Panel Decision for dispute CAC-ADREU-005379

Case number	CAC-ADREU-005379
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Domain names	nordicnaturals.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Nordic Naturals, Mr. Antonio Claudio Martinez II, Legal Counsel

Respondent

Organization / Name	UK DOMAIN DEVELOPERS LTD, UK DOMAIN DEVELOPERS LTD

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 other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

1 The Complainant is Nordic Naturals, Inc., a company incorporated in the State of California in the United States of America. The Complainant was incorporated in February 2002.
2 The Complainant is active in the market for dietary supplements, where it markets and sells premium fish oil and Omega 3 fatty acid supplements world-wide, including in the European Union.
3 The Complainant asserts that it has marketed and sold its products in various EU member states since January 2004. The Complainant is the owner of a number of trade mark registrations for the mark NORDIC NATURALS and has submitted a copy of International Registration No. 991 386 for the mark NORDIC NATURALS in international class 5. The base application is a United States of America application with number 77543335 and the priority date is 11 August 2008. The date of the International Certificate of Registration is 19 February 2009. The International Registration designates inter alia the European Community. The certificate states that the element NATURALS has been disclaimed.
4 The Complainant further asserts that it (and its affiliates) are the holders of numerous domain name registrations including the mark NORDIC NATURALS. The Complainant submitted WHOis information showing that it registered the domain name NORDICNATURALS.NO on 22 September 2005.
5 The Respondent is UK Domain Developers Ltd, a company with place of business in the United Kingdom. On 7 April 2006, the first day of the Land Rush period, the Respondent obtained the registration of the domain name NORDICNATURALS.EU, which was subsequently blocked by EURid.
6 The website accessed via the domain name NORDICNATURALS.EU lists various vitamin, fish oil and Omega 3 supplements. These products are all linked to search engine results.
7 The Respondent was a respondent in four other .eu ADR proceedings, namely case 04872 (GREENIES), 04819 (AMBIENCR), 04492 (SPONDA), and 01375 (RABBIN).
8 By letter dated 6 January 2009 from the Complainant to the Respondent, the Complainant offered the Respondent a settlement payment in return for the transfer of the disputed domain name to it. There is no evidence before the Panel to suggest that the Respondent replied to this letter.
9 On 14 July 2009, the Complainant issued the Complaint in the present ADR proceedings. Having been notified of the Complaint, the Respondent did not submit a response to the Complaint within the required time period. On 21 September 2009, the Czech Arbitration Court issued a Notification of Respondent's Default.
10 The Panel invited the parties by Nonstandard Communications dated 23 and 30 October 2009 to make submissions on specific points raised by the Panel. While the Complainant made further submissions, the Respondent again failed to respond to the Panel's communications.

A. COMPLAINANT

1 The Complainant seeks a decision transferring the disputed domain name to the Complainant. Alternatively, the Complainant seeks revocation of the disputed domain name.
2 The Complainant submits that the Respondent should be considered as having no right or legitimate interest in the disputed domain name because:
2.1 the Complainant has prior rights in the trade mark NORDIC NATURALS, which precede the Respondent's registration of the domain name;
2.2 the Complainant's trade mark is present in many countries world-wide, including in the United Kingdom, and is well-known throughout the world;
2.3 the Respondent's site did nothing to disclaim any relationship with the Complainant;
2.4 the Respondent does not use the domain name in connection with a bona fide offering of goods and services;
2.5 there is no license, consent or other right by which the Respondent would have been authorised to register or use the domain name incorporating the Complainant's trade mark NORDIC NATURALS;
2.6 the Respondent has registered the disputed domain name to divert consumers and to prevent the Complainant from reflecting the mark in a corresponding domain name.
3 The Complainant further argues that the domain name should be considered as having been registered and used in bad faith because the Respondent:
3.1 had no prior rights in or authorisation given by the Complainant to use the NORDIC NATURALS trade mark;
3.2 was aware that the Complainant is a leading fish oil and dietary supplement distributor throughout the world;
3.3 knowing the goodwill and reputation of the Complainant's products, registered the disputed domain name in order to prevent the Complainant from reflecting the mark in a corresponding domain name, and seeking to disrupt the Complainant's business;
3.4 has appeared in four different ADR proceedings in respect of domain names in which it claimed rights; in three of these cases the domain names were transferred to the complainants;
3.5 creates the impression that the web-site is the official web-site for Nordic Naturals products;
3.6 registered the disputed domain name for the purpose of selling it to the Complainant;
3.7 failed to respond to the Complainant's settlement offer; and
3.8 failed to submit a response in the ADR proceedings.
4 With regard to the general eligibility requirements for registration of a .eu domain name, the Complainant submits that it satisfies the requirements by virtue of a presence in the EU through Nordic Naturals Ltd, an English company registered on 20 February 2009, and wholly owned by Joar Opheim, who also wholly owns the Complainant.

