Panel Decision for dispute CAC-ADREU-005376

Case number	CAC-ADREU-005376
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Domain names	monsterfinance.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Monster Worldwide Ireland Limited

Respondent

Organization / Name	Monster Finance Limited, Rahat Kazmi

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 has not been informed of any other legal proceedings that are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

1.The Complainant, which is a company established in Ireland, is a wholly owned sub-subsidiary of Monster Worldwide Inc. (the “Parent Company”). The Parent Company wholly owns Monster Worldwide Holdings (Ireland) Limited, which in turn wholly owns the Complainant.

2.The Complainant and the Parent Company are providers of online careers and recruitment resources under the general style and business name of “Monster”. The trade name is protected by various trade marks throughout the Community. The Parent Company is the registered proprietor of two current Irish registered trade marks: Irish Trade Mark No. 218395 MONSTER IRELAND and Irish Trade Mark No. 218388 MONSTERBOARD. In addition, the Parent Company is the registered proprietor of 10 Community trade mark (CTM) registrations, including CTM registration No. 000706655 MONSTER. The others include: MONSTER.COM, MONSTER WORKS FOR ME, MONSTER WORLDWIDE MONSTER OFFICE HR, CHIEF MONSTER, MONSTER MOVING, The MONSTER BOARD, MONSTER (figurative) and a unlabelled figurative mark. To the satisfaction of the Panel, a copy of each trade mark has been supplied with the Complaint.

3.In addition, the Parent Company is the registrant of top level domain names including monster.com and various country level domain names across the European Union including in Ireland (monster.ie).

4.The Complainant avers that it is a licensee of rights to the above trade marks (the “ Monster Trade Marks”) and entitled to enforce the exclusive rights of the Parent Company in the Monster Trade Marks against third parties. However the Complainant adds that the Parent Company and Complainant have not entered into a written licensing agreement in respect of these marks.

5.The Respondent is, as confirmed by Eurid, the registrant of the disputed Domain Name, monsterfinance.eu, and is recorded as being a company incorporated in Ireland, with the point of contact being a person by the name of Mr Rahat Kazmi.

6.The Domain Name was registered to the Respondent on May 27, 2008 by a Registrar accredited by Eurid, which registration was subject to the Regulation (EC) No 733/2002 on the implementation of the .eu Top Level Domain and related legislation and rules.

A. COMPLAINANT

7. The Complainant avers that the Domain Name is identical or confusingly similar to a name in which the Complainant has prior rights, that the Respondent has no rights or legitimate interests in the Domain Name, and that the Domain Name has been registered or is being

used in bad faith.

Identical or Confusingly Similar Name
8. The Complainant submit that the names MONSTER and MONSTERFINANCE are misleadingly [sic] similar.

9. The Complainant submits that in analysing the identity between the Monster Trade Marks and the disputed Domain Name, the .eu top level domain should not be taken into consideration on the grounds that its technical and functional relevance is recognised by internet users: SANOFI-AVENTIS v. UK Domain Developers, LTD Case No. 04819. The Complainant submits that the relevant part of the disputed Domain Name is MONSTERFINANCE which is misleadingly similar to the Monster Trade Marks.

10. According to the Complainant, the key element of the Monster Trade Marks are clearly incorporated into the disputed Domain Name, and that the addition of the word “finance” to the mark MONSTER does not change the overall impression of the designation as being a domain name connected to the Complainant and the Parent Company.

11. The Complainant asserts that a domain name that wholly incorporates a registered mark may be sufficient to establish confusing similarity. The Complainant submits that the mere addition of a common term such as “finance” to the MONSTER mark is of no import, it doesn’t change the overall impression of the designation as being a domain name connected to the Complainant and the Parent Company. The Complainant contends that such a descriptive component added to the Monster Trade Marks even adds to the confusion by leading users to believe that the Complainant and the Parent Company operate the web site associated to the disputed Domain Name, providing a special focus on recruitment information relating to finance positions.

