Panel Decision for dispute CAC-ADREU-004560

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Case administrator

Name	Josef Herian

Complainant

Organization / Name	My Home Limited, Mr. Jim Miley

Respondent

Organization / Name	MyHome S.A., Jean-Michel Gathon

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 that are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

In this proceeding, the Complainant is My Home Limited, a company incorproated in Ireland, the Respondent is My Home SA, a company incorporated in Luxembourg, and the disputed domain name is "myhome.eu". In addition the Complainant is known by its trade mark and domain name, "myhome.ie". For ease of reference therefore, references to the parties may include their place of incorporation or "nationality".

Myhome.eu was registered to the Respondent during the second part of phased (or "sunrise") registration as provided for by the Regulation 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration ("the .eu Regulation").

Separately, the Complainant had made two successive applications during the Sunrise period, but these were declined on the grounds of administrative deficiency. No administrative or other proceedings were initiated against the Registry with regard to registration.

After the Complaint and Responses were filed, the Complainant sought and was granted leave to file a Rejoinder. Thereafter, the Respondent sought and was granted leave to file a Further Response, with the Complaint offered a further opportunity to reply.

This dispute turns on points of fact, upon which I, as the Panel, have to make findings, and on interpretation of the .eu Regulation.

A. COMPLAINANT

1. The Complainant.

The Complainant was incorporated in Ireland on 3rd August 2000 under the name Myhome Limited. It has traded in this name since incorporation.

Its primary business is the operation of a wholly Internet-based property and home services portal using the domain name myhome.ie, as well as other related businesses and websites, including www.myhomecommercial.ie, www.myhomeshop.ie, www.myhome2let.ie and www.myhomemortgage.ie. It claims to be Ireland’s leading property and homes website, and can testify to more than 1,000 estate agents (auctioneers) listing residential and commercial property for sale or lease on the website on a daily basis. In April 2007, over 480,000 unique users visited the site. In addition to being the market leader in residential property listings in Ireland, myhome.ie also offers advice and news related to the property market with advice and tips for home improvements and renovations.

2. The Disputed Domain Name

The Complainant had originally attempted to register the disputed domain name itself, but found that its application was rejected on grounds of administrative deficiency. So it then sought to purchase the domain name from the Respondent, and made an offer based on its pre-estimate of the reasonable costs incurred by the Respondent.

3. The Complaint

The disputed domain name is identical or confusingly similar to a name in which it has national or Community legal rights and was either registered to the holder that did not have any rights or legitimate interest in the name, or has been registered or is being used in bad faith.

4. The Complainant's Rights

The Complainant owns the Irish registered trade mark MYHOME.IE in respect of the advertising and promotion of property sales and rentals and other matters. The trade mark was registered on 1st December 2000 under Irish Trade Mark Registration Number 221381. A copy of the Complainant's Trade Mark registration from the Irish Patents Office is supplied. It avers that the trade mark has been used by the Complainant since it first began operations in the year 2000 and has become synonymous with the Complainant and its operations since the myhome.ie website was launched in February 2001. The Complainant states that it has made a substantial investment in developing and providing its services and has acquired a tremendous amount of goodwill and brand identity through its operations and trading.

The Complainant's contends that its Irish trade mark rights establish a "prior right" in accordance with Article 10(1) of the .eu Regulation.

It further contends that its trade mark rights in myhome.ie are identical to the disputed domain name. In this regard, it points to the convention of disregarding Top Level Domain suffixes that are incorporated into registered trade marks when assessing the similarity of those legal rights to domain names. When the correctness of this convention was challenged by the Respondent, the Complainant, in its Rejoinder, cited the decision of the Panel in Case No. 00283 (lastminute.eu) that re-affirmed an established principle that the Top Level Domain extension of a domain name does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

It also cites WIPO Case No D2004-0508 (littlehousecompany.com) wherein the Panel observed that differences between the Top Level Domain suffixes of two or more domain names and trademarks are insignificant when considering whether or not a trademark infringement has occurred.

5. The Respondent's Rights and Legitimate Interests

The Complainant contends, for several reasons, that the Respondent does not have any rights in law or legitimate interests in the disputed domain names

Firstly, it avers that the Respondent has not used the disputed domain name or a name corresponding to it in connection with the offering of goods or services, nor made any demonstrable preparations to do so.

It points out that for some time the Respondent maintained a webpage, resolving to myhome.eu that acted as a portal with links to a number of other sites on it. These links were almost exclusively to Irish property-related sites, most of which are direct competitors of the Complainant's business, although it specifically contained link to the Claimant's website, myhome.ie. According to the Complainant, this unauthorized link to its website did not appear on the homepage to myhome.eu, but rather was through a link from the homepage to a sub-page of its own site.

The Complainant adds that, in consequence of being put on notice of its intentions to purchase the disputed domain name, the Respondent "foresaw the likelihood of a challenge to its ownership through the ADR procedure", and so replaced the portal with a link to the home page of a-syst.com. It avers that this new homepage does not represent any new offering of goods or services, or any demonstrable preparations to do so by the Respondent, but is "a thinly veiled effort to disguise its lack of a legitimate interest".

Secondly, the Complainant contends that the Respondent is not an undertaking, organization or natural person commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law. In support it has reproduced, in exhibit form, the results of an internet search against the term “myhome” which, it points out resulted in no references to any services or goods being offered by the Respondent; meanwhile, a search for “MyHome SA” and “MyHome S.A.” on the same internet search engine revealed just ten hits, most of which did not relate to the Respondent’s undertaking. Finally, it states, other extensive searches on the Internet failed to produce evidence of the Respondent’s common usage of the “MyHome” name as a trading name. In its final analysis, the Complainant submits that the Respondent is clearly not an undertaking, organization or natural person commonly known by the domain name.

