Panel Decision for dispute CAC-ADREU-004423

Case number	CAC-ADREU-004423
Time of filing	2007-03-27 12:00:00
Domain names	sony-ericsson.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Sony Ericsson Mobile Communications AB

Respondent

Organization / Name	B-D-S, Piotr Marcinski

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 pending or decided legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The present complaint was filed on March 27, 2007 by the Swedish company Sony Ericsson AB (« Sony Ericsson ») and is directed against a Polish individual by the name of Piotr Marcinski which registered the domain name “sony-ericsson.eu” on April 7, 2006. Sony Ericsson relies upon its earlier trademarks and domain names, as well as the worldwide notoriousness of the name Sony Ericsson to sustain that the Respondent cannot have any legitimate interest in the disputed domain name and necessarily acts in bad faith.

Although we the Respondent did not file any response to the Complaint and was thus found in default on June 20, 2007.

The Panel was appointed on July 5, 2007.

A. COMPLAINANT

The Complainant seeks the transfer of the disputed domain name for the reasons below:

1 – The Complainant considers that the disputed domain name is confusingly similar to its trademark « Sony Ericsson » use of which is granted to the complainant by respective holders of the « Sony » and the « Ericsson » trademarks. The complainant claims that following this grant, the trademark « Sony Ericsson » has become highly recognized and has lead to a number of domain names formed with « Sonyericsson » and « sony-ericsson » in a variety of Top Level Domains.

The Complainant cites earlier WIPO and UDRP cases, which all ruled in its favour regarding variations of its trademark used as domain names.

2 - The Complainant claims that the disputed domain name was registered without legitimate interest in that :
- the Respondent has no link of any kind with Sony Ericsson

- the Respondent has not demonstrated any bona fide commercial activity under the name “Sony-Ericsson”

- the Respondent has not demonstrated non-commercial or fair use of the domain name

3 - The Complainant claims that the disputed domain name was registered and is used in bad faith because :
- The name was intentionally used to attract Internet users for commercial gain by creating a likelihood of confusion on a name on which

rights are established.
- The name was registered primarily to be used by the Registrant for its own purposes.
- When asked to transfer, the Registrant claimed the complainant had no right under Polish law, clearly ignoring and disputing the complainant's rights.
- Use of the Domain name by the Respondent renders the complainant's reputation and goodwill out of their control.

B. RESPONDENT

The Respondent did not file any response to the Complaint and was found in default on June 20, 2007.

DISCUSSION AND FINDINGS

Given the facts and arguments of the parties, the Panel should decide whether the conditions of article 21 of Reg. No. 874/2004 are satisfied to decide whether the disputed domain name should be transferred to the Complainant or not.

1) ON THE PRIOR RIGHTS

Pursuant to Article 21. Reg. No. 874/2004, "A registered domain name shall be subject to revocation […] 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."

The Panel finds that the trademark rights vested in the name SONY-ERICSSON claimed by the Complainant are clearly substantiated.

The Complainant justifies that it owns Community trademark registrations for both "SONY" and "ERICSSON" as well as a series of domain names formed with SONYERICSSON. The Complainant also establishes it prevailed in various cases where domain names confusingly similar to SONYERICSSON where at play.

Besides, SONY ERICSSON is the Complainant's corporate name and tradename, under which it has been running its business for many years, as established by the Certificate of Incorporation submitted to the panel.

2) ON THE IDENTITY OR CONFUSINGLY SIMILARITY OF THE DOMAIN NAME

The disputed "Sony-Ericsson.eu" domain name wholly incorporates the combination of both trademarks that the Complainant claims were licensed to it as well as identical to the complainant's corporate name.

It is well-established that the extension of a domain name ".eu" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of the Regulation (EC) No. 874/2004 (cf case No. 00283, lastminute.eu).

The Panel thus finds that the first requirement of Article 21 (1) of the Regulation (EC) No. 874/2004 is satisfied.

