Panel Decision for dispute CAC-ADREU-004760

Case number	CAC-ADREU-004760
Time of filing	2007-11-09 11:30:50
Domain names	catalinamarketing.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Catalina Marketing Corporation

Respondent

Organization / Name	IWEBMENT MEDIA LIMITED, James Jackson

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

FACTUAL BACKGROUND

Catalina Marketing Corporation (hereinafter “Catalina” or “Complainant”) is a leading company in the behaviour-based marketing services and solutions. It was first incorporated in the United States on 10 October 1983 and afterwards expanded its business to the UK (on 11 December 1990), to France (on 4 October 1993) and to Italy (in January 2000).

The Complainant owns the following trademark registrations:

(a) Community trade mark No. 1,706,126 for the word mark CATALINA MARKETING, which is registered in respect of various goods and services in classes 9, 16, and 35;
(b) Community trade mark No. 3,145,109 for a device mark, which contains the words CATALINA MARKETING and which is registered in respect of various goods and services in classes 9, 16, and 35;
(c) UK trade mark No. 1,571,722 for the word mark CATALINA, which is registered in respect of various goods and services in classes 9, 16, and 35;
(d) UK trade mark No. 1,571,728 for the word mark CATALINA CHECKOUT SAVER, which is registered in respect of various goods and services in classes 16 and 35;
(e) US trade mark No. 2,606,388 for the word mark CATALINA MARKETING, which is registered in respect of services in class 35, in particular for “promoting the sale of goods and services of others through computerized distribution of messages and incentives, namely coupons. Premiums, rebates, cash discounts and/or samples”;
(f) US trade mark No. 2,860,092 for a device mark which contains the words and which is registered in respect of services in class 35, in particular for “Promoting the goods and services of others through the distribution of printed material and promotional contests; promoting the sale of goods and services of others through the distribution of incentives, coupons, premiums, rebates, cash discounts, samples and messages through direct mail, the Internet, and retail point of sale systems; marketing services, namely, direct marketing advertising for others, conducting marketing studies, and consumer behavior research and analysis”.
Moreover, the Complainant is the holder of a number of domain names, which include “catalinamarketing.com” and “marketing.co.uk”.

On 07.06.2006 Iwebment Media Limited (hereinafter the “Respondent”) registered the domain name “CATALINAMARKETING.EU” (hereinafter “Disputed Domain Name”).

In or around September 2006 the Complainant wrote to the Respondent notifying its interest in the Disputed Domain Name.

On 26.09.2006 the Respondent replied “(…) We have plans for the name and don’t intend to sell it at this time (…)”.

On 25.07.2007 the Complainant’s solicitors wrote to the Respondent requesting the return of the Disputed Domain Name.

The Respondent did not respond to that letter.

On 26.10.2007, the Complainant filed a complaint against the Respondent indicating in detail the factual and legal grounds supporting its claim for transfer of the Disputed Domain Name. The Complaint Time of Filing was 09.11.2007. On the same date, the Case Administrator acknowledged the receipt of the complaint and filed the “Request for EURid Verification”.

On 13.11.2007, EURid filed a “Nonstandard Communication” answering to the “Request for EURid Verification”.

On 14.11.2007, EURid filed a “Notification of Deficiencies in Complaint”. The deficiencies were related to the Respondent’s name and its contact details.

On 20.11.2007, the Complainant filed the Amended Complaint.

On 26.11.2007, the Case Administrator filed the “Complaint Check”, permitting the Complainant to proceed further in the ADR proceedings and forwarded the Complaint to the Respondent, together with the communication of “Commencement of the ADR Proceeding”. In this communication, the Case Administrator stated that, within 30 working days from the delivery of the Complainant’s notification, the Respondent must submit to the Court a Response according to the requirements that are described in ADR Rules, Paragraph B 3 and in ADR Supplemental Rules.

On 14.02.2008, since no Response was filed by the Respondent, the Case Administrator filed a “Notification of Respondent Default” serving the Respondent with all the appropriate information related to its default.

On 20.02.2008, the “Panelist Selection” was issued and this Panel filed the “Statement of Acceptance and Declaration of Impartiality and Independence”.

On 21.02.2008, the Case Administrator served the parties with the “Notification of Appointment of the ADR Panel and Projected Decision Date”.

On 25.02.2008, the “Case File” was transmitted to the Panel.

On 10.03.2008, the Panel filed a “Nonstandard Communication” requesting confirmation of the Complainant’s name as this appeared to be a typographical error in the Complaint.