Thirdly, the Complainant asserts that the Respondent is not making a legitimate and non-commercial or fair use of the disputed domain name, or if so doing, in a way that is without intent to mislead consumers or harm the reputation of the names on which the rights are recognized.

In this regard, the Complainant points out that in actual fact the Respondent is not now making any practical use of the disputed domain name, but is instead using myhome.eu as a link to an IT-outsourcing website run by A-Syst SA. In the Complainant’s view, myhome.eu clearly has no relation at all to the business of IT-outsourcing.

Furthermore, the Complainant submits the Respondent’s earlier use of the domain name was in fact a blatant intent to mislead consumers and to harm the reputation of the Claimant by using the domain as an Irish property portal site, under the banner of “The Best my home Resources and Information”. This, the Complainant cites was clear attempt to mislead consumers both in Ireland elsewhere as it was attempting to benefit from the goodwill established by the Claimant in that brand in Ireland by using an identical name. In this regard, it observes that the nationality and dialect of a Mr. Doyle – who was the person representing the Respondent during the initial negotiations are relevant. According to the Complainant Mr. Doyle is almost certainly an Irish citizen, judging by his name and his accent, and it is inconceivable that he would not have been aware of the myhome.ie domain and trade mark at the time of registering the domain.

In its Rejoinder, the Complainant dealt further with these matters. It points to discrepancies between what was said in person or writing and what can be shown to be case. For instance, the Respondent is quoted as saying that the Respondent has put “considerable effort into the website, documentation and logo” whereas there is no evidence that any website has been developed or displayed, and indeed the Complainant points to an admission by the Respondent that it has not been able to spend the necessary time, energy and allocate other resources to the business developed around the disputed domain name.

Further, it points out that the creation of an incorporated company with legal personality with a name that is the same as a disputed domain name does not amount to demonstrable use of that name. It avers that the Luxembourg company was incorporated for the sole purpose of registering the disputed domain name, which (it says) is a common practice of cyber-squatters, and in support it points out that the Luxembourg company is not commonly-known by its name.

6. Registration or use in bad faith

The Complainant avers that one or more of the scenarios of bad faith in Paragraph B(11)f are made out in support of its submission that the disputed domain name was registered or has been used in bad faith.

Firstly, the Complainant relies principally on the exchange of correspondence (emails) between the parties prior to commencement of this administrative proceeding as evidence that the disputed domain name was registered for the purpose of selling it to someone with rights to it.

(The Panel notes that there are some issues of fact that turn on what was said and when, so it is appropriate to recite the salient elements of the negotiations.)

The Complainant originally attempted to contact the Registrar’s contact on 3 May 2007 with a view to acquiring the domain name from the Respondent. Its email received a bounce-back from the registrar’s email address indicating that the recipient’s address had rejected the email. A further email was transmitted on 24 May 2007 to the registrant (recorded as a Mr. Jean-Michel Gathon in the Whois section on the EURid website) and once again received a bounce-back from the registrar’s email address indicating that the recipient’s address had rejected the email

On 4 June 2007, the Complainant received an email from Mr. Brian Doyle of A-Syst SA, in response to its email to the registrant advising that he was “responsible for the MyHome project and the associated domain name”. He advised the Complainant to “make a proposal for the transfer”. The following day the Complainant offered, in writing, €1,000 to €2,000 subject to the costs involved for the Respondent in registering the disputed domain name. Mr. Doyle responded that the matter had been discussed and the Respondent did not want to release the domain as they had “put considerable effort into the web site, documentation and logo.”

Over the following days, further contact was established by telephone, during which Mr. Doyle is reported to have said that the domain would be used as a portal site for many different businesses, and that the chances of them selling the domain were slim. However, he did advise that his team were meeting the following day (7 June 2007), and that “he would inform the team that another party was interested in acquiring the domain.”

Apparently subsequent to that meeting, Mr. Doyle reverted by email on 7 June 2007, stating that there was “some effort required to remove the name but it can be done”, but noting that it is “a very good name to have and that [he] should approach these companies who may be interested in it and also those individuals who applied for this name in the past”. He concluded by saying that he “will put it up for general sale some time and when [he does he] will notify [the Complainant]”.

In the Complainant’s submission, the emails from Mr. Doyle of 4 and 7 June 2007 clearly indicate that the Respondent was willing to sell the domain name if offered the right price, whereas the outright rejection of the monetary offer (some 17 minutes after it was made) suggests that the Respondent was intent on getting a much higher fee for the domain. Further, the Complainant contends that the email from Mr. Doyle of 7 June 2007 clearly indicates that the Respondent is intent on selling the domain name to the highest bidder.

In support, the Complainant cites Case No. 04015 (tirfort.eu) Czech Arbitration Court which reiterates that “dealing in domain names may be a legitimate activity, but only where 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”. As such, the Complainant adds that the offering for sale of the myhome.eu domain by the Respondent cannot be seen to be a legitimate activity, but is instead evidence of registration or use in bad faith; the registration was clearly in bad faith and for purely speculative reasons.

Secondly, the Complainant contends that the Respondent clearly engaged in such a pattern of conduct in order to prevent the Claimant from acquiring or operating the domain name. This is, it states, evidenced by the fact that the Respondent, was clearly aware of the link between the domain and the Complainant, and operated the domain in such a way as to penetrate the Irish property market. The Complainant adds that there is no evidence that the domain has ever been used in a relevant or legitimate manner by the Respondent. It was used in an illegitimate manner that was intentionally identical or confusingly similar to the services being offered by the Complainant through its myhome.ie domain. The change of home page to that of the pre-existing a-syst.com domain does not represent a new-found intention to use the domain name for any legitimate purposes. It merely reflects a badly-disguised effort by the Respondent to appear as if it is making some meaningful use out of the domain name, presumably in anticipation of a challenge to its registration of the disputed domain name.

