Panel Decision for dispute CAC-ADREU-005243

Case number	**CAC-ADREU-005243**
Time of filing	**2008-11-13 09:16:23**
Domain names	**osisoft.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**OSIsoft, Inc., Darren Matt**

Respondent

Organization / Name	**Fienna, Ltd., Gerald Mwanyika**

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

To the knowledge of the Panel, there are no other legal proceedings pending or decided that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the owner of Community Trade Mark No. 00253755 wordmark "OSISOFT" – filed on 12 June 2001 and registered on 27 January 2003.

The Respondent asserts to have registered the name without prior knowledge of the Complainant's alleged prior rights and is prepared to surrender the domain name without due delay.

A. COMPLAINANT

The Complaint is specified as follows:

1. Complainant's prior trademark rights

The Complainant is the owner of Community Trade Mark No. 00253755 wordmark "OSISOFT" – filed on 12 June 2001 and registered on 27 January 2003.

The trademark is registered for the following goods and services:

Class 9:

"Computer hardware and computer software and electronic manuals supplied therewith; computer software and electronic manuals supplied therewith for use in collecting, storing, verifying, converting, analyzing and distributing data from manufacturing, process, network, and other analog or digital data sources, for reporting, analysis, and integration with other business applications; computer peripherals; computers and data processing equipment; operating and user instructions stored in digital form for computers and computer software, in particular on floppy disks or CD-ROM."

Class 35:

"Business services and business management services; business administration."

Class 42:

"Computer services, namely, computer software development services; computer programming services; computer consultation services in the field of computer hardware and computer software; and installation and support services in the field of computer software; support services in the field of computer hardware."

In this context the Complainant notes that it has been renamed from "OSI Software, Inc." to “OSIsoft, Inc.” in 2002. The Complainant indicated the owner name change in respect of the CTM "OSISOFT" to OHIM.

2. Extensive use of the Complainant's CTM "OSISOFT" in the European Union for many years

The Complainant explains that it has used (and is presently using) its CTM "OSISOFT" since many years to great extent in the European Union, i.e. also since the registration of the Complainant's CTM "OSISOFT" in the year 2003. Further, a "Google search" for "osisoft" of 3 November 2008 appears to reveal that 102000 results are found for "osisoft" and that the first fifty results all refer to the Complainant's trademark/company.

3. Contested domain of the Respondent

The Respondent is the owner of the contested domain "www.osisoft.eu". The domain was registered by the Respondent on 7 April 2006.

4. No use of the contested domain by the Respondent

According to the Complainant, the Respondent has not used the contested domain "www.osisoft.eu" since the registration on 7 April 2006 until now. The Complainant attaches the results of a Google-search from 3 November 2008 showing that there is no result for "www.osisoft.eu".

In addition, copies of excerpts from "www.archive.org" ("Wayback Machine") 3 November 2008 are submitted. The "Wayback Machine" is an internet tool to archive web pages since 1996. Until now 85 billion web pages are archived through the "Wayback Machine" on "www.archive.org".

The "Wayback Machine" has not found any matches for "www.osisoft.eu".

Recapitulatory, the Complainant states that it is without a doubt that the Respondent has not used the contested domain "www.osisoft.eu" since the registration of the domain on 7 April 2006 until now.

5. Respondent no trademark owner (Community Trade Mark, International Trademark and trademark in the United Kingdom)

A trademark search reveals that the Respondent is not the owner of any Community Trade Mark, any International Trademark and any trademark in the United Kingdom (the place of incorporation of the Respondent), let alone a trademark named "OSISOFT".

6. Respondent has not been commonly known by the domain name "osisoft"

Further, the Complainant puts forward that "Google-searches" for "osisoft" in connection with "Fienna" as well as in connection with "Mwanyika" of November 03, 2008 show that no results exist for "osisoft" in connection with "Fienna" and "osisoft" in connection with "Mwanyika" respectively.

The Complainant bases on the facts outlined under no. 4, 5 and 6 to show that it is evident that the Respondent has not been commonly known by the domain name "osisoft".

