Panel Decision for dispute CAC-ADREU-005126

Case number	CAC-ADREU-005126
Time of filing	2008-07-15 11:52:16
Domain names	averygraphics.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Avery Dennison Corporation; Avery Dennison U.K. Ltd., Sapphire

Respondent

Organization / Name	Dotasterisk Ltd., Dotasterisk Ltd.

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 which are pending or decided in relation to this dispute or the disputed domain name <averygraphics.eu>.

FACTUAL BACKGROUND

The Complainant has requested transfer of the domain name <averygraphics.eu> to the Complainant by initiating ADR proceedings.

The Complainant, Avery Denninson Corporation, through its subsidiary Avery Denninson UK Ltd. (collectively, “Avery” or “The Complainant”), has successfully registered and has valid trademark rights on the word “AVERY” in connection with the bona fide offering goods and/or services that have to do with graphic arts and stenography products ranging from writing instruments to paper, adhesive labels and graphic laminates. The said trademark registrations are protected in a wide range of jurisdictions throughout the countries of the European Union as well as in the United States.

The Respondent is Dotasterisk, Ltd. with physical location in London, Great Britain. According to the information retrieved from the WHOIS database, the Respondent registered the disputed domain name <AVERYGRAPHICS.EU> with deLink GmbH, a Registrar located in Germany, on April 7, 2008.

The Complaint was filed on July 15, 2008 and the Respondent failed to provide a Response to the Complaint.

A. COMPLAINANT

The Complainant seeks a transfer of the disputed domain name <averygraphics.eu> from the Respondent to the Complainant in accordance with Paragraph B 11 (b) the .eu Alternative Dispute Resolution Rules (hereinafter “the ADR Rules”). In line with this, the Panel contends that the Complainant satisfies the general eligibility criteria for registration according to Paragraph 4 (2) (b) of Regulation (EC) No 733/2002.

The Complainant contends the following:

The Complainant has registered trademark rights in the mark “AVERY” in connection with graphic arts and stenography products ranging from writing instruments to paper, adhesive labels and graphic laminates. The Complainant owns the following registered trademarks on the term “AVERY” throughout the European Union: (1) Armenian Registration No. 7757 (December 29, 2003); (2) Austria Registration No. 51985 (March 2, 1964); (3) Benelux Registration No. 23540 (September 3, 1972); (4) Swiss Registration No. 329834 (March 9, 1964); (5) Czech Registration No. 159801 (June 23, 1970); (6) German Registration No. 818059 (April 6, 1966); (7) Danish Registration No. 29551965 (November 6, 1965); (8) Spanish Registration No. 433917 (October 30, 1963); (9) Finnish Registration No. 44089 (February 19,

1965); (10) French Registration No. 1491992 (November 7, 1963); (11) United Kingdom Registration No. 856328 (July 1, 1977); (12) United Kingdom Registration No. 856329 (November 8, 1963); (13) Greek Registration No. 30780 (October 17, 1964); (14) Greek Registration No. 42305 (July 19, 1969); (15) Hungarian Registration No. 120340 (October 22, 1968); (16) Irish Registration No. B71188 (August 12, 1968); (17) Irish Registration No. B71189 (August 12, 1968); (18) Irish Registration No. 121208 (May 26, 1986); (19) Irish Registration No. 121209 (May 26, 1986); (20) Italian Registration No. 427030 (December 14, 1966); (21) Norwegian Registration No. 63587 (March 19, 1964); (22) Polish Registration No. R-48674 (November 28, 1969); (23) Portuguese Registration No. 121109 (October 18, 1965); (24) Portuguese Registration No. 121110 (October 18, 1965); (25) Swedish Registration No. 113629 (August 6, 1965); Slovakian Registration No. 159801 (May 24, 1998). The Complainant also holds a valid registration of the same mark <AVERY> in the United States dated July 23, 1963, Registration No. 0753359 (Exhibit A: Registration Certificate, Exhibit B: Registration Certificate 2, Exhibit C: Registration Certificate 3), which they have renewed on September 22, 2004 (Exhibit D: Renewal Notice). According to the Complainant, the aforementioned registrations are prima facie evidence of the validity of the mark <AVERY>. The <AVERY> trademark has been used in connection with a variety of graphic design products since at least as early as 1941 and, for this, the Complainant attaches evidence in the form of Exhibit A (Registration Certificate I, II, III). He also attaches evidence of renewal of the trademark registration in the USPTO, in the form of Exhibit A (Renewal Notice).