On 19.03.2008, the Case Administrator filed three “Nonstandard Communications” clarifying, firstly, that “the Case Administrator in ADR Proceedings has no means to verify details of the Complainant but can notify the Complainant that those details are insufficient” and, secondly, that the Authorized Representative confirmed that Francine Hewes is the in-house lawyer for Catalina Marketing Corporation and that the latter is the Complainant. In the last “Nonstandard Communication” the Case Administrator extended the Projected Decision Date from 22.03.2008 to 31.03.2008.

On 25.03.2008 the Panel asked the Case Administrator to invite the Authorized Representative to confirm that Catalina Marketing Corporation is the correct Complainant and that the insertion of Francine Hewes as the Complainant was a typographical error and, accordingly, to file an amended Complaint.

On 02.04.2008 the Complainant’s Authorized Representative filed a further Amended Complaint specifying that the Complainant is Catalina Marketing Corporation.

A. COMPLAINANT

The Complainant contends that the Disputed Domain Name is identical to some of the above mentioned trade marks ((a), (b), (e) and (f)) and domain names “.com” and “.co.uk”, and is confusingly similar to the UK trade marks CATALINA and CATALINA CHECKOUT SAVER.

In addition, the Complainant submits evidence to prove that it also has widely used and promoted its trade mark CATALINA MARKETING since 1990 in the USA, in the UK, in France and in Italy. The Complainant states that it has invested heavily in its business and its marketing budget has been typically split between advertising in trade publications, web banners in e-publications and attendance at

trade show and conferences. Catalina Marketing contends that in 2006 alone £ 68,000 was spent on marketing activity in the UK.

For these reasons the Complainant contends that its rights in the name “Catalina Marketing” are protectable and enforceable under the common law of passing-off and under the Trade Marks Act 1994 in the UK and under the registered trade mark legislation and unfair competition laws of various territories overseas.

The Complainant further alleges that the Respondent does not have any legitimate rights or interests in the Disputed Domain Name. The Complainant asserts that Respondent has no connection with it, and it has not ever been an employee or an agent of the Complainant.

In the Complainant’s view the Respondent uses the Disputed Domain Name in the following manner:

• it attracts Internet browser searching for “Catalina Marketing” thereby creating a likelihood of confusion between the Disputed Domain Name and the Complainant’s trade marks and business names;
• it exacerbates that confusion by promoting businesses which also provide marketing services; and
• of particular concern to the Complainant is the fact that it then re-directs browsers to the web pages of these third party marketing companies from which services similar to those of the Complainant can be accessed/purchased.
Finally, the Complainant cites a decision in respect of the domain names “basler-haarkosmetik.eu” and “baslerhaarkosmetik.eu” registered by the Respondent as being indicative of the Respondent’s past conduct. In the Complainant’s view it is noteworthy that the Respondent attempted to sell the disputed domain names to the complainant during the ADR proceedings.

B. RESPONDENT

On 26.11.2007, the Case Administrator duly served the communication of “Commencement of ADR Proceeding”. In this communication, the Case Administrator expressly informed the Respondent of its duty to submit a Response within the term of thirty (30) working days from the communication, according to Section B 3 of the “.eu Alternative Dispute Resolution Rules” (hereinafter “Rules”). The Respondent did not submit its Response. Therefore, the Respondent is in default in this ADR procedure.

DISCUSSION AND FINDINGS

Under Paragraph B 11 (d) (1) of the ADR Rules “the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves 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”.
The Panel will proceed to establish whether the Complainant has discharged the burden of proof in respect of the the requirements set out in Paragraph B 11 (d) (1).

a) The default of the Respondent

First of all it is noteworthy that, notwithstanding the Case Administrator duly served the Respondent with the necessary communication (on 26.11.2007, the “Commencement of ADR Proceeding”), the Respondent did not file any Response and, therefore, did not challenge in any way the arguments affirmed by the Complainant and did not try to demonstrate its eventual rights in the Disputed Domain Name.

b) Identity or confusing similarity of the domain name “CATALINAMARKETING.EU”

The Complainant has provided and the Panel accepts, evidence of its registered trade marks and common law useage rights for CATALINA MARKETING in several countries, including the UK, which is the Respondent’s home country. The trade mark CATALINA MARKETING has been widely used and promoted. Based on the evidence provided by the Complainant, it has advertised its trade marks extensively across a broad range of newspapers and has developed substantial reputation and goodwill in relation to the mark.

Further, the Disputed Domain Name is identical to the Complainant’s registered trade mark CATALINA MARKETING.

