Panel Decision for dispute CAC-ADREU-002955

Case number	**CAC-ADREU-002955**
Time of filing	**2006-10-03 14:12:19**
Domain names	**f1.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Formula One Licensing BV, Sean Corbett**

Respondent

Organization / Name	**RoosIT, Marc Roos**

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 pending or decided legal proceedings which relate to the Disputed Domain Name.

FACTUAL BACKGROUND

The Complainant is a Netherlands company, Formula One Licensing BV, and the Respondent, RoosIT, appears to be the trading name of another Netherlands Company, Roos Informatie Technologie BV.

On 7 December 2005 three Sunrise applications were made to register the Disputed Domain Name, "f1.eu".

- The first in time was by Annette Sneider, based on a Benelux trade mark for "www.f1.eu". This application was rejected by the .eu domain name Registry, EURid.

- The second was by the Complainant, based on a UK trade mark for "F1". The Complainant failed to provide its documentary evidence in time. This application was therefore also rejected by EURid.

- The third was by the Respondent, based on a Maltese trade mark for "F&1". The documentary evidence was provided on 2 January 2006 and this third application was accepted by EURid.

On 24 February 2006 the Complainant's representatives wrote to the Respondent requesting that the Respondent withdraw its application. The Respondent did not reply.

On 8 August 2006 the Complainant's representatives wrote to EURid suggesting that the Respondent was in breach of its contractual obligations as a .eu domain name Registrar and/or was abusing the Sunrise application system. EURid replied on 24 August 2006 to say that it did not believe the Respondent was in breach of its contractual obligations and that it would not take any action.

On 15 September 2006 the Complainant submitted a Nonstandard Communication to the ADR Center, which contained the text of the current Complaint and the Annexes

On 3 October 2006 the Complainant submitted the Complaint together with the Annexes. On the same day EURid confirmed that the Respondent was the current registrant of the Disputed Domain Name.

On 13 October 2006 the proceedings formally commenced.

On 30 October 2006 the Respondent sent a fax to the ADR Center, in which it claimed that it had transferred the Disputed Domain Name to Stichting Roos Beheer on 28 September 2006 and that it had confirmed this transfer by fax to EURid on 29 September 2006. On the same day EURid reconfirmed that the Respondent was the registrant of the Disputed Domain Name on the date the Complaint was filed.

The Respondent failed to submit a Response.

On 7 December 2006 the Panel was appointed.

A. COMPLAINANT

The Complainant says that it is the owner of various trade marks such as FORMULA 1, FORMULA ONE and F1 and provided evidence of various international trade mark registrations.

The Complainant says that the Respondent has no rights or legitimate interest in the Disputed Domain Name for the following reasons:

(1) the Respondent is not intending to use the trade mark "F&1" for a bona fide offering of goods, given that RoosIT has made 214 similar trade mark applications in Malta, such as "S&P&O&R&T&S", "H&O&T&E&L", "P&O&K&E&R", "L&I&N&U&X", and "O&2", which were solely intended to allow the Respondent to register domain names such as "sports.eu", "hotel.eu", "poker.eu", "linux.eu" and "o2.eu".

(2) although the trade mark "F&1" was registered by a UK company, Lively Limited, it is in the same format as RoosIT's applications and for the same services, namely "Internet website such as providing telecommunication connections to a computer network and providing user access to a computer network"

(3) the trade mark registration specifies that "Registration gives right to the exclusive use of the letter 'F' and the numeral '1' only when used together with the symbol '&' as shown on the mark"

(4) neither the Respondent nor Lively Limited are commonly known under the domain, since the domain has not been activated

(5) the Respondent could not make fair use of the domain since anyone typing f1.eu would believe that they would be taken to the Complainant's website, and so any use would constitute trade mark infringement

The Complainant also says that the Respondent applied for or intends to use the Disputed Domain Name in bad faith due to the pattern of "ampersand" trade mark applications and the inherent unlikelihood that the Respondent intends to use them all itself, leading to the inference that it must be intending to use them to sell to interested third parties and/or to gain commercial attention for its own core business.

B. RESPONDENT

The Respondent did not submit a Response.

DISCUSSION AND FINDINGS

1. Under Regulation 874/2004, Article 22(1)(a), an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21.

2. Under Regulation 874/2004, Article 21(1), a registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where [A] 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 [B] has been registered by its holder without rights or legitimate interest in the name; or [C] has been registered or is being used in bad faith.

