Panel Decision for dispute CAC-ADREU-005332

Case number	CAC-ADREU-005332
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Domain names	lernercatalog.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Lernco, Inc.

Respondent

Organization / Name	Andy Ltd., Kurt Janusch

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 legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The respondent registered the disputed domain name lernercatalog.eu on 7 April 2006. The Complainant, owner of various trademarks LERNER in the European Community, approached the Respondent on 14 April 2008 demanding that he cease the use of the domain name and remove all contents from it. On 4 June 2008 the Respondent, after receiving a follow-up letter, responded to the Complainant suggesting that the Complainant purchase the domain name. After further exchange of letters and failing to find an amicable settlement the Complainant submitted the Complaint to the Czech Arbitration Court requesting that the disputed domain name is revoked.

A. COMPLAINANT

The Complainant submitted the following Complaint:

1. Complainant, Lernco, Inc., is a company registered in the State of Delaware, United States of America. Lernco, Inc. operates LERNER NEW YORK retail stores throughout the United States offering moderately priced women's apparel and accessories, as well as a line of clothing under the "Lerner" brand label.

2. Complainant owns registrations of the LERNER mark for a variety of apparel and accessories, along with retail store services, in many of the member countries of the European Union, as following:

--Benelux Registration No. 424,555 of the mark LERNER for retail services in International Classes 40, 41 and 42;
--Benelux Registration No. 418,590 of the mark LERNER for clothing in International Class 35;
--French Registration No. 1,386,464 of the mark LERNER for retail services in International Class 35;
--French Registration No. 1,355,689 of the mark LERNER for clothing in International Class 25;
--German Registration No. 1.103,100 of the mark LERNER for clothing in International Class 25;
--Hungarian Registration No. 126,001 of the mark LERNER for clothing in International Class 25 and retail services in International Class 35;
--Italian Registration No. 762,332 of the mark LERNER for clothing in International Class 25 and retail services in International Class 35;
--Portuguese Registration No. 234,716 of the mark LERNER for clothing in International Class 25;
--Spanish Registration No. 1,188,761 of the mark LERNER for retail services in International Class 35;
--United Kingdom Registration No. 2,025,502 of the mark LERNER for magazines, catalogs and brochures, all relating to fashion in International Class 16;
--United Kingdom Registration No. 1,558,311 of the mark LERNER for clothing in International Class 25; and

--United Kingdom Registration No. 1,568,723 of the mark LERNER for retail services in International Class 35.

Attached as Annex 1 are copies of certificates of registration or registration database extracts for the above registrations.

3. By incorporating the mark LERNER, the disputed domain name is confusingly similar to Complainant's registered mark. Moreover, Complainant submits that the designation LERNER in the disputed domain name is predominant thus causing confusion as to source or sponsorship of the disputed domain name and any content on accompanying web pages.

4. The Respondent has no right or legitimate interest in the disputed domain name. In fact, the Respondent does not have and has never had any connection with the Complainant, does not deal in the Complainant's products and is not a licensee of the Complainant.

5. Upon information and belief, Complainant submits that there is no evidence of the Respondent's use of, or demonstrable preparations to use the contested domain name or a name corresponding to the contested domain name in connection with a bona fide offering of goods or services.

6. When Complainant first became aware of the Respondent, the disputed domain name linked to an Internet web page with hyperlinks to third-party commercial web-sites offering apparel and accessories. Attached as Annex 2 is a snapshot copy of Respondent's web page taken in April 2008.

7. Currently, the disputed domain name redirects to www.sergiudraganus.com, which appears to be the personal web site of Sergui Draganus. While the text of the web site is in a foreign language, there is one profanity in the English language on the web page. Attached as Annex 3 is a copy of the home page of www.lernercatalog.eu as redirected to www.serguidraganus.com.

8. Complainant submits that the content on the accompanying web pages that have been and currently are associated with the disputed domain name demonstrate Respondent's bad faith.

