Panel Decision for dispute CAC-ADREU-004438

Case number	CAC-ADREU-004438
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Domain names	interactive-brokers.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Interactive Brokers (U.K.) Ltd, Flavio Iten

Respondent

Organization / Name	Georg Gottfried

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

FACTUAL BACKGROUND

1. Georg Gottfried (hereinafter – the Respondent), a resident of Germany, registered the domain name INTERACTIVE-BROKERS.EU on 7 November 2006.
2. The Complainant is Interactive Brokers (U.K.) Ltd (hereinafter – the Complainant) - the company registered in the United Kingdom and using the trade name “Interactive Brokers (U.K.) Limited” in the UK.
3. The Complainant’s affiliate, Interactive Brokers LLC, a company based in the USA, has a valid registration of the Community Trade Mark “INTERACTIVEBROKERS.COM” registered with the Office for Harmonization in the Internal Market (OHIM) (trade mark No. 001313667) and a valid registration of the USA trade mark “INTERACTIVEBROKERS.COM” registered with the United States Patent and Trademark Office.
4. The Complainant submitted a complaint against the Respondent to the ADR Center for .eu, attached to the Arbitration Court attached to the Economic Chamber of the Czech Republic and the Agricultural Chamber of the Czech Republic (hereinafter – the Court) on 24 April, 2007.
5. The Respondent failed to submit a response.

A. COMPLAINANT

7. The Complainant requests that the Respondent “immediately cease using” the disputed domain name and that the domain name be transferred to the Complainant.
8. The Complainant describes itself as the UK based company using the trade name “Interactive Brokers (U.K.) Limited” in the UK. The Complainant also submits that its affiliate – the company registered in the USA - has a valid registration of the Community Trade Mark “INTERACTIVEBROKERS.COM” registered with the Office for Harmonization in the Internal Market (OHIM) (trade mark No. 001313667) and a valid registration of the USA trade mark “INTERACTIVEBROKERS.COM” registered with the United States Patent and Trademark Office.
9. The Complainant contends that the Respondent is aware of the fact the Complainant has been registered since 28 March 2000 (under Company No. 03958476) as a private limited company in the United Kingdom and that the Respondent has been using the Complainant’s name and trade marks without the Complainant’s consent. The Complainant also maintains that the Respondent has registered the domain name “INTERACTIVEBROKERS.MOBI”.
10. The Complainant also adds that the group of companies to which it belongs is in the process of becoming publicly listed on the NASDAQ stock exchange in the USA and is a well-known broker in the US market and in Europe. Therefore, illegitimate use of its intellectual property can cause significant damage.

B. RESPONDENT

12. Despite reminders, the Respondent has not filed a response to the complaint.

DISCUSSION AND FINDINGS

13. In order to render a decision, the Panel has to establish the existence of the conditions set in Article 21(1) of Regulation (EC) No. 874/2004 of April 28, 2004, (hereinafter – the Regulation). It states that:
"1. 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."
14. It is apparent from the above-mentioned provision that in order to succeed with the complaint, the Complainant must prove its right or interest in the name and identity, or similarity, of the domain name to such a name and then, at least one of the two following elements: (a) registration of the domain name without right or legitimate interest; and/or (b) registration or use of the domain name in bad faith.
15. Identity Or Confusing Similarity and Established Rights
16. As mentioned before, the Complainant reasons that it has the right to mark "INTERACTIVE-BROKERS" due to the trade name "Interactive Brokers (U.K.) Ltd" registered Community Trade Mark "INTERACTIVEBROKERS.COM" and the US trade mark "INTERACTIVEBROKERS.COM" (hereinafter the latter two jointly – the Marks).
17. It should be noted that the Complainant is not the registrant and owner of the Marks, but the USA company Interactive Brokers LLC is. The Complainant failed to show its affiliation with Interactive Brokers LLC—but even if it had, that would not qualify as proof of the rights mentioned in Article 10(1) of the Regulation. The USA company Interactive Brokers LLC and the Complainant are two legally-distinct and separate entities, and the rights of one cannot be automatically expanded to another. The Complainant also did not show any contractual relations (e.g., licenses) with Interactive Brokers LLC, which could give it any rights to the Marks.
18. For this reason the Panel states that the Complainant has not proven the right to the mark "INTERACTIVE-BROKERS" based on the Marks.
19. The Complainant also argues that it has the right, such as the rights mentioned in Article 10(1) of the Regulation, by virtue of the trade name "Interactive Brokers (U.K.) Ltd" and submits a copy of the Companies House webpage.
20. Indeed, the trade name and/or company name may amount to a prior right under the meaning of Article 10(1) of the Regulation if it is protected under the national law of the UK. Whereas a trade name may qualify for protection in the UK under its passing off doctrine, the Panel finds that the trade name "Interactive Brokers (U.K.) Ltd" is a recognizable right under the meaning of Article 10(1) of the Regulation.
21. Having acknowledged that, the Panel has to decide whether the disputed domain name is identical or confusingly similar to the Complainant's trade name.
22. The Complainant's trade name "Interactive Brokers (U.K.) Ltd" consists of the words "interactive" and "brokers". The Panel purposely omits the "(U.K.)" and "Ltd" parts of the name, as the latter indicates the form and the former the place of the economic activity of the legal entity, and are therefore excluded from the comparison.
23. The disputed domain name also consists of two words - "interactive" and "brokers" - separated by a dash. The .eu suffix is also excluded from the comparison, as being just an indicator of a TLD zone.
24. Having compared the visual, aural, and conceptual aspects of the Complainant's company name and the disputed domain name, the Panel finds them not identical, but similar. The Panel also believes that such similarity is confusing.
25. For the purposes of Article 21(1), the Panel decides that the disputed domain name is confusingly similar to the name in respect of which the Complainant's rights are recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), namely – a trade name.
26. Absence Of Legitimate Interest Or/And Registration Or Use In Bad Faith
27. Having found the confusing similarity and established rights, the Panel has to address the question of existence or absence of legitimate interest, or registration, or use in bad faith, as set out in Article 21(1)(a) and 21(1)(b) of the Regulation.
28. Existence or absence of legitimate interest
29. The list of cases such as how the legitimate interest may be demonstrated for the purposes of Article 21(1)(a) of the Regulation is given in Article 21(2). At least one of the listed occurrences is enough to satisfy the legitimate interest requirement.
30. The Panel finds that the Respondent has registered the disputed domain name with legitimate interest, which is defined in Article 21(2)(c) of the Regulation, i.e. "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".
31. The Panel draws this conclusion after evaluating the distinctive features of the disputed domain name and its relation to the recognized right of the Complainant: First of all, the words "interactive" and "brokers" (and the combined phrase "interactive brokers") lack distinctiveness. The primary activity of the Complainant, as stated in the complaint, is financial services and brokering; and so, the phrase "interactive brokers" directly describes its business.