Thirdly, the Complainant avers that it is obvious that the disputed domain name was registered primarily for the purpose of disrupting the professional activities of the Complainant because the evidence is that that the Respondent used the domain as a portal site for Irish property-related activities, and even linked indirectly to the Complainant’s own website.

Finally, the Complainant contends that there is no doubt but that the domain name was intentionally used to attract Internet users for commercial gain to the Respondent’s website. The Respondent’s use of the name was exclusively for the purpose of creating a likelihood of confusion in the Irish property market between myhome.eu and the hugely successful and highly regarded myhome.ie brand. The Complainant believes that the Respondent obviously had the Complainant’s trade marks in mind when registering the disputed domain name, especially as the Complainant’s trade mark is well known in the sector of interest and the disputed domain name is identical to it. In this regard it is completely inconceivable that Mr. Doyle, who is almost certainly an Irish citizen who is in charge of the Respondent’s “project”, was not aware of the existence of myhome.ie. However, the Complainant concedes that it is not clear whether the Respondent in fact realised any commercial gain through the website, though, points out that, as with most portal sites, it was clearly their intention to achieve such a commercial gain at some future point (if not already doing so) through advertising and selling of prime space on the homepage.

Later in the Rejoinder, the Complainant deals with points that were not apparent to the Complainant at commencement.

Firstly, it avers that evidence of the Respondent’s bank accounts and leases involving a property owned by the Respondent does not demonstrate that it has conducted a genuine business activity under the disputed company name or domain name

Secondly, the Respondent's had explained that it was not responsible for the so-called Irish property portal content, but that this provided for by its Registrar without its knowledge. In response the Complainant refers to the standard terms of EuroDNS (the Registrar of the disputed domain name), which the Respondent is contractually bound to have acknowledged, which allows EuroDNS to display web pages at its discretion, offer various services and contain advertising.

In the Complainant's submission, the Respondent must be held responsible for this content. In particular, the Complainant argues in the Rejoinder:

"… the entire ADR system is predicated on the basis that the Registrant (who is referred to as the "Respondent" in the ADR Rules) is the person ultimately responsible for what appears on its domain name. If the Panelist allows the Respondent to abdicate its responsibility in this instance by denying liability and passing the buck to the Registrant (the Respondent's agent, who in turn passes the buck back to the Respondent in its Terms and Conditions, and to an unnamed third party now on the Domain Name), the entire ADR system will be thrown into disrepute. If this defence was permitted, no doubt, future "Respondents" could similarly acquiesce while infringing materials were placed on their websites, and then simply claim that they had nothing to do with the content, thereby avoiding the application of the ADR Rules."

B. RESPONDENT

1. The Respondent

The Respondent is a société anonyme incorporated on 13 October 2005 under Luxemburg law with the name Myhome S.A. Following incorporation, the name MYHOME was added to the Luxemburg trade and company name register on 2 November 2005, with the registration number B111415.

By Article 3 of its articles of association the Respondent's activities consist in managing private patrimony including real estate. The initial business idea behind the creation of the company hinged upon short term business support services, namely: serviced offices, secretarial support, IT support, apartments for short-to-medium rental. MYHOME was adopted as a brand name because it implies a home provided to companies/professionals where they can carry out their activities. The concept borrows from the "formula consisting of "My + [word]" [that is] highly popularized through operating systems/computer programs such as Windows."

2. The Disputed Domain Name

The Respondent applied for the domain name myhome.eu on 9 February 2006, during the second part of the sunrise period. It acted through EuroDNS S.A, an accredited registrar. The prior rights relied upon was its company name registered in the Luxemburg trade and company name.

The relevant documents were delivered the Registry on 23 February 2006, and on 22 September 2006 the domain name was been granted to the Respondent.

The Respondent has no other domain name than myhome.eu.

3. The Response

The Respondent's defence is that it has rights and legitimate interests in the disputed domain name, which was not registered and is not being used in bad faith.

4. The Complainant's Rights

The Respondent observes that whilst the Complainant owns a semi-figurative trade mark, the territorial scope of the mark is limited to the Irish territory. (It further points out that, despite the Complainant contentions, it is not in possession of a Community Trade Mark.) Notwithstanding the Irish Trade Mark Right, the Respondent speculates whether the Complainant could be entitled to obtain the disputed domain name in any event.

In the Respondent's submission, according to Article 10(2) of Regulation 874/2004 "the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists."

If the Complainant has submitted the Irish trade mark the refusal may have been based on the fact that from a verbal point of view the trade mark contained “ie” in addition to “myhome”. That is to say, the Registry would have to take into account the letters “ie” too. It notes that there is no evidence of the terms of the Registry’s decision, but whatever they may be, as the Complainant has not challenged the Registry’s decision in this respect it must be treated as having acquiesced to those rejections.

Further, the Respondent avers that the verbal element of the semi-figurative trade mark invoked by the Complainant is “MyHomeie” and thus in any case not identical to the company name of Myhome S.A. in which name the application for the disputed domain name was made. It adds further that it is very doubtful that any confusing similarity can be withheld between the conflicting signs as:

- the verbal signs “my home” and “myhome” are rather widespread as a distinctive sign in different ambits and on different territories (within the European Union and outside the European Union);
- the verbal sign “My Home” is not particularly distinctive for the services for which the invoked trade mark has been registered by the complainant,
- the difference between “MyHomeie” and “myhome” gains in importance/relevance in the light of the 2 aforementioned considerations,
- the relevant territories are different (respectively Ireland and Luxemburg),
- the activities of both companies are different (portal services versus short term business support services).