The Complainant further contends that Avery, as a business, has established itself as a leader in the field of graphics and graphic design products and office supply/business support products. Over 65 ago, Avery created and began marketing a distinctive line of products under the term <AVERY>, and it proceeded to register <AVERY> as a trademark in various jurisdictions around the world. According to the Complainant, Avery's <AVERY> products are well-known and highly regarded among consumers of graphic design goods, adhesives, paper and office products. The Complainant asserts that they have spent considerable sums on advertising and promotion of the <AVERY> trademarks in connection with their goods.

The Complainant is further of the opinion that the <AVERY> mark has become directly associated with the Complainant's goods and has acquired a secondary meaning to the customers conducting business with the Complainant. The Complainant believes that over its many years of developing, marketing and delivering its goods, consumers have also associated the quality of the Complainant's goods with its <AVERY> marks with the Complainant having benefited from such association.

In trying to convince the Panel that the domain name in question <averygraphics.eu> should be transferred to them, the Complainant contends that the disputed domain name <averygraphics.eu>, which is registered by the Respondent, is virtually identical to the Complainant's mark <AVERY>; the only differences are the addition of a highly descriptive term and the generic domain identifier. Moreover, the disputed domain name has at times, according to the Complainant, been used in connection with an Internet site where the Respondent has offered links to third-party providers of graphic design and office products in direct competition with the Complainant. This, for the Complainant, has resulted in the profiting of the Respondent.

The Complainant's rights on the term <AVERY> are undisputed, since the Complainant provided evidence of multiple trademark registrations consisting of the term <AVERY> in several jurisdictions. According to the Complainant, the Respondent added the descriptive term "GRAPHICS" and the top-level territorial identifier ".eu" to the mark of the Complainant. As a result of this, the Respondent's domain name looks and sounds like a plausible domain name affiliated with the business of the Complainant. For these reasons, the Complainant asks the Panel to acknowledge the confusingly similar character between the disputed domain name <averygraphics.eu> and the Complainant's trademark <AVERY>.

The Complainant also draws analogies between the EURid domain name disputes before the Czech Arbitration Court and the Uniform Domain Name Dispute Resolution Policy (UDRP) endorsed by the Internet Corporation for Assigned Names and Numbers (ICANN) in order to make the arguments further convincing. (Sony Ericsson Mobile Communications AB v. D-B-S, Piotr Marchinski – Case No. 04423, 2007-08-07).

For the Complainant, the addition of a highly descriptive term and the top-level domain identifier ".eu" to the Complainant's established <AVERY> mark is insufficient to distinguish the disputed domain name from the Complainant's registered mark provided that <AVERY> remains the dominant feature of The Respondent's domain name (Perot Systems Corp. v Harold R. Brown III, FA0105000097303; Victoria's Secret et al v Harold R. Brown II/Ted Waitt, FA0101000096561).

Furthermore, the Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name and they argue the following.

The Respondent registered the disputed domain name <averygraphics.eu> on April 7, 2006, long after the date of first use of the Complainant's mark <AVERY>, which dates back to 1941 and after the date that the mark was first registered as a valid trademark in Europe back in 1963. Therefore, the Complainant's use and registration of the name <AVERY> far precedes the Respondent's registration

of the domain name <averygraphics.eu>.

The official representative for the Complainant has sent cease and desist letters as well as reminders to the Respondent, including most recently on May 9, 2008, which was sent to the Respondent's administrative contact email addresses as provided in the WHOIS database (Exhibit B). According to the Complainant, the Respondent has not responded to these letters, whilst his domain name promotes a company or entity having to do with "European Identity". In the early period following the Respondent's original registration of the disputed domain name, it was used in connection with a web site featuring a keyword list containing the terms "Avery Dennison", "Avery", "Self Adhesive Labels", and the like, which provided links to third-parties' web sites from the site of the dispute domain name <averygraphics.eu>, namely those of the Complainant's competitors. According to the Complainant's information and belief, the Respondent profited from "page views" generated by visitors seeking information about the Complainant's AVERY-branded goods, and from "click-thoughts" to the third party sites by those visitors who assume that there is some association, affiliation or sponsorship between the Complainant and the Respondent (and the third-parties linked on the Respondent's site), which is not the case.

For the Complainant, in any event and given their extensive trademark rights on the term <AVERY>, the Respondent has no legitimate interest in the use of the disputed domain name, <averygraphics.eu> and for this reason the Respondent is a classic trademark infringer. There is no evidence whatsoever that the Respondent has ever used the name <AVERY> in connection with the bona fide offering of goods and/or services (Compagnie de Saint Gobain v Com-Union Corp., WIPO D2000-0020). The Complainant further argues that, as it appears, the Respondent has not used the <AVERY> name in connection with any web site or other activity where bona fide non-commercial or fair use of the AVERY mark is made. Rather, the Respondent's sole use of the mark is in connection with an Internet site unaffiliated with the Complainant where the Respondent has and is apparently selling competitive goods and/or services. As such, the Respondent cannot be deemed to have any legitimate interest or right in the domain name (General Electric Company v. Forddirect.com, Inc., WIPO D2000-0394).

