Panel Decision for dispute CAC-ADREU-004744

Case number	**CAC-ADREU-004744**
Time of filing	**2007-11-13 13:01:01**
Domain names	**edf-uk.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**EDF, Roseline DESJUZEUR**

Respondent

Organization / Name	**Richard Anthony WINTER**

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

On August 9, 2007 the Complainant filed a complaint before the WIPO Arbitration and Mediation Center against Mr. Richard Anthony Winter, relating to the domain names <edf-uk.org>, <edf-uk.biz>, <edf-uk.info>, <edf-uk.net>, <edf-uk.com>. This complaint was decided in a Decision dated November 5, 2007 ordering that these domain names be transferred to the Complainant.

FACTUAL BACKGROUND

The Complainant, ELECTRICITE DE FRANCE (“EDF”), is a leading European energy provider, enjoying a prominent position in the electricity and gas market both in France and in the United Kingdom.

The Complainant is the owner of numerous trademark registrations in France, England and around the world, including the following: (i) the French Trademark EDF (word mark) registered on September 3, 2001 with registration number 013119175; (ii) the CTM Trademark EDF (word mark) registered on November 16, 2001 with registration number 002467652; (iii) the UK Trademark EDF (word and device mark) registered on April 28, 2006 with registration number 2420592; and (iv) the UK Trademark EDF ENERGY (word mark) registered on June 25, 2003 with registration number 2335999.

The Complainant is also the owner of the following domain names: (i) <edf.co.uk> registered on April 15, 1999; (ii) <edf.com> registered on June 8, 2002; (iii) <edf.fr> registered on January 1, 1995; (iv) <edf.net> registered on February 16, 1998.

The Respondent registered the <edf-uk.eu> domain name (the “disputed domain name”) on June 4, 2007.

On June 18, 2007 the Complainant sent a letter to the Respondent requiring him to withdraw all domain names registered by him that included the term ‘edf’. The Respondent did not respond to this letter.

On November 11, 2007 the Complainant filed its Complaint, seeking the transfer of the disputed domain name. The Respondent’s default was notified on January 2, 2008.

On January 16, 2008, Dr. David J. A. Cairns was appointed as single panellist, and the file was transmitted to the Panel on January 21, 2008.

A. COMPLAINANT

The Complainant contends that the disputed domain name is identical or confusingly similar to the trademarks in which the Complainant has rights for many reasons including the following: (i) the disputed domain name entirely reproduces the trademark EDF; (ii) this term constitutes the most distinctive and meaningful part of the disputed domain name; (iii) the ‘uk’ part constitutes a generic term that does

not differentiate the disputed domain name from the Complainant's trademark; and (iv) given that EDF constitutes a well-known trademark, the disputed domain name creates or attempts to create confusion.

The Complainant states that the Respondent has no rights or legitimate interest in respect of the disputed domain name because: (i) the Respondent has no links with the Complainant's business; (ii) no authorization has ever been granted by the Complainant to the Respondent to register the disputed domain name or to use its trademark in it; (iii) the Respondent is not and has never been known or reputed under the term EDF; (iv) and the Complainant's rights in the EDF trademarks were well established before the Respondent registered the disputed domain name.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith for the following reasons: (i) because of their notoriety, it can be presumed that the Respondent knew about the Complainant's trademarks at the moment of registration ; (ii) considering such notoriety, it is reasonable to believe that registration of the disputed domain name was made with the sole purpose of preventing the Complainant from registering the domain name; (iii) the disputed domain name is passively held by the Respondent without hosting any website, which indicates that the Respondent does not conduct any legitimate commercial or non-commercial activity in relation to the disputed domain name; (iv) the Respondent registered other 'edf-uk' domain names, demonstrating the Respondent's intention to disrupt the professional activities of EDF; (v) any active use by the Respondent of the disputed domain name would create damage to EDF due to the confusion it creates to the users.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

Commission Regulation (EC) Nº 874/2004 of 28 April 2004 ("the Regulation") provides for an ADR procedure in respect of allegedly speculative or abusive domain name registrations. Article 21 of the Regulation describes speculative and abusive registrations. Article 21(1) states that a registered domain name is 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 10(1) defines 'prior rights' and includes registered national and community trademarks.

Article 21(2) sets out various circumstances that may demonstrate that the Respondent has a legitimate interest in the domain name. Article 21(3) elaborates circumstances that may demonstrate registration or use of a domain name in bad faith.

The Panel is required to decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules (paragraph B.11(a) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules")). Paragraphs B.11(d),(e) and (f) of the ADR Rules repeat the legal requirements of Articles 21(1), (2) and (3) of the Regulation.