5. The Respondent’s Rights and Legitimate Interests.

The Respondent disputes that it is devoid of legitimate interests as to the “myhome” domain name in Luxemburg. In this regard it points to its incorporation as a Luxemburg company under that name, the insertion of that name in the Luxemburg trade name and company name register, and the conduct of activities under that distinctive sign in Luxemburg. Further, it points out that no opposition to use of “myhome” as a trade name was ever entered in Luxemburg.

In the Respondent’s submission the fact of incorporation and entry in the trade register gives rise to a right under Luxemburg law that is recognized in the .eu Regulation. It submits that it is for the Complainant to explain why these events do not qualify as “demonstrable preparations” under the .eu Regulation.

Similarly, the Respondent disputes the Complainant’s contention that it is not commonly known by the domain name. It observes that the limited number if huts resulting from an internet search engine is irrelevant, since a company will by definition be known under its company or trade name for plenty of purposes, including tax, administrative, business and other purposes.

Finally, the Respondent relies upon the fact of incorporation in reference to the allegation that it is not making legitimate and non-commercial or fair use of the disputed domain name. In this regard, it avers that the allegation pre-supposes a total absence of rights on the part of the Respondent, which is plainly not the case. However, to the extent that the allegation is relevant it observes that the re-direction of the domain name to the A-Syst web site – which is a sister company of the Respondent - does not mislead consumers or harm the reputation of the Complainant. As for the so-called Irish property portal, the Respondent explains that this was in fact a parking page placed by the Registrar, in respect of which the Respondent had no responsibility for, and avers that at the time the re-direction was put in place the parking page was advertising sex industry related links.

6. Registration or use in bad faith.

The Respondent disputes the allegation that it registered the disputed domain name for the purpose of selling it.

It concedes that the exchange of correspondence indicates that the Respondent was willing to sell the domain name, but observes that this exchange was generated by the Complainant itself. In any event, it submits that the exchange explicitly confirms that in February 2006, when the domain name was applied, that it was not with the intention of selling it on.

Referring to the chain of correspondence cited by the Complainant, the Respondent stated in evidence that when the Complainant made initial contact on 3 May 2007, to manifest the interest of an undisclosed client to acquire the domain name, the Respondent did not even bother to answer his e-mail. And it was only when the second email was received insisting on behalf of the undisclosed client on the transfer of the domain name that the Respondent answered (on 4 June 2007) that it would discuss the issue internally at the occasion of a meeting with the people in charge of the Respondent’s project. In the Respondent’s submission this clearly and explicitly indicates that the Respondent has never even envisaged or discussed the possibility of selling the domain name before the Complainant made contact.

Subsequently, the Respondent adds, consideration was given to selling the domain name but the officers of the company decided that that they did not wish to release the domain name as they had already put considerable efforts into the web site, documentation and logo.

The Respondent confirms that contact was made by telephone, pointing out that the identity of the Complainant was disclosed in the second or third telephone call. In exchange the Respondent maintains that it indicated that the team in charge of the project did not wish to abandon that name since, in addition to the registration with the Luxemburg trade and company register, considerable efforts had already been put in a draft web site, documentation and logo.

Eventually there were discussions internally within the Respondent on a possible change of distinctive sign in relation to its activities. According to the Respondent, those discussions concluded that a change of distinctive sign in connection with its activities should not be totally excluded but would require some efforts (finding a new name, changing the company name in the articles of association – which requires the intervention of a notary public, notify the changes to the trade and company name registry, notify the changes to relevant administrations and clients, applying for a new domain name, adaptation of – draft - documentation, etc.). In any event, the Respondent maintains that to the extent the name would ever really be offered for sale, the Respondent's concern was to make sure that the sale would cover all the costs associated to a change of distinctive sign.

In an e-mail of 7 June 2007 the Respondent concedes that it limited itself to mentioning vaguely that it would put up the domain name for a general sale sometime and, when it did so that, it would notify the Complainant. However it adds that the object of this last communication was to curb the insistence of the Complainant, although in actual fact no final decision has actually ever been taken in this respect. In this regard, it states that it has never contacted or approached anyone that may have any interest in the domain.

Secondly, the Respondent rejects registering the disputed domain name in order to prevent a right holder from reflecting his trade name in a domain name. It points out that the parking page listing Irish property sites was entirely the act of the Registrar, and should not be regarded as an attempt by the Respondent to penetrate the Irish property market. In support it refers to a letter from the Registrar confirming that the website content was in fact supplied automatically (by a third party), and thus content is made up of website links relevant to a domain name according to Google's calculation, and that no website is supposed to be pointed deliberately. In this regard the Respondent observes that the link to the Complainant's website is, in the exhibit supplied the Complainant, a sponsored link and in some way the Complainant has probably paid to have links to its site placed on parking pages.

The Respondent adds that, conversely, it has already obtained income from companies that have contracted lease services from the Respondent. But it concedes that it has not been possible yet to find enough time or to allocate enough resources to finalize the promotion of services through the Internet since the domain name was registered to the Respondent. In this regard, the Respondent suggests separately that the effect of the second scenario in Article 21(3)(b) is that a company registering a domain name reflecting its company and trade name has at least two years to put it to genuine use.

Thirdly, the Respondent denies attempting to disrupt the Complainant's services as it is impossible to show that the name was registered primarily for this purpose.