32. However, the words “interactive” and “brokers” (and the combined phrase “interactive brokers”) are generic. Therefore, the Respondent has the same right and interest to register and use them as does the Complainant. It would be unfair to grant such a right and monopoly to the Complainant.
33. Therefore, the Panel believes that the Respondent could be making a legitimate and non-commercial or fair use of the domain name and that falls within the meaning of legitimate interest.
34. Having found that at least one requirement of Article 21(2)(c) is satisfied, the Panel considers it unnecessary to examine the others.
35. Registration or use in bad faith
36. Another ground for revocation of the registered domain name is when it has been registered or is being used in bad faith. The meaning of “bad faith” is described in Article 21(3) of the Regulation. At least one of the mentioned occurrences is enough to satisfy the bad faith test.
37. As to this, the Respondent published an announcement on the website available through the disputed domain name, stating his intention to sell the disputed domain name. The announcement contains the text “Buy this domain. The domain interactive-brokers.eu may be for sale by its owner!” And, there is the link to the website of Sedo GmbH (www.sedo.com) – the company primarily involved in domain trading and offering such services to subscribers. This proves the intention of the Respondent to sell the disputed domain name.
38. Furthermore, the disputed domain name has not been used in a relevant way by the Respondent. The disputed domain name directs viewers to the website where the links to other websites are placed.
39. In addition, the disputed domain name is parked with Sedo GmbH (www.sedoparking.com). Parking the domain name within the domain selling website may serve as evidence that the Respondent had no intention to use the disputed domain name in any other way than selling.
40. Therefore, the Panel decides that the Respondent has registered and used the disputed domain name in bad faith.
41. Findings
42. The disputed domain name, which is confusingly similar to the Complainant’s trade name, has been registered and is used by the Respondent in bad faith within the meaning of Article 21(3) of the Regulation.
43. For these reasons, the Panel finds that the complaint relating to speculative and abusive registrations set out in Article 21 of the Regulation is justified. The Complainant satisfies the general eligibility criteria set out in Article 4(2)(b) of the Regulation (EC) 733/2002 and, accordingly, the Panel directs that the domain name to be transferred 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 INTERACTIVE-BROKERS be transferred to the Complainant.

The decision shall be implemented by the Registry within thirty (30) days of notification of the decision to the parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction.

PANELISTS

Name	**Andrius Iskauskas**

DATE OF PANEL DECISION 2007-07-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, the UK based company Interactive Brokers (U.K.) Ltd, claims a right to the domain name INTERACTIVE-BROKERS.EU, registered by the Respondent, Georg Gottfried, on 7 November 2006. The Complainant argues that it has the right to mark “INTERACTIVE-BROKERS” due to the trade name “Interactive Brokers (U.K.) Ltd,” a registered Community Trade Mark “INTERACTIVEBROKERS.COM,” and the US trade mark “INTERACTIVEBROKERS.COM”. The Complainant alleges that the disputed domain name is confusingly similar to its recognized and established right.
The Respondent has not filled its reply to the Complaint.
The Panel applied the test provided in Article 21 of the Regulation (EC) No. 874/2004 of April 28, 2004, and came to the conclusion that:
a. The Complainant cannot rely on the Community Trade Mark “INTERACTIVEBROKERS.COM” and the US trade mark “INTERACTIVEBROKERS.COM,” as they are owned by a separate legal entity - the US company Interactive Brokers LLC;
b. However, the Complainant’s trade name amounts to a prior right under the meaning of Article 10(1) of the Regulation as it is protected under national law;
c. The visual, aural, and conceptual aspects of the Complainant’s company name and the disputed domain name make them confusingly similar but not identical;
d. The disputed domain name has been registered and used in bad faith, as the Respondent registered the domain name and is using it primarily for the purpose of selling it.

For all the aforesaid reasons, the Panel orders that the domain INTERACTIVE-BROKERS.EU be transferred to the Complainant.