A. The Complainant's Rights:
The Panel finds that the Complainant is the owner of the registered trademarks for the EDF trademark referred to above, and therefore has a right recognised and established by the national and community law in the trademark EDF.

B. Identical or Confusingly Similar:
The disputed domain name is not identical with the EDF trademark, but does incorporate this mark entirely. The fact that a trademark is incorporated in its entirety in a domain name is a solid indication, but does not ipso facto mean, that the domain name is confusingly similar to the trademark. The similarity of the trademark and the domain name depends on many factors, including "the relative distinctiveness of the trademark and the non trademark elements of the domain name, and whether the non trademark elements detract from or contradict the function of the trademark as an indication of origin" (See Pfizer Inc v. The Magic Islands, WIPO Case No. D2003 0870).

The disputed domain name differs from the EDF trademark by the addition of a hyphen and the suffix 'uk'.

The Panel finds that the disputed domain name is confusingly similar to the EDF trademark for the following reasons: (i) 'EDF' does not have any ordinary meaning but is a distinctive acronym; (ii) the suffix 'uk' is a geopolitical description that lacks distinctiveness (see BHP

Billiton Innovation Pty Ltd. v. Domain Place, WIPO Case No. D2007-0244); (iii) the separation of the two parts of the disputed domain name by a hyphen emphasises the trademark element part of the disputed domain name; (v) the EDF trademark is widely-known in Europe and Internet users will associate the disputed domain name with the Complainant's trademarks.

C. Rights or Legitimate Interest:
The Panel notes the following circumstances in relation to any possible rights or legitimate interest of the Respondent in the disputed domain name: (i) there is no evidence before the Panel that the Respondent has any proprietary or contractual rights in any registered or common law trademark corresponding in whole or in part to the disputed domain name; (ii) the Respondent is not authorized or licensed by the Complainant to use the EDF trademark or to register and use the disputed domain name; (iii) The Complainant's trademark rights substantially pre-date the Respondent's registration of the disputed domain name; (iv) there is no evidence that the Respondent has been commonly known by the disputed domain name; (v) the Respondent is not using the domain name in connection with the offering of any goods or services, nor is there any evidence of preparation to do so; (vi) there is no evidence of legitimate non-commercial or fair use of the disputed domain name; and (vii) the Respondent has not submitted a Response or otherwise asserted any right or legitimate interest in the disputed domain name.

Article 21(2) of the Regulation and paragraph B.11(e) of the ADR Rules provide a list of three circumstances, any of which is sufficient to demonstrate that the Respondent has rights or a legitimate interest in the disputed domain name. There is no evidence before the Panel of the existence of any of these circumstances in the present case.

Accordingly, the Panel concludes that the Respondent registered the disputed domain name without any rights or legitimate interest in the name.

The Complainant further contends that the disputed domain name was registered or is being used in bad faith. However, the Panel is not required to decide this question as under the ADR Rules and the Regulation registration or use in bad faith is an alternative, and not additional, requirement to registration without rights or legitimate interest.

Accordingly, the Complainant has satisfied the substantive requirements of the ADR Rules and the Regulation. The Respondent's registration is speculative or abusive, and the Complainant is entitled to the appropriate remedy in accordance with paragraph B.11(b) of the ADR Rules

D. Remedy:
The Complainant has submitted evidence that it is incorporated pursuant to French law with its registered office in Paris. Therefore the Panel finds that the Complainant satisfies the general eligibility criteria for registration of a .eu TLD set out in paragraph 4(2)(b) of Regulation (EC) Nº 733/2002 of the European Parliament and of the Council of 22 April 2002.

Therefore, the requirements for the requested transfer of the domain name to the Complainant are satisfied.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B.12 (b) and (c) of the ADR Rules, the Panel orders that the domain name <edf-uk.eu> be transferred to the Complainant.

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

PANELISTS

Name	David Cairns

DATE OF PANEL DECISION 2008-02-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant has demonstrated its rights in the EDF trademark. The disputed domain name is confusingly similar to this trademark as the addition of a hyphen and a geopolitical suffix is not sufficient to distinguish the disputed domain name from the EDF trademarks.

The Respondent did not file a Response asserting any rights of legitimate interest in the disputed domain name. On a consideration of all the circumstances the Panel found that the Respondent registered the disputed domain name without any rights or legitimate interest in

the name.

The Panel was not required to decide the Complainant's further contention that the disputed domain name was registered or is being used in bad faith, as under the ADR Rules and the Regulation registration or use in bad faith is an alternative, and not additional, requirement to registration without rights or legitimate interest.

Accordingly, the Respondent's registration was speculative or abusive. The Panel found that the Complainant satisfied the general eligibility criteria for registration of a .eu TLD and therefore ordered that the disputed domain name be transferred to the Complainant.