Panel Decision for dispute CAC-ADREU-005455

Case number	CAC-ADREU-005455
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Domain names	epsonoffer.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	EPSON Europe BV c/o Demys Limited, Tim Brown

Respondent

Organization / Name	Costas Ioannou

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

FACTUAL BACKGROUND

1.The Complainant is Epson Europe BV, a company incorporated in the Netherlands and the Respondent is an individual named Costas Ioannou.

2.The Respondent registered the Disputed Domain Name, “epsonoffer.eu” on 19 December 2007.

3.On 2 July 2009, the Complainant submitted the Complaint, together with the Annexes. On 21 July 2009 the Czech Arbitration Court notified the Complainant of certain deficiencies in the Complaint. The Complainant was given 7 days in which to amend its Complaint. The Complainant duly amended the Complaint and submitted the amended Complaint on 21 July 2009.

4.On 24 July 2009 these proceedings formally commenced.

5.The Respondent failed to submit a response.

6.On 5 October the Panel was appointed.

A. COMPLAINANT

7.The Complainant contends that it is the licensee of the following registered trade marks:

a.UK Trade Mark number 1048343 - EPSON - registered 19 June 1975 in class 9;

b.Registered Trade Mark number 73061282 (US) - EPSON - registered 25 August 1975 in classes 9, 21 and 26;

c.European Community Trade Mark number 004147229 - EPSON - dated 29 November 2004 and registered in classes 2, 9 and 16.

d.The licence is dated June 11th 1991 in the name of Seiko Epson Corporation (SEC) who is the owner of the trade marks referred to above. The licence is in writing and signed by the president of SEC. Article 2.1(e) of the Trade Mark Licence gives the Complainant the right to “take all steps which, in the mutual opinion of the Licensor (SEC) and Licensee (the Complainant), shall be deemed necessary to protect and promote Licensor’s rights in and to the Mark in the territory”.

8.The Complainant contends that it has “extremely strong rights” in the Epson mark and:

a.Epson is an extremely well-known made up term and forms the first dominant, most significant and distinctive element of the Disputed Domain Name;

b.The additional word “offer” in the domain name is not dominant, being merely generic and descriptive;

c.Had the domain name not included the Epson mark, its meaning and significance would have been entirely different, in that it would not relate specifically to the Complainant or its products.

9.The Complainant contends that the Respondent has no Right or Legitimate Interest in the Disputed Domain Name, in particular:

a.The Respondent knew, or ought to have known, about the UK and Community Trade Marks Epson which grant exclusive rights to SEC in the mark Epson;

b.The Respondent is not a Licensee of the Complainant and has not received any permission or consent from the Complainant to use the Complainant’s trade marks.

c.The Respondent has not been commonly known by the trade mark Epson.

d.The Respondent owns no trade marks or service marks incorporating the Epson mark in product names.

e.The Respondent is not an authorised distributor of the Complainant’s products.

f.The Respondent has at no time made an offering of goods and services under the name Epson and has made no demonstrable preparations to do so. The Respondent is not making any use of the domain name at all because the Disputed Domain Name resolves to an error 404 page.

10.The Complainant contends that the Disputed Domain Name has been registered in bad faith. The Complainant makes the following contentions:

a.The Respondent has engaged in a pattern of abusive registrations. The Respondent has registered :
(i) HPoffer.co.uk
(ii) Lexmarkoffer.co.uk
(iii) Olivettioffer.co.uk
(iv) Olivettioffers.co.uk
(v) Panasonicoffer.co.uk
(vi) Sharpoffer.co.uk
(vii) Toshibaoffer.co.uk

These domain names relate to and include the well known marks of electronics manufacturers including Lexmark, Toshiba, Sharp, Panasonic and Olivetti. The Disputed Domain Name was registered on the same day as hpoffer.co.uk, lexmarkoffer.co.uk and panasonicoffer.co.uk and a day later than olivettioffers.co.uk and olivettioffer.co.uk. Sharpoffer.co.uk and Toshibaoffer.co.uk were registered some time before the Disputed Domain Name.

b.The Respondent has already been the subject of a successful complaint by the Complainant in respect of the domain name Epsonoffer.co.uk under the Nominet Dispute Resolution Service policy.

c.The Disputed Domain Name has been registered with the intention of attracting internet users for commercial gain. Other domain names registered by the Respondent including Epsonoffer.com and Epsonoffer.co.uk formerly resolved to Pay Per Click advertising which displayed advertisements relating to a number of the Complainant’s competitors, and related third party manufacturers. The inference is that the Respondent is engaged in a pattern of registration and use of domain names containing trade marks to which he has no rights and that the Respondent intends or intended to use the Disputed Domain Name in the same way. The use of the domain names in this way is intended by the Respondent to attract internet users to his websites by creating confusion with the Complainant’s trade mark and giving rise to the impression in the mind of consumers that the Respondent’s websites are run by, affiliated to, sponsored by or endorsed by the Complainant.

d.The Domain name is registered primarily to disrupt the business of a competitor. The Complainant relies upon the same reasoning as referred to in paragraph 10(c) above and contends that the definition of “competitor” should not be restricted to a commercial or business competitor, but should encompass a person who acts in opposition to another. The Complainant cites the WIPO case numbers D2000-0279, D2000-1571 and D2000-1772 in support of this contention. The Complainant concludes that the Respondent, in this case, is acting as a competitor to the Complainant by promoting the printer peripherals and suppliers of other third party business in its other domain name registrations. The Complainant says that its business will have been disrupted by the Respondent’s registration of a misleading domain name and its use in association with advertising the Complainant’s competitor’s products.

B. RESPONDENT

11. The Respondent did not submit a response.

DISCUSSION AND FINDINGS

12.Under Regulation 874/2004, article 22(1)(a), an ADR procedure may be initiated by any party where the Registration is speculative or abusive within the meaning of Article 21.

13.Article 21 of Regulation 874/2004 states that a registered domain name shall be subject to revocation using an appropriate extrajudicial 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 and where it has been registered by its holder without rights or legitimate interest in the name; or has been registered or has been used in bad faith.

14.The Complainant has submitted an extract from the UK Intellectual Property Office website, the United States Patent and Trade Mark Office website, and the Office for Harmonisation of the Internal Market (OHIM) website which shows that “Epson” is registered as a trade mark and is a right which is recognised or established by National and/or Community Law. The Disputed Domain Name “epsonoffer.eu” is not identical to the trade mark rights held or licensed by the Complainant. However, the use of the word “offer” is likely to cause confusion in the mind of internet users as to whether the disputed domain name is associated with the Complainant. This is because the word “offer” is a generic and descriptive term that has been placed in conjunction with the strong and distinctive brand name and trade mark of the Complainant. Therefore, the Complainant has established that the Disputed Domain Name is confusingly similar to a name which is recognised or established by National and/or Community Law.

15.The Respondent has not submitted a Response and therefore the Panel is not aware that the Respondent has any registered rights or any other rights in the name Epson. The Panel has considered the website www.epsonoffers.eu and notes that the website is not active. In the absence of any other information to the contrary and given the background of the Respondent’s activities provided by the Complainant in this matter, namely:

a.that the Respondent is not a licensee of the Complainant and has not received any permission or consent from the Complainant to use the Complainant’s trade marks; and

b.the Respondent is not commonly known by the name Epson,

the Panel finds that the Respondent has no legitimate interest in the Disputed Domain Name.

16.Since the Panel has held that the Respondent has no right or legitimate interest in the Disputed Domain Name there is no need to make a finding as to bad faith for the purposes of Article 21(1). However, since the issue has been raised, the Panel will comment on this issue.

17.Article 21(3) defines what is meant by bad faith. In particular, bad faith may be demonstrated where:-

a.the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name in respect of which a right is recognised;

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 by National or Community Law from reflecting this name in a corresponding domain name provided that a pattern of such conduct by the Registrant can be demonstrated;

c.the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor;

d.the domain name was intentionally used to attract internet users for commercial gain.

18.The Complainant has submitted evidence that the Respondent owns domain names that constitute a pattern of abusive registrations. For example, hpoffer.co.uk, lexmarkoffer.co.uk, olivettioffer.co.uk, olivettioffers.co.uk, panasonicoffer.co.uk, sharpoffer.co.uk and toshibaoffer.co.uk. In addition, the Respondent was the owner of Epsonoffer.co.uk and Epsonoffer.com. Some of these domain names resolve or formerly resolved to Pay Per Click advertising which display advertisements relating to a number of the Complainant's competitors. The only inference that can be drawn from this activity is that the Respondent intends to create confusion for commercial gain by the generation of internet traffic which results in Pay Per Click revenue.

19.The Panel has considered this evidence and concludes that the Complainant has demonstrated that the Respondent has engaged in a pattern of conduct where it has registered a large number of domain names in order to attract internet users for commercial gain.

20.The Complainant also contends that the domain name was registered primarily to disrupt the business of a competitor. The Complainant refers to a number of other UDRP decisions where a broad interpretation of "Competitor" is adopted. These decisions are not binding on the Panel and only act as persuasive authority. Also, the evidence presented as to the intentions of the Respondent regarding its use of the Disputed Domain Name are circumstantial. The Disputed Domain Name is not currently in use and no evidence has been put forward that it ever was in use. Having said this, the circumstantial evidence provided demonstrates that the other domain names registered in a similar way and at the same time to the Disputed Domain Name and resolve or did resolve to Pay Per Click websites selling computing products.

21.No evidence has been submitted by the Respondent to challenge the claims by the Complainant and/or that the Respondent's registration of a number of domain names that were used for Pay Per Click websites was for a reason other than to attract internet users for commercial gain and/or disrupt the business of a competitor.

22.On this basis, it is the Panel's view that the registration of the Disputed Domain Name is registered 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 EPSONOFFER be transferred to the Complainant

PANELISTS

Name	**Simon Bennett**

DATE OF PANEL DECISION 2009-10-19

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 "epsonoffer.eu".
The Panel held that the name was identical to the Complainant's right derived under a licence of a trade mark registration for "EPSON".
The Panel held that the Respondent had no rights or legitimate interest in the name. The Panel made this finding based upon the absence of any evidence that the Respondent was authorised to trade under the name or is commonly known by the name.
The Panel also found that the Disputed Domain Name had been registered in bad faith because the Respondent had engaged in a pattern of conduct involving the registration of a large number of domain names which had been resolved to pay per click websites selling competing products to the Complainant.
The Panel therefore ordered that the Disputed Domain Name be transferred to the Complainant.