Panel Decision for dispute CAC-ADREU-004655

Case number	CAC-ADREU-004655
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Domain names	secretsinlace.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Secrets in lace retail Group, Incorporated, Secrets in lace retail Group, Incorporated

Respondent

Organization / Name	Fienna, Ltd., Fienna, Ltd.

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

No other legal proceedings concerning the disputed domain name are currently pending.

FACTUAL BACKGROUND

- The domain name secretsinlace.eu was registered by the Respondent on 7 April 2006, the first day on which that domain name became free after the sunrise period.

- Barring error, the domain name at issue, secretsinlace.eu, does not currently correspond to any active website.

- A first complaint filed by the Complainant on 15 August 2007 met with a notification of deficiencies. The Complainant then filed, on 4 September 2007, a fresh amended complaint which was found to be admissible. The Complainant, Secrets in lace retail Group, Incorporated, invoked its rights in the name SECRETS IN LACE in its capacity as the “exclusive licensee” of the CTM registration 004476362 SECRETS IN LACE, dated 26.05.2005. It maintained that the Respondent had no rights or legitimate interest in the domain name at issue and had acted in bad faith in registering it.

- The Respondent failed to provide its Response.

A. COMPLAINANT

- The Complainant, Secrets in lace retail Group, Incorporated, states that it is the exclusive licensee of the CTM registration 004476362 SECRETS IN LACE, of 26.05.2005.

- The Complainant is a company which has been trading in USA and worldwide since 1997 and has won a reputation in SECRETS IN LACE branded clothing, including lingerie, hosiery and sleep wear products, sold under that earlier registered CTM trade mark.

- The contested domain name is a reproduction of the Complainant’s registered trademark SECRETS IN LACE.

- The authorized representative of the Complainant wrote to the Respondent demanding the transfer of the domain name under threat of an ADR action. No satisfactory response was received to the letter and therefore ADR proceedings were commenced.

- The Respondent clearly has no legitimate rights or interests in the domain name, while the SECRETS IN LACE products of the Complainant are readily available throughout Europe both in commerce and via the Complainant’s website.

- Furthermore, given the reputation of the Complainant in its SECRETS IN LACE products, the Complainant submits that the Respondent

registered the domain name in bad faith.

- In addition, various other ADR proceedings have already been brought against Fienna Ltd., the Respondent: for example, No. 02235 and No. 01328. The decisions were always positive for the Complainant and the Respondent never even reacted in the proceedings. Thus the fact that the Respondent has taken advantage of the Complainant's reputation and registered this valuable domain name speculatively with a view to holding the Complainant to ransom or selling the domain name on to an unconnected third party is sufficiently proved.

For all these reasons the Complainant requests that the disputed domain name be transferred to it.

B. RESPONDENT

The Respondent did not reply to the complaint.

DISCUSSION AND FINDINGS

When regulating ADR proceedings, article 22, paragraph 10, of Commission Regulation No. 874/2004 states the following:

"10. Failure of any of the parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty."

The fact that the Respondent did not submit a reply could lead directly to acceptance of the Complainant's claims. However, in the interest of equity, the undersigned panelist will reach his decision after assessing the circumstances surrounding the case.

Pursuant to article 11, paragraph (d)(1), of the .eu Alternative Dispute Resolution Rules, the Panel shall grant the remedies requested if the Complainant proves "in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that:

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

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

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

1. Domain name identical or confusingly similar to a name in respect of which a right is recognized.-

The Complainant invokes CTM No. 004476362 SECRETS IN LACE, which was duly granted and is in force. Although the Complainant states that it is the exclusive licensee under that trademark, the fact is that, according to the information available in the database of the OHIM, the Complainant is actually the owner of that trademark. There can consequently be no doubt as regards its standing to bring these proceedings.

It is evident that the contested domain name, secretsinlace.eu, is exactly the same as the aforementioned Community trademark SECRETS IN LACE.

The Panel therefore considers that the first of the requirements for the Complaint to be accepted is met.

2. Absence of Rights or Legitimate Interest

The Respondent has not submitted any reply. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the name in dispute since the name clearly corresponds to the subject matter of its Community trademark, SECRETS IN LACE.

The Complainant has also shown that correspondence was exchanged between the parties and that, in the course thereof, the Respondent did not prove or even lay claim to any legitimate interest in the contested domain name.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

“As mentioned above in section 3, the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists. WIPO Case No. D2002-0273 <sachsen-anhalt>; WIPO Case No. D2002-0521 <volvovehicles.com>”

The Panel therefore considers that the Respondent has not evidenced legitimate rights.

3. Bad Faith

The Complainant has clearly proved its right to the contested name, whereas the Respondent has not given any kind of reason for having adopted it.

The Panel has ascertained that, as the Complainant claimed, the Respondent has indeed been involved, in that same role, in other ADR proceedings relating to (alleged) cybersquatting. In various cases those proceedings ended with a decision upholding the complaint and observing bad faith on the part of the Respondent. That was so in, for example, cases 02235 (palmerscocoabutter.eu) and 01328 (tse-systems.eu).

From the foregoing it may be gathered that the Respondent has engaged in a pattern of conduct which may without doubt be regarded as amounting to bad faith and is, indeed, specifically included among the circumstances denoting bad faith listed in Paragraph 11(f)(2)(i) of the ADR Rules.

The Panel therefore considers it proved that the Respondent acted in bad faith when registering the contested domain name.

4. As to the remedies requested

Article 22(11) of Commission regulation No. 874/2004 states that in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community;

2. an organisation established within the European Community without prejudice to the application of national law; or

3. a natural person resident within the European Community.

In this case the Complainant requests that the contested domain name be transferred to it. However, the Complainant is a U.S. company and has not supplied any evidence to the Panel indicating that it satisfies any of the requirements laid down in Article 4(2)(b) of Regulation (EC) No 733/2002. Consequently, in accordance with article 22, the domain name may not be transferred but only revoked.

DECISION

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

the domain name SECRETSINLACE be revoked

PANELISTS

Name	Luis de Larramendi

DATE OF PANEL DECISION 2007-12-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant in the proceedings is the owner of CTM registration 004476362 SECRETS IN LACE, which is prior to the contested

domain name. The Complainant points out that the trademark and the domain name are identical and submits that the Respondent has no legitimate rights or interests in the name and has acted in bad faith, misappropriating the rights of the Complainant. It has been shown that emails were exchanged by the parties and that in that correspondence the Respondent did not prove or even claim any legitimate right or interest.

The Respondent did not reply to the complaint.

The Panel considers it proved that the trademark and the domain name have the same subject matter and, given the Respondent's failure to respond, notes that the latter has not provided any plausible account of possible rights or legitimate interests in the domain name at issue and also deems it proved that the Respondent acted in bad faith, given that he was previously in turn the Respondent in other ADR proceedings addressing similar circumstances which concluded with decisions upholding the complaints.

As a result, the Panel rules that the domain name secretsinlace.eu must be revoked, but not transferred to the Complainant as requested by the latter given that the Complainant does not satisfy the general eligibility criteria as set out in Article 4(2)(b) of Regulation (EC) No 733/2002.