12. In support of its contention the Complainant refers to:

- Globet-International Sports Betting Limited v. Claes Persson Case no. 04147 (The ability for such a generic word to distinguish the domain name from the trade mark is limited and has little, if any, legal significance. In this case, the generic word “games” could cause further association with the Complainant’s trade mark due to the fact that the trade mark is registered for gaming services.);

- Globet-International Sports Betting Limited v.Cassini Limited Case No. 04154 (“The Panel does not believe that the generic words clearly distinguish the disputed domain names from the trade mark and in fact considers that they may well cause further association with that mark given that the generic words are somewhat related to the Complainant's business”);

- Tarkett SAS Rezept Ltd v. Janusch Kurt Case No. 04052 (The addition of such a descriptive element to the very distinctive word “tarkettis" is not capable of excluding confusing similarity between the Domain Name and the trade marks.);

- The Boston Consulting Group Limited Grupa Kapitałowa BCG Sp. z o.o Case No. 04278 (key element of the domain name is “bcg”, and the rest of the name incorporating the word “consulting” is descriptive.);

- Enterprise Rent-a-Car UK Limited v. Mary Zeng Case No. 04337 (key component of the domain is the word ‘Enterprise’ the ‘carrental’ element is descriptive or generic.)

13. The Complainant submits that proof of the confusing similarity of the disputed Domain Name can be seen from an email sent by one of the Complainant and Parent Company’s major clients, Alstrom, querying whether they should mention Monster Finance to their financial community. A copy of this email was attached to the Complaint. The email includes the text of an announcement purportedly issued by "Rahat Kazmi, MBA" with an email alias serviced by the domain name monsterfinance.ie, offering a free trial for posting jobs on monsterfinance.eu.

14. As to the absence of a written licence agreement in favour of the Complainant and in relation to the Monster Trade Marks, the Complainant submits that that, nonetheless, a licence agreement exists between the Parent Company and the Complainant.

15. In this regard the Complainant asks the Panel to consider the following decisions:

- Yakult Europe B.V. v Mark Weakley Case No. 05156 (where although no evidence of a license agreement was submitted by the complainant the panel on the facts concluded that the complainant had rights over the trade marks registered in the name of the complainant’s parent company); and,

- BenQ Europe BV v Zheng Qingying Case No. 05002 (where complainant’s parent company and not the complainant itself owned the BenQ trade marks the panel was willing to infer that the complainant had a licence to use the BenQ trade marks. The panel considered

that a licence was evident from the mere fact that the trade mark BenQ was an integral part of the complainant's name and that a licence would logically include granting powers to defend the BenQ trade marks within the European Community area).

16. Furthermore, the Complainant points to the substantial goodwill and therefore unregistered or common law trade mark rights in the name MONSTER, and that it operates Monster Ireland and a website resolving to www.monster.ie that receives over 290,000 visits per month and has 230,000 CVs on its website, and which produced a turnover in Ireland of €3,174,595 for 2005, €5,007,715 for 2006 and €6,016,743 for 2007.

17. Finally, the Complainant submits that the name MONSTER is not descriptive and that the Complainant's use of the name MONSTER has ensured that it has acquired distinctiveness and a secondary meaning in Ireland attributable solely to the Complainant, which is protected under Irish law.

No Rights or Interests
18. The Complainant avers that it is not aware of any evidence that at any material time the Respondent has ever had any rights or legitimate interests in, or has ever indicated any legitimate use of, the disputed Domain Name. It avers that the Respondent has no link whatsoever with the Complainant or the Parent Company, and that in particular the Complainant and the Parent Company have not licensed or otherwise authorised the Respondent to use the Monster Trade Marks or to apply for the disputed Domain Name.

19. Further, the Complainant submits that the Respondent is not using the disputed Domain Name in connection with a good faith offering of goods or services or the operation of a business. The Complainant submits that the Respondent's efforts to attract internet users to its website through confusion with the Monster Trade Marks obviates any possibility that the disputed Domain Name is being used in connection with either the good faith offering of goods or services or operation of a business. This interpretation is consistent with the decision in Tarkett SAS v. Rezept Ltd Case No. 04052. ("the holder of the domain name is not using the domain name in connection to a bona fide offering of goods and services since the trade mark of the Complainant is used for the purposes of diverting Complainants' customers.").