A. COMPLAINANT'S RIGHT

3. The Complainant has submitted its International Registration 732134 for the mark "F1", its International Registration 823226 for a design mark including the words "Formula 1" and a list of its International Registrations including these two and others such as "F1 RACING SIMULATION" and "FORMEL EIN".

4. The majority of these registrations are irrelevant to the present proceedings as they are not identical or confusingly similar to the name "F1".

5. However, International Registration 732134 is for a mark which is identical to the name "F1". Although it has apparently been refused protection in the United Kingdom, it is protected in other countries within the European Community.

6. Therefore, the Complainant has established that the "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".

B. RESPONDENT'S RIGHTS OR LEGITIMATE INTEREST

7. The Respondent has not submitted a Response and so the only possible right of which the Panel is aware is the Maltese trade mark registration for "F&1" owned by Lively Limited.

8. As the Disputed Domain Name was accepted by EURid during the Sunrise period, the Panel infers that EURid must have made the following findings:
(a) that the Maltese trade mark was a prior right "recognised or established by national and/or Community law" under Regulation 874/2004, Article 10(1)
(b) that "F&1" is identical to "F1", after taking into account the special rules to be applied to the ampersand symbol (&) as a special character under Regulation 874/2004, Article 11
(c) that the Respondent provided sufficient evidence that it had a licence of that trade mark from Lively Limited.

9. If EURid's decision to accept the Sunrise application under Article 10 was correct, it follows that the Respondent had a right in the name "F1" when the Disputed Domain Name was registered for the purposes of Article 21(1)(a). A right which is sufficient for a Sunrise application must be sufficient to avoid a finding that the holder had no right in the name, leaving bad faith under [C] as the only basis for a challenge.

10. The Complainant did not formally challenge EURid's decision to accept the Sunrise application. However, the Panel does not believe that the Complainant is thereby prevented from challenging EURid's findings in the present proceedings. Although the Complainant does not challenge the validity of the Maltese trade mark nor the licensing arrangements between the Respondent and Lively Limited, it does challenge whether a trade mark registration for "F&1" should be regarded as a right in "F1".

11. The question of how ampersands in trade marks should be interpreted under Regulation 874/2004 has been considered in a number of previous ADR decisions, including the following (by date of decision):

(a) 398 (BARCELONA): EURid's decision to accept "BARC & ELONA" as a Prior Right for "BARCELONA" annulled
(b) 265 (LIVE): EURid's decision to accept "LI&VE" as a Prior Right for "LIVE" annulled
(c) 394 (FRANKFURT): EURid's decision to accept "FRANKF & URT" as a Prior Right for "FRANKFURT" annulled
(d) 188 (123): EURid's decision to accept "1.2.3" as a Prior Right for "123" would have been accepted but the decision was annulled on other grounds
(e) 532 (URLAUB): EURid's decision to accept "u*r*l*a*u*b" as a Prior Right for "URLAUB" accepted
(f) 475 (HELSINKI): Traffic Web Holding ordered to transfer "HELSINKI", which it had registered on the basis of "HELSI & NKI" as a Prior Right, on the basis of bad faith
(g) 735 (NICE): EURid's decision to accept "N&ICE" as a Prior Right for "NICE" annulled
(h) 1239 (PESA): EURid's decision to accept "p&a" as a Prior Right for "PESA" accepted (on the basis that the Hungarian word for "and" is "es")
(i) 1459 (CESE): EURid's decision to accept "C&E" as a Prior Right for "CESE" annulled (on the basis that the Hungarian word for "and" is actually "és" not "es")
(j) 1867 (OXFORD): EURid's decision to accept "OXF & ORD" as a Prior Right for "OXFORD" accepted
(k) 1996 (THINKTANK): EURid's decision to accept "THINK!T@NK" as a Prior Right for "THINKTANK" accepted
(l) 2185 (ANTWERPEN): EURid's decision to accept "ANTWERP&!" as a Prior Right for "ANTWERP" and "ANTWERPEN" annulled (rejecting the argument that the Dutch word for "and" is "en")
(m) 2221 (REYKJAVIK): EURid's decision to accept "REYKJA & VIK" as a Prior Right for "REYKJAVIK" annulled
(n) 1523 (COLOGNE): EURid's decision to accept "COL & OGNE" as a Prior Right for "COLOGNE" annulled
(o) 2416 (TIMESONLINE): EURid's decision to accept "TIMESON&LINE" as a Prior Right for "TIMESONLINE" accepted (by 2-1)

12. These decisions are not consistent. However, considering in particular the cases where the ampersand in the trade mark has been deleted entirely in the domain name, this Panel prefers the approach taken in relation to BARCELONA, LIVE, FRANKFURT, NICE, ANTWERP, REYKJAVIK, COLOGNE and TIMESONLINE (by the minority) to that taken in relation to OXFORD and TIMESONLINE (by the majority). In particular, this Panel agrees with the reasoning adopted by the Panels in relation to ANTWERP and COLOGNE.