Finally, the Respondent denies intentionally using the disputed domain name to attract Internet users for commercial gain, as it does not offer any services in Ireland or target Irish companies or target the real estate portal market whether in Luxemburg or Ireland. It only offers services to Luxemburg companies in the lease and short-term business support market. Once again in this regard it denies being responsible for the Irish property related content displayed on the parking page.

DISCUSSION AND FINDINGS

1. Introduction

In this proceeding, an Irish limited company, an Irish trade mark, a Luxemburgish société anonyme and a .eu domain name have been created with an identical stem, namely "myhome". Each is written in unbroken script, and each purports to be the brand name of services provided in relation to property. Furthermore, each is recognized as valid within the jurisdiction that enabled it to be registered or incorporated. The two companies, MyHome Ltd, and MyHome SA now dispute the others rights to register the .eu domain, myhome.eu.

The parties, in detailed written submissions that, on printing, stretch towards one hundred fifty pages, have raised numerous issues of fact and law. In this regard, I have deliberately set out the parties' respective arguments in detail. I intend to reach findings on as many issues as affect my final decision. Where no finding is offered in relation to an allegation, submission or fact, then this can be treated as not being cogent to my final analysis.

The nature of this dispute, and the allegations raised, has meant making certain findings of fact. In making these findings I am reminded of the burden and standard of proof; the burden being on the party that asserts to the civil standard of the balance of probabilities. Where, in relation to a certain fact asserted, a prima face case is proven then the onus shifts to the other party to rebut, again to the same civil standard.

With regard to points of law, I have been referred to several decisions of administrative panels, and where necessary I will adopt or distinguish the precedent that the relevant decision sets.

2. Admissibility

According to Article 21 of the .eu Regulation:

"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."

It falls on the Complainant to establish the constituent elements of this provision before I can revoke a registration, and consequently transfer it away from the Respondent Registrant.

The Complainant relies upon its registered trade mark as the basis of rights to the make this Complaint. That mark is semi-figurative in the name and style of MYHOME.IE. I am aware of the notoriety of the trade mark and of the website portal to which it relates. Even if I were not, the claims of notoriety made by the Complainant are not challenged by the Respondent and so I would be bound to accept them in any event.

I have inspected the copy trade mark certificate and find that the Complainant has a valid and enforceable trademark, created by law. The Complainant submits that its trade mark is a “prior right” pursuant to Article 10(1) .eu Regulation, and whilst I recognize that technically that is correct the categorisation of such rights relates only to period of phased registration.

However, I find, with little effort required to do so, that the trade mark and the disputed domain name are identical or similar. In this regard, the Respondent argues that the suffix “.ie” in the trade mark should be sufficient to render the trade mark and disputed domain name (which of course includes a different extension) as non-identical, but I am not persuaded by that the Respondent’s fairly extensive submission. Rather, the Complainant cites authority that I acknowledge as correct: this being that a top level domain extension is not material for the purposes of determining whether it is identical or confusingly similar. With such a finding, the Respondent will doubtless be unsurprised to note that I cannot accept that there is any basis for finding that the trade mark and disputed domain name are not confusingly similar.

Finally, I find I cannot draw any adverse inference from the fact that the Complainant’s original application for the disputed domain name during the Sunrise period was declined. Contrary to the Respondent’s submission I do not agree that this suggests an absence of rights to a domain name. Even if I should imply a negative connotation, the Complainant has nevertheless produced in this proceeding a valid and enforceable trade mark evidencing rights in principle to the disputed domain name.

So in my view this proceeding turns on whether the Respondent has any rights or legitimate interests in the disputed domain name, and if it has, whether nevertheless the disputed domain name has been registered or is being used in bad faith.

3. Legitimate Interests

Examples of legitimate interest are set out in the .eu Regulation (Article 21(2)), and thus they include:

(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 alleges that none of the foregoing examples apply, that is to say: the domain name has not be used or prepared demonstrably to be used in connection with an offering of goods and services; the Respondent is not commonly known by the domain name; and, it is not making legitimate use without intent to mislead consumers etc.

I find that the Complainant, which had the harder task of proving an absence of interest (and for this reason was allowed file a rejoinder in reply to the Response), established a prima facie case, and this regard I took into account the Respondent's apparent willingness to sell the domain name to someone, like the Complainant, with an interest and the fact that the domain name was being used to host a website with links competing with the Complainant's business.

However, having considered one point not expressly dealt with by either parties, as well as the Respondent's explanations, I find on balance, and for several reasons, that it does possess a legitimate interest in the domain name.

First and foremost, it cannot escape a Panel's attention that the disputed domain name was registered to the Respondent during the Sunrise period of registration, and that there has been no subsequent and material changes to the registration. Unlike the land-rush and subsequent periods in the life of a general Top Level Domain, applications during the Sunrise period are subject to prior scrutiny. As stated in Article 10 (1), to succeed in the period of phased registration an applicant must establish "prior rights" that are supported by relevant documentation. These rights include business identifiers and company names in so far as they are protected under national law in the Member-State.

The Respondent relied upon its company name, and according to the Sunrise rules company names registered in Luxemburg are eligible to be relied upon as a protected prior right during Phase 2. In this regard, the company name is identical or similar to the disputed domain name, and as the name was subsequently granted I find I have to assume that the Respondent produced adequate documentary evidence in support.

Thus I find that if a company name can form the basis of a proven and acknowledged prior right, only if there is overwhelming evidence, proving that the original registration was in error, could a Panel find, in the absence of a renewal or any material changes to the registration, that the same company name cannot form the basis of a legitimate interest in a subsequent administrative proceeding, brought by a third party.

Even if I were not to accept the mere, uncorroborated fact of registration during the Sunrise period as a sufficient legitimate interest, I find in any event that the Respondent has adequately proven a legitimate interest by adducing extracts from the company and trade name registers showing a similarity between the domain name and its own protected name.

