Panel Decision for dispute CAC-ADREU-003495

Case number	**CAC-ADREU-003495**
Time of filing	**2006-11-20 12:59:01**
Domain names	**skyblog.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**VORTEX**

Respondent

Organization / Name	**British Sky Broadcasting Ltd**

FACTUAL BACKGROUND

The Complainant is a French Company named Vortex which operates in the media field. The Complainant is a subsidiary of the French Group ORBUS , a group of media which controls in particulars the radio SKYROCK and the internet company TELEFUN. In December 2002, the Complainant has launched a weblog service named “SKYBLOG”.
The Respondent is British Sky Broadcasting Ltd, a corporation registered under the laws of Great-Britain and Northern Ireland, which carries out its activity within the media field. The Respondent is the successor of a company named Sky Television Plc.
On November 3, 1998 the Complainant and Sky Television Plc entered into by an agreement whereby the Complainant undertook, in particular, “to never use nor seek to register any other trademarks containing the work “sky” except “Skyrock” and “Skyzin”.
The Respondent has registered the domain name <skyblog.eu> on June 7, 2006.
On November 20, 2006, the Complainant filed a complaint so as to obtain the transfer the said domain name.
On, January 5, 2007 the Respondent filed its response requesting to the panel to dismiss the complaint.

A. COMPLAINANT

The Complainant is a French Company named Vortex which operates in the media field. The Complainant is a subsidiary of the French Group ORBUS , a group of media which controls in particulars the radio SKYROCK and the internet company TELEFUN. In December 2002, the Complainant has launched a weblog service named “SKYBLOG”. With 6 millions blogs of which 15.000 to 20.000 created daily, SKYBLOG is the first European platform and the second world one.
A coexistence agreement was entered into by the predecessor of the Respondent and the Complainant on November 3, 1988 on the basis of the French trademarks “SKY CHANNEL” n°1/270.896 owned by SATELLITE TELEVISION (predecessor of the Respondent) and “SKYROCK” n°1.383.823 owned by the Complainant. According to the Complainant, this coexistence agreement should be considered null and void for lack of cause since the French trademark SKY CHANNEL expired on November 23, 1993.

The Complainant claims to have the following prior rights over SKYBLOG :

- The Complainant has registered with the French Company TELEFUN (another subsidiary of the French ORBUS Group), a large number of domain names such as <skyblog.com>, <skyblog.net> or <skyblog.org> filed on October 29, 2002;
- The Complainant has filed the French trademark SKYBLOG n°02 3 195 764 on November 25, 2005 as well as the Community trademark SKYBLOG n°003 837 556, on May 14, 2004. The Community trademark is not yet registered since it has been opposed by the Respondent on the basis of its UK registrations and CTM application "SKY";
- The Complainant is the owner of the well-known trademark SKYBLOG, according to Article 6 of the Paris Convention and article L. 713-5 of the French Intellectual Property Code;
- SKYBLOG is one of the trade names of the Complainant.
- The Complainant has created the name SKYBLOG so that it benefits from copyright protection.

According to the Complainant, the Respondent has not any activity with the term SKYBLOG prior to the SKYBLOG's weblog service of the Complainant, dated December 2002. Therefore, the Complainant considers that the contentious domain name has been registered by the Respondent without rights or legitimate interest and with the purpose of disrupting the activity of the Complainant.

As a result, the Complainant requests the Panel to consider the registration of <skyblog.eu> as an abusive registration and consequently to transfer this domain name to the benefit of the Complainant.

B. RESPONDENT

The Respondent indicates that the Parties are currently in litigation in France the outcome of which affects the Complainant's rights to own and use any marks incorporating the word SKY, including SKYBLOG.

The Respondent indicated that an agreement was reached between the predecessors of the Respondent and the Complainant, on November 3, 1988, stating in particular that :

(i) the Complainant will never use nor seek to register any other trademarks containing the work "SKY" except "SKYROCK" and "SKYZIN" and

(ii) this agreement is binding upon the parties hereto, their successors, their assigns, any registered users or licensees whom may be appointed, and may only be modified or amended by subsequent written agreement.

