Panel Decision for dispute CAC-ADREU-004668

Case number	**CAC-ADREU-004668**
Time of filing	**2007-09-07 11:01:47**
Domain names	**nexcom.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Nexcom UK Ltd, Mr Stephen David Ritchie**

Respondent

Organization / Name	**Lehigh Basin Ltd, Chris Goodwin**

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

FACTUAL BACKGROUND

The Complainant in this ADR Proceeding is Nexcom UK Limited, a limited company with a place of business in Milton Keynes, United Kingdom. The Complainant is a wholly-owned subsidiary of a Taiwanese company named Nexcom International Co. Ltd ("Nexcom International"). The Complainant's business (and that of Nexcom International) is the manufacture and supply of computer products for industrial processes. The Complainant is designated as the European Service Centre, responsible for all business in the European marketplace. The Complainant's turnover grew to £3.2 million in 2006 with a forecast of £6 million for 2007.

The Complainant is the licensee of European Community registered trade mark no. 911487 ("NEXCOM" - use classes 09, 16 and 42) registered on 21 February 2001.

The Respondent is Lehigh Basin Limited, a limited company with its registered office in Hull, United Kingdom. The Respondent registered the disputed domain name on 7 April, 2006.

In about late June or early July 2007 the Complainant's Marketing Manager, Steve Ritchie, attempted to contact the Respondent by telephone at the telephone number on the WHOIS but was connected only to an answering machine on which he left messages. Mr Ritchie followed up these telephone calls with emails dated 3 and 4 July and a letter dated 5 July 2007. No reply was received from the Respondent to any of this correspondence.

The Complaint was filed on 6 September 2007. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for the disputed domain name on 7 September 2007. On the same date, EURid replied in a non-standard communication confirming that the disputed domain name nexcom.eu was registered with 123domainrenewals, LLC, that the current Registrant of the domain name was the Respondent, that the domain name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the disputed domain name was English. It also provided the full details from the WHOIS database for the registrant, technical, administrative and billing contacts.

In a non-standard communication dated 7 September 2007, the Complainant filed an electronic copy of its Appendix to the Complaint having noted that it had not been sent through to the Czech Arbitration Court with the Complainant's online application due to a computer error.

On 11 September 2007, the Czech Arbitration Court conducted a formal compliance review in respect of the Complaint and found it to be

in compliance. Accordingly, the formal date of commencement of the ADR Proceeding was therefore 11 September 2007 and a Notification of Complaint and Commencement of ADR Proceeding was issued to the Respondent on that date. This stated that a Response was to be submitted within 30 working days. On 2 November 2007 the Czech Arbitration Court filed a non-standard communication stating that the date by which a Response should be filed was 12 November 2007. The Respondent did not comply with this deadline and the Czech Arbitration Court notified the Respondent of its default on 13 November 2007.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the appointed Panel on 26 November 2007, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ('ADR Rules') and the date by which a decision on the matter was due, which was specified as 27 December 2007.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 29 November 2007.

A. COMPLAINANT

The word "Nexcom" is registered in favour of Nexcom International as a community trademark in relation to computer apparatus, printed matter and computer services (no. 911487 for classes 09, 16, and 42). On 7 August 2007 Nexcom International granted a licence to the Complainant to use this trademark for the purpose of the Complainant's business, worldwide.

Identical or confusingly similar to name for which a right is recognized

The domain name nexcom.eu is identical to the registered mark "Nexcom" except for the addition of the characters ".eu". Authority exists for the proposition that the specific top-level of a domain name does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of the regulation (EC) No. 874/2004.

Registration by Respondent without right or legitimate interest

Nexcom International's "Nexcom" trademark pre-dates the registration of nexcom.eu by 5 years. The Respondent knew, or ought to have known of Nexcom International's rights in this name via publically available trademark search information. The Respondent has been granted no licence or other permission to use the trademark. The Respondent is not commonly known by the name "Nexcom", and is not making a legitimate and non-commercial use of the name "Nexcom" without intention to mislead; the Respondent's name is different from the word "Nexcom", and to the best of the Complainant's knowledge the Respondent is not making any use of the domain name at all.

