Panel Decision for dispute CAC-ADREU-003465

Case number	**CAC-ADREU-003465**
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Domain names	**rotary.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Rotary International**

Respondent

Organization / Name	**Name Redacted**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a United States non-profit corporation. The Complainant's website describes it as "a worldwide organization of business and professional leaders that provides humanitarian service, encourages high ethical standards in all vocations, and helps build goodwill and peace in the world."

The Complainant owns a number of registered trade marks for the word "ROTARY" including: UK Trade Mark 1300500 dated 10 February 1987 in class 42; UK Trade Mark 1536528 dated 22 May 1993 in class 16; UK Trade Mark 2101074 dated 23 May 1996 in classes 14, 25 and 42; Community Trade Mark 897843 dated 29 July 1998 in nine classes; Community Trade Mark 1973049 dated 27 November 2000 in class 42; Community Trade Mark 3201456 dated 21 May 2003 in classes 9, 24 and 36; and Community Trade Mark 3936366 dated 8 July 2004 in 17 classes.

On 24 January 2006, the Respondent applied for a Danish trade mark for the word "ROTARY". On 26 January 2006, a Danish trade mark VR 2006 00404 for "ROTARY" was registered in the name of the Respondent ("the Danish Mark").

On 31 January 2006, the Respondent applied for the domain name ROTARY during the first phase of the sunrise registration period based on the Danish Mark.

The domain name ROTARY was registered in the name of the Respondent on 30 April 2006.

A. COMPLAINANT

There is without any doubt identity between the Complainant's prior trade marks for "Rotary" and the registered domain name.

The Complainant's trademark "ROTARY" is a renowned and well-known trade-mark which is associated with the Complainant not only in Europe but throughout the world as explained at www.rotary.org. The Respondent does not appear to have any connection whatsoever with the name "Rotary".

The Respondent appears to be an experienced trademark expert and therefore he should be familiar with the fact that the Complainant has prior rights to the name Rotary not only in Europe but througout the world. Consequently, the registrant has no rights or legitimate interest in the disputed domain name which has been registered in bad faith as it is preventing the Complainant from using the domain in Europe.

B. RESPONDENT

The disputed domain name was duly and legally registered and awarded under the sunrise period in accordance with the Sunrise Rules. The Danish word trade mark which was the basis for this application is still valid and live, having been examined by the Danish trademark office.

There is no evidence of bad faith in respect of the domain name. The registration was neither speculative nor abusive.

The Complainant, whose name consists of two words and not JUST “Rotary”, has not provided any evidence in support of its statement that its trade mark is renowned and well-known trademark. Even if is well-known, it is only as “ROTARY CLUB”, a private, elite club, where decision makers come together for networking and fundraising. “ROTARY INTERNATIONAL” is not associated or remembered by the average customer with or for special products or services, nor is it well known.

The Complainant argues that the Respondent is an experienced trademark expert and should be familiar with the Complainant’s prior rights in the name ROTARY. The Respondent has not only a trade mark agency but has other legal trade documents (“Gewerbescheine”) for trading since many years. He also founded a company with the company function: “services, trade and manufacturing of goods of all kind”.

The Complainant is also an experienced trade mark expert and therefore should be familiar with the fact that an identical sign can be registered for various trade marks providing that the goods and services for which the trademarks are registered are not confusingly similar to each other.

The word ROTARY is commonly used word in English, French and Spanish. It has many dictionary meanings such as a device rotating around a central axis, a traffic roundabout and a type of engine.

There are various other ROTARY trade marks worldwide (including UK, US and Community) which are not connected with the Complainant.

The Complainant does not have a unique right to use the word ROTARY or the disputed domain name because it does not have the trade mark rights for all goods and services under the Nice classification.

There is no similarity (point of contact) of goods and services in relation to the Complainant and Respondent trade marks.

Dealing with Article 21 of Commission Regulation 874/2004 concerning speculative and abusive registrations:

1(a): The Respondent has mark rights in relation to the disputed domain name.

2(b): The domain name was not registered in bad faith

3(a): There are no circumstances or evidence indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring it to the holder of a name in respect of which a right is recognised or established by national and/or community law or to a public body.

The Complainant has produced no evidence in support of its statements.

The Respondent never made an offer to sell or licence, or any other offer, to the Complainant or to any other company or person.

3(b): The domain name was not registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or community law, or a public body, from reflecting this name in a corresponding domain name.

