Panel Decision for dispute CAC-ADREU-004526

Case number	CAC-ADREU-004526
Time of filing	2007-06-04 10:29:54
Domain names	placement.eu, emprunt.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Mr. Didier MOTTE

Respondent

Organization / Name	Ovidio Limited

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

There are no other legal proceedings of which the Panel is aware that are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Respondent registered the domain names “EMPRUNT” and “PLACEMENT”with Eurid on 12 December, 2006, thus after the end of the Sunrise Phase.

A complaint has been lodged on 30 May, 2007 by Complainant, owner of a 2 Benelux word/image trademark registrations: “€mprunt be” (0709652) and “Placement.Be” (0765735) for services in classes 35, 36 and 38. Complainant had applied for the domain names in dispute during the Sunrise Phase, but its applications were rejected.

On its websites, the Respondent currently uses a domain parking system, operated by Sedo GmbH, Germany. It presents several links to other websites, some of them related to the term “emprunt “, which is French for ”loan” respectively, the term “placement”, which has – among many others – the meaning of “the act of an employment office or employer in filling a position” both in English and in French.

The Complainant requests the Panel to decide:

Transfer of the domain names EMPRUNT and PLACEMENT to the Complainant.

A. COMPLAINANT

The Complainant is of the opinion that the registration of the disputed domain names by the Respondent violates Art. 21 of the EC-Regulation 874/2004 as:

- the domain names are identical or at least confusingly similar to its trademarks,

- the Respondent has no right or legitimate interest in the domain names;

- the Respondent uses the domain names in bad faith.

The Complainant states in particular that the Respondent is not making a legitimate and non-commercial or fair use of the domain names. It is, on the contrary, making a commercial use by advertising links to commercial third-party sites, some of which are operated

by competitors of the Complainant.

The Respondent's use of the domain names is not a bona fide use in connection with the offering of any goods or services. The Respondent does not, in fact, use the domain names to offer any goods or services at all. It merely provides links to third-party websites, to gain income from the number of visitors who are forwarded to those sites.

With respect to bad faith, Complainant states that the Respondent uses the domain names registered for "Direct Navigation" purposes. This system is used to generate traffic. When accessing the domain, the visitor is confronted with a list of sponsored links.

Finally, the Complainant stresses that the Respondent registered the domain names primarily for the purpose of unfairly disrupting the business of the Complainant. The Respondent uses the domain names to provide links to competitors of the Complainant in regard to the provision of loans, financial services and financial assistance.

Moreover it is argued that the Respondent registered the domain names to block the Complainant's trademarks, in order to selling, renting or otherwise transferring it to the Complainant at a latter stage. The Respondent's registration inevitably blocks the Complainant from reflecting its own brand name in a .eu domain name.

The Complainant satisfies the general eligibility criteria for registration set out in Article 4(2)(b) of Regulation 733/2002/EC, as established by the several annexes attached hereto.

B. RESPONDENT

The Respondent states the following :

The Complaint is based upon two highly-stylized graphical marks, that cannot constitute a
legally enforceable prior right in regard to the specific words in question (i.e. "emprunt" and "placement"). The words claimed are in fact descriptive and
no trademark would have been registered for their text equivalent.

The Complainant has failed to prove that Respondent's registration of the domain names
Emprunt.eu and placement.eu is speculative or abusive within the
meaning of Article 21 of the EC Regulation No. 874/2004 ("Article 21").

• The Complainant holds only highly-stylized figurative marks that are neither
identical nor confusingly similar to the domain names;
• The domain names are generic and descriptive terms. "Emprunt" means
loan in French and "Placement" refers to (amongst other things) "the act of
an employment office or employer in filling a position";
• A trademark for the text equivalents of the marks would be invalid;
• The domain names were registered during the public Landrush period
because they were generic and descriptive terms and each is being used in
its descriptive sense;
• Both the Paris Convention and the European Directive on Trademarks
permit Respondent's use and expressly prohibit Complainant from
interfering with such use; and,
• Complainant's assertion that Respondent intends to sell the Domain
Names is false;
o The Respondent has never intended to sell domain names;
o The Respondent has never sold a domain name;
o The Complainant offered to purchase the domains in December 2006
and was rejected as a matter of policy.

The Respondent is a Cypriot corporation and satisfies the residential requirements necessary for holding .eu domain names. The Respondent has made a serious and substantial investment in the .EU tld for legitimate business reasons. It is not a cybersquatter and does not seek to register or profit from typos or trademarks held by others.

The Respondent offers a platform of integrated performance-based search services providing both content and advertising to the European Internet user community. The Respondent's websites include over 900,000 pages of substantive content (not including

advertisements links). Its platform provides valuable information to users and enables merchants to simultaneously market and sell products and services across multiple distribution channels, including search engines, portals, product shopping engines, directories, and selected Web sites. The Respondent's services are "localized" in the European Community and provided free of charge to Internet Users. The service is provided in multiple languages – the systems currently support 12 of the official EU languages. Websites are rendered both (a) in the language of the actual user, and (b) contain content intended to be relevant to users at their actual location.

