basis of prior trademark rights.

These applications were rejected by the Registry.

The Complainant filed a complaint against the domain name holder seeking transfer of the Domain Name HAJI.EU.

A. COMPLAINANT

The Complainant is a limited liability company corporation incorporated under the law of the Federal Republic of Germany.

The Complainant produces markets and distributes beverages. The company has been founded in 2003 by Mr. Ali Eghbal and Mr. Gregor vom Endt, who are both appointed as the sole two managing directors of the Complainant.

The two managing directors are the owners of numerous German as well as international trademarks, which are all concerning the term "haji", in class 32 and 33 of Nice Classification.

The complainant is the sole and exclusive licensee of these trademarks.

In its complaint, the Complainant asserts that the disputed domain name, "haji.eu" is identical to the wording of the trademarks "haji".

According to the Complainant it results from the trademark registers of Germany as well as the European Union and the WIPO that no other trademark rights concerning the term “haji” do exist. As a consequence, the Complainant states that the Respondent cannot be the holder of any right concerning this term.

Furthermore the Respondent does not have any legitimate interest in the domain name since he has not used the domain name in connection with the offering of goods or services. The domain is used as part of the “SEDO Domain Parking Program” meaning that there is no activity on behalf of the Respondent.

The domain name holder is not making a legitimate and non-commercial or fair use of the domain name nor he has been commonly known by the domain name, according to the Complainant.

On the contrary, the Complainant points out some statements from the Respondent’s website showing that the respondent owns a domain name portfolio and is trying to acquire as many domain names as possible. This is the behaviour of someone who is otherwise identified as a domain grabber or cybersquatter, who does not a lot to avoid conflicts with right holders.

In a later nonstandard communication the Complainant informs that the Respondent sent an e-mail where he offered to transfer the disputed Domain Name without any charge under the condition that the ADR proceeding be dismissed.

The Complainant suspects it is an acknowledgement of its remedies, and did not reply to this offer.

B. RESPONDENT

The Respondent requested a short extension of time to submit its response. The Court granted a seven day extension.

In its response, the Respondent claims that the word HAJI is a generic term derived from arabic, used in numerous languages as Indonesian which means:
1. One who has made a pilgrimage to Mecca.
2. Often used as a form of address for one who has made such a pilgrimage.

Secondly the Respondent reminds that a trademark registration provides limited rights. Therefore it is permitted that different companies utilize the same mark provided that the respective uses are different in nature.

Complainant’s mark cannot be used to assert a right to the words “haji” beyond the use in connection with beverages. Complainant’s marks are not sufficiently strong as to preclude a third party from using a similar domain name to describe goods and completely unrelated to those claimed by the Complainant.

Then the Respondent claims that it has a legitimate interest in the domain name since it is in the “direct navigation business” which is a recognized search method wherein a constructed search phrase is entered in the form of a domain name in the browser rather than in a search engine.

The Respondent claims he did not act in bad faith since he did not offer the disputed Domain Name for sale nor he selected it to prevent Complainant from acquiring the Domain Name.

It claims that it had no knowledge of the Complainant or its asserted prior right before the present proceeding.

At last the Respondent points out the fact that there is no likelihood of confusion that its use of the Domain Name could be confused with the Complainant’s business.

Therefore the respondents requests that the Complaint be denied.

DISCUSSION AND FINDINGS

First, having consideration to the fact that the Complainant is not the owner of the trademark rights on which the Complaint is based, the panel has to determine whether the Complainant is eligible to file the Complaint in the present case.

According to article B1(a) of the ADR Rules every person or entity may initiate an ADR procedure by filing a complaint.

Articles 21 and 22 of the Regulation (EC) No. 874/2004 do not provide differently.

As a result, the exact text of the Regulation (EC) No. 874/2004 and the ADR Rules do not require Complainant to be the same as the holder of the name in respect of which a right is recognized or established.

The panel also refers to the RESTAURANT case (ADR00597).

The Complainant is the exclusive licensee of the trademarks owners, who are also the founders and managing directors of the Complainant. Even the licence agreement does not contain any provision allowing that legal action be brought by the licensee the panel accepts that Complainant filed the Complaint in his formal capacity of exclusive licensee.

At last the panel points out the fact that the Respondent did not challenge the filing of the Complaint by the Complainant instead of the trademark owners.

In accordance with Article 21.1 of Commission Regulation (EC) No 874/2004 and Article 11(d)(1) of the Rules, a registered domain name shall be subject to revocation where the following three circumstances are given:

(A) that the disputed 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

(B) that the Respondent has registered such a domain name without holding rights or legitimate interests in respect of the disputed domain name

OR

(C) that the disputed domain name has been registered or is being used by the Respondent in bad faith.

Identity or confusing similarity

According to the first element foreseen by Article 21.1 of Regulation 874/2004 and Article 11(d)(1) of the Rules the Complainant must fulfill the following two conditions: (i) to hold a name in respect of which a right of the Complainant is recognised or established by national and/or Community law, and (ii) show evidences that the said name is identical or confusingly similar to the disputed domain name.

The Complainant has provided the panel with documentary evidences showing that it owns several German and international trademark registrations on the term “HAJI”.