3(b)(i): No pattern of such conduct by the Respondent has been proved.

3(b)(i): Not applicable as less than two years has elapsed since the domain name was registered.

3(b)(iii): Not applicable.

3(c): The domain name was not registered primarily for the purpose of disrupting the professional activities of a competitor. The parties’

respective trademarks were registered for different and disssimilar goods and classes. The Complainant is not a competitor of the Respondent, because the parties act in completely different sectors and there is no overlap in their activities and trade mark rights.

3(d): The domain name was not intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder or a domain name.

This provision is not applicable because the domain name has not yet been used. In future it will be used to promote goods for which trade mark rights exists and these goods are not confusingly similar to the goods and services covered by the Complainants' trademarks.

3(e): The domain name registered is not a personal name for which no demonstrable link exists between the domain name holder and the domain name registered.

In Case 00131 (MINITEC), the summary of the Panel's decision stated: "With respect to the alleged registration of the disputed domain name in bad faith, the Panel concluded that a mere existence of the Complainant's more senior trademark (regardless of its potential well-known character) did not constitute a bad faith element of the Respondent's domain name registration. In addition, The Panel also concludes that the Respondent has no intention to attract Internet users to the disputed domain name website by confusing them about the origin of products promoted through such website. The Panel holds that any such confusion (if any) would be purely accidental and unintentional."

DISCUSSION AND FINDINGS

Procedural issues

On 24 January 2007, the date that this decision was due, the Complainant filed a non-standard submission which was in effect a reply to the Response - although there is no automatic right of reply in these proceedings. Paragraph B8 of the ADR Rules enables the Panel in its sole discretion to admit further statements or documents from the parties. Here, the Complainant has not offered any exceptional or other circumstances justifying its further submission at a very late stage and so the Panel declines to admit it.

On 24 January 2007, the Respondent also filed a non-standard submission in response to the Complainant's submission. Given that the Panel has disallowed the Complainant's submission and that the Respondent too has offered no exceptional or other circumstances justifying its submission, the Panel also declines to admit the Respondent's statement.

Introduction

Under Article 21(1) of Regulation (EC) 874/2004 ("the Regulation"), the disputed domain name is subject to revocation if it is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and where it (a) has been registered by its holder without rights or legitimate interests in the name or (b) has been registered or is being used in bad faith.

Rights

By virtue of its registered trade marks within the EU, the Complainant has established rights in the name "ROTARY" for the purposes of Article 21(1) of the Regulation.

The Panel makes no finding in relation to common law rights. The Respondent contests the Complainant's alleged reputation in the name "ROTARY" and the Complainant has provided no evidence in support of its claims in this respect other than a reference to its website.

The Panel finds that the disputed domain name is identical to the name "ROTARY" in which the Complainant has established relevant registered trade mark rights.

Rights or Legitimate Interests

The Complainant has made out a prima facie case to the effect that the Respondent lacks rights or legitimate interests in the disputed domain name.

Article 21(2) of the Regulation sets out three ways whereby the Respondent may demonstrate rights or legitimate interests:

21(2)(a): Use of the domain name or a name corresponding to the domain name in connection with an offering of goods or services or demonstrable preparations to do so. Here, the domain name has not been used and the Respondent has not demonstrated any preparations for use.

21(2)(b): The holder of the domain name has been commonly known by the domain name. There is no evidence that this applies.

21(2)(c): Legitimate and non-commercial or fair use without intent to mislead customers or harm the reputation of a trade mark. This is inapplicable as the domain name has not been used at all.

The above factors are not exhaustive. Are there any other factors evidencing the existence of rights or legitimate interests? In this context, it is important to examine the Respondent's purpose in registering the disputed domain name.

The Complainant has exhibited some printouts of a website at copernicus.net in which the Respondent is described as a European Trade Mark Attorney operating a "Highly Specialised International Trademark & Naming Agency" established in January 2001 called "Copernicus Consulting" and based in Vienna.

The Respondent does not dispute the Complainant's assertion that he is an "experienced trade mark expert". To this the Respondent adds that he "has other legal trade documents ('Gewerbescheine') for trading since many years. He also founded a company with the company function: 'services, trade and manufacturing of goods of all kind'." In support the Respondent supplies a one page document in German headed "Gewerbeschein". Notwithstanding Paragraph A3(c) of the ADR Rules and paragraph B1(d) of the Supplemental ADR Rules, this document has not been translated into English, the language of this ADR Proceeding. The Panel is entitled to disregard it in accordance with paragraph A3(c) of the ADR Rules but, in any case, it does not appear to be anything more than some sort of general permission to carry on business in Vienna.