Secondly, I am not persuaded that this is a case in which a company has been incorporated with the sole purpose of registering a domain name. Whilst there has been little or no demonstrable activity in relation to the domain name, that is, myhome.eu, a name corresponding to the domain name, that is MyHome SA, has been used to form a company, acquire assets and rent property Of course, with the company and domain name stems being identical, this distinction is probably semantic, but my finding is that even in the absence of significant use of the domain name, there is a corresponding and identical name that has been used. And according to Article 21(2)(a) use of, or demonstrable preparation to use, a corresponding name can constitute prior use.

Thirdly, I am not convinced by the Complainant's arguments that the company has not been commonly known by its domain name, when the company and domain name stems are identical. The argument is novel, and in one sense correct, since the Respondent is not known by the full domain name including extension, as is the Complainant for instance. Yet, the Complainant cites elsewhere for its own purposes that in comparisons between domain names and other business identifiers, TLD extensions can be ignored.

As regards the final example (fair use), the Complainant makes a strong argument that the use was not fair. As indicated above, I found the evidence produced of possible cyber-squatting was sufficient to establish a prima facie case. Unfortunately, as I have already found the basis for a legitimate interest on the part of the Respondent, it does not fall to consider under this head of claim whether the Respondent's explanations are acceptable. The examples cited in Article 21(2) are scenarios that suggest the existence of a legitimate interest, and they are not cumulative or selective conditions which can negate a legitimate interest. For example, if a holder can show that he is making legitimate fair use of a domain name (without intention to mislead consumers) it would be inappropriate to negate that

interest if equally it can be shown that the holder has not been commonly known by the domain name.

Instead, I find that the allegations of intention to sell and commercial gain are more properly dealt with under the heading of bad faith.

Accordingly I find that the Complainant has not shown that the disputed domain name has been registered by its holder without rights or legitimate interest in the name.

4. Bad Faith

Bad faith is described in Article 21 .eu Regulation by reference to examples, these being:

(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 contends that each (except the last) of the foregoing can apply in the present case, but I find that only two require serious consideration. Scenario (c) is not adequately made out in the Complain and would, in my opinion, require something more that what has been shown to have occurred – namely the linking to third party sites (which constitutes a potential commercial gain under Scenario (d)).

As for Scenario (b), I find that neither the principal nor the proviso relied upon (pattern of conduct) are made out, despite the arguments put forward. Admittedly, the Respondent's circumstances – consisting of a new company formed shortly before application with little subsequent demonstrable use of the disputed domain name – suggest that possibly the Respondent intended to deprive the Complainant of use of the disputed domain name, but ultimately on the balance of probabilities I am not persuaded by this. For the reasons set out below with regard to the two scenarios examined in detail I do not find that the domain name was, at the time, registered to deprive the Complainant, or someone like it, of the disputed domain name. Furthermore, pattern of conduct is usually proven by the registration of a number (at least several) different domain names, rather than a respondent's conduct in relation to one domain. Even if I was to accept argument in relation to the latter, the pattern of conduct evidenced by the exchange of emails and telephone calls is at best equivocal. On the one hand, it might be evidence of a cyber-squatter at work; on the other hand, it might be evidence of the genuine response to a genuine offer. Of the two, I do not have a reason disbelieve the latter.

This leaves bad faith characterized by the intention of selling and bad faith characterized by intention to attract Internet users, as relevant to my decision, both of which turn on issues of fact.

5. The domain name was registered or acquired primarily for the purpose of selling

In support of its contention, the Complainant recites at length the email and telephone exchanges between itself and the Respondent. This was, in effect, a period of negotiation, since a definite offer to purchase, as well as an implied invitation to treat, is in evidence.

According to the Complainant, the fact that the Respondent entertained its interests, considered its offer, and invited further interest in the future demonstrates sufficient intention to sell if the price was right. If one factors in the less than substantial evidence of use of the disputed domain name, then one can conclude, as the Panel finds, that there is a prima facie case that the domain name was registered primarily for the purpose of selling. It is not a strong case as the evidence is not clear that this was the primary purpose, but it is certainly suggestive.

Thus the matter turns on the credibility of the Respondent's explanation for the chain of events. In its defence it states that it did not seek out the Complainant, but responded to the latter's advances. It points out that, in the end, it did not sell, agree or promise to sell, or make counteroffers on a price; nor has it sought out offers from other potential buyers.

However, the Respondent did consider the offer made, it did suggest that a transfer would be considered and might occur, and it did appear to hold out the prospect of selling at a later date. In addition, it stated early on in the exchange of correspondence that it has put "considerable effort into the website, documentation and log" (and later it refers to a draft website) but has not produced any evidence to support this statement. The only evidence adduced relates to the purchase and lease of premises.

These viewpoints are evenly balanced, and so to determine where truth lies, I am minded to apply the line of reasoning adopted by the Panel in Think Service, Inc. v. Juan Carlos aka Juan Carlos Linardi WIPO Case No. D2005-1033 (which itself relies upon Emilio Pucci SRL v.Mailbank.com Inc., WIPO Case D2000-1786 and Builder's Best Inc. v. Yoshiki Okada, WIPO Case No. D2004-0748) which runs:

the relevant bad faith must be specific to the Complainant, or at very least that the Respondent must have "had the Complainant in mind" when he registered the Domain Name.