7. Legal Comments

Considering the above under no. 1 to no. 6, the Complainant emphasizes the following:

a) The domain name "osisoft" is identical to the Complainant's CTM "OSISOFT"; see Article 21 (1) and Article 10 (1) of the EC Regulation No. 874/2004 (in the following: the Regulation).

b) In addition, the domain "www.osisoft.eu" has been registered by the Respondent without rights or legitimate interest in the name, see Article 21 (1) (a) of the Regulation. The Complainant emphasizes the following:

- The Respondent has not used the domain name "osisoft" or a name corresponding to the domain "osisoft" in connection with the offering of goods or services or has made demonstrable preparation to do so until now, see Article 21 (2) (a) of the Regulation.

- The Respondent has not been commonly known by the domain name "osisoft" until now, see Article 21 (2) (b) of the Regulation.

- The Respondent is not making a legitimate and non-commercial or fair use of the domain name "osisoft", see Article 21 (2) (c) of the Regulation.

c) Furthermore, the domain name "www.osisoft.eu" has been registered by the Respondent in bad faith, see Article 21 (1) (b) of the Regulation. The Complainant emphasizes the following:

- The circumstances show that the domain name "osisoft" was registered by the Respondent primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name (i.e. the Complainant) in respect of which a right is recognised or established by national and/or Community law (i.e. the CTM "OSISOFT" of the Complainant) – see Article 21 (2) (b) of the Regulation; and

- the domain name "osisoft" has been registered by the Respondent in order to prevent the holder of such a name (i.e. the Complainant) in respect of which a right is recognised or established by national and/or Community law (i.e. the CTM "OSISOFT" of the Complainant), from reflecting this name in a corresponding domain name (i.e. the domain "www.osisoft.eu" – see Article 21 (2) (c) of the Regulation.

In this context the Complainant highlights that the Respondent has not used the domain "www.osisoft.eu" in a relevant way for at least two years from the date of registration (i.e. 7 April 2006) until now - according to Article 21 (3) (b) (ii) of the Regulation demonstrating bad faith in terms of Article 21 (2) (c) of the Regulation.

d) Moreover, the Complainant refers to the attached copies of the decisions of the Arbitration Court of 20 August 2007 and 9 June 2006. The Respondent in both cases submitted is a Fienna, Ltd. (i.e. obviously the Fienna, Ltd. named in the contested domain "www.osisoft.eu" as the organisation for the registrant). In one of the submitted cases the revocation of the domain at issue was ordererd by the Arbitration Court, in the other case the transfer of the domain at issue was ordered by the Arbitration Court.

Finally, the Complainant refers to the attached copies of the decisions of the Arbitration Court of 7 July 2008, 27 February 2008 and 28 May 2007. The Respondent in all the cases submitted was a Mandarin Pacific Services Limited, Gerald Mwanyika (i.e. obviously the Gerald Mwanyika named in the contested domain "www.osisoft.eu" as the indidual for the registrant). In all the three submitted cases the transfer of the domains at issue was ordered by the Arbitration Court.

For the above given reasons and in accordance with Article 22 (11) of the Regulation the Complainant "applies to revocate the domain "www.osisoft.eu" ".

B. RESPONDENT

The Respondent asserts to have registered the name without prior knowledge of the Complainant's alleged prior rights and is prepared to surrender the domain name without due delay.

Furthermore, the Respondent states that the Complainant has not contacted the Respondent before initiating the ADR and goes on with "Would he have done so and would a check of his alleged rights resulted in the assumption of a prior right the Respondent would have agreed to an immediate transfer of the domain name. The Respondent is still prepared to transfer the domain name. The Complainant would have to suspend the ADR (and get his ADR fees refunded) and then initiate a trade request with Eurid. The Respondent undertakes to agree to this transfer request without due delay. The choice is with the Complainant.".

DISCUSSION AND FINDINGS

The ADR Procedure relates to the domain name “osisoft.eu” (the “Domain Name”). The Respondent is the holder of the Domain Name.

1. In accordance with Article 21.1 of the Regulation (EC) No 874/2004 (the “Regulation 874/2004”), it should be established whether the Domain 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 (i.e., the rights mentioned in Article 10.1 of Regulation 874/2004).

The Complainant has a right to the name “osisoft”, i.e. as a registered community trademark. The Complainant is the owner of the

Community Trade Mark No 00253755 word mark “OSISOFT”, filed on 12 June 2001 and registered on 27 January 2003 for goods and services in Class 9, 35 and 42.

The Domain Name is identical to the Complainant’s Community Trade Mark “OSISOFT”.

