Panel Decision for dispute CAC-ADREU-004955

Case number	CAC-ADREU-004955
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Domain names	collierscre.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Colliers International Property Consultants Inc and Colliers CRE Plc

Respondent

Organization / Name	Zheng Quingying

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

1. The Panel has been advised by the Complainants that the Disputed Domain Name is the subject of proceedings by EURid against the Respondent before the Court of First Instance (CFI) in Brussels and that court has apparently ordered certain domain names, including the Disputed Domain Name, be placed on hold. Apparently also, this hold order was the subject of a summary procedure, presumably for its discharge, which was refused, and is now appealed. Aside from that summary procedure, a decision on the merits in the action is not expected until the end of 2008. No orders, judgments or statements of case from that action were submitted. The Complainants instead submitted emails from EURid's legal department. EURid's opinion is that the court proceedings are no bar to the initiation of this ADR proceeding.

2. It is less clear what EURid's position is as to any transfer ordered by this Panel, if any, as it seems to suggest both that no transfers can be made in light of the hold order but also that any transfer ordered would still be made within 30 days of this Panel's decision, if any.

3. The ADR Rules laid down under Article 22(1)(a)and (b)of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Policy Regulation")provide at Rule A(5) that the conduct of ADR Proceedings shall not be prejudiced by any court proceeding. This is subject to Rule A(4)(c)which says that the Panel shall terminate an ADR proceeding if the dispute the subject of the Complaint has been finally decided by a court. We are not aware of the subject of the proceedings before the court, EURid refers to eligibility issues so we assume the action is for revocation under Art. 20 of the Policy Regulation. If so, there is no identity of issues and no final decision has been given, on the information available to us.

4. Without the court hold order, we cannot know whether it will prevent the Registry from implementing any transfer decision made by this Panel. We would assume it would. However, the Complainants likely wish to avoid the Disputed Domain Name being released back to the market on any eventual order for revocation and wish to proceed with this ADR proceeding, even if any transfer ordered, if any, must await the outcome of the court action.

FACTUAL BACKGROUND

5. The Respondent registered the Disputed Domain Name on 7 November 2006. His details were withheld from the WHOIS database and the Complainants obtained disclosure of the Respondent's identity from EURid.

6. The Complainants are part of a group of real estate and property services companies known as Colliers International with 267 offices in 57 countries. The business started in 1976, initially in Australia, later moving into Asia, the Americas, Europe, the Middle East and Africa. It has annual revenues exceeding US $1 billion. The first Complainant owns the registered marks and the second is a UK entity, Colliers CRE Plc, an AIM listed company, incorporated in 2001, and the second largest group company, with 16 UK offices and revenue of

USD$180 million in 2006.

7. On 27 December 2006, the Complainants, by their solicitors, sent a cease and desist letter to the Respondent by recorded delivery. No response was received.

8. As at 30 November 2006, the Disputed Domain Name did not resolve to a website but by 12 June 2007, it pointed to a Sedo parking site where it was offered for sale for £380. That offer had disappeared by 14 June 2007. The Complainants submitted screenshots as of each of these dates.

A. COMPLAINANT

9. The Complainants say they have rights in the names COLLIERS and COLLIERS CRE to which they say the Disputed Domain Name, is identical or confusingly similar. They contend the Respondent lacks any rights or legitimate interests in the Disputed Domain Name, which they say was registered and is used in bad faith.

10. The Complainants rely on the following to support their claims to rights.

10.1. The registered Community marks; E832733, the word mark COLLIERS, and E832758, a figurative mark employing the word mark and a device. They say the Disputed Domain Name is similar to these marks and the word mark forms the dominant part of the Disputed Domain Name rendering it confusingly similar.

10.2. Rights under English common law protected by the cause of action for passing-off, based on the goodwill and reputation arising from use of the name, COLLIERS CRE, in trade in the UK. They say the Disputed Domain Name is identical to this mark.

11. The Complainants submit the Respondent has no rights or legitimate interest in the Disputed Domain Names. In particular:

11.1. The Respondent has no connection with the Complainants and has no consent, permission or licence to use their registered and/or unregistered marks.