13. The Panel notes that the Maltese trade mark registration for "F&1" is specifically limited to "the exclusive use of the letter 'F' and the numeral '1' only when used together with the symbol '&' as shown on the mark". The Panel does not believe that this gives any right to the name "F1", whether under Article 10 or Article 21(1)(a). The Panel therefore finds that the Respondent has no right in the Disputed Domain Name by virtue of the Maltese trade mark registration for "F&1" owned by Lively Limited.

14. The Respondent has provided no evidence of any legitimate interest and the Complainant has amply explained why no such interest exists. Therefore, the Panel finds that the Respondent has no legitimate interest in the Disputed Domain Name either.

C. RESPONDENT'S BAD FAITH

15. As the Panel has already held that the Respondent has no right or legitimate interest in the Disputed Domain Name there is no need to make a finding as to bad faith for the purposes of Article 21(1). However, as the issue has been argued the Panel believes it is appropriate to record its view.

16. A definition of bad faith is provided in Article 21(3). However, this is non-exhaustive and the fact that a Respondent's conduct cannot be neatly categorised into one of the subparagraphs of Article 21(3) does not mean that the Respondent has not registered or used a particular domain name in bad faith.

17. In this case the Respondent has failed to respond to contact from the Complainant's representatives or from the ADR Center. In the absence of a Response, the Panel can only assess the submissions and evidence before it.

18. The Complainant has presented cogent evidence that the Respondent has adopted a pattern of conduct in registering trade marks consisting of generic words and existing trade names with the addition of ampersands. In the absence of any explanation from the Respondent, it seems highly unlikely that the Respondent intends to use these trade marks for anything other than Sunrise applications for .eu domain names without the ampersands.

19. The Complainant has suggested a number of reasons why the Respondent may have wanted to register all of these domain names. These reasons are necessarily speculative but again, in the absence of any explanation from the Respondent, it seems more than likely that the Respondent either intended to sell them to the Complainant or third parties or to use them to generate trade or revenue, for instance through advertising.

20. Where such conduct involves a generic name it may not be regarded as being in bad faith, although many would regard obtaining such a generic name during the Sunrise period as fairly sharp practice and not within the spirit of the rules. However, where such conduct involves a name in which a third party has rights, and the registrant can expect to receive Internet traffic intended for that third party, the conduct is properly termed bad faith. The Panel finds that this is the case in relation to the Disputed Domain Name and therefore finds that the Disputed Domain Name was registered by the Respondent in bad faith.

21. This finding is supported by the fact that the Respondent has not provided a response but only a purported transfer from the Respondent to Stichting Roos Beheer, a company which appears to be related and whose signatory appears to be the same Mark Roos as signed the transfer on behalf of the Respondent. This appears to be simply an attempt to avoid these proceedings and, in the circumstances, constitutes further evidence of bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraph B12(b) of the Rules, the Panel orders that the domain name F1 be transferred to the Complainant.

PANELISTS

Name	Christopher Stothers

DATE OF PANEL DECISION 2006-12-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought an action against the Respondent for a speculative and abusive registration of the domain name "f1.eu", based on a Maltese trade mark for "F&1".

The Panel held that the name was identical to the Complainant's trade mark registration for "F1".

The Panel then held that the Respondent had no rights or legitimate interest in the name. The Panel found that the Maltese trade mark did not give rights in the name "F1", particularly as the registration was specifically limited to "the exclusive use of the letter 'F' and the numeral '1' only when used together with the symbol '&' as shown on the mark".

The Panel also held that the Respondent had registered the name in bad faith. The registration was part of a pattern of conduct in registering trade marks consisting of generic words and existing trade names with the addition of ampersands. In the absence of any explanation from the Respondent, it was highly unlikely that the Respondent intended to use these trade marks for anything other than Sunrise applications for .eu domain names without the ampersands. Moreover, it seemed more than likely that the Respondent either intended to sell the registered names to the Complainant or third parties or to use them to generate trade or revenue, for instance through advertising.

The Panel therefore ordered that the domain name be transferred to the Complainant.