Finally, the Complainant asserts that the Respondent's registration and use of the disputed domain name <averygraphics.eu> has been done in bad faith. According to the Complainant's contentions, the Respondent has made no attempt to create a legitimate interest in the domain name. In order to support this argument, the Complainant contents that, according to the ADR Rules, registration of a domain name with the purpose of attracting users for commercial gain constitutes bad faith. Moreover, for the Complainant, the Respondent cannot use lack of knowledge as their defense; they knew or they should have known that registration of <averygraphics.eu> infringed on the Complainant's rights and this conduct would further prevent the Complainant from using the <AVERY> mark in a corresponding domain name. Furthermore, in light of the Respondent's activities at the <averygraphics.eu>, including their choice of "keywords" and the nature of the goods and services linked to on the site, the use of the Complainant's widely-known mark permits the inference that the Respondent was aware of the <AVERY> mark prior to the registering the disputed domain name; this has been decided that constitutes bad faith (Victoria's Secret et al v Harold R. Brown II/Ted Waitt, FA0101000096561; Sony Ericsson Mobile Communications AB v. D-B-S, Piotr Marchinski – Case No. 04423, 2007-08-07). The domain name <averygraphics.eu> is so obviously connected with the Complainant and its goods that its registration and/or use by someone with no connection with the Complainant suggests bad faith. The Respondent is not a licensee or authorized dealer of the Complainant, nor has the Respondent otherwise obtained authorization to use the Complainant's <AVERY> mark.

B. RESPONDENT

The Respondent is in default having failed to provide a timely response to the Complaint.

DISCUSSION AND FINDINGS

First of all, the Panel notes that the Respondent is in default in the meaning of Paragraph B 10 (a) and (b) of the ADR Rules, which state that the Panel may consider the failure by the Respondent to comply with the time limits for filing a Response as grounds to accept the claims of the Complainant, and that the Panel shall draw such inferences from the default as it considers appropriate.

According to Articles 21 (1) and 22 (11) of the Commission Regulation (EC) No 874/2004 and Paragraph B 11 (d) (1) of the ADR Rules the Complainant bears the burden of proof in proving the following:
(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 would like to assert, before starting establishing whether the requirements of Paragraph B 11 (d) (1) apply, that, in deciding this dispute, account will not be given to the cited case law that the Complainant has provided and therefore not make use of precedent, especially one that is derived from a similar dispute resolution process like the UDRP.

The first requirement is that 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. The Panel finds as follows:

The Complainant is the legitimate proprietor of the trademark <AVERY>. In fact, the Panel is of the opinion that the Complainant holds very strong trademark rights on the term <AVERY> having valid trademark registrations in both the United States and Europe. Especially, with the trademark rights within the European Union, the Panel has to acknowledge that the Complainant registered these prior to the introduction of the Community trademark, which merely demonstrates the will of the Complainant to protect their trademark rights across the countries of the European Union. This, by itself, demonstrates to the Panel the strong trademark rights that the Complainant possesses and their willingness to protect these against potential infringers. Even though the mark <AVERY> does not fall within the category of the marks one might characterize strong or well-known, still the Panel accepts that <AVERY> is a strong trademark and known within the groups of businesses, individuals and entities that deal with graphic designing.

The Panel, therefore, accepts that the registration of the disputed domain name <averygraphics.eu> is similar to the trademarked term AVERY and can potentially confuse and/or mislead consumers. The disputed domain name consists of two words: “avery” and “graphics”. Although the Panel should accept that this domain name is not identical per se to the Complainant’s trademark <AVERY>, still the addition of the word ‘graphic’ represents the kind of business of the Complainant and is not enough, according to the Panel, to distinguish it from the Complainant’s mark. It is almost inevitable that when consumers access the website <averygraphics.eu>, they will think that they are accessing a website affiliated with the Complainant. For these reasons, the Panel declares that the Complainant has satisfied the first of the requirements of paragraph 11 (d)(1)(i) of the ADR Rules and that the disputed domain name <averygraphics.eu> is confusingly similar to the Complainant’s mark.

The second requirement as per paragraph 11(d)(1)(ii) of the ADR Rules is that the domain name holder has no rights or legitimate interests in the disputed domain name.