B. RESPONDENT

The Respondent did not file a Response to the Complaint or other submission.

DISCUSSION AND FINDINGS

1 The Panel has reviewed and considered the Complainant's Complaint and further submissions in response to the Panel's Nonstandard Communications and annexed documents in detail.
2 Article 22.10 of Commission Regulation (EC) No 874/2004 (the "Regulation") and Paragraph B.10(a) of the ADR Rules provide that if, as in the present case, a party fails to respond within the given deadlines, the Panel shall proceed to a decision on the Complaint, and may consider the failure to respond as grounds to accept the claims of the counterparty.
3 However, the Panel does not consider that the Regulation or the ADR Rules envisage the Panel simply upholding the Complaint in all cases where a Respondent fails to respond. Rather, in order for the complaint to succeed, the Complainant must still demonstrate that the requirements of Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules are satisfied.
4 In accordance with Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules, in order to succeed, the Complainant must establish that:
(a) the disputed domain name is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognised or established by national and/or Community law; and either
(b) the domain name has been registered by the Respondent without rights or legitimate interest in the domain name; or
(c) the domain name has been registered or is being used in bad faith.
5 If the Complainant succeeds in this respect, in order to obtain a transfer of the disputed domain name to itself, Article 22.11 of the Regulation further requires that the Complainant applies for the disputed domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002. The remedies which the Panel may otherwise grant would be restricted to a revocation of the disputed domain name.
6 Turning, first to the question whether the question whether the domain name is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognised or established by national and/or Community law.
7 The Complainant has adduced evidence of an international trademark registration for the mark NORDIC NATURALS with priority date

