Panel Decision for dispute CAC-ADREU-004015

Case number	CAC-ADREU-004015
Time of filing	2006-12-29 11:14:21
Domain names	tirfor.eu, secalt.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	., TRACTEL INTERNATIONAL SAS

Respondent

Organization / Name	MANDARIN & PACIFIC SERVICES LIMITED, Gerald Mwanyika

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

None

FACTUAL BACKGROUND

The Complainant, Tractel International SAS, is the holding company of a multinational group of 20 companies specialised in lifting, material handling, measurement of tension and loads, suspended working platforms, building maintenance installations and fall arrest safety equipment. The group began in Luxembourg in 1948 and is now present in about 15 countries.

The Complainant owns various trade marks in the term TIRFOR. Its subsidiary, Secalt S.A., owns various trade marks in the term SECALT. The TIRFOR and SECALT trade marks are registered in many countries worldwide, including in various European countries, and certain of them have been registered for almost 60 years. The Complainant and Secalt S.A. also own the domain names <tirfor.com> and <secalt.com> respectively.

The Respondent registered both <tirfor.eu> and <secalt.eu> ("the Disputed Domain Names") on 7 June 2006.

The Complainant wrote to the Respondent by email on 20 July 2006 and 15 September 2006 informing him of its rights. On 18 October 2006, the Respondent replied stating that the emails sent were blank and so the Complainant re-sent the previous emails. On 22 December 2006, the Complainant filed a Complaint under the .EU Alternative Dispute Resolution ("ADR") procedure with the Czech Arbitration Court. Due to various deficiencies in the Complaint, the Panel was not appointed until 20 February 2007. On 27 February 2007, the Complainant requested a one month suspension of the ADR procedure in order to attempt to reach an amicable settlement. This was granted by the Panel. On 27 March 2007, the Complainant again requested a one month suspension of the procedure and again this was granted by the Panel.

A. COMPLAINANT

(i) Identity between the Complainant's prior rights and the Disputed Domain Names

The Complainant asserts that its trade marks are prior rights in accordance with Article 10(1) of Regulation EC n° 874/2004 ("the Regulation") which lays down public policy rules concerning the implementation and functions of the .EU Top Level Domain and the principles governing registration. Article 10 of the Regulation states that "Prior rights" shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works. Furthermore, the Complainant points out that Article 21 of the Regulation states:

"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, such as the rights mentioned in Article 10(1), and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or

(b) has been registered or is being used in bad faith."

The Complainant asserts that the Disputed Domain Names are identical to the trade marks TIRFOR and SECALT as the spelling is the same. It further points out that when assessing whether domain names are identical or confusingly similar to prior rights, it is a common and established practice to disregard the top-level part of the domain name, as its existence is dictated by the very nature of the Domain Name System, and the addition of the .EU extension merely fulfils the function of distinguishing one namespace from another.

The Complainant therefore concludes that the first paragraph of Article 21 is fulfilled because the Complainant owns relevant prior rights which are identical to the Disputed Domain Names.

(ii) The Respondent's lack of rights or legitimate interest in the Disputed Domain Names

The Complainant points out that Article 21 of the Regulation states that:

"1. A registered domain name shall be subject to revocation … where it:

(a) has been registered by its holder without rights or legitimate interest in the name;
(b) ….

2. A legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where:

(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(b) the holder of a domain name, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law."

The Complainant points out that the Respondent has not used the Disputed Domain Names or a name corresponding to them in connection with the offering of goods or services, nor made any demonstrable preparations to do so.

In addition, the Complainant's search on an internet search engine relating to TIRFOR brought back over 57,000 results, most of which referred to the trade mark TIRFOR for the Complainant's handling apparatus.

The Complainant points out that the Respondent does not appear on the internet in connection with either of the trade marks SECALT or TIRFOR, and no link or reference between the Respondent and the trade marks may be found.

The Complainant underlines that the trade marks at issue are the only ones in existence, even for any other types of goods or services in any other sector of activity. The Respondent is not the proprietor of any Community trade marks, International trade marks nor any trade marks in the United Kingdom (the Respondent's apparent domicile).

According to the Complainant, the Respondent has not been commonly known by the domain names, even in the absence of a right.

The Complainant also asserts that the Respondent is not making a legitimate and non commercial or fair use of the Disputed Domain Names, without intent to mislead consumers or harm the reputation of the names on which the rights are recognised.

The Complainant states that it notified its rights to the Respondent via email on 20 July 2006, 15 September 2006 and 18 October 2006,

but no explanation regarding the registration of the Disputed Domain Names was provided by the Respondent.

The Complainant further asserts that the notoriety of its trade marks and the registration of several other domain names by the Complainant or one of its subsidiaries prior to registration of the Disputed Domain Names is further evidence of the Respondent's intention to confuse and mislead internet users.

The Complainant therefore concludes that Article 21(1)(a) of the Regulation related to lack of rights and legitimate interest is fulfilled.