The Respondent began its project in early 2006 and began registering domain names in April 2006 during the .eu public Landrush. The Respondent has only registered .eu domain names that are publicly available for registration. The Respondent did not participate in the Sunrise process.

The Respondent has developed an automated computer system which it uses to identify generic or descriptive terms that could serve as likely "keyword" search phrases. The system operates in part with a focus towards words that have been the subject of keyword searches in Google, Yahoo, and other search engines. Words with high search traffic are initially selected whereafter the system then attempts to remove terms that correspond to known trademarks or famous names. Resulting domain names are registered for use in the Respondent's business. Because of the nature of the Respondent's business model, it does not attempt to register domain names that have little or no contextual meaning as a likely search phrase for end-users.

The Respondent has written over 90 separate software programs (not including commercial software acquired) representing well over 10,000 lines of complex coding. The programs work together and form the key component in the Respondent's overall computer system.

The Respondent does not advertise its domain names or websites but instead relies upon what is known as "Direct Navigation" to attract its users. Both substantive content and advertisements are contextually related to the words forming the domain names. Direct Navigation is a recognized method used by approximately 15% of all Internet users to locate information on the Internet. Using this process of Direct Navigation, users type a constructed search phrase in the form of a domain name directly into the browser instead of using a search engine such as Google. Direct Navigation provides a user with more relevant content free of charge. Direct Navigation has been repeatedly approved as a legitimate use in various WIPO decisions.

The Respondent does not park its domain names. The Respondent's use is much more sophisticated than the basic Direct Navigation process and both its systems and development program show that Respondent does not merely register and park domain names. The services of Sedo, Google and others are only a shrinking part of the overall business model.

The Respondent requests that this Panel not consider exhibits and references which are not provided in English or that the Panel order the Complainant to provide a true and accurate translation of any non-English documentation or reference in the Complaint. (ADR Rules §A(3)(c)).

DISCUSSION AND FINDINGS

A claim for the transfer of the domain names to Complainant can only be granted in case the requirements of Article 21.1 of the EC Regulation No. 874/2004 (Speculative and abusive registrations) are complied with and Complainant is eligible to register .eu domain names acc. to Article 4.2 b) of the EC Regulation No. 733/2002 (see also Paragraph B.11(b) ADR Rules).

1. The Complainant has proved that it is the owner of the Benelux trade marks right "€mprunt" 0709 652 and "Placement.be"0765 735. Such trade mark rights are rights acc. to Article 10.1 of the EC Regulation No. 874/2004.

As the trademarks are word/image trademarks, the question arises, whether such trademarks grant protection with respect to the individual terms "emprunt" and "placement". The Respondent has argued that such terms are descriptive, and that the terms themselves would not have been registered as trademarks because of their alleged descriptive character. The Respondent comes to the conclusion that in such a case, the word/image trademark would not grant protection with respect to the individual terms "emprunt" and "placement" and provide a right according to Article 10.1 EC Regulation No. 874/2004.

Both trademarks are registered for services in classes 35, 36 and 38. The Panel accepts the excerpts from the Benelux Trademark register provided by the Complainant, without requesting a translation. Although the excerpts have not been presented by Complainant in the language of the proceeding (English), but have been presented in French, the Panel is not hindered to accept the evidence (A 3 (c) ADR-Rules), as such rule only allows, but not requires the Panel to disregard such proof (cf. ADR 52 "YOGA"; 910 "REIFEN").

2. The trademarks are not merely composed ot the two terms in question ("emprunt and "placement"), but contain further elements such as simple figurative elements, the terms ".Be"/"be" and, in case of "€mprunt be", the "Euro-symbol" and the term "www.emprunt.be" in small letters. Therfore, it has to be ascertained, whether, the Complainant can assert rights with respect to the domain names in dispute, basing its claim on the corresponding individual terms included in the trademarks.

The global appreciation whether the domain names are confusingly similar to the trademarks in question must be based on the overall impression created by the trademarks, bearing in mind, in particular, their distinctive and dominant components. In the case at hand the Panel is of the opinion that the terms "Emprunt" and "Placement" are the most distinct and dominant elements of the trademarks in question dominating the overall impression of the signs. The "Euro-symbol "€" in "€mprunt" will be easily read as "E" and the "be" as well as the "www.emprunt.be" will be regarded as not dominating the trademark, as they both indicate that the term "emprunt" is related to the internet. The same applies with respect to the ".Be" in "Placement.Be". The addressed market will easily understand this suffix as the top Level Domain of Belgium. Therefore, the Panel is of the opinion that the Complainant may successfully assert rights based on the terms "emprunt" and "placement", provided that such terms are not merely descriptive.

In view of the Panel, the assumption that the terms contained in the trademarks are of a merely descriptive character is not correct. As said, the trademarks are, besides others, protected for services in class 38, such as "services telex, telégraphiques, téléphoniques, radiotéléphoniques et radiotelégraphiques (€mprunt) and telecommunications (Placement.Be). Complainant's trademarks would only grant no protection at all in the event that they were descriptive for all goods and services they are registered for. Thus, the Panel must accept the Benelux registrations, and the fact that the terms "emprunt " and "placement" grant trademark protection and form a right as requested by Article 21.1 EC Regulation No. 874/2004.