11 August 2008. The disputed domain name NORDICNATURALS is identical with the Complainant's registered trade mark.
8 However, the Panel notes that the Respondent's registration of the disputed domain name actually pre-dates the priority date of the Complainant's registered trade mark. On the question whether registration of a domain name before the complainant acquires trade mark rights in the name prevents a finding of identity or confusing similarity, the Panel notes that Art 21.1 of the Regulation makes no specific reference to the date on which the trade mark owner acquired the rights relied upon. Registration of a domain name before the complainant acquires trade mark rights in the name therefore does not in itself prevent a finding of identity or confusing similarity. It is sufficient that the complainant has rights in the mark at the time when the Complaint is made. The Panel thereby follows what appears to be the WIPO consensus view on this issue.
9 While the Complainant has also adduced evidence that it is the owner of the domain NORCICNATURALS.NO, this domain name registration is not a right within the meaning of Article 10 of the Regulation, not least because it does not arise or is protected under the laws of a Member-State (Norway not being a member of the European Union). While the Complainant has also relied upon its trading activities in various Member-States, the Complainant has neither suggested that this gave rise to rights within the meaning of Article 10 of the Regulation, not explained how such rise would have arisen or be protected under the laws of a Member State.
10 The Panel will next deal with the Complainant's submission that the Respondent registered and/or uses the disputed domain name in bad faith. The Panel does not find that the Respondent registered the disputed domain name in bad faith for the following reasons. Art 21.3 of the Regulation sets out circumstances which are indicative of bad faith. The Respondent may in principle fall within Article 21.3(b) of the Regulation, i.e., have registered the domain name to prevent the Complainant from reflecting its registered trade mark in a corresponding domain name, in that it has been a respondent in a number of prior ADR proceedings, and does not appear to have used the domain name in a relevant way for at least two years from the date of registration; the Panel is mindful however that it is difficult to establish bad faith in circumstances where the Respondent's registration of the disputed domain name actually pre-dates the registration of the trade mark rights relied upon by the Complainant.
11 It is of course conceivable that the Respondent may have registered the disputed domain name in the anticipation that the Complainant may wish to secure the disputed domain name. However, the Respondent cannot have been aware at the date of registration of the disputed domain name of the (then not yet existing trade mark rights of the Complainant in that name). There is no evidence before the Panel showing that the Respondent was or must have been aware of the Complainant's intention to apply for trade mark rights in the name NORDIC NATURALS, or that the Respondent was or should have been clearly aware of the Complainant when it registered the disputed domain name. There is further no evidence before the Panel confirming that NORDIC NATURALS was a famous mark.
12 Furthermore, there is insufficient evidence otherwise to corroborate bad faith. In particular, there is no evidence that the Respondent has sought to sell the disputed domain name to the Complainant. To the contrary, the Respondent has not responded to the Complainant's offer to purchase the disputed domain name. There is also no evidence (beyond the assertion of fact by the Complainant) that the Respondent registered the disputed domain name primarily for the purpose of disrupting the Complainant's business, or intentionally to divert business away from the Complainant for commercial gain by creating a likelihood of confusion between the Complainant's trade mark and the web-site linked to the disputed domain name.
13 The Panel does, however, accept the Complainant's submission that the disputed domain name was registered by the Respondent without rights or legitimate interest in the name. First, the Panel notes that the Respondent did not file a response in these ADR proceedings and took no steps to assert such rights. The Panel infers from the Respondent's default that no such legitimate interest exists. Secondly, a review of the circumstances referred to in Article 21.2 of the Regulation confirms the absence of any rights or legitimate interest of the Respondent in the name NORDIC NATURALS. Namely:
13.1 the Respondent has not used the domain name in connection with the offering of goods or services and has made no demonstrable preparation to do so. The Respondent's corporate name suggests that it is a domain name development company, and not in the business of selling dietary supplements. The web-site linked to the disputed domain name sets out links to third party internet search engine results for various dietary supplements. It is therefore not used by the Respondent in connection with the offering of goods and services. It is now established by a continuing line of WIPO decisions that providing links to other commercial web-sites unrelated to the Respondent's business does not amount to a genuine offering of goods and services; likewise, it does not amount to an offering of goods and services if the Respondent is seeking to attract and divert online traffic;
13.2 the Respondent is not known by the name NORDIC Naturals; and
13.3 the Respondent is not making any legitimate and non-commercial or fair use of the domain name.
14 The Panel is therefore satisfied that the disputed domain name should be revoked within the meaning of Article 21.1 of the Regulation and Paragraph B11(d) of the ADR Rules.
15 The Panel does not find the Complainant to be eligible for the requested transfer of the disputed domain name. The Complainant is a corporate entity incorporated in the State of California in the United States of America. It does therefore not satisfy the general eligibility criteria within the meaning of Paragraph 4(2)(b) of Regulation (EC) No 733/2002 and Article 22.11 of the Regulation. The fact that the Complainant has an affiliated entity, Nordic Naturals Ltd, with separate legal personality in the UK, with which it is connected through the common ownership of both corporate entities by the same third party, does not provide the Respondent with the required presence within the EU. However, there is no reason why Nordic Naturals Ltd (the UK entity) should not be able to apply for registration of the domain name NORDICNATURALS.EU once the disputed domain name registration by the Respondent has been revoked.

DECISION

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

PANELISTS

Name	Gregor Kleinknecht, LLM MCIArb

DATE OF PANEL DECISION 2009-11-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant seeks the transfer of the disputed domain name NORDICNATURALS.EU to the Complainant. The Respondent failed to respond to the Complaint within the applicable time limits, or at all. The Complainant has established that the disputed trade name is identical with the mark NORDIC NATURALS in respect of which the Complainant has a right which is recognised or established by national and/or Community law. The Panel did not find that the Respondent registered or is using the disputed domain name in bad faith but found that the Respondent had no rights or legitimate interest in the disputed domain name. Since the Complainant did not meet the general eligibility criteria for the transfer of the disputed domain name but, in the alternative, asked for the disputed domain name to be revoked, the Panel granted that remedy.