20. The Complainant submits that the Respondent's use of a confusingly similar Domain Name on a website offering for sale overlapping products and services is not a bona fide offering of goods or services pursuant to the equivalent UDRP: for example, Reed Elsevier, Inc. et. Al v. Ulexis a/k/a Law firm, NAF Case No. 97684 (August 31, 2001) (finding no legitimate interest when respondent used the disputed domain name to offer similar/related services and to divert potential customers to its competing website);

21. The Complainant claims that, in actual fact, there is no bona fide business behind the Respondent's website that resolves at the disputed Domain Name as when it conducted a search in very broad terms, there are no jobs found in the search results. A copy of a printout of the homepage of the website that resolves at the disputed Domain Name and a printout of unsuccessful search conducted for a job under "All" specialisms, sectors and locations was attached to the Complaint.

22. Finally, the Complainant submits that relying upon the foregoing in demonstrating a prima facie case that the Respondent is without rights of interests in the domain name, the burden in relation to this element now shifts to the Respondent.

Registration or Use in Bad Faith
23. The Complainant relies upon the following grounds:

(i) 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 (Article 21(3)(d));

(ii) the domain name was registered primarily for the purpose of disrupting the commercial activities of a competitor (Article 21(3)(c))

24. In the Complainant's view it is apparent that at the time of registration of the disputed Domain Name, the Registrant was well aware of the reputation of the Monster Trade Marks. The Registrant is situated in Dublin. The Registrant cannot but be aware of the reputation in Ireland of the Monster Trade Marks. The Complainants submit that, given the significant degree of renown of the Monster Trade Marks in Ireland, it is highly unlikely that the Registrant chose the disputed Domain Name for its descriptive qualities or some other genuine reason independently of the Monster Trade Marks.

25. The Complainant avers that the Complainant and Parent Company's job board websites are of worldwide renown and have built up significant global reputation and goodwill including in Ireland. The Complainant and Parent Company's websites under the MONSTER

brand have been in operation for over a decade. As a result of the extensive promotion under the MONSTER brand the Complainant and the Parent Company have achieved a unique and special reputation amongst a widespread and international market, including Ireland. The Complainant avers that its "share of voice" (that is, its total spend on marketing as a proportion to the market) has been above seven per cent for each of the years 2005 to 2008.

26. The Complainant claims that the Respondent cannot but be aware of the reputation in Ireland of the Monster Trade Marks. The Respondent's use of the Monster Trade Marks in the disputed Domain Name and also on the site itself is intended to lead consumers to believe that they had reached the Complainant's website and so divert internet traffic from the Complainant thereby interfering with the Complainant's business. Accordingly, the Complainant submits, pursuant to Article 21(3)(c), that the Respondent has registered or is using the disputed Domain Name primarily for the purpose of interfering with the business of the Complainant. In this regard, the Respondent's use of the domain name monsterfinance.ie and the mark MONSTER FINANCE which are similar to the trade marks for identical services namely job board websites gives rise to a likelihood of confusion in the eyes of consumers. Usage of the disputed Domain Name incorporating the Complainant and Parent Company's MONSTER trade mark and indicia such as the monster figure on the website that resolves at the disputed Domain Name are likely to confuse consumers into falsely associating the services being offered by the Respondent with the services offered by the Complainant and the Parent Company and/or that there is some connection or association between the Respondent and the Complainant and the Parent Company.

27. The Complainant submits that the use of the disputed Domain Name by the Respondents is an attempt to confuse internet users under the concept of "initial interest confusion" where internet users may be confused as to the ownership of the disputed Domain Name given the fact that it is identical or misleadingly similar to the Monster Trade Marks. Such confusion, it points out, was held to amount to bad faith in Mars UK v. UK Domain Develpoers Case No. 04872; Suzuki International Europe GmbH v. Bint Praha Case No. 04398 and Sponda Oyj v. UK Domain Developers Ltd Case No. 04492.