By doing so I find that I cannot on the balance of probabilities conclude that the Respondent's primary intention, at the time the domain was registered, was to sell the disputed domain. The ordinary and natural meaning of "primary" is foremost, of first rank of importance or value. This implies that there is no other overriding or principal purpose or intention. From the evidence before me, the Respondent had a business plan of supplying property or business related services. It executed this plan, not simply by registering a domain name, but first of all incorporating a company in a name and style that was consistent with the original objective, and later managing the company to acquire assets in its name, and exploiting those assets. The worst that can be said against the Respondent is that it is a small enterprise that has been slow, even very slow, to role out its profile on the Internet through use of the disputed domain name, and that momentarily it considered an offer to purchase the domain name. I find that these reasons cannot support a finding that the Respondent registered the disputed domain name with the primary intention of selling it to someone like the Complainant.

In Think Service, Inc. the Panel's found there was no evidence that the Respondent was even aware of the Complainant or its trade mark when he registered the Domain Name. In my view, a similar set of circumstances are in evidence in the present proceeding.

6. Intention to attract Internet users for commercial gain

In support of this final scenario, the Complainant produced in evidence screen shots of the website that resolved to the disputed domain name for a period prior to commencement of this administrative proceeding. The page was subsequently replaced by a re-direction to the website of a company trading in the name of a-syst.com. According to the Respondent this latter company is a sister to the Respondent, in that it is under common ownership.

I find that there is a prima facie case establishing bad faith on this occasion since it is evident that the page contains links to websites that compete with the business of the Complainant, even if one link is to the Complainant's own website.

In its defence, the Respondent explains that the page in question was a parking page; that is, one which is put in place to host a domain that is not otherwise put to use. It claims that it was not responsible for content at this stage, as its own website was not ready (or prepared) to go live, but rather that it was the responsibility of its Registrar. According to a letter from the Registrar and produced in evidence by the Respondent, the Registrar had deferred responsibility to a third party whose business is to post content on empty websites; and according to the Registrar's explanation the third party generates content by inserting links in turn generated by the a Internet search engine. Apparently, the purpose of the chain of delegation is to avoid the domain name resolving to an error message.

The question is whether this convoluted explanation that it is all an accident of circumstance is credible. There is then the question as to whether I should accept it.

Regarding credibility, the explanation is not an exceptional one to make or justify since any informed and regular Internet user will be aware that it is the common practice in the domain hosting and registrar business to park underdeveloped domain names and to generate content based on de facto relevancy of names and words. Against this, the thrust of the Complainant arguments forces the simple and valid point that the inclusion of links to competing sites on an otherwise inactive website suggests the pursuit of commercial gain. In this regard it is, admittedly, also common practice for cyber-squatters to use the same technique to generate income.

The matter is once again evenly balanced. In my view an answer lies in the screen shot provided by the Complainant. The title is described as “Myhome.eu – the Best my home Resources and Information.” In my analysis, this does not sufficiently imply bad faith as, other than the inclusion of the words “my home”, the “best resources and information” is, in the opinion of this Panel, a claim frequently made on the Internet.

Within the body of the page, the domain name is repeated along side a web-search box; this possibly generates sponsored links to the key words entered. In a separate box there are some further links, again possibly to sponsored web links. But in the main body there are some hypertext links, which in the current example includes re-directions to the Complainant’s web page and one belonging to a third party. The Respondent suggests that possibly the Complainant’s web page appears because the Complainant does pay for its links to be inserted as a sponsored link. This may or may not be true, so I reach no conclusion in this regard.

Finally, there is the URL at the foot of the screen shot, which indicates the location of the page actually being viewed. This last component is most informative since it reveals that the web page was being hosted under the domain name, sedoparking.com. This corresponds to the Respondent’s evidence that, according to information supplied by its own Registrar (EuroDNS), content for the web page was supplied by Sedo.com.

Thus I find that there is some acceptable corroboration for the Respondent’s explanation. And I find further support for its position on other points that undermine a credible connection being made between the sponsored links displayed on the parked page and the alleged intention on the part of the Respondent to attract Internet users for commercial gain: for instance, it is a very credible that the links were generated automatically and outside its control, or that links other than those relating to Irish property sites might be generated at any time; secondly, one also has to consider that an Internet search when physically located in Ireland might produce different results to a search conducted when physically located in Luxemburg or elsewhere; thirdly, if the Respondent was making a commercial gain from maintaining an Irish property portal, then is one to assume it made a commercial gain from inclusion of the Complainant’s website?; fourthly, with only one known domain (and no suggestion of any others) the estimated income is likely to be very negligible, if it exists at all; fifthly, it would be wrong to assume in the absence of cogent evident that the Respondent was profiting from the sponsored links; finally, which ever of the foregoing apply, an Internet-based business like the Complainant would have to produce very substantial evidence that it has not at some point, either intentionally or inadvertently, agreed to or failed to adequately opt out of, its domain name being used as a sponsored link on a parked page like the one resolving to the disputed domain name.

Each of these observations strengthens the credibility of the Respondent’s explanation in my view. Moreover, I also take into consideration that the Respondent subsequently re-directed the domain to its sister company’s site. Whilst the Complainant has argued that this indicates to a lack of use of the domain name, it also serves to demonstrate that action was taken in a reasonable period of time, to bring to a halt a practice that the Complainant complains of. In this regard, I do not find that it is a thinly-veiled attempt to disguise a legitimate interest or conceal bad faith.

As to whether I can accept the explanation, the Complainant, in its Rejoinder, robustly submits that I cannot: the Respondent, it states, must be held accountable for content on web pages that resolve to a domain name under its control. It points out that contractually between Registrar (EuroDNS) and Registrant, the Respondent is bound to have notice of content. Moreover, the Complainant argues that “… the entire ADR system is predicated on the basis that the Registrant (who is referred to as the “Respondent” in the ADR Rules) is the person ultimately responsible for what appears on its domain name. It concludes, forcefully, that to allow a Respondent the defence of ignorance and thus abdicate its responsibility would bring the whole ADR system into disrepute.