(iii) Registration or use in bad faith of the Disputed Domain Names

The Complainant points out that Article 21(3) of the Regulation reads as follows:

"3. Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where:

(a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name 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; or

(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 or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:

(i) a pattern of such conduct by the registrant can be demonstrated; or

(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or

(iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;

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

(d) the domain name was 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 of a domain name; or

(e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered."

The Complainant points out that it informed the Respondent about its trade mark rights and offered him a chance to explain his conduct, but the Respondent did not reply. The Complainant asserts that it is more than probable that the Respondent had the Complainant’s trade marks in mind when registering the Disputed Domain Names, especially as the Complainant’s trade marks are well known in the sector of interest and the Disputed Domain Names are identical to them. The Respondent was not authorized to proceed by the Complainant and nor was he authorised to use the Complainant’s trade marks.

The Complainant further points out that at the time of the registration of the Disputed Domain Names, the Complainant's trade marks were registered and used in a large number of countries, in particular in Europe. According to the Complainant, the Respondent could not ignore the existence of the trade marks, especially in view of the fact that he is domiciled in the United Kingdom.

In the Complainant's view, bad faith is reinforced by the fact that the Respondent did not reply after having been notified of the Complainant's rights in the terms TIRFOR and SECALT.

The Complainant also asserts that the Disputed Domain Names were registered in order to prevent the Complainant from reflecting them in corresponding domain names, and this behaviour may be considered as a pattern of conduct.

In addition the Complainant asserts that the Respondent has registered the Disputed Domain Names for speculative reasons to prevent it from doing business with its trade marks and to attract internet users to a possible website in the near future.

According to the Complainant, no explanation may be reasonably submitted as to why the Respondent selected the Disputed Domain Names other than to mislead internet users and to create a likelihood of confusion with the Complainant's trade marks and the Complainant's existing websites registered under different extensions.

Finally, the Complainant asserts that the fact that the Respondent is holding the Disputed Domain Names and not pointing them to a website may be considered to be passive use. Such use is in bad faith because it prevents the Complainant from reflecting its trade marks in corresponding domain names.

The Complainant therefore concludes that the Respondent has registered or used the Disputed Domain Names in bad faith, in accordance with Article 21(3) of the Regulation.

B. RESPONDENT

According to the Respondent, the Complainant failed to communicate with the Respondent effectively before initiating the Complaint. On 20 July 2006 and 15 September 2006, the Complainant sent a blank email to the Respondent. On 18 October 2006, the Respondent sent an email to the Complainant stating that only blank emails were received. On the same day the Complainant responded by sending an email stating that the emails that had been sent previously could be found below, but according to the Respondent this was not the case and the email did not contain any further information.

The Respondent therefore asserts that he did not have the chance to respond to the Complainant because he never received a formal complaint.

The Respondent adds that he is nevertheless willing to transfer the Disputed Domain Names to the Complainant if the Complainant signs an agreement in relation to each Disputed Domain Name (attached to the Respondent's Response, together with two invoices), agrees to drop the Complaint and pays the fee of €30 for each Disputed Domain Name.

DISCUSSION AND FINDINGS

Paragraph B11(d)(1) of the ADR Rules ("the Rules") provides that the Panel shall issue a decision granting the remedy requested in the event that the Complainant proves the following:

"(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith."

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has rights recognized by the national law of a European Member State in the trade marks TIRFOR and SECALT. The Panel notes that the SECALT trade marks are in fact owned by Secalt S.A., rather than by the Complainant directly. However the Panel is satisfied on the extensive evidence put forward by the Complainant that Secalt S.A. is in fact a subsidiary of the Complainant and the Complainant can therefore justifiably lay claim to such rights.

The Panel considers that, as previously held in numerous other Panel decisions, the generic top level domain suffix .EU is without legal significance and has no effect on the issue of similarity.

On the basis of these considerations, the Panel finds that the Disputed Domain Names are identical to trade marks in which the Complainant has rights recognized by the national law of a European Member State. Paragraph B11(d)(1)(i) of the Rules is therefore met.

B. Rights or Legitimate Interests

The second element to consider under paragraph B11(d)(1)(ii) of the Rules is whether the Respondent has registered the Disputed Domain Names without rights or legitimate interest in them. Paragraph B11(e) of the Rules sets out various ways in which a Respondent may demonstrate rights or legitimate interest in a domain name, without limitation, as follows:

"(1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law."

The Panel has considered the extensive evidence put forward by the Complainant and considers that the Complainant has presented a clear demonstration of the Respondent's lack of rights or legitimate interest in the Disputed Domain Names. Even though the Respondent filed a Response to the Complaint, it has failed to rebut that demonstration, raising none of the issues referred to in paragraph B11(e) of the Rules, and putting forward no other reasons substantial enough to convince the Panel of its rights or legitimate interest in the Disputed Domain Names.