28. The Complainant also submits that the disputed Domain Name has been selected and is being used with the intent to confuse and redirect internet users to the Respondent's website. The Respondent's website is designed in such a way as to create further confusion on the part of internet users into thinking they have reached the Complainant's website. This interpretation is, it submits, consistent with the decision in Spacewall GmbH v,. Aphrodite Ventures Ltd Case No. 05040. The Complainant submits that the Respondent has registered and is using the disputed Domain Name primarily for the purpose of targeting the Complainant's business and Monster Trade Marks and that such use by the Respondent would be actionable in an Irish court as trade mark infringement and/or passing off.

29. Accordingly, the Complainant submits, pursuant to Article 21(3)(d), that the Respondent has through the use of the disputed Domain Name, intentionally attempted to attract internet users to a website or other online location by creating confusion with the Monster Trade Marks.

30. Relying on the all the foregoing the Complainant seeks to have the domain name transferred to it.

B. RESPONDENT

31. The Respondent has failed to file a Response to the invitation extended to it, and accordingly the Panel is not in receipt of any contentions advanced on behalf of the Respondent.

32. According to the Complainant, a person introducing himself as Mr Rahat Kazmi, phoned the Complainant's Solicitors on 24 September 2008. The Complainant appears to be of the understanding that a letter sent to the Complainant has been seen by Mr Kazmi and that they expected a response from him. The Complainant avers that no communication was received from the Respondent.

DISCUSSION AND FINDINGS

The Panel finds as follows:

33. The application is properly made by the Complainant as licensee, even though it has not supplied a written licence agreement or supplied written confirmation from the trade mark holder that a licence is in place.

- In the Panel's opinion whether or not a party operates under the benefit of a licence granted by the trade mark holder is, partly, a question of fact. In this regard, the Complainant has stated that it carries on business under the trade marks by virtue of a licence granted by the trade mark holder. Also, the Complainant has stated that that it is a wholly owned subsidiary of the trade mark holder. Statements made by a complainant in its Complaint can constitute evidence of the particular fact averred, and neither piece of evidence is challenged by the Respondent.

- Moreover, the Panel is satisfied that when a group of companies comprises or includes both the parent trade mark holder and a wholly-owned subsidiary licensee an inference can be drawn that the latter is properly licensed to enforce the former's trade mark rights. This can fairly be concluded by reason of the fact of ownership and that, for the purposes of the EU Treaty, and competition law particularly, the group would be considered as a single unit.

34. The domain name is identical or confusingly similar to a name in which the Complainant has prior rights.

- The .eu extension should be ignored when comparing domain names and trade names and marks as to do otherwise is not a fair or logical comparison.

- Equally, a generic word of no significance, distinction or consequence that is incorporated into a domain may be ignored in order to ascertain similarity of the remainder of the domain name with a trade mark.

- The word "monster" can simultaneously be both a generic term and a mark that has acquired distinctiveness and a significant degree of renown during the course of business. Where an otherwise generic term has been properly registered as a trade mark, then this presupposes that it has an element of distinction that is closely aligned to an offering of goods and services, assuming the holder has made use of the trade mark.

- As both national and Community Trade Marks exist for MONSTER, and since the term "monster" is incorporated into the domain name, and disregarding “finance” and the .eu extension for the reasons set out, the latter is identical to the former. The Panel does not find that the word “monster” has a secondary meaning in Ireland that is attributable solely to the Complainant. That might be the case in relation to recruitment services but not generally. However, this does not detract from the finding of identicalness for the purposes of the Regulation.

- Even if the domain name was considered as a whole, that is, by including the term "finance" as a means to qualify the word “monster”, this simply results in the finding that the domain name is on its face confusingly similar with the trade mark as the qualifying word “finance” is generic and does not significantly alter the overall similarity of the domain name to the trade mark. In this regard the Complainant's areas of business and the evidence of the Respondent's use of the domain name have been taken into account.

35. No finding can be made as to whether the Respondent has any or no rights or legitimate interests in the domain name.

- The Panel accepts the Complainant's evidence that the Respondent does not have the benefit of any licence to use the trade marks, but this leaves unanswered the obvious similarity between the registered name of the Respondent, Monster Finance Ltd, and the eponymous domain name.