3) ON THE LEGITIMATE INTEREST IN THE NAME

"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;

Pursuant to Article 10 of the Regulation (EC) No. 874/2004, the legitimate interest condition is considered as fulfilled when:
a) prior to any notice of an alternative dispute resolution procedure, 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
b) the Respondent has been commonly known by the domain name
c) the Respondent is making a legitimate and non commercial or fair use of the domain name, without intend to mislead consumers or harm the reputation of the name on which a right is recognized.

The Respondent, being in default, has not presented any justification for holding the disputed domain name.

Besides, the Panel observes that the disputed domain name resolves to a virtually empty page only displaying the domain name itself and the email address of the Respondent, lacking any connection with the offering of goods or services.

Additionally, the Respondent cannot claim to be commonly known by the domain name considering sonyericsson.eu – which belongs to the Complainant – has been displayed in various ads in many countries and on the Internet and all lead to the Complainant's sites.

Given the Respondent's site does not contain any information whatsoever, its use of the domain name does not constitute fair use either.

The Panel therefore considers that there is no element in the present case which may be interpreted as justifying a finding that Respondent has any rights or legitimate interests in the disputed domain name.

4) ON THE RESPONDENT'S BAD FAITH

"A registered domain name shall be subject to revocation where it
(b) has been registered or is being used in bad faith."

The Complainant is a major telecommunication company and it asserts that it has been using its corporate name, trade name and trade mark SONY ERICSSON for many years all throughout the world.

The Panel agrees that the notoriousness of the name SONY ERICSSON is indisputable.

Earlier UDRP decisions have confirmed the outstanding notoriousness of the trade mark SONY ERICSSON and its derivatives.

It is the Panel's opinion that the Respondent necessarily had the Complainant's trademark in mind when it registered the disputed domain name for it could realistically ignore that there is only one SONY ERICSSON company in the world and that the name SONY ERICSSON is not free to use.

The Respondent's behaviour does not appear to have been dictated by a bona fide intent to use the disputed domain name, in the Panel's view.

Of true relevance is also the fact that the Respondent did not bother to respond, even if its email address is the same as the one displayed on the web page, to which therefore he presumably wishes to be reachable.

The Respondent has registered as a domain name a trademark which it necessarily knew was not available and did not use it for any specific purpose besides trying to divert Internet users, and quite possibly willing to offer the name for sale. Its resort to a so-called "Polish exception" as to the trademark protection to which the Complainant is entitled is also a clear indication of its disregard for the trademark protection rules and another show of disrespect.

Such a behaviour clearly reveals that the Respondent acted in bad faith when it sought to register the disputed domain name.

For all above reasons, the Panel finds that the Respondent has no right or legitimate interest in the disputed domain name and is further convinced that the Respondent registered the disputed domain name in bad faith.

It does not appear necessary therefore to examine whether the Respondent uses the domain name in bad faith.

5) TRANSFER OF THE DOMAIN NAME

The Complainant is a company incorporated under Swedish law and having its place of business within the European Community. Therefore, the requirements for the requested transfer of the domain name to the Complainant are satisfied (Section B No. 1 (b) (12) of the ADR Rules).

The Panel finds that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002.

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

PANELISTS

Name	**Jean-Christophe A. Vignes**

DATE OF PANEL DECISION 2007-08-03

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 “sony-ericsson.eu”.

The Panel held that the name was identical to the Complainant’s right derived under a licence of trade mark registrations for “Sony” and “Ericsson”.

The Panel held that the Respondent had no rights or legitimate interest in the name. The Panel made this finding based upon the notoriety of the name itself added to the virtual absence of content on the Respondent’s web site or any sign of intended trading activity.

The Panel also found that the Disputed Domain Name had been registered in bad faith because the Respondent could simply not ignore its registration would be infringing rights of the Complainant, and because the Respondent chose not to use its opportunity to provide any explanation that might have led the Panel to think otherwise.

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