Registration by Respondent in bad faith

The registration of the disputed domain name, particularly without use being made of it, can only have been undertaken in order to prevent the holder or licensee of a name recognised as a result of the trademark registration by national and community law from using the same name in a corresponding domain name.

Nexcom International has made use of the word Nexcom in its trading operations globally since 1992 and had a turnover of $240 million in 2006. The Complainant's corporate name includes the word 'Nexcom' and the Complainant has made use of the word Nexcom in its trading operations throughout Europe since 1998. The Respondent was incorporated as a United Kingdom limited company only on 21 March 2006 and is not commonly known by the domain name.

The Respondent is not making use of the disputed domain name for any purpose. A Google search against "nexcom.eu" on 19 July 2007 did not match any documents. The nature of the business of the Respondent is not specified in the public domain company information available by web search from the Registrar of Companies in the United Kingdom. The only activities of the Respondent that the Complainant has been able to identify are registrations of .eu domain names, some abusive.

In contrast, a search against Nexcom directs users to the nexcom.com web site providing the history of Nexcom International and its products. Thus, an ordinary web search would have revealed the existence of Nexcom International which should have prompted consideration of a formal trademark search.

In addition, (1) the Respondent does not respond to bona fide attempts to contact it, (2) the Respondent does not appear to be using the name "Nexcom" to promote goods or services that it can supply, and (3) in accordance with B11(f)(2)(1) the Respondent has a history of abusive .eu registrations namely:

Case number 04318 "E-AIRFRANCE"
Case number 02791 "Messe-Stuttgart".

B. RESPONDENT

The Respondent has not responded to the Complaint.

DISCUSSION AND FINDINGS

1. Preliminary - No Response

The Respondent has not filed a Response to the Complaint. In such an eventuality, the effect of the provisions of Article 22(10) of Commission Regulation (EC) No 874/2004 ('Regulation 874') and Paragraph B10(a) of the ADR Rules is that the failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a Complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21(1) of Regulation 874 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. Applicable provisions

This Complaint is brought under the auspices of Regulation 874 and the ADR Rules. Article 22(1)(a) of Regulation 874 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21.

Article 21(1) states that a registered domain name may be subject to revocation where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(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.

Article 21(2) provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) states that:

"[...]

"'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

Article 22(11) 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.

Paragraph B11(d)(1) of the ADR Rules provides as follows:-

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) 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."

It is clear from the applicable provisions that the burden of proving that a .eu domain name registration is speculative or abusive lies with the Complainant. Accordingly, the first question for the Panel is whether the Complainant has proved that the disputed domain 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.

3. Rights - identical or confusingly similar

The Complainant has provided evidence that it is the licensee of European Community trademark no. 911487 for the word mark NEXCOM, the proprietor of which is the Complainant's parent company, Nexcom International. This is a name in respect of which a right is recognised by Community law and it is clearly identical to the disputed domain name, disregarding the top level domain '.eu' as is customary for the purposes of comparison.

4. Respondent's Rights or Legitimate Interest

Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent might demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods and services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate, non-commercial or fair use of the domain name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or Community law.

The Respondent has failed to submit a Response to the Complaint and there is no evidence on the record which indicates that Respondent might be able to satisfy any of these tests. The Complainant addresses each of the tests in turn, asserting that the Respondent has not used the domain name, is not commonly known by it and is not making a legitimate and non-commercial use of it. The Complainant also points out in its submissions that the Respondent failed to reply to the correspondence from the Complainant's Marketing Manager. Clearly it is difficult for the Complainant to prove a negative as is required by the ADR Rules and the Panel takes the view that where a prima facie case has been made out by the Complainant addressing the terms of 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules, it falls to the Respondent to provide an explanation of its rights or legitimate interest in the domain name, if any. The Respondent has provided no such explanation and the Panel cannot conceive of any rights or legitimate interest that the Respondent might have asserted, whether in terms of the non-exhaustive examples in Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules or otherwise. Furthermore, if the Respondent had any such rights or legitimate interest in the disputed domain name it is reasonable to infer that it would have responded to one or other of the Complainant's Marketing Manager's attempts to contact the Respondent to discuss the matter. In all of these circumstances, the Panel finds that the Respondent registered the disputed domain name without rights or legitimate interest.

