Panel Decision for dispute CAC-ADREU-004881

Case number	**CAC-ADREU-004881**
Time of filing	**2008-01-04 09:11:05**
Domain names	**jetpilot.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Point of Sports GmbH, n/a**

Respondent

Organization / Name	**Vinitsia, Ltd, n/a**

FACTUAL BACKGROUND

The Complainant, Point of Sports GmbH ("PoS"), is a distributor of the holder of the trade mark JET PILOT, Japanese company Chiyoda Building Co. Ltd. Chiyoda). Chiyoda is the owner of the trademark JET PILOT, which is protected through word mark and/or design mark registrations in several countries throughout the world, including in France, Germany, Italy, Spain, Switzerland, the United Kingdom and in the Benelux as well as through the community trademark registration No. 2335776 JET PILOT.

The Respondent, Vinitsia Ltd., registered the disputed domain name on 7 April 2006. Respondent failed to submit its Response.

A. COMPLAINANT

The Complainant argues in its Complaint that the disputed domain name (i) is identical or confusingly similar with the protected name (JETPILOT), (ii) was registered without any rights or legitimate interest in the name and/or (iii) is being used in bad faith.

1. Identicality/Similarity of the disputed domain name

The Complainant argues that the disputed domain name is identical or at least confusingly similar to the protected name, the only difference being the space between JET and PILOT in the trademark.

2. Registration without rights or legitimate interest

The Complainant argues that there is no indication whatsoever which could prove Respondent's legitimate interests to the disputed domain name. The company name of the Respondent does not in any way correspond to the domain name. The domain name is still not activated.

According to the Complainant, there is no indication on the Internet or otherwise that the Respondent holds any trademark or

trade name that correspond to the disputed domain name or that the Respondent is commonly known by the domain name, or that the Respondent has used the domain name or a name corresponding to it in connection with the offering of goods or services, or made any demonstrable preparations to do so.

Furthermore the Complainant argues that there is no indication on the Internet or otherwise that the Respondent is making a legitimate and non-commercial or fair use of the disputed domain name.

3. Respondent's bad faith

According to the Complainant, the domain name has been registered for abusive speculative purposes, i.e., in order to prevent the holder of corresponding trademark rights to register and use the domain name. As mentioned in the Complaint, Chiyoda sent a letter to the Respondent on 10 August 2006, in which Chiyoda asserted its rights to the trademark JET PILOT and requested a transfer of the disputed domain name. The Respondent responded on 22 December 2006 that it could transfer the domain name to Chiyoda for 30 EUR. However, after various reminders without any further reaction or other proposal from the Respondent, The Complainant argues it is clear that the Respondent has had no interest or intention in transferring the domain name for the proposed fee, but rather waited for a more substantial offer from the Complainants.

The Complainant further mentions a pattern of conduct by the Respondent and demonstrates such pattern of conduct by a number of .eu ADR decisions.

B. RESPONDENT

As mentioned above, Respondent failed to submit a Response. The Panel verified with the Case Administrator that the Respondent was properly notified of the Response in accordance with the ADR Rules. According to the Case administrator, the postal package sent to the Respondent's address was returned back because the addressee was not known on the specified address. Despite the fact that the Respondent failed to submit its Response, the Panel decided to consider the present case on its merits, i.e. without exercising the option given to the Panel by Par. B10(a) of the ADR Rules to decide in favour of the Party not in default – i.e. the Complainant.

DISCUSSION AND FINDINGS

1. Preliminary Issue

The Panel thinks it necessary to deal with the following preliminary issue before discussing the Complainant's claims:

Is it possible in .eu ADR that two unrelated co-Complainants file a single Complaint?

In the present case, the Complaint seems to be filed by two entities, PoS and Chiyoda as co-Complainants. PoS and Chiyoda are unrelated independent business partners, a producer and its distributor.

ADR Rules expressly exclude more than one unrelated Complainants for disputes with more than one disputed domain name. Par. B1(c) of the ADR Rules states that "The Complaint may relate to more than one domain name, provided that the Parties and the language of the ADR Proceedings are the same.").

There are no such express provisions for disputes with a single disputed domain name. Nevertheless, the definition of "Complainant" in the ADR Rules speaks about "the Party initiating a Complaint" and the definition of "Party" means "a Complainant …..". In addition, the on-line platform of the Czech Arbitration Court does not technically enable to input into the form of a Complaint more than one entity. In the current ADR Proceeding, the Complainant for this technical reason had to include only PoS as the Complainant in the Complaint form on the on-line platform and mentioned Chiyoda as its co-Complainant only in the Annex to the Complaint, containing a copy of the Complaint in PDF.

All this suggests that the ADR Rules currently do not allow multiple unrelated parties to act as co-Complainants in a single ADR Proceeding. According to the (limited) knowledge of the Panel, there has been no ADR Proceeding where the co-

Complainants were unrelated entities.

Therefore, the Panel concludes that .eu ADR Rules do not allow more than one unrelated entities to file a single Complaint as co-Complainants. In the present case, the Panel considers PoS as the single Complainant because this is the entity to which the disputed domain name is to be transferred according to the Complaint.

As a side note, due to the annexed copy of the Complaint in PDF which mentions Chiyoda as a co-Complainant it is clear that the electronic submission did not fully correspond with the hardcopy of the Complaint. Although this difference was understandably made by the Complainant due to the technical reasons of the on-line platform, the Panel recommends to the Case Administrator to notify and clarify this formal inconsistency with the ADR Rules in future similar ADR Proceedings.