2. Further, the Panel needs to assess whether at least one of the other two elements of Article 21.1 of the Regulation 874/2004 are met. It should be established whether the Respondent registered the Domain Name without rights or legitimate interest in the name “osisoft” or whether the Respondent registered or used the Domain Name in bad faith (Article 21.1 (a) and (b) of the Regulation 874/2004).

a) The Panel is of the opinion that it is significantly demonstrated that the Respondent registered the Domain Name without rights or legitimate interest in the Domain Name. The Respondent fails to demonstrate its rights or legitimate interest in the Domain Name.

It appears that:

- The Respondent has not used the Domain Name or a name corresponding to the domain “osisoft” in connection with the offering of goods or services or has made demonstratable preparation to do so until now (Article 21.2 (a) of the Regulation 874/2004).
- The Respondent has not been commonly known by the Domain Name “osisoft” until now (Article 21.2 (b) of the Regulation 874/2004).
- The Respondent is not making a legitimate and non-commercial or fair use of the Domain Name “osisoft” (Article 21.2 (c) of the Regulation 874/2004).

The Respondent does not rebut this.

b) The Panel is of the opinion that it is sufficiently demonstrated that the Respondent registered or used the Domain Name in bad faith.

The Complainant fails to set out the circumstances that would show that the Domain Name was registered by the Respondent primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to the holder of a name (i.e. the Complainant) in respect of which a right is recognised or established by national and/or Community law (Article 21.3 (a) of the Regulation 874/2004). The mere reference to other decisions by the Arbitration Court apparently taken against the same Respondent, ordering the transfer or the revocation of the domain name at issue should not lead to such conclusion.

However, the Panel finds that the Respondent has registered the Domain Name in order to prevent the Complainant from reflecting its name in a corresponding domain name (Article 21.3 (b) of the Regulation 874/2004). From the number of such decisions by the Arbitration Court apparently taken against the same Respondent, it can be inferred that the Respondent has engaged in a pattern of such conduct which may be regarded as amounting to bad faith as included among the circumstances denoting bad faith listed in Article 21.3 of the Regulation 874/2004. Furthermore, the Respondent appears not to have used the Domain Name in a relevant way for at least two years from the date of registration (i.e. 7 April 2006) until now (Article 21.3 (b) (ii) of the Regulation 874/2004). The Respondent does not prove the contrary.

3. According to Article 22.11 of the Regulation 874/2004, the ADR panel shall, in the case of a procedure against a domain name holder, decide that the domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, 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 the Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community; or
2. an organisation established within the European Community without prejudice to the application of national law; or
3. a natural person resident within the European Community.

In this case, the Complainant is a U.S. company which seems aware of the fact that it does not satisfy the general eligibility criteria. The Complainant therefore requests to revoke the Domain Name.

DECISION

For all the foregoing reasons, in accordance with Paragraph B 12 of the ADR Rules and Article 22.13 of the Regulation 874/2004, the

Panel orders that the Domain Name OSISOFT be revoked within thirty calendar days of the notification of the decision to the parties, unless Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12 of the ADR Rules.

PANELISTS

Name	**Bart G. Goddyn**

DATE OF PANEL DECISION 2009-03-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The ADR Procedure relates to the domain name “osisoft.eu” (the “Domain Name”). The Respondent is the holder of the Domain Name.

1. The Complainant has a right to the name “osisoft”, i.e. as a registered community trademark. The Complainant is the owner of the Community Trade Mark No 00253755 word mark “OSISOFT”, filed on 12 June 2001 and registered on 27 January 2003 for goods and services in Class 9, 35 and 42. The Domain Name is identical to the Complainant’s Community Trade Mark “OSISOFT”.

2.

a) The Panel is of the opinion that it is significantly demonstrated that the Respondent registered the Domain Name without rights or legitimate interest in the Domain Name. The Respondent fails to demonstrate its rights or legitimate interest in the Domain Name.

b) The Panel is of the opinion that it is sufficiently demonstrated that the Respondent registered or used the Domain Name in bad faith.

3. The Complainant is a U.S. company which seems aware of the fact that it does not satisfy the general eligibility criteria set out in Article 4(2)(b) of the Regulation (EC) No 733/2002. The Complainant therefore requests to revoke the Domain Name.

In accordance with Paragraph B 12 of the ADR Rules and Article 22.13 of the Regulation 874/2004, the Panel orders that the Domain Name OSISOFT be revoked within thirty calendar days of the notification of the decision to the parties, unless Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12 of the ADR Rules.