Therefore, the Panel is satisfied that the Complainant has fulfilled Paragraph B 11 (d) (1) (i) of the Rules (as well as Article 21 (1) of the Regulation).

c) Respondent’s rights or legitimate interests in the domain name registration

The burden of proof rests with the Complainant to establish at least a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name and it is then for the Respondent to rebut this assertion.

The Panel accepts the Complainant's assertion that there is no relationship between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant nor has he otherwise obtained consent to use the words "catalina marketing" in the Disputed Domain Name.

The Respondent has used the Disputed Domain Name for the Complainant's trade marks in connection with a "pay-per-click" site that offers goods and services of one of the Complainant's competitors. The Respondent does not appear to have used the Disputed Domain Name in connection with any other bona fide offering of goods and services pursuant to Paragraph B 11 (e) (1) of the Rules. In several WIPO Administrative Panel Decisions (See WIPO Case No. D2004-0305, WIPO Case No. D2005-0356 and WIPO Case N. D2007-0449), the use of domain name to operate a "pay-per-click" search engine has not been deemed a bona fide offering of goods or services, but rather a circumstance which points to the Respondent's bad faith in the use of the Disputed Domain Name. In this case the Respondent has failed to demonstrate circumstances indicating why such a use, particularly in relation to links to competitor's sites is not bad faith use.

In view of the Respondent's apparent lack of bona fide interest in the Disputed Domain Name and the Respondent's failure to rebut the Complainant's assertion, in addition to the findings as noted under section (d) below, the Panel finds that the Complainant has succeeded in demonstrating that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Therefore, the Panel concludes that the Complaint fulfills Paragraph B 11 (d) (1) (ii) of the Rules (as well as Article 21 (1) (a) of the Regulation).

d) Respondent has registered or used the Disputed Domain Name in bad faith

Paragraph B 11 (d) (1) of the Rules, unlike the equivalent Paragraph 4 (a) of the Uniform Domain Name Dispute Resolution Policy (hereinafter the "Policy"), does not require a finding of both "registration and "use" in bad faith – one or other will suffice. Although, it is not strictly necessary under the Rules to determine this element, as the Panel's finding concerning no rights or legitimate interests has in part been informed by the Panel's consideration concerning bad faith, then it is appropriate for the Panel to do so.

The Panel considers that, at the time of the Disputed Domain Name's registration, it was highly unlikely that the Respondent was unaware of the Complainant's trade mark rights. The Complainant's trade mark was registered in the UK in 2000 (which is the Respondent's home country), 6 years prior the Disputed Domain Name's registration. As noted above the Complainant appears to have made substantial use of its trade mark in the UK through use and advertising since 2000.

Further, the Complainant's trade mark is highly distinctive and it appears to the Panel that it is unlikely that the Respondent chose the Disputed Domain Name by coincidence.

Finally, it is noteworthy that the Respondent registered the Disputed Domain Name on 7 June 2006, the date of the release announced by EURid. In the Panel's view, all these circumstances point to an inference that the Respondent chose its domain name "knowingly".

For these reasons the Panel is prepared to infer that the Respondent registered the Disputed Domain Name in bad faith.

In addition and as noted earlier, the evidence provided by the Complainant shows that the Respondent has hosted a sponsored links website, providing links to various competitors of the Complainant as well as to an affiliate site of the Complainant. Although not on its own definitive, the Panel considers that this circumstance is indicative also of use in bad faith.

Accordingly, the Complainant has satisfied the requirements of the Paragraph B 11 (d) (1) (iii) of the Rules.

(C) Conclusion

According to the above, the Complaint should be accepted and 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 CATALINAMARKETING be transferred to the Complainant

PANELISTS

Name	Alistair Payne

DATE OF PANEL DECISION 2008-03-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant provided evidence of its registered trade marks and common law useage rights for CATALINA MARKETING in several countries, including the UK, which is the Respondent's home country. The Panel found the Disputed Domain Name is identical to the registered trade mark owned by the Complainant and in which the Complainant has common law rights.
The Respondent did not file a Response asserting any rights of legitimate interest in the Disputed Domain Name and the Panel found that the Respondent registered the Disputed Domain Name without any rights or legitimate interest in the Disputed Domain Name.
The Panel considered, for several reasons, that at the time of the Disputed Domain Name's registration, it was highly unlikely that the Respondent was unaware of the Complainant's trade mark rights and in the circumstances of this case inferred that the Disputed Domain Name was registered in bad faith.
The Panel also considered that the Respondent's use of the Disputed Domain Name, for hosting a sponsored links website and providing links to competitors of the Complainant, is indicative also of use in bad faith.
Accordingly, the Panel ordered that the Disputed Domain Name be transferred to the Complainant.