Nowhere does the Respondent explain in any detail, or provide supporting evidence concerning, his various alleged businesses activities, let alone demonstrate what relevance, if any, these have to the name "ROTARY".

The Respondent relies also on the Danish Trade Mark. The printout is in Danish and this has not been translated either. It is apparent, however, that this is an expedited trade mark, applied for and registered shortly before the domain name application. The Panel believes that the trade mark was registered for the purpose of obtaining the disputed domain name in the .eu sunrise period. While there is a general and unsupported assertion by the Respondent that, in future, the disputed domain name will be used to promote unspecified goods for which he has trade mark rights and which will be dissimilar to those of the Complainant, there is no detailed explanation beyond that and no supporting evidence indicative of a genuine intention to use the mark. In those circumstances, the Panel considers that the Danish Trade Mark is insufficient, of itself, to generate rights or legitimate interests.

Nor is it relevant that the term "ROTARY" is theoretically capable of being used by the Respondent in a manner which does not infringe the Complainant's registered trade marks or that third parties unconnected with the Complainant also own trade marks for "ROTARY".

The Respondent says that "ROTARY" is a generic word to which the Complainant has no exclusive rights. But there is no indication that the Respondent registered the domain name for a genuine purpose based on its generic meaning. The Respondent has not suggested, let alone provided supporting evidence, that he was, say, in the business of dealing in generic domain names or involved in some other trade relevant to the generic meaning, for example in relation to rotary engines.

Taking the above matters into account, in particular the lack of any clear and credible explanation of the Respondent's purpose in registering the disputed domain name, the Panel concludes that it has been registered by the Respondent without rights or legitimate interests for the purposes of Article 21(1) of the Regulation.

As lack of rights and legitimate interests is an alternative requirement to registration or use in bad faith, there is no need for the Panel to address the latter issue.

Remedy

The Complainant seeks "[p]rimarily transfer of the domain name as the Complainant is an organisation with local offices around Europe. In this respect I refer to section 1 (ii) in the .eu Domain Name Registration Policy. Alternatively, revocation of the domain name."

Article 22(11) of the Regulation states that the Panel shall decide that the domain name shall be revoked if finds that the domain name is speculative or abusive as defined in Article 21. It also provides that the domain name shall be transferred to the Complainant if the Complainant applies for the domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) 733/2002.

Those general eligibility criteria are:

1. an undertaking having its registered office, central administration or principal place within the European Community;

2. organisations established within the European Community without prejudice to the application of national law; or

3. natural persons resident within the European Community.

The Complainant has not supplied any evidence to the Panel indicating that it satisfies any of these criteria. Accordingly, the Panel's decision is that the domain name should be revoked and the Panel declines to order the transfer of the disputed domain name 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 ROTARY be revoked

PANELISTS

Name	**Adam Taylor**

DATE OF PANEL DECISION 2007-01-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The disputed domain name is identical to the name "ROTARY" in which the Complainant has established relevant registered trade mark rights.

The Complainant has made out a prima facie case to the effect that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has failed to demonstrate rights or legitimate interests in accordance with Article 21(2) of the Regulation (EC) 874/2004.

The Respondent has not explained in any detail or provided supporting evidence concerning its various alleged businesses activities, let alone demonstrate what relevance, if any, these have to the name "ROTARY".

The Respondent's Danish Trade Mark is insufficient, of itself, to generate rights or legitimate interests at it appears to the Panel that it was registered for the purpose of obtaining the disputed domain name in the .eu sunrise period and the Respondent has not supplied any detailed explanation or supporting evidence indicative of a genuine intention to use the mark.

It is irrelevant that the term "ROTARY" is theoretically capable of being used by the Respondent in a manner which does not infringe the Complainant's registered trade marks or that third parties unconnected with the Complainant also own trade marks for "ROTARY".

There is no indication that the Respondent registered the domain name for a genuine purpose based on its generic meaning.

Taking the above matters into account, in particular the lack of any clear and credible explanation of the Respondent's purpose in registering the disputed domain name, the Panel concludes that it has been registered by the Respondent without rights or legitimate interests for the purposes of Article 21(1) of the Regulation.

The Panel decides that the domain name should be revoked and declines to order the transfer of the disputed domain name to the

Complainant as there is no evidence that it satisfied the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) 733/2002.