Panel Decision for dispute CAC-ADREU-005646

Case number	**CAC-ADREU-005646**
Time of filing	**2010-03-16 15:35:35**
Domain names	**dinerscards.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Discover Financial Services (UK) Limited, Mr Colin Bell**

Respondent

Organization / Name	**Dinerscards Ltd, Pramatarov Dimitar**

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, pending or decided, which relate to the disputed domain name DINERSCARDS (the "Domain Name").

FACTUAL BACKGROUND

The Complainant, Discover Financial Services (UK) Limited, is part of the Diners Club group and is licensed by Diners Club International Ltd. (“Diners Club”). Under an Intercompany License Agreement dated 21 September 2009 between Diners Club and the Complainant (the “License Agreement”), the Complainant has been granted the right to litigate, arbitrate and otherwise make enforcement efforts against any third party relevant to the trade marks and domain names set out in that agreement on behalf of Diners Club. Under the Agreement, the Complainant is authorised to take enforcement action in respect of the following trade marks owned by Diners Club:
- CTM No. 3777621 DINERS, with a filing date of 5 September 2003 and registration date of 29 August 2005;
- CTM No. 111906 DINERS CLUB with a filing date of 1 April 1996 and registration date of 7 October 1998;
- CTM No. 2903045 DINERS CLUB and design with a filing date of 23 October 2002 and registration date of 25 May 2004;
- CTM No. 173211 DINERS CLUB INTERNATIONAL and design with a filing date of 1 April 1996 and registration date of 7 January 1999; and
- CTM No. 5426416 DINERS SAFE with a filing date of 30 October 2006 and registration date of 18 October 2007 (the "DINERS trademarks").

The Complainant’s group also owns the following domain names:

- <dinerscards.com>, registered on 17 May 2003;