First, the Respondent argued that it was unaware of the Complainant's grievance before the Complaint was filed, but this is of no relevance to the question of the Respondent's rights or legitimate interest in the Disputed Domain Names, and indeed there is no obligation on a Complainant to notify a Respondent before the actual filing of a Complaint under the Rules. Secondly, in its Response the Respondent offered to sell the Disputed Domain Names to the Complainant and attached two invoices, one for each Disputed Domain Name, together with various terms and conditions pertaining to the proposed sale. The Panel is of the opinion that dealing in domain names may be a legitimate activity, but only when such domain names are clearly generic. The sale of domain names which are identical to distinctive trade marks, as is the case here, cannot be said to be a legitimate activity, even when the sums involved are not particularly significant (in this case, €30 per Disputed Domain Name).

The Panel therefore finds that the Respondent has no rights or legitimate interest in the Disputed Domain Names. Paragraph B11(d)(1)(ii) of the Rules is therefore met.

C. Registered or Used in Bad Faith

The third element to consider under paragraph B11(d)(1)(iii) of the Rules is whether the Disputed Domain Names have been registered or are being used in bad faith. However it should be noted that consideration of this element is not strictly required in this particular instance as it is only necessary for a Complainant to prove either the second element under paragraph B11(d)(1)(ii) or the third element under paragraph B11(d)(1)(iii). In this case the Panel has found that the Respondent has no rights or legitimate interest in the Disputed Domain Names under paragraph B11(d)(1)(ii), thus satisfying the conditions to issue a decision granting the remedy requested. However the Panel will go on to consider the question of registration or use of the Disputed Domain Names in bad faith for the sake of completeness. Paragraph B11(f) of the Rules sets out various circumstances which may be treated by the Panel as evidence of the registration or use of a domain name in bad faith, without limitation, as follows:

"(1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or Community law, or to a public body; or

(2) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:

(i) the Respondent has engaged in a pattern of such conduct; or

(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or

(iii) there are circumstances where, at the time the ADR Proceeding was initiated, the

Respondent has declared its intention to use the domain name, in respect of which a right is recognized or established by national and/or Community law or which corresponds to the name of a public body, in a relevant way but failed to do so within six months of the day on which the ADR Proceeding was initiated;

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

(4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is 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 Respondent; or

(5) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered."

Given the arguments put forward by the Complainant, together with the Respondent's Response offering to sell the Disputed Domain names to the Complainant, the Panel finds that the Respondent registered the Disputed Domain Names primarily for the purpose of selling them to the Complainant. Paragraph B11(f)(1) of the Rules is therefore satisfied. In view of the notoriety of the Complainant's trade marks, the Panel agrees with the Complainant that it is inconceivable that the Respondent was unaware of them at the time of registration of the Disputed Domain Names and could not have chosen them accidentally. The Panel is therefore of the opinion that, in these particular circumstances, and given the distinctiveness of the Complainant's trade marks, there could be no conceivable good faith registration or use of the Disputed Domain names by the Respondent.

The Panel therefore concludes that the Complainant has succeeded in proving that the Disputed Domain Names were registered or are being used in bad faith. Paragraph B11(d)(1)(iii) of the Rules is therefore met.

DECISION

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

PANELISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2007-05-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Panel found that the Complainant had rights recognized by the national law of a European Member State in the trade marks TIRFOR and SECALT. Furthermore, the Panel found that the Disputed Domain Names were identical to such trade marks. Paragraph B11(d)(1)(i) of the Rules was therefore met.

The Panel considered on the evidence put forward by the Complainant that the Complainant had presented a clear demonstration of the Respondent's lack of rights or legitimate interest in the Disputed Domain Names. Even though the Respondent filed a Response to the Complaint, it failed to rebut that demonstration by arguing that it had not been notified of the Complainant's grievance before the filing of the Complaint and offering to sell the Disputed Domain Names to the Respondent for €30 each. In the Panel's opinion the sale of domain names identical to distinctive trade marks could not be said to be a legitimate activity, even when the sums involved were not particularly significant. The Panel therefore found that the Respondent had no rights or legitimate interest in the Disputed Domain Names. Paragraph B11(d)(1)(ii) of the Rules was therefore met.

On the basis of the arguments put forward by the Complainant, together with the Respondent's response, the Panel found that the Respondent had registered the Disputed Domain Names primarily for the purpose of selling them to the Complainant. In addition, the Panel was of the opinion that, in the particular circumstances, and given the distinctiveness of the Complainant's trade marks, there could be no conceivable good faith registration or use of the Disputed Domain names by the Respondent. The Panel therefore concluded that the Complainant had succeeded in proving that the Disputed Domain Names had been registered or were being used in bad faith. Paragraph B11(d)(1)(iii) of the Rules was therefore met.

The Panel therefore ordered that the Disputed Domain Names be transferred to the Complainant.