# Panel Decision for dispute CAC-ADREU-003147

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| Case number | **CAC-ADREU-003147** |
| Time of filing | **2006-10-23 10:28:20** |
| Domain names | **autotrader.eu** |

## Case administrator

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| Name | **Josef Herian** |

## Complainant

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| Organization / Name | **Trader Media Group (2003) Limited** |

## Respondent

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| Organization / Name | **First European Technology Limited, First European Technology 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

A previous complaint in relation to the disputed domain name was filed against the Reigistry (complaint number 00191). The complaint was rejected.

FACTUAL BACKGROUND

The Complainant is an English company, Trader Media Group (2003) Limited and the Respondent, First European Technology Limited is also an English company.

On the first day of Phase One of the Sunrise Period the Respondent applied to register the Disputed Domain Name, “Autotrader.eu”. On 5 March 2006 the Disputed Domain Name was registered in the name of the Respondent. On 15 September 2006 the Complainant received an email purporting to offer the Disputed Domain Name to it for US$ 10,000.

On 23 October 2006, the Complainant submitted the Complaint together with the Annexes. On 30 October 2006 EURid confirmed that the Respondent was the current Registrant of the Disputed Domain Name.

On 31 October 2006 the proceedings formally commenced.

The Respondent failed to submit a response.

On 3 January 2007 the Panel was appointed.

A. COMPLAINANT

The Complainant contends that it is the publisher of the well known motoring publication “Auto Trader” which was launched in the UK in 1977 and is Trader Media Group’s flagship publication. Auto Trader is available in hard copy and on-line and is the United Kingdom’s biggest selling motoring magazine with a weekly circulation of in excess of 400,000. In addition, the Auto Trader associated website, www.autotrader.co.uk, was launched in 1996 and is Europe’s largest motoring website with around 320,000 vehicles listed at any one time. The site generates 366,791,334 page impressions per month and has 6,831,897 unique users per month.

The Complainant contends that it has registered a number of trade marks in the UK, republic of Ireland, Germany, Benelux and EU for the name Auto Trader. It is also the Registrant of a large number of domain names incorporating the name “Auto Trader” which it uses in the course of trade throughout the European Community.

The Complainant contends that it has used the Auto Trader brand since 1977 in relation to its products and services and has acquired

common law rights and goodwill in the Auto Trader name in the United Kingdom.

The Complainant contends that the Respondent has no rights or legitimate interest in the name and that the Disputed Domain Name has been registered and is being used in bad faith. In particular:-

(a) The Respondent was incorporated on 20 November 2005. The Company registration details for the Respondent show that the Respondent has failed to specify the nature of its intended business activities and it has never filed any accounts.

(b) Having conducted a search on the world wide web the Complainant has found no evidence that the Respondent trades or that it has at any time traded in goods and/or services in the United Kingdom or elsewhere in the European Community with or in association with the name Auto Trader.

(c) On 22 November 2005 the Respondent applied to register a Benelux Trade Mark for Auto Trader in Class 15 of the Nice Classification system in respect of “plectrums” a category of goods unrelated to the natural meaning ascribed to the words Auto Trader. The Complainant contends that the Respondent applied for the Benelux Auto Trader trade mark in Class 15 to avoid any likelihood of objection from third parties including the Complainant. The Complainant contends that the Respondent never had or intended to trade in musical products and/or plectrums under the name Auto Trader and that its sole reason for applying the Benelux trade mark (which was registered under the Benelux Accelerated process for trade mark registrations) was to acquire the corresponding .eu domain name.

The Complainant submits that in addition the Respondent has filed over 100 trade mark applications in the Benelux Registry all of which were registered on 22 November 2005. The trade marks were registered by the Respondent and another company, First Internet Technology Limited that is registered at the same address. The trade marks registered by the Respondent include marks such as “Digital Camera”, “Mortgage Loan” and “Online Poker” for goods and services such as “computer games for Catholic kids”, “services of a funeral director” and “table silver” respectively. The Complainant contends that the goods registered are wholly unconnected with the natural meaning of the trade marks and the diversity of the trade marks registered by the Respondent illustrates that the Respondent has no defined trade and no bona fide existing business with established goodwill in any of these businesses.

The Complainant also contends that in respect of each Benelux trade mark registered by the Respondent, the Respondent applied for the corresponding .eu domain name in Phase 1 of the Sunrise Period. The Complainant contends that:

(a) There is no evidence that the Respondent has used the domain name or a name corresponding to the domain name in connection with any goods or services;

(b) The Disputed Domain Name has been registered and has been used in bad faith;

(c) The Disputed Domain Name was registered as a blocking tactic in order to prevent the Complainant from using the Disputed Domain Name in the course of its business;

(d) The Respondent registered the Disputed Domain Name primarily for the purpose of disrupting the professional activities of a competitor;

(e) The Respondent registered the Disputed Domain Name primarily for the purpose of selling, renting or otherwise transferring the Disputed Domain Name to the holder of a name where a right is recognised and established by National and Community Law;

(f) The Complainant therefore seeks to have the Disputed Domain Name transferred to it.