On January 2001, the Complainant initiated proceedings against the Respondent before French Courts, relying on its SKYROCK trademark. In response, the Respondent relied on the Agreement both as a defence and as a basis for breach of contract.

On January 16, 2004, the Paris Court of First Instance, in particular:

(i) considered that the agreement entered into by the parties was a final and binding settlement,

(ii) prohibited the Complainant from using the term "SKY" whether alone or together with other terms, with the exception of "SKYROCK" and "SKYZIN" after one month from notification of this decision and, beyond this period, with a penalty of €1.000 for each recorded infringement and,

(iii) ordered the cancellation of the Complainant's French trade mark registrations other than SKYROCK and SKYZIN.

On June 1, 2005, the Court of Appeal confirmed the decision and ordered the cancellation of the French trademark SKYBLOG n°02/3.195.764.

In addition, the Court hold that the prohibition of use by the Complainant of the term SKY alone or together with other terms excepting SKYROCK and SKYZIN shall take effect three months from notification of this ruling and thereafter, be subject to a penalty of €2,500 per recorded infringement.

The Complainant appealed from the decision and was dismissed on July 11, 2006 by the Supreme Court.

Regarding the SKYBLOG Community Trademark, the Respondent brought an opposition action before OHIM against the registration of such trademark based on the agreement entered into by the parties as well as its earlier rights in the mark SKY and the family of SKY marks.

The Respondent provided with numerous SKY trademarks which all predate the contentious domain name. In addition, the Respondent claims to use the mark SKY since 1984 and has built up significant unregistered trade mark rights and goodwill and reputation in the mark SKY, in parallel to its registered rights.

The Respondent considers that a very substantial reputation is attached to the word SKY, so that anyone using the SKY mark with a common descriptor such as BLOG, would be assumed by the UK public as being, in some way, connected or associated with the Complainant.

Finally, the Respondent considers that in bringing this Complaint, the Complainant has abusively breached its obligations of the agreement. Therefore, the Complaint shall be seen abusive for being in defiance of French Judgements.

DISCUSSION AND FINDINGS

By decision of June 1st, 2005, the Paris Court of Appeal hold, in particular, that the prohibition of use by the Complainant of the term SKY alone or together with other terms, excepting SKYROCK and SKYZIN, shall take effect three months from notification of this ruling and thereafter, be subject to a penalty of €2,500 per recorded infringement. In addition, the Paris Court of Appeal ordered the cancellation of the French SKYBLOG trademark n°02/3.195.764, since such application infringes the terms and conditions of the agreement entered into by the parties on November 3, 1988.
The Complainant appealed from the decision and was dismissed on July 11, 2006 by the Supreme Court. Therefore, the non use of the work “SKYBLOG” by the Complainant has been finally decided by a Court.
Pursuant to 4) c) of the ADR rules, “the Panel shall terminate the ADR proceeding if it becomes aware that the dispute that is the subject of the Complaint has been finally decided by a court of competent jurisdiction or an alternative dispute resolution body”.
To the extent that the Paris Court of first Instance, confirmed that by Paris Court of Appeal and the Supreme Court, has already held that the Complainant was prohibited from using the term SKY alone or together with other terms excepting SKYROCK and SKYZIN, there is no reason for the Panel to decide further on this matter.
Therefore, the Panel decides to terminate the case.
However, the Panel does not found that the Complainant has brought this procedure in bad faith and is guilty of reverse domain hijacking.

DECISION

For all the foregoing reasons, in accordance with Paragraphs A 4 (c), B12 (b) and (c) of the Rules, the administrative proceedings is terminated.

PANELISTS

Name	**Isabelle Leroux**

DATE OF PANEL DECISION 2007-03-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

French Courts have prohibited the Complainant from using the word SKYBLOG, subject to a penalty, and have cancelled the French SKYBLOG trademark n°02/3.195.764. This decision was based on an agreement entered into by the Complainant and the predecessor of the Respondent, providing that the Complaint shall “never use nor seek to register any other trademarks containing the work “sky” except “Skyrock” and “Skyzin”.
Therefore, and pursuant to 4) c) of the ADR rules, the administrative proceedings is terminated.