9. As further evidence of Respondent's bad faith registration of the disputed domain name, Complainant asserts that on April 14, 2008, Complainant, through its authorized representative, sent a letter to Respondent demanding that he cease use of the disputed domain name and remove all content from accompanying web pages. Complainant also requested that the disputed domain name be assigned to Complainant. Respondent did not reply to Complainant's April 14th letter. Attached as Annex 4 is a copy of Complainant's April 14th letter to Respondent.

10. On June 3, 2008, Complainant forwarded a follow-up letter to Respondent. Attached as Annex 5 is a copy of Complainant's June 3rd follow-up letter to Respondent.

11. On June 4th, Complainant, through its authorized representative, was contacted by Respondent via e-mail. In the e-mail, Respondent informed Complainant's representative that there were no registered marks for the disputed domain name. Respondent listed many countries whose databases Respondent had purportedly consulted. Respondent ended the communication by stating,

"I have registered this name because I was not aware that a trademark exist. [sic] If you have a trademark for it please forward to me as soon as possible, otherwise think for [sic] a good offer and maybe I will sell this domain name to you.
Regards, KJ."

This June 4th e-mail was sent from "SD" at the e-mail address serguiliano@yahoo.com. Attached as Annex 6 is a copy of Respondent's June 4th answer to Complainant's letters.

12. On June 24, 2008, Complainant, through its authorized representative, responded to Respondent's June 4th e-mail by advising Respondent of countries where Complainant's LERNER mark was registered, and attaching evidence of registration in the form of copies of certificates of registration as well as registration database extracts. Attached as Annex 6 is a copy of Complainant's June 24th response to Respondent's June 4th answer.

13. On June 24, 2008, Respondent replied to Complainant's June 14th communication and stated,

"Please go to www.eurid.eu in order to check the rules for .eu registrations. I will not transfer the domain name to you for free because you do not have the legal right to own this domain name.
If you have a better proposal don't esitate [sic] to contact me."
Attached as Annex 7 is a copy of Respondent's June 24th reply to Complainant.

14. Complainant disputes Respondent's assertion that it does not have a legal right to own the disputed domain name as Complainant is not a citizen of a EU-member country since a qualified individual or entity could register the domain name as agent for Complainant, such as a licensee. In any event, in its letter dated April 14th, Complainant requested that all content be removed from the web pages accompanying the web site. Respondent did not remove such content. Rather, Respondent is now causing the disputed domain name to redirect to a different domain name with corresponding web pages that contain profanity. These actions are further illustrative of Respondent's bad faith.

15. Complainant further points out that Respondent has been involved in several .eu ADR proceedings with factual circumstances in common with Complainant. Specifically, Complainant notes the following ADR Decision Nos. 05087, 04447, 01901, 04127, 04052, 04195 and 02219 involving Respondent with decisions in favor of the complainants. Most notably, the findings in the Panel Decision in Case 02219 noted that Respondent (Kurt Janusch) has been responsible for registering a large number of .eu domain names (approximately 3,000) with no intention of ever trading under such names. Attached as Annex 8 is a print out of the Panel Decision in Case No. 02219 – under Discussion and Findings, see paragraph 2. Alleged Registration and Use of Domain Name in Bad Faith on Page 4 of the attached printout.

16. Complainant submits that Respondent has engaged in a pattern of conduct where he has registered a large number of domain names – including the disputed domain name - in bad faith, without any apparent intention to trade under such names.

B. RESPONDENT

The Respondent did not submit a response.

DISCUSSION AND FINDINGS

According to Regulation (EC) No 874/2004 of 28 April 2004, Article 21(1), a registered domain name is subject to revocation where the name is identical or confusingly similar to a prior right recognised by national or Community law and where the domain name is registered without rights or legitimate interest in the name or it has been registered in bad faith.