It is clear to the panel that the trademark held by the Complainant is distinctive with regard to its business at least, no matter of its descriptive character in non-european languages.

The panel notes that the international trademarks held by the Complainant have effect in Cyprus where the Respondent is based.

Therefore, the Complainant has fulfilled the first one of the conditions established by the first element foreseen by Article 21.1 of Regulation 874/2004 and Article 11(d)(1) of the Rules.

Then, the only difference existing between the “HAJI” trademarks owned by the Complainant is the inclusion of the “.EU” suffix in the disputed domain name.

The “.eu” suffix must be disregarded for determining whether the domain name is identical or confusingly similar to the trademark. See: ADR 596 (RESTAURANTS), ADR 475 (HELSINKI), ADR 387 (GNC) ADR 1676 (BAUMAX).

The Panel concludes that the domain name is identical to a name in which the Complainant has trademark rights within the meaning of Article 21 (1) of Regulation 874/2004 (and of Paragraph B11 (d)(1)(i) of the ADR Rules).

Existence of rights or legitimate interest in the Domain Name

The Complainant is requested to prove that the Respondent has no right nor legitimate interest in the disputed Domain Name.

It results from the various statements of the Complaint and the Response that the Respondent does not hold any right on the disputed domain name, in the sense of the ADR Rules Paragraph B11(e).

The Respondent explains that the domain name was selected randomly and automatically thanks to its descriptive character.

However the Respondent claims a legitimate interest in the Domain Name, since it is used for direct navigation purpose.

The question is therefore to determine whether the use of a domain name for direct navigation could be considered as a legitimate interest.

The Panel is of the opinion that the direct navigation system described by the Respondent in its statements is not per se incompatible with a legitimate interest in domain names.

Nevertheless, the panel also refers to the provisions of the ADR Rules paragraph 11 (e) which determine what can be regarded as a legitimate interest, and notes that in the present case:
Prior to the filing of the complaint, the Respondent was not using the disputed Domain Name to offer goods or services.
The Panel is indeed of the opinion that the Domain Name was merely parked.

Moreover the Respondent offered to transfer – without any charge - the Domain Name to the Complainant as soon as the Complaint was notified, which demonstrates he acknowledged its lack of interest in the Domain Name.

The Respondent is not commonly known under the disputed Domain Name. The panel was not provided any document showing that the Respondent was doing business under the disputed Domain Name.

Most of all the Panel denies a non-commercial use since the Respondent is a business entity which registered thousands of domain names under ".eu".

The direct navigation system used by the Respondent is generating important incomes so that the panel cannot look upon the Respondent as making a non-commercial use of the Domain Name.

Having also regard to the pending litigation where the Respondent is involved with the European Registry, it is clear to the panel that there is no legitimate interest in the disputed Domain Name.

Since the Respondent did not make contentions that could demonstrate a legitimate interest other than those enumerated in Art. 21(2) Regulation EC/874/2004 the Complainant met the requirements of a transfer of the Domain Name so that the contentions to a registration in bad faith could be disregarded by the Panel as not relevant to the case.

Consequently, the Panel orders that the Domain Name be transferred to the Complainant.

DECISION

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

PANELISTS

Name	**Alexandre Nappey**

DATE OF PANEL DECISION 2006-10-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The disputed domain name concerns the domain name HAJI.EU which corresponds to numerous german and international trademarks owned by the Complainant.

The Respondent registered the domain name on April 7, 2006 during the landrush period and is using it for its "direct navigation" business, which is similar to a parking page with contextual content generated automatically.

The Respondent claims a legitimate interest on the domain name since the word HAJI is a descriptive term derived from arabic and which means "pilgrim".

The Complainant asserts that the domain was registered and is used in bad faith.

Having consideration to the provisions of the EC Regulation No 874/2004 paragraph 21 and 22, and to paragraph B(1)(a) of the ADR Rules, the panel accepts that the complaint is filed by the exclusive licensee of the trademarks, on behalf of the owners who are anyway the managing directors of the Complainant.

With regard to the evidence provided by the Complainant supporting its prior rights on the trademark HAJI, including in Cyprus where the Respondent is based, the panel declares that the disputed domain name is identical to the trademarks HAJI, the suffix ".eu" being disregarded.

Then the panel finds that no right is established on the domain name on behalf of the Respondent.

Furter, the panel considers that the Respondent has no legitimate interest in the domain name since it is not used to support any offer of goods or services, but merely parked. The Respondent is indisputably not known under the domain name and it is clear to the panel that the domain name is not under non commercial or fair use insofar as the sole purpose of the Respondent's business (so called "direct navigation business") is to generate revenues with parking pages, and not to provide the internet users with relevant information.

Moreover as stated by the Complainant the Respondent offered to transfer the disputed domain name as soon as the Complaint was notified, which demonstrates its acknowledgement of the Complainant's rights, and its own lack of legitimate interest in the domain name.

The Panel reminds lastly that the Respondent (and/or its registrar) is involved in various court proceedings brought by the European Registry.

Therefore the Panel orders that the domain name HAJI.EU be transferred to the Complainant.