Panel Decision for dispute CAC-ADREU-005309

Case number	CAC-ADREU-005309
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Domain names	euroairport.eu

Case administrator

Name	Tereza Bartošková

Complainant

Organization / Name	AEROPORT DE BALE MULHOUSE, Monsieur Rémy JOESSEL

Respondent

Organization / Name	David FISHMAN

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

None that the Panel is aware of

FACTUAL BACKGROUND

The present complaint was filed on December 1st, 2008 by the French company AEROPORT DE BALE MULHOUSE (« Aeroport de Bale ») and is directed against a French individual by the name of David FISHMAN whom registered the domain name “euroairport.eu” on August 8, 2006.

Aeroport de Bale relies upon its earlier trademarks and domain names, as well as its notoriousness in a particular French Region as well as neighbouring countries of Switzerland and Germany to sustain that the Respondent does not have any legitimate interest in the disputed domain name and did act in bad faith both in registering the domain name and then offering to sell the name to Aeroport de Bale.

The Respondent filed a response to the Complaint on February 4th 2009 arguing that he and his partners have developed several travel-related websites based on either acronyms or generic names and that even though he now lives close to Aeroport de Bale’s location, it was not true at the time of the Domain Name Registration and therefore he could not know about the Airport or its brand.

The Respondent also maintains that an offer to buy the domain was extended to him by Aeroport de Bale’s Internet provider before the Respondent quoted any price.

The Panel was appointed on February 19 2009.

A. COMPLAINANT

The Complainant seeks the transfer of the disputed domain name for the reasons below:

1 – The Complainant considers that the disputed domain name is confusingly similar to several of its device marks « Euro Airport » :
a) French Trademark « EuroAirport » No 1409118 filed on 16/03/1987 regularly renewed
b) International Trademark « EuroAirport » No 516361 filed on 10/09/1987 regularly renewed
c) Community Trademark « EuroAirport » No 000290080 filed on 14/06/1996 regularly renewed
d) International Trademark « EuroAirport » No 885784 filed on 27/03/2006 designated European Community and extended to Switzerland
e) French Trademark « EuroAirport » No 063439960 filed on 11/07/2006

The complainant claims that following those grants, the trademark « Euro Airport » has become highly recognized and has lead to a number of domain names in a variety of Top Level Domains.

2 - The Complainant claims that the disputed domain name was registered and is used in bad faith because :
- The Respondent could not ignore the existence of the trademark and its use living in the same city as the Airport itself.
- The Respondent tried to “monetize” the Transfer of the domain name by asking 3500 € from the Complainant.

B. RESPONDENT

B. Respondent

The Respondent claims that the domain name was registered as part of a travel venture developed with associates in order to create travel-related websites.

The Respondent adds that the Domain name was registered during the .EU land rush phase and is composed of two generic terms.

He also maintains that although he now lives close to the Aeroport de Bale, that was not the case at time of Registration.

The Respondent also maintains that the monetary transaction was only contemplated after a third party working for the Complainant offered to buy the domain.

DISCUSSION AND FINDINGS

Given the facts and arguments of the parties, the Panel should decide whether the conditions of article 21 of Reg. No. 874/2004 are satisfied to decide whether the disputed domain name should be transferred to the Complainant or not.

Article 21. Reg. No. 874/2004 clearly states:
1. A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), 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.
2. A legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where:
(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name 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) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;
(c) the holder of a domain name 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 recognised or established by national and/or Community law.
3. Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where:
(a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or
(b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:
(i) a pattern of such conduct by the registrant can be demonstrated; or
(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or
(iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;
(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or
(d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the

website or location or of a product or service on the website or location of the holder of a domain name; or
(e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered.

As a result the Panel has to look through the above criteria in deciding whether to grant the Complainant request or not.

1/ ON THE IDENTITY OR CONFUSING SIMILARITY OF THE DOMAIN NAME
The Panel must ask whether "the Complainant's right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1)".

The Complainant justifies that it owns Community and French trademarks as well as a series of domain names formed with EUROAIRPORT.

However, the Panel notices that every trademark produced by the complainant is a device mark ("Marque figurative" in French) composed by a logo of some kind which, while incorporating the words "Euro" and "Airport", is more than the two words themselves.

The CTM, although being a right under Art. 10(1) Regulation 874/2004, is therefore not identical with the Domain. The Panel agrees with the prevailing case law of WIPO Administrative Panels under the UDRP, stating that a word/device trademark can never be identically reproduced in a domain name (cf. eg. WIPO Domain Name Decision No. D2003-0614 – spreewald.com).

Indeed, the rationale used in ADR.EU case #04261 (Domain name « MOTORSHOWBOLOGNAFIERE.eu ») is quite similar to this very case:

"In the view of the Panel, the CTM is also not confusingly similar to the Domain. The Complainant asserts that the graphical elements of its CTM have to be ignored within the comparison between the CTM and the Domain. The Panel would be inclined to follow this view, however only in case the word elements of the CTM were distinctive […] adding a merely geographical indication cannot create distinctiveness".