11.2. There is no evidence of any use by the Respondent constituting an offering or preparations prior to the cease and desist letter of 27 December 2006, for the purposes of Art. 21(2)(a)of the Policy Regulation.

11.3. There is no evidence the Respondent is commonly known by the name, for the purposes of Art. 21(2)(b) of the Policy Regulation.

11.4. There is no evidence of legitimate or non-commercial fair use, for the purposes of Art. 21(2)(c) of the Policy Regulation. The Complainants further submit the Respondent's use is commercial and the Respondent has failed to submit any evidence yet if it had an innocent or legitimate explanation it would have come forward with it or answered the cease and desist letter.

12. As to bad faith, the Complainants rely on the following:

12.1. The offer to sell the Disputed Domain Name for £380 on the site on 12 June 2007, was designed to elicit an offer from the Complainants pursuit to Art. 21(3)(a) of the Policy Regulation.

12.2. The marks are uniquely associated with the Complainants and the Respondent must have had prior knowledge of the Complainants and known they would want the Disputed Domain Name, which was registered to block them, pursuit to Art. 21(3)b) of the Policy Regulation.

12.3. Further, the Respondent has engaged in a pattern of such conduct, evidenced by some 15 findings of bad faith against him in EURid ADR proceedings. This, it is submitted, is why he withheld his name from the WHOIS database.

B. RESPONDENT

13. The Respondent failed to submit any Response.

14. §10 of the ADR Rules provides that where there is a failure to comply with a time period, the Panel is to proceed to a decision on the Complaint and may consider the failure as grounds to accept the claims of the other party or draw the appropriate inferences.

DISCUSSION AND FINDINGS

15. The Policy Regulation allows a party to initiate an ADR procedure where a registration is speculative or abusive, as defined in Art. 21.

16. This allows for revocation or transfer where the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national or Community law and where registered without rights or legitimate interest and registered or used in bad faith. This is reflected in §11(d) of the ADR Rules.

17. The Policy Regulation at Art. 21(2) provides examples of how legitimate interest may be demonstrated, echoed in §B11(e)of the ADR Rules), and Art. 21(3) provides examples for bad faith echoed in §B11(f)).

18. In this case, the Complainants have rights recognized by Community law in the registered Community marks. The dominant part of the Disputed Domain Name is the word Colliers, which is the registered word mark. They are therefore, confusingly similar. The Complainants submitted very extensive evidence as to the use of the unregistered or common law mark, Colliers CRE, in trade in the UK, providing financial and promotional material and press and media clippings as well as evidence of their use of the domain name collierscre.com. The Disputed Domain Name is identical to this common law or unregistered mark. We find the Complainants have the requisite rights.

19. There is nothing on the face of the facts suggesting the Respondent has any legitimate rights or interest in the name, pursuant to Art. 21(2) of the Policy Regulation. The Complainants say, and we accept, that once they make out a prima facie case as to the lack of any such factors, the burden shifts to the Respondent. That burden is obviously not discharged here and the Respondent has not come forward with any justification for his selection and use of the Disputed Domain Name. There is no licence, offering, own name or other use. We can see no use other than the parking for advertising revenue, which is a commercial use.

20. As to bad faith, we find bad faith made out on all counts, the offer on Sedo, the uniqueness of the name and its exclusive use by the Complainants together with prior knowledge more likely than not, and the Respondent's pattern of bad faith registrations.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name COLLIERSCRE be transferred to the Complainant

PANELISTS

Name	**Ms. Victoria McEvedy**

DATE OF PANEL DECISION 2008-06-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

English language summary

The Complainants sought the transfer of the domain name ColliersCRE.eu

based on its Community Trade Marks and its unregistered UK mark arising from its trade in the UK. The Complainants alleged lack of rights or legitimate interest on the basis that the Respondent had no licence, no offering, no right and made only commercial and non legitimate use. Bad faith was alleged on the basis of an offer for sale, prior knowledge and uniqueness and a pattern of registrations. The Respondent was in default.