I agree that if respondents are not adequately held in check for their actions then this would undermine the value of the ADR system of remedies for domain disputes. However, the operative word employed in the bad faith case in issue is intentionally. The case is only made out if the domain name was “intentionally” used to attract Internet users, for commercial gain, etc. One might therefore argue that the standard of intention required is specific intention, since the case does not allow expressly allow for recklessness. If this was the case, successful complaints will be rare events. On the other hand, the case speaks of the “creating a likelihood of confusion”, which

conveys that something less than specific intention is required. In any event, since evidence of some actual or apparent intention is required, as a matter of interpretation therefore, I find that the case does not impose a standard of strict liability, which would follow if the Complainant's line was adopted. And I am not aware of any authority, whether from a judicial or extra-judicial source, stating that bad faith is a torts of strict liability, rather it implies a mental element.

Thus, I find I need to consider if the Respondent intended to attract Internet users intentionally, for commercial gain, by creating a likelihood of confusion with the Complainant's enforceable rights in law. Two of these components are already made out: there is a likelihood of confusion between the Complainant's name and online presence and the Respondent's name and putative online presence. Moreover, the website produced by the Complainant does display third party links. However, and in the final analysis, taking into account the matters raised herein, I find the Respondent's explanations are plausible. Thus, on the balance of probabilities I cannot find that the domain was or is being used with the intention of attracting users for commercial gain.

7. Conclusion

In conclusion, and after careful evaluation of the facts, I find that the Complainant has not proven its case. As much as it appears on first impression that the the disputed domain name has been registered to a registrant whose primary interest was pecuniary or commercial gain, on inspection I find innocent and acceptable explanations for the events and facts that were suspicious.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied

PANELISTS

Name	**Joseph Dalby**

DATE OF PANEL DECISION 2007-10-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

In this proceeding, an Irish limited company, an Irish trade mark, a Luxemburgish société anonyme and a .eu domain name have been created with an identical stem, namely "myhome". Each is written in unbroken script, and each purports to be the brand name of services provided in relation to property. Furthermore, each is recognized as valid within the jurisdiction that enabled it to be registered or incorporated. The two companies, MyHome Ltd, and MyHome SA now dispute the others rights to register the .eu domain, myhome.eu.

This proceeding turns on whether the Respondent has any rights or legitimate interests in the disputed domain name, and if it has, whether nevertheless the disputed domain name has been registered or is being used in bad faith.

Regarding legitimate interest, I find on balance, and for several reasons, that it does possess a legitimate interest in the domain name.

First and foremost, it cannot escape a Panel's attention that the disputed domain name was registered to the Respondent during the Sunrise period of registration, and that there has been no subsequent and material changes to the registration. Secondly, this is not a case in which a company has been incorporated with the sole purpose of registering a domain name. Thirdly, the company has been commonly known by its domain name, since the company and domain name stems are identical. As regards fair use, the Complainant makes a strong argument that the use was not fair. Unfortunately, as I have already found the basis for a legitimate interest on the part of the Respondent, it does not fall to consider under this head of claim whether the Respondent's explanations are acceptable.

Regarding bad faith, I find that none of the cases of bad faith are made out.

In particular Scenario (b) is not made out for the reasons set out in relation to the other bad faith cases discussed Furthermore, pattern of conduct is usually proven by the registration of a number (at least several) different domain names, rather than a respondent's conduct in relation to one domain.

In support of its contention that the Respondent intended to sell the domain name, the Complainant relies on the email and telephone exchanges between itself and the Respondent.
It is not a strong case as the evidence is not clear that selling was the primary purpose, but it is certainly suggestive.

The matter turns on the credibility of the Respondent's explanation. I am minded to apply the line of reasoning adopted by the Panel in Think Service, Inc. v. Juan Carlos aka Juan Carlos Linardi WIPO Case No. D2005-1033 which runs the relevant bad faith must be specific to the Complainant, or at very least that the Respondent must have "had the Complainant in mind" when he registered the Domain Name. The ordinary and natural meaning of "primary" is foremost, of first rank of importance or value. This implies that there is no other overriding or principal purpose or intention. From the evidence before me, the Respondent did not register the disputed domain name with the primary intention of selling it to someone like the Complainant.

In relation to the Respondent's intention to attract Internet users for commercial gain the Complainant produced in evidence screen shots of the website indicating links to competing sites.
In its defence, the Respondent explains that the page in question was a parking page.

The question is whether this explanation is credible. There is then the question as to whether I should accept it.

Regarding credibility, the matter is once again evenly balanced. In my view an answer lies in the screen shot provided by the Complainant. The URL at the foot of the screen shot indicates the web page was being hosted under the domain name that corresponds to the Respondent's evidence. Thus I find that there is some acceptable corroboration for the Respondent's explanation

As to whether I can accept the explanation, the Complainant, in its Rejoinder, robustly submits that I cannot: the Respondent, it states, must be held accountable for content on web pages that resolve to a domain name under its control; and that to allow a Respondent to abdicate its responsibility would bring the whole ADR system into disrepute.

I find that the operative word employed in the bad faith case in issue is intentionally. The case is only made out if the domain name was "intentionally" used to attract Internet users, for commercial gain, etc. Since evidence of some actual or apparent intention is required, as a matter of interpretation therefore, I find that the case does not impose a standard of strict liability, which would follow if the Complainant's line was adopted.

Thus, on the balance of probabilities I cannot find that the domain was or is being used with the intention of attracting users for commercial gain.

The Complainant's complaint is denied.