Further: "Since the word portions of the word/device CTM are not distinctive, the Panel follows the prevailing case law of the WIPO Administrative Panels under the UDRP, stating that merely descriptive word elements of a word/device trademark cannot create a confusing similarity between trademark and domain name (cf. eg. WIPO Domain Name Decisions cases No. D2003-0645 – britishmeat.com; D2006-0778 – brabant-wallon.org; D2004-0717 – aberdeenairport.com; all with further references)".

Additionally, it is also worth noting that Eurid's validation rejected the Complainant Registration's of "Euroairport.eu" during the Sunrise process which was specifically devised to protect trademark holders (including device marks such as this one) such as Aeroport de Bale.

As a result, the question on whether the Complainant's rights are enough to fight the registration of what is merely some graphics combined with a combination of two generic terms remains open.

2/ On the Legitimate interest from the Respondent

"A registered domain name shall be subject to revocation where it
(a) has been registered by its holder without […] legitimate interest in the name";

There is no question that the behaviour of the Respondent is questionable and his defence is not as articulate as one might hope. It is also true that the term "Domaining" used by the Respondent is often assimilated to cybersquatting.

However, Article 21 of the Regulation clearly indicates that to be relocated the name must have been registered "without legitimate interest" by the Respondent. In this case, it puzzles the Panel not to find no argument on the Complainant's side as to the Respondent's lack of legitimate interest in Registering the name.

Moreover, pursuing its own investigation, the Panel discovered that names such as SCD.eu and NQ.eu do indeed appear as to have been registered by the Respondent or its associates and are used to promote travel and various related information. That would explain the Respondent "Legitimate" interest in a name incorporating terms such as "Euro" and Airport".

Lastly, contrary to what is usually the case in arbitration cases involving so-called “Domaining” activities, the Panel has discovered that the Euroairport.eu domain name does not point to any so-called “parking page” listing competitors or even content linkable to Aeroport de Bale therefore strongly avoiding risks of confusion with the former.

3/ ON THE RESPONDENT’S BAD FAITH

“A registered domain name shall be subject to revocation where it
(b) has been registered or is being used in bad faith.”

a) on the lack of notoriousness of the trademark
The Complainant is a major airport company and it asserts that it has been using its corporate name, trade name and trade mark EUROAIRPORT for many years all throughout the world.

The Respondent maintains it did not know about the use of the brand by the Aeroport de Bale because he lived further away at the time and it cannot be substantiated either way by the Panel.

The fact is that the (device) mark “euroairport” is composed of terms widely used by a variety of stakeholders in the travel industry and may not be immediately link to Aeroport de Bale. Indeed, the Panel must admit that itself did not know the Airport under that name, despite being French and having travelled to Switzerland many times before.

It is therefore the Panel’s opinion that the Respondent did not necessarily have the Complainant’s trademark in mind when it registered the disputed domain name.

b) on the offer to sale the domain name

The Panel has a rather difficult time assessing the relevancy of the so-called “offer to buy” the domain name extended to the complainant in the amount of 2,000 Euros.

Had the domain name been exploited by the Respondent in a way immediately detrimental to the Complainant, thus putting pressure on the Complainant to pay as soon as possible; or had the Respondent appeared more aggressive towards the Complainant, substantiating allegation of “blackmail” (“escroquerie” in French – email from May 19th), such actions would have indeed be constitutive of bad faith and as such gladly considered by the Panel.

Instead, while this fact is alluded to in a letter from the complainant merely quoting a phone call between parties, it is somewhat mitigated by a similar allegation from the Respondent who states the offer to sell was extended by one of the Complainant’s partner. Without clear documentary evidence on both counts, the Panel is inclined to reject the argument altogether.

4/ Territoriality

The Complainant is a company incorporated under French law and having its place of business within the European Community. Therefore, the requirements for the requested transfer of the domain name to the Complainant would be satisfied (Section B No. 1 (b) (12) of the ADR Rules).

In summary, although the Complainant is based into the European Union and does hold a trademark similar to the disputed domain name, the Panel finds that the existence of both bad faith and illegitimate interest from the Respondent is not sufficiently established under the conditions of article 21 of Reg. No. 874/2004.

DECISION

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

the Complaint is Denied

PANELISTS

Name	Jean-Christophe A. Vignes

DATE OF PANEL DECISION 2009-03-11

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought an action against the Respondent for a speculative and abusive registration of the Domain Name “euroairport.eu”.

The Panel held that the production of a device mark by the Complainant was not enough to establish confusing similarity vis a vis the domain name

The Panel held that the Respondent’s interest in the travelling industry could pass as legitimate interest in the two generic terms that form the name. The Panel made this finding based upon the lack of notoriety of the name itself outside of one particular region.

The Panel also found that the Disputed Domain Name had not necessarily been registered in bad faith because there was a real possibility that the Respondent could not know its registration would be infringing rights of the Complainant.

The fact that the Respondent allegedly asked the Complainant for money to get the domain name back has not been taken into account by the Panel since the Respondent maintains the offer to buy the name was extended by one of the Complainant’s service provider. As the result, the two hear-say arguments wash-out.

The Panel therefore rejected the Complainant’s request.