1. Preliminary issues
The Complainant is a company registered in the United States. Pursuant to Regulation 874/2004, Article 2 and Regulation (EC) No 733/2002, Article 4(2)(b), the Complainant is not eligible to register .eu top level domain names in its name. There is nothing in these regulations, however, that would prohibit an undertaking that is not eligible to register a .eu from instigating ADR proceedings that violate their rights. Regulation 874/2004 in fact states in Article 22(1) that ADR proceedings can be initiated by "any party" without further qualifications regarding the eligibility to actually have a .eu domain name in its name. If the Complainant is not entitled to register a .eu top level domain the panel cannot naturally order the domain name to be transferred to it. In the present case the Complainant has requested that the disputed domain name is revoked. The panel finds that the Complainant is eligible to initiate ADR proceedings and to request that the disputed domain name is revoked.

2. Prior rights
The complainant is an American company Lernco, Inc., trading in the field of women's clothing and accessories. It is the owner of various trademarks for the mark LERNER in several countries of the European Community. For example, it is the owner of UK registrations No. 2025502 LERNER for goods in class 16 and No. 1568723 LERNER for services in classes 42 and 45. In addition, the Complainant is the owner of various other trademarks for the mark LERNER in the European Community. The panel is satisfied that the Complainant is the owner of a prior right as mentioned in Article 10(1) of Regulation 874/2004.

3. Confusing similarity
The Complainant has rights for the trademark LERNER under national and Community law. The disputed domain name in this case is lernercatalog.eu. The domain name is not identical to the prior right of the Complainant. At issue is therefore the similarity of the signs LERNER and LERNERCATALOG. It is well-established principle in both ADR and UDRP proceedings that the top level domain .eu shall not be taken into consideration when assessing the similarity of a prior right and a domain name. For example, see ADR case No 1250 VOCA, regarding domain name voca.eu.

The Complainant's trademark LERNER is included in its entirety in the disputed domain name. The difference between the prior right and the disputed domain name is that the disputed domain name contains an additional word, namely "catalog". Word "catalog" in this context has a very little or no distinctive character. The panel further notes that the Complainant's UK registration No. 2025502 LERNER covers goods in class 16. These goods include "magazines, catalogues and brochures". The case law of the Czech Arbitration Court clearly establishes that adding a non-distinctive element to a prior trademark does not remove confusing similarity. For example, the

panel held in case No. 4319 AIRFRANCEAIRLINES that the disputed domain name airfranceairlines.eu was confusingly similar to the prior right AIR FRANCE.

The panel finds it established that the disputed domain name lernercatalog.eu is confusingly similar to prior right LERNER.

4. Rights or legitimate interest in the name
Regulation 874/2004 gives the respondent the possibility to establish that despite the disputed domain name is confusingly similar to a prior right, the respondent has rights or legitimate interest in the name. The regulation lists several ways of establishing sufficient rights or interests in the name. The Complainant has made a reasonable assertion and argument that the Respondent does not have rights or legitimate interest in the disputed domain name and the Respondent has not rebutted this even though given a chance. The Respondent did not submit any arguments or evidence that would demonstrate its rights or legitimate interest in the disputed domain name.

The panel therefore finds that the disputed domain name was registered without rights or legitimate interest in the name.

5. Bad faith
The Complainant has also argued that the disputed domain name was registered in bad faith. The Complainant has also provided some evidence to that support that claim. However, because the disputed domain name is confusingly similar to the prior right of the Complainant and the Respondent does not have rights or legitimate interest in the disputed domain name, there is no need to further consider the question of whether the Respondent registered the disputed domain name 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 LERNERCATALOG be revoked.

PANELISTS

Name	**Erkki Holmila**

DATE OF PANEL DECISION 2009-05-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the owner of various trademarks for the mark LERNER in several countries in the European Community. The Respondent registered domain name lernercatalog.eu

The panel found that despite not being eligible to register a .eu top level domain in its name, the Complainant is nevertheless eligible to initiate ADR proceedings pursuant to Regulation 874/2004. The panel further found that the disputed domain name was confusingly similar to the prior right LERNER owned by the Complainant. The disputed domain name incorporated trademark LERNER in its entirety and added only an element with no or little distinctive character to it. Further, the Complainant made reasonable arguments and allegations that the Respondent does not have rights or legitimate interest in the name and the Respondent did not rebut these.

For those reasons the disputed domain name was ordered to be revoked.