- On its face the similarity constitutes some interest in the domain name although, in the absence of any submissions from the Complainant and any Response from the Respondent, the Panel cannot reach a conclusion as to whether it constitutes or does not constitute a legitimate interest as exemplified in Article 21 of the Regulation 874/2004.

- The Panel has considered inviting further submissions from the Complainant but, in view of the finding on the issue of bad faith, concludes that this would not alter the overall decision.

36.The Respondent registered and or used the domain name in bad faith.

- On the balance of probabilities the Respondent registered the domain name in bad faith. This is not straightforward if one examines the relevant evidence in isolation. The word “monster” can be generic and could be used in a different context outside the Complainant's area of business; secondly it is coupled with a descriptive word that likewise can be attributed to an area of business that is different from the Complainant's; thirdly, there is a identicalness between the domain name and the Respondent's registered name. However evidence of use in bad faith can infer an intention to register the domain name in bad faith when there is no other evidence of legitimate activity. Certainly the Complainant has established a prima facie case of bad faith in the act of registration, and in the absence of any Response from the Respondent, the Panel therefore finds that the Complainant's version has to be preferred.

- It can be said more easily that on the balance on probabilities the domain name is being used in bad faith. The evidence presented by the Complainant is probative of bad faith, in that the web page resolving to the domain name has, at some point at least, been used to attract internet users to a site that competes with the Complainant's business. The Panel accepts that the Complainant's name and

brand has or would have acquired a significant degree of renown that the Respondent was or ought to have been aware of it. In this regard, the word “monster” may be generic but not so in the context in the area of recruitment services (– it is this fact that gives rise to an inference of bad faith in the act of registration). In addition the get up of the web site, the specific activities in the area of recruitment services, and the active selling undertaken on behalf of the Respondent in the form of the email from Mr Kasmi, are also indicative of bad faith. Based on the foregoing the Panel is on the firm conclusion that the domain name is being used in bad faith.

CONCLUSION

37. The Panel finds in conclusion that the disputed domain 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 that it has been registered or is being used in bad faith.

38. The Panel also notes that the Complainant has applied for and is eligible to be registered the disputed domain name.

DECISION

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

PANELISTS

Name	**Joseph Dalby**

DATE OF PANEL DECISION 2009-06-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant and its Parent Company are providers of online careers and recruitment resources under the general style and business name of “Monster”. The trade name is protected by various trade marks throughout the Community. The Complainant averred that it is a licensee of rights to the above trade marks, but could not produce a written licensing agreement in respect of these marks.

According to the Complainant, the .eu extension could be ignored. Further its Trade Marks are clearly incorporated into the disputed Domain Name, and that the addition of the word “finance” to the mark MONSTER does not change the overall impression of the designation as being a domain name connected to the Complainant and the Parent Company. Several decisions were relied upon. Evidence of active selling on the part of the Respondent was offered.

The Complainant confirmed that the Respondent was not operating with the benefit of a licence to use the trade marks. It also alleged that one could find an absence of legitimate interest when a respondent used the disputed domain name to offer similar/related services and to divert potential customers to its competing website. Several decisions were relied upon.

Finally, the Complainant pointed out that the Respondent's website was clearly attempting to attract Internet users interested in recruitment services away from the Complainant and to its own site. This was for the purpose of disrupting the commercial activities of a competitor, which had a world renowned brand and reputation that the Respondent must have been aware of.

The Panel found that the application was properly made by the Complainant as licensee, even in the absence of a written licence agreement. Statements made by a complainant in its Complaint can constitute evidence of the particular fact averred, and these were not challenged by the Respondent. Moreover, one can in appropriate circumstances infer that within a group of companies a subsidiary will be licensed to use and enforce the parents trade mark rights.

The Panel also found that the domain name without generic words and .eu extension was identical to the trade marks; otherwise it was confusingly similar.

The Panel could make no finding as to whether the Respondent and no nor any legitimate interests.

The Panel was satisfied beyond the relevant standard that the domain name was either registered and or was being used in bad faith.