5. Registered or used in bad faith

For the sake of completeness, the Panel will also deal with the issue of bad faith. This is expressed in Article 21(1)(b) of Regulation 874 and paragraph B11(d)(iii) of the ADR Rules as a further alternative to a lack of rights or legitimate interest which may be proved by the Complainant. Registration or use in bad faith may be proved by the Complainant. Article 21(3)(a) to (e) and the corresponding paragraph B11(f)(1) to (5) provide non-exhaustive examples which may be evidence of bad faith registration or use.

In the present case, the Complainant focuses upon Article 21(3)(b)(i) [paragraph B11(f)(2)(i)], namely where 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 a pattern of such conduct by the registrant can be demonstrated.

In support of this assertion, the Complainant points to two previous ADR cases involving the Respondent, namely case nos. 02791 "Messe-Stuttgart" and 04318 "E-AIRFRANCE". In the latter case, the panel was expressly of the view that the Respondent had engaged in a pattern of conduct of registering domain names to prevent rights holders from reflecting their names in corresponding domain names

within the meaning of Article 21(3)(b)(i) of Regulation 874. Taking these two cases together with the present case, the Panel has no hesitation in finding that the disputed domain name was registered as part of the same pattern of conduct, as laid down by Article 21(3)(b)(i). Furthermore, the Panel considers that it is very unlikely that the Respondent registered the disputed domain name without knowledge of the Complainant and/or its rights in the name NEXCOM. The Respondent had an opportunity to present any alternative explanation or answer to the Complainant's assertions either by responding to the Complainant's Marketing Manager's correspondence or to the present Complaint and in both cases it failed to do so, thus leading to the reasonable inference that it has no such explanation or answer to put forward. Consequently the Panel finds that the disputed domain name was registered in bad faith.

The Panel has found that the Complainant has proved the required elements within Article 21(1) of Regulation 874 and the corresponding provisions of the ADR Rules. The Complainant seeks a transfer of the disputed domain name and appears to be eligible under Regulation (EC) No 733/2002. Accordingly, in terms of Article 22(11) of Regulation 874 the Panel determines that the disputed domain name should be transferred to the Complainant.

DECISION

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

PANELISTS

Name	**Andrew D S Lothian**

DATE OF PANEL DECISION 2007-12-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant in this case claimed rights by way of licence of the European Community registered trade mark "NEXCOM". It asserted that the disputed domain name nexcom.eu was identical to this name and had been registered by its holder without rights or legitimate interest in the name and in bad faith, on the basis that there was no evidence of the Respondent ever having had a right or legitimate interest in the name according to the criteria laid down in the ADR Rules and that the Respondent was engaged in a pattern of conduct of registering domain names to prevent rights holders from reflecting their names in corresponding domain names.

The Respondent did not file any Response.

The Panel found that the disputed domain name was identical to the registered trade mark NEXCOM which had been licensed to the Complainant by its parent company, the proprietor thereof.

The Panel also found that the record showed no indication of any rights or legitimate interest on the part of the Respondent in the disputed domain name and that the Complainant had made out a prima facie case on this point. Accordingly, and in the absence of any Response or explanation from the Respondent, the Panel found that the Respondent did not have any rights or legitimate interest in the disputed domain name.

The Complainant identified two previous .eu ADR cases, nos. 02791 "Messe-Stuttgart" and 04318 "E-AIRFRANCE" involving the same Respondent as the present case. In each of these a finding of registration without rights or legitimate interest or in bad faith had been made. In the latter of these two cases the panel had already found the existence of a pattern of conduct on the part of the Respondent in registering domain names to prevent holders of names in which rights have been recognised by national or Community law from reflecting such names in corresponding domain names. Accordingly, the Panel in the present case found that the disputed domain name had been registered in bad faith.

The Panel therefore ordered that the disputed domain name be transferred to the Complainant.