The Complainant contends that through the disputed domain name <averygraphics.eu>, the Respondent promotes a business or an entity having to do with “European Identity”. They further contend that prior to this the domain name was being used in connection with a web site featuring a keyword list containing the terms “Avery Dennison”, “Avery”, “Self Adhesive Labels”, and the like which provided links to third parties’ websites that were in direct competition with the Complainant. Having not received a response from the Respondent, the Panel conducted their own research and the Respondent’s site is indeed promoting some sort of an “European Identity” business; however, the site is currently inactive, therefore, the Panel was not able to retrieve more information. Although the Panel has only the words of the Complainant that, at some moment in time, the website was potentially harming the Complainant’s rights, still and even without this assertion the Panel has to question the Respondent’s choice of this particular domain name <averygraphics.eu>. This domain name does not accurately represent a business named ‘European Identity’ and the choice of it raises concerns that the domain name holder did not mean to make a legitimate use of it. Currently, the website provides a link to what can only be presumed as the Respondent’s trademark right but the link is also inactive. Therefore, there is no evidence whatsoever presented to this Panel that the Respondent has ever used the work AVERY or GRAPHICS in any fashion. It is for these reasons that the Panel confirms that the Respondent has no right and/or legitimate interests in the disputed domain name <averygraphics.eu>.

Finally, the last requirement as per paragraph 11(d)(1)(iii) of the ADR Rules is that the domain name holder has registered and is using the domain name in bad faith.

The Complainant asserts that the Respondent is not a licensee or an authorized representative of the Respondent. Also the Complainant has provided evidence (Exhibit C: copy of demand letter) that they have contacted the Respondent seeking to resolve this dispute amicably; the Respondent once again failed to reply.

The Panel is of the opinion that the Respondent is acting in bad faith. If the Respondent were serious about their business they would have answered to the letters sent by the Complainant explaining the reasons behind the choice of the disputed domain name <averygraphics.eu> and the nature of their business. The Respondent failed to do so repeatedly. Moreover, according to the Complainant’s assertions, at some point in time, the Respondent was using the website to promote the goods of the Complaint to their competitors.

Therefore, this Panel is of the opinion that the registration by the Respondent of the disputed domain name <averygraphics.eu> was not a random choice by the Respondent as it ‘graphically’ depicts the Complainant’s <AVERY> trademark and the nature of their business. Moreover, given the fact that the Respondent failed to respond to this complaint, the Panel is left with no choice but to take the assertions of the Complainant on board. The Respondent’s initial conduct of featuring through his web site a keyword list containing the terms “Avery Dennison”, “Avery”, “Self Adhesive Labels” demonstrates that the domain name was registered with the purpose of

disturbing the business of the Complainant. This fact by itself demonstrates both bad faith registration and use and the Panel feels that there is no reason as to not accept the allegations of the Complainant (from the Panel's own research the facts that the Complainant has presented are indeed correct and true, which means that the Complainant is acting in good faith and all the information that they have provided this Panel to consider should consequently be accurate and correct).

Based on these facts, the Panel accepts that the Complainant has also satisfied the third element of paragraph 11(d)(1) and that the domain name has been registered and used in bad faith.

DECISION

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

PANELISTS

Name	**Dr. Konstantinos Komaitis**

DATE OF PANEL DECISION 2008-10-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, Avery Denninson Corporation, through its subsidiary Avery Denninson UK Ltd. (collectively, "Avery") has requested transfer of the domain name <averygraphics.eu> to The Complainant by initiating ADR proceedings.
The Respondent, Dotasterisk, Ltd., with its physical location in London, UK, is in default.
The Complainant seeks a transfer of the disputed domain name <averygraphics.eu> from the Respondent to the Complainant in accordance with Paragraph B 11 (b) the .eu Alternative Dispute Resolution Rules (hereinafter "the ADR Rules").
The Complainant has registered trademark rights in the mark <AVERY> in connection with graphic arts and stenography products ranging from writing instruments to paper, adhesive labels and graphic laminates.
The Complainant is further of the opinion that the <AVERY> mark has become directly associated with the Complainant's goods and has acquired a secondary meaning to the customers conducting business with the Complainant.
The Complainant also contends that their use and registration of the name <AVERY> far precedes the Respondent's registration of the domain name <averygraphics.eu> and for this reason the Respondent has no rights or legitimate interests in the domain name.
The Complainant also asserts that the Respondent has sought in the past to disrupt the business of the Complainant and this is an indication of bad faith.
The Respondent is in default.
The Panel, therefore, accepts that the registration of the disputed domain name <averygraphics.eu> is similar to the trademarked term <AVERY> and can potentially confuse and/or mislead consumers.
There is no evidence whatsoever presented to this Panel that the Respondent has ever used the work AVERY or GRAPHICS in any fashion or in connection with any business.
This Panel is of the opinion that the registration by the Respondent of the disputed domain name <averygraphics.eu> was not a random choice by the Respondent as it 'graphically' depicts the Complainant's AVERY trademark and the nature of their business – and this is bad faith.
The decision of the Panel is that the disputed domain name <averygraphics.eu> should be transferred to the Complainant.