2. Respondent‘s lack of rights or legitimate interests and/or his bad faith

After dealing with the preliminary issue mentioned above, the Panel agreed that the disputed domain name is confusingly similar, indeed almost identical with the protected name. Then the Panel considered whether the Complainant sufficiently presented and proved Respondent‘s lack of rights or legitimate interests and/or his bad faith.

As the Complainant mentioned in its Complaint, in Panel decision ADR 2035 (WAREMA) the Panel stated in relation to demonstrating a right or legitimate interest in the disputed domain name according to Art. 21(2)(a) and (b) of the Regulation EC/874/2004: “Furthermore, the Panel holds that although the burden of proof lies with the Complainants, the existence of a right or legitimate interest is difficult to prove since the relevant facts lie mostly in the sphere of the holder. Hence, the Panel holds that it is sufficient that the Complainants contend that the obvious facts do not demonstrate a right or legitimate interest of the Respondent in the Domain Name. The onus then shifts to the Respondent to produce factual evidence for a right or legitimate interest”.

The Panel agrees with this approach. Since the Complainant complied with the stated requirements and the Respondent failed to file a Response, the Panel agree with the Complainant that the Respondent does not have any rights or legitimate interest in the name.

Regarding Respondent‘s bad faith, the Complainant referred to a pattern of conduct of the Respondent, demonstrated by several .eu ADR Decisions, such as Decision No. 04269 Vinitsia Ltd ./. SALOMON S.A. regarding domain name salomonsports.eu, Decision No. 03024 Vinitsia Ltd ./. Euro Suisse International Ltd, Mr Disby Tang regarding domain name binatone.eu, Decision No. 03149 Vinitsia, Ltd. ./. Edscha AG regarding domain name edscha.eu, decision No. 01412 Vinitsia, Ltd. ./. Pharma Medico UK Ltd., Morten Christensen regarding domain name nourkrin.eu, and Decision No. 01304 Vinitsia Ltd ./. Kemet International Limited, Dr Andrew George Riedl regarding domain name kemet.eu.

In addition, the Respondent is not known on the postal address it provided to EURid. One member of the current Panel asserts that under Swedish law it is possible to have a company name including an “Ltd” suffix only in case of a branch/division of a foreign company and that no such branch was registered in the name of the Respondent, Vinitsia . All this together with the demonstrated pattern of conduct suggests that the Respondent may have intentionally provided a false address to EURid. For these reasons the Panel considers that the Respondent registered the disputed domain name with bad faith.

3. Remedies requested

The Complainant requested in its Complaint a transfer of the disputed domain name. The Complainant is not the owner of protected name JET PILOT, it is Chyioda who owns the trademarks JET PILOT. The Complainant is a distributor of Chyioda. Annex 2 § 3 to the Complaint, the Distribution Contract, does not even constitute an exclusive license but a (limited) sole distribution contact. A sole contract is not an exclusive right - and not a licence at all - but gives the supplier (Chiyoda) a right to also distribute the goods itself within the agreed territory in competition with the distributor. In addition, the Distribution Contract states in its Par. 14.1.3 that “…. Any proceedings against such infringers shall be within the exclusive control of the Supplier [meaning Chiyoda] and the Supplier‘s expense… ”.

There have been several decisions in .eu ADR dealing with the question whether a licensee is entitled to the transfer of the disputed domain name. In several Decisions, the Panel decided to transfer the disputed domain name where a controlling entity granted a non-exclusive worldwide license to its subsidiary to use the protected name (e.g. in ADR 5668 – NEXCOM). In some decisions, Panel decided for the transfer in case of an exclusive European license granted again by a controlling entity to its wholly owned subsidiary (e.g. in ADR 4759 – CYWORLD).

In the present case, as mentioned above, the Distribution Contract is not an exclusive license and PoS and Chiyoda are not related entities. The Panel considers that even if the Complainant was granted an exclusive right limited for use in Europe this would probably not constitute a right in itself for the transfer of the disputed domain name, since the domain names .eu are not limited geographically to Europe and, as mentioned above, PoS is not a subsidiary of Chiyoda.

Therefore, it was the opinion of the Panel that a transfer in this case necessitates a formal consent of the rightholder, Chiyoda. The Panel requested that the Complainant provides such a consent. The Complainant did provide the consent of Chiyoda in the form of a telefax message. Therefore, the Panel is satisfied that the rightholder, Chiyoda, consents with the transfer of the disputed domain name to the Complainant.

Because the Complainant, Point of Sports GmbH, is an entity eligible to be the holder of .eu domain name in accordance with the Par. 4(2) b) of Regulation 733/2002, the Panel orders that the domain name jetpilot.eu be transferred to Point of Sports GmbH.

DECISION

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

PANELISTS

Name	**Wolter Wefers Bettink**

DATE OF PANEL DECISION 2008-04-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

In this case, a German distributor together with Japanese trademark holder sought transfer of the disputed domain name “jetpilot” to the German distributor. Two issue are interesting in connection with the case: (i) whether ADR Rules enable two unrelated co-Complainants to file a single Complaint; and (ii) whether a non-exclusive licensee of a limited trademark use right can be transferred a disputed domain name substantially similar to the trademark.

The Panel came to a conclusion that (i) current ADR Rules do not enable several unrelated co-Complainants to file a single Complaint; this will change after the adoption of so called Class Complaint procedure; and (ii) a non-exclusive licensee must present a consent of the trademark holder with the requested transfer of the disputed domain name to the licensee (in the present case, a distributor).

The Panel considered the German distributor as the only Complainant and ordered to transfer the disputed domain name to him becuase the trademark holder provided its consent with the transfer.