## B. RESPONDENT

The Respondent did not submit a response.

## DISCUSSION AND FINDINGS

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.

Article 21 of Regulation 874/2004 states that a registered domain name shall be subject to revocation using an appropriate extra-judicial or judicial procedure, where 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 and where it has been registered by its holder without rights or legitimate interest in the

name; or has been registered or has been used in bad faith.

The Complainant has submitted an extract from the UK Trade Mark's Registry database demonstrating that it is the owner of a right which is recognised or established by National and/or Community Law for the name Auto Trader. Therefore, the Complainant has established that the name is identical or confusingly similar to a name which is recognised or established by National and/or Community Law. The fact that the Complainant's UK registered trade mark is for the two words "Auto Trader" and the Disputed Domain Name is one word "autotrader" is not a material difference and both the Disputed Domain Name and the Complainant's trade mark should be regarded as identical for the purposes of this matter.

The Respondent has not submitted a Response and therefore the only right of which the Panel is aware is the Benelux Trade Mark registration for "Auto Trader" owned by the Respondent.

The Panel notes that the Benelux trade mark was registered before the commencement of the Sunrise Period and it is assumed that the Disputed Domain Name was accepted by EURid during the Sunrise Period on the basis of the Benelux trade mark as evidence of a prior right under the Sunrise Rules.

The Benelux Trade Mark registration for Auto Trader held by the Respondent is registered in Class 15 for plectrums. There is no evidence that the Respondent has used the trade mark Auto Trader in respect of the provision of either goods or services or further that the trade mark Auto Trader has ever been applied to plectrums by the Respondent. As such the Respondent has provided no evidence of any legitimate interest in the name Auto Trader. In addition the Respondent has registered a large number of Benelux Trade Marks which it has used as a basis for registering corresponding .eu domain names, without any apparent trading interest in such names. In the circumstances, the Panel finds that the Respondent has no legitimate interest in the Disputed Domain Name.

Since the Panel has 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, since the issue has been raised the Panel will deal with this issue.

Article 21(3) defines what is meant by bad faith. In particular, bad faith may be demonstrated where:

(a) the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name in respect of which a right is recognised;

(b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised by National or Community Law from reflecting this name in a corresponding domain name provided that a pattern of such conduct by the Registrant can be demonstrated;

(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor;

(d) the domain was intentionally used to attract internet users for commercial gain.

The Complainant has submitted a copy of an email it received from "marcmpc@aol.com" on 15 September 2006 which states that "someone has offered US$10,000 funds to purchase www.autotrader.eu. I saw the ADR that you tried to get it and lost. So, to be fair, do you want to purchase it or should we consider the other offer from a third party - could be a competitor, we don't know. Let us know asap."

It is not by any means clear that this email was sent by or on behalf of the Respondent. However, it does not appear likely that there could be any other party other than the Respondent who would be able to invite the Complainant to purchase the Disputed Domain Name as it is only the Respondent who can agree to sell the Disputed Domain Name.

In addition the Complainant has demonstrated, that the Respondent has engaged in a pattern of conduct where it has registered a large number of domain names without any apparent intention to trade under such names.

Further no evidence has been provided by the Respondent to challenge the claim that the email of 15 September 2006 was sent by the Respondent or on its behalf, or that the Respondent's registration of a large number of domain names was for a reason other than the sale of the domain names to third parties or to use them to generate trade or revenue.

It should be noted that many of the domain names registered are in fact generic, such as "car", "job", "photography" and "travel". As such, it may be difficult to consider such conduct as being in bad faith. However, where such conduct involves a name in which a third party

has rights and where correspondence exists requesting a large payment for the transfer of the domain name such use could be considered to be in bad faith. The Panel therefore finds that the Disputed Domain Name was registered by the Respondent in bad faith.

DECISION

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

## PANELISTS

| Name | Simon Bennett |
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DATE OF PANEL DECISION 2007-01-29

## 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 “Autotrader.eu” based on a Benelux trade mark for “Autotrader”.

The Panel held that the name was identical to the Complainant’s trade mark registration for “Auto Trader”.

The Panel also held that the Respondent had no rights or legitimate interest in the name. The Panel made this finding based upon the absence of any trading activity by the Respondent or any intended trading activity under the name Autotrader.

The Panel also found that the Disputed Domain Name had been registered in bad faith because the Respondent had purported to invite the Complainant to offer US$10,000 in return for the transfer of the domain name and because it had engaged in a pattern of conduct involving the registration of a large number of domain names without any apparent intention to trade under such names.

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