3. For the above reasons, the terms "emprunt" and "placement" included in the registered trademarks are identical and the trademarks are confusingly similar to the Respondent's domain names "EMPRUNT.eu" and "PLACEMENT.eu". The suffix ".eu" is to be disregarded in this respect (see also ADR 475 "HELSINKI"; 387 "GNC"; 596, "RESTAURANT").

4. The Complainant has argued that the Respondent has no rights or legitimate interests in the domain names. The burden of proof in this regards is on Complainant's side (see also ADR 1304 "KEMET", 2929 "SOFTAGE" with further citations). However, facts need only to be proven, in so far as they are not in dispute. By Annex B Respondent has provided printouts of the websites "emprunt.eu" and "placement.eu", proving that they are currently parked with the Internet service provider Sedo and display several links to other websites, some of them (but not all) being related to the terms "emprunt" and "placement" respectively.. Therefore, the actual content of these websites and use of the disputed domain names is not disputed.

The Respondent claimed to have made legitimate use of the domain names. However, the aforementioned use can not in itself establish a legitimate interest acc. to Article 21. 2 (c) EC Regulation No. 874/2004. It is commonly known that these parking systems are offered by the internet service providers in order to offer the domain name holder profit by way of pay-per-click revenues (cf. ADR 2727 "STAEDLER") and therefore
solely as alternative to the "site under construction" design.
Several Panels have decided in other proceedings that such use as such is no fair use under Article 21. 2 (c) EC Regulation No. 874/2004 (ADR 3976" ABAT", 4337 "ENTERPRISECARRENTAL", 3949 "ACL", 2381 "HAJI"). The Panel refers to these decisions and agrees with them also regarding the circumstances of the present case.

Furthermore, the Respondent has also claimed that it intends to add significant content to the domain names in question via its so called Direct Navigation system that it already uses on other websites. However, in the opinion of the Panel, these mere allegations cannot be regarded as sufficient to comply with the prerequisites of Article 21.2 (a) EC Regulation No. 874/2004 since a preparation to offer goods or services for these domain names has not been demonstrated. Mere allegations and the fact that such (different) content has been provided on other sites, does not prove at all that Respondent intends to place the same content on the sites under the disputed domain names.

Further, the Respondent is not commonly known under the domain names Article (21.2 (a) EC Regulation No. 874/2004) and no further indications of rights or legitimate interests according to Article 21. 1 EC Regulation No. 874/2004 have been presented.

Therefore, the Panel is of the opinion that the Respondent does not have any rights or legitimate interests in the domain names.

5. Consequently, the Panel did not have to decide, whether the Respondent registered and/or used the domain names in bad faith.

6. Finally, the Panel verified that the Complainant, being a natural person, domiciled in Belgium, also satisfied the criteria for eligibility for a .eu domain name as set out in Article 4 (2) (c) of Regulation (EC) No. 733/2002.

7. Accordingly, the Panel ordered the transfer of the domain names “EMPRUNT.eu” and “PLACEMENT.eu” 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 PLACEMENT, EMPRUNT be transferred to the Complainant

PANELISTS

Name	**Dr. Tobias Malte Müller, Mag. iur.**

DATE OF PANEL DECISION 2007-09-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the owner of two Belgium word/image trademarks “€mprunt be” and “Placement.Be”, which are registered for services in classes 35, 36, and 38. The Respondent registered the domain names “EMPRUNT” and “PLACEMENT”with Eurid on 12 December, 2006, thus after the end of the sunrise phases.

On the websites, the Respondent currently uses a domain parking system, operated by Sedo GmbH, Germany. It presents several links to other websites, some of them related to the term “emprunt “, which is French for ”loan”respectively, the term “placement”, which has – among many others – the meaning of “the act of an employment office or employer in filling a position”both in English and in French.

The Complainant requests the Panel to decide to transfer the domain names EMPRUNT and PLACEMENT to the Complainant.

The Complainant doubts the existence of rights or legitimate interests of the Respondent in the domain names. The Respondent argues that the trademarks, particularly the terms “emprunt” and “placement” are of descriptive character, and do, therefore, not entitle the Complainant to request the domain names. The Respondent maintains that it intends to provide the websites under the domain names with content related to the terms “emprunt” and “placement”.

The Panel is of the opinion that neither the trademarks nor the terms included (“emprunt” and “placement”) are of mere descriptive character for all services the trademark is registered for. Further, the terms “emprunt” and “placement” both dominate the overall impression of the trademarks. Therefore, the Complainant may assert its rights based on the terms “emprunt” and “placement”, successfully.

As the Panel decided not to regard the content on the websites as establishing legitimate and non-commercial or fair use, nor as use of the domain names in connection with the offering of goods and services nor demonstrable preparation to do so, and as, further, there are no other indications in this respect, the Panel is of the opinion that the Respondent has no rights or legitimate interests to hold the domain names in question.

Therefore, the Panel has decided to transfer the domain names to the Complainant.