Panel Decision for dispute CAC-ADREU-005156

Case number	CAC-ADREU-005156
Time of filing	2008-08-11 11:28:06
Domain names	yakult.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Yakult Europe B.V., Mrs Morita

Respondent

Organization / Name	Mark Weakley

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

This Panel is not aware of any other legal proceedings pending or decided, related to this domain name.

FACTUAL BACKGROUND

1. On 7 April 2006, Mr. Mark Weakley (hereinafter, the "Respondent") registered the domain name <yakult.eu> (hereinafter, the "Domain Name").

2. On 11 August 2008, the company Yakult Europe B.V. (hereinafter, the "Complainant") filed its complaint before the Czech Arbitration Court, requesting the transfer of the Domain Name to the Complainant (hereinafter, the "Complaint").

3. The Respondent was notified of the ADR proceeding, but failed to file a response to the Complaint.

A. COMPLAINANT

The following arguments were sustained by the Complainant in the Complaint:

(a) That it is a subsidiary of the Japanese company Kabushiki Kaisha Yakult Honsha, using the trademark YAKULT as a brand name of their products for many years and in many countries. The Complainant and its parent company have registered "YAKULT" as a trademark in many countries worldwide, including the European Union, under CTM registration numbers 4126851 (YAKULT), 4126843 (YAKULT), 2658201 (YAKULT LIGHT), 1992577 (YAKULT), 1050210 (YAKULT) and 104620 (YAKULT).

(b) That the Domain Name is identical to the trademarks in which the Complainant and its parent company have rights.

(c) That the Respondent has not made any active use of the Domain Name to support any offer of goods or services, but has merely parked the domain name. Therefore, there are no circumstances which would allow to assume that the Respondent has made or will make legitimate use of the Domain Name.

(d) That considering the notoriety of the trademark YAKULT, it is not credible to believe that the Respondent registered the Domain Name without knowledge of the Complainant's trademark. Thus, the Respondent registered the Domain Name in bad faith.

(e) That Complainant's representatives requested the Respondent to cease and desist from using the Domain Name and to transfer it to the Complainant, by e-mail dated 6 September 2007; as of the date of filing the Complaint, the Respondent had not responded.

B. RESPONDENT

The Respondent failed to file a response to the Complaint.

DISCUSSION AND FINDINGS

1. According to Article 22.11 of the Commission Regulation (EC) nº 874/2004 of April 2004, laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter the "Regulation"), in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21.

2. Such Article 21 of the Regulation states that a registered domain name shall be subject to revocation where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith.

3. In this same sense, Article B.11.d of the .eu Alternative Dispute Resolution Rules (hereinafter, the "ADR Rules") establishes that the Panel shall issue a decision granting the remedies requested, 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.

4. 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:

4.1. In the Complaint, it is stated that the Complainant and its parent company have registered "YAKULT" as a trademark in many countries worldwide, including the European Union, under CTM registration numbers 4126851 (YAKULT), 4126843 (YAKULT), 2658201 (YAKULT LIGHT), 1992577 (YAKULT), 1050210 (YAKULT) and 104620 (YAKULT).

4.2. However, according to the documentation submitted by the Complainant, the registered trademarks (as opposed to the mere trademark applications) in respect of which a right is recognized regarding YAKULT, are registered on behalf of Kabushiki Kaisha Yakult Honsha (i.e., the alleged parent company of the Complainant).

4.3. Notwithstanding the above, and even though the Complainant does not prove in its Complaint the legal relationship with its alleged parent company, nor the fact that it is entitled to use such trademarks (e.g., by submitting a license agreement), as this Panel would have expected, this Panel has verified these aspects on its own and came to the conclusion that the Complainant has rights over the abovementioned trademarks (YAKULT). In this Panel's opinion, it is clear that the Complainant uses the trademark "YAKULT" in Europe and that its alleged parent company (the holder of the trademark rights) consents such use. Similar approach has been taken in other ADR Decisions, such as Decision nº 02235-"PALMERSCOCOABUTTER.EU".

4.4. In this Panel's opinion, the fact that the Domain Name (YAKULT) is identical to the registered trademark used by the Complainant (also YAKULT) is clearly obvious.

4.5. Therefore, the first requirement established by Article B.11.d of the ADR Rules has been duly satisfied.

5. The domain name has been registered by the Respondent without rights or legitimate interest in the name:

5.1. According to the Complainant, the Respondent has not made any active use of the Domain Name to support any offer of goods or services, but has merely parked the Domain Name.

5.2. As established by Article 21.2 of the Regulation and Article B.11.e of the ADR Rules, a legitimate interest may be demonstrated where:

(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(b) Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(c) Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognized or established by national and/or Community law.

5.3. In this Panel's opinion, the Complainant did not submit definitive supporting evidence proving that the Respondent has registered the Domain Name without rights or legitimate interest in the name. However, this Panel shares the position stated in many ADR Decisions (among others, Decision nº 2035-"WAREMA.EU" and 4925-"NYU.EU") that although the burden of proof lies with the Complainant, the existence of a right or legitimate interest is difficult to prove since the relevant facts, as stated above, lie mostly in the sphere of the Respondent. Therefore, it shall be sufficient that the Complainant proves that the obvious facts do not demonstrate a right or legitimate interest of the Respondent in the Domain Name. The burden of the proof then shifts to the Respondent, who shall be able to prove its rights or legitimate interest in the Domain Name.

5.4. In this sense, the Respondent had the possibility to prove its rights or legitimate interest in the Domain Name by filling a response to the Complaint. However, by failing to submit a response to the Complaint, the Respondent failed to prove its rights or legitimate interest in the Domain Name. In this respect, under Article B.10.a and B.10.b of the ADR Rules, 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.

5.5. On the other hand, the Complainant has affirmed that the Respondent has not made any active use of the Domain Name to support any offer of goods or services. Moreover, this Panel has not found any evidence regarding a possible right or legitimate interest in the Domain Name from the Respondent. Hence, this Panel concludes that the Domain Name has been registered by the Respondent without rights or legitimate interest in the name.

5.6. Therefore, the second requirement established by Article B.11.d of the ADR Rules has been duly satisfied.

6. The domain name has been registered or is being used in bad faith:

6.1. The above conclusion that the Respondent does not have rights or legitimate interests in the domain name is enough to satisfy the requirements of Article 21 of the Regulation. However, for completeness, this Panel would like to assess whether the domain name was registered or is being used in bad faith.

6.2. Article 21 of the Regulation and Article B.11.f of the ADR Rules establish a list of circumstances (in particular but without limitation) which may be evidence of the registration or use of a domain name in bad faith. None of these circumstances were alleged nor proved by the Complainant.

6.3. The Complainant states that, considering the notoriety of the trademark YAKULT, it is not credible to believe that the Respondent registered the Domain Name without knowledge of the Complainant's rights over the trademark. Thus, according to the Complainant, the Respondent registered the Domain Name in bad faith.

6.4. However, this Panel considers that the Complainant did not prove the notoriety of the trademark YAKULT, in particular, in Finland, where the Respondent is located.

6.5. Hence, the bad faith of the Respondent was not duly demonstrated.

6.6. However, such lack of probe with regard to the Respondent's bad faith does not impact the decision of this Panel, as in accordance to what was stated above, the Respondent has registered the Domain Name without rights or legitimate interest in the Domain Name and this is enough as to satisfy Article 21 of the Regulation.

7. According to the above, the Complainant has satisfied the requirements of Article 21 the Regulation and of Article B.11.d of the ADR Rules. It is therefore entitled to obtain revocation of the Domain Name. The Complainant has additionally requested the transfer of the Domain Name. According to Article 22.11 of the Regulation, the domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in article 4(2)(b) of Regulation (EC) No 733/2002.

8. The Complainant is an undertaking having its registered office within the Community; hence, it is entitled to request the transfer of the Domain Name.

DECISION

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

YAKULT be transferred to the Complainant.

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

PANELISTS

Name	Gonzalo Gállego

DATE OF PANEL DECISION 2008-11-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1. On April 7, 2006, Mr. Mark Weakely (hereinafter, the “Respondent”) registered the domain name <yakult.eu> (hereinafter, the "Domain Name").

2. The company Yakult Europe B.V. (hereinafter, the “Complainant”) filed a complaint before the Czech Arbitration Court against the Respondent requesting the transfer of the Domain Name (hereinafter, the “Complaint”). Pursuant to the Complaint: (i) the Domain Name is identical to certain trademarks owned by the Complainant and its parent company; (ii) the Respondent has no legitimate interest in the Domain Name; and (iii) the registration and use of the Domain Name is in bad faith.

3. The Respondent failed to file a response to the Complaint.

4. As stated in the Complaint, the Complainant is the legitimate titleholder of several EU trademarks including the name “YAKULT”, which are currently in full force and effect. In this regard, Complainant contends that the controversial Domain Name is identical or confusingly similar to such trademarks, in respect of which a right has been recognized by the Community law.

5. In addition, Complainant contends that the Respondent has no legitimate interest in the Domain Name since he has not made any active use of the Domain Name to support any offer of goods or services.

6. Likewise, the Complainant contends that the Respondent has registered and uses the Domain Name in bad faith since it is not credible that the Respondent registered the Domain Name without knowledge of the Complainant's trademark, considering its notoriety.

7. This Panel found that the Domain name is identical to the trademarks in which the Complainant has rights. Thus, the first (and essential) requirement of Article 21.1 of the Regulation has been met.

8. Additionally, this Panel understands that, since the Complainant has demonstrated that the Respondent does not have, prima facie, a legitimate interest on the Domain Name and considering that such contention has not been opposed by the Respondent, this Panel concluded that the Respondent has no legitimate interest and, thus, requirements of Article 21.2 of the Regulation has been met.

9. Given to the fact that the Respondent has registered the Domain Name without any rights or legitimate interest, it was not necessary to analyse whether the Domain Name had been registered or is being used by the Respondent in bad faith or not. However, for the sake of completeness, his Panel assessed this issue and concluded that the Complainant has not proven the existence of bad faith in the registration or use of the Domain Name.

10. In light of the above, and as requested by the Complainant, the Domain Name <yakult.eu> shall be transferred to the Complainant.