Panel Decision for dispute CAC-ADREU-004863

Case number	CAC-ADREU-004863
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Domain names	babywell.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	Brand Scout GmbH

Respondent

Organization / Name	Georg Gottfried

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, pending or decided, that relate to the disputed domain name.

FACTUAL BACKGROUND

1. Complainant owns the German trademark no. 30257416 “Babywell” (with design), which was registered on 21 January 2003 for numerous childcare-related goods in classes 03, 05, 10, 11, 16, 20, 21, 25, 28, 29, and 30. The trademark depicts a baby that is crawling on top of the slightly stylized word “Babywell”. The word elements “Baby” and “well” are held in different colours.

2. On 20 June 2006 Respondent registered the disputed domain name “babywell.eu”. It is used for a “direct navigation“ parking website operated by Sedo and displays sponsored link advertisements for various third party websites. On this Sedo parking website the disputed domain name is also offered for sale to any interested third party.

3. On 8 August 2007 Respondent sent an e-mail to an affiliated company of Complainant and explicitly offered to sell the disputed domain name to this company.

A. COMPLAINANT

4. Complainant contends that the disputed domain name is identical or at least confusingly similar to its German trademark no. 30257416 “Babywell”. Complainant further states that Respondent never intended to use the disputed domain name for any other purpose than selling it, and that Respondent does not have any (other) own interest in the domain name. In its fairly brief Complaint Complainant finally contends that Respondent’s registration and use of the disputed domain name violate Complainant's trademark and obstruct Complainant's interests as the owner of its mark.

5. Based on these arguments Complainant requests transfer of the disputed domain name.

B. RESPONDENT

6. No Response or other communication has been received from Respondent in respect of the Complaint.

DISCUSSION AND FINDINGS

7. Respondent has failed to submit any Response to the Complaint. In accordance with Paragraph 10(a) of the .eu Alternative Dispute Resolution Rules (hereinafter the “ADR Rules”) the Panel nevertheless proceeds to a decision as set out below.

8. According to Article 21(1) of Regulation (EC) No. 874/2004 (hereinafter the “Public Policy Rules”) and Paragraph B11(d)(1) ADR Rules

Respondent's registration of the disputed domain name is considered abusive and speculative if

(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.

9. The Panel considers the domain name "BABYWELL" to be confusingly similar to Complainant's "Babywell" trademark. The most prominent feature of Complainant's trademark is the word element "Babywell", while the graphical elements merely appear as decorative additions that in no way dominate the overall impression of the mark. This differentiates the present case from previous decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP), where the respective panels found the figurative elements to be more dominant than the word elements (cf. WIPO Case No. D2006-0001 <post.com>, WIPO Case No. D2006-0778 <brabant-wallon.org>, or WIPO Case no. D2001-0964 <cream.com>).

10. The Panel has noted previous panel decisions which have held that figurative trademarks do not necessarily give rights in a word element contained therein, particularly if this word element is highly descriptive (CAC case no. 3299 WEBTV; CAC case no. 3299 MOTORSHOWBOLOGNAFIERE, the latter with additional references to various decisions under the UDRP). This Panel, however, tends to follow the reasoning in CAC case no. 596 RESTAURANTS and CAC case no. 597 RESTAURANT, where the respective Panels found the disputed domain names to be confusingly similar to the respective device marks despite the potentially descriptive nature of their word elements. This is based on the following considerations: During the phased registration period pursuant to Article 10 Public Policy Rules a priority domain name registration could be based on any registered trademark, irrespective of the goods or services for which it was protected. According to Section 19(2) of the EURid Sunrise Rules this was particularly true for device marks with design elements, irrespective of the potentially descriptive nature of their word element. Under the UDRP, which has served as a template for the dispute resolution mechanism of the Public Policy Rules and is therefore comparable in many aspects, it is generally agreed that the content of a website displayed under the disputed domain name (whether it is similar or different to the business of a trademark owner) is irrelevant in the finding of confusing similarity. For similar reasons this Panel tends to attach little weight to the potentially descriptive nature of a device mark's word elements when assessing the aspect of confusing similarity under Article 21(1) Public Policy Rules, but rather thinks that this descriptive nature is more appropriately dealt with under the second (legitimate interest) or third (bad faith) element of Article 21(1) Public Policy Rules. In this specific case the word element "Babywell" may indeed be more or less descriptive for some or all of the childcare-related goods for which Complainant's mark is registered. But unlike other words that could never be considered distinctive regardless of the goods or services at issue (such as, for example, "super", "extra", "ultra", "ideal" or "euro") the word "Babywell" is generally capable of distinguishing the goods or services of one undertaking from those of other undertakings (cf. Article 2 of the First Directive 89/104/EEC to Approximate the Laws of the Member States Relating to Trade Marks).

11. The following example may help to clarify this distinction: In CAC case no. 283 LASTMINUTE the complainant based its case on a trademark that had been registered as a word mark for clothing (class 25), even though this very word was descriptive for travel related services (which, coincidentally, was the complainant's main area of business). Accordingly the panel in that case had no problem finding the trademark and the domain name to be confusingly similar (or even identical), but discussed the descriptive nature of the relevant word only under the aspect of bad faith registration or use. For the present case this Panel finds that Complainant can just as well rely on its trademark registration for "Baybywell", regardless of the goods for which it is registered, to satisfy the first requirement of confusing similarity.

12. On the evidence made available to the Panel, and in the absence of any Response from Respondent, the Panel is convinced that Respondent does not have any rights or legitimate interest in the disputed domain name. Respondent is in particular not commonly known by the name "BABYWELL", and there is no evidence of any own domain name use (whether non-commercial or in connection with the offering of goods or services) by Respondent. The mere use of a third party's (in this case Sedo's) domain name parking system for sponsored link advertising is not sufficient to demonstrate Respondent's legitimate interest in the domain name (cf. CAC case no. 3976 ABAT, sub 3; CAC case no. 4337 ENTERPRISECARRENTAL; CAC case no. 3949 ACL; CAC case no. 2727 STAEDTLER; CAC case no. 3926 ESPRIT). While it is generally Complainant who bears the burden of proof regarding Respondent's rights or legitimate interest (or rather the lack thereof), Complainant's contention that the obvious facts do not demonstrate a right or legitimate interest of Respondent in the disputed domain name are sufficient in this regard. Based on these contentions the onus shifts to Respondent to produce factual evidence for a right or legitimate interest (see CAC case no. 2035 WAREMA, sub 8.1; CAC case no. 2888 GERMANWINGS; and the detailed discussion in CAC case no. 3444 OCUNET, sub 2). Respondent has not even claimed any right or legitimate interest in this regard.

13. The Panel concedes that the domain name “babywell.eu” could potentially be used in a legitimate (descriptive) manner for a website dealing with the well-being of babies. Such potential legitimate use is, however, in this Panel’s view not sufficient because Article 21(2) Public Policy Rules explicitly requires actual use (cf. sub-paragraphs a and c) or at least demonstrable preparations to do so (cf. sub-paragraph a). In this regard the Panel respectfully disagrees with the view expressed in CAC case no. 4438 INTERACTIVE-BROKERS, sub 33.

14. The first two elements of Article 21(1) Public Policy Rules are met, so that it is not necessary to consider the third element (bad faith registration or use) as well because it will have no influence on the final outcome of the decision. Given Respondent’s unsolicited offer to sell the domain name to an affiliated company of Complainant, and in view of the two earlier CAC decisions of which the Panel is aware and in which Respondent was apparently involved (cf. CAC case no. 3976 ABAT and CAC case no. 4438 INTERACTIVE-BROKERS), it nevertheless appears quite likely that at least the requirements of Article 21(3)(a) and/or Article 21(3)(b)(i) Public Policy Rules would be satisfied as well.

15. Complainant, being a limited liability company under German law, satisfies the eligibility requirement for .eu domain name registrations pursuant to Article 4(2)(b)(ii) of Regulation (EC) No. 733/2002.

DECISION

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

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

PANELISTS

Name	**Thomas Schafft**

DATE OF PANEL DECISION 2008-03-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Complainant owns the figurative German trademark “Babywell”, which is registered for numerous childcare-related goods. The Panel found the disputed domain name “babywell.eu” to be confusingly similar to Complainant’s trademark, despite the potentially descriptive nature its word element “Babywell”.

The Panel further held that Respondent’s use of the disputed domain name for a domain name parking website with sponsored link advertising does not constitute a legitimate interest. The theoretical possibility to use the disputed domain name in a legitimate descriptive manner for a website dealing with the well-being of babies was also not accepted as sufficient, because Article 21(2) Public Policy Rules explicitly requires actual (not potential) use or at least demonstrable preparations to do so.

Absent any other indications for a right or a legitimate interest that Respondent might have the Panel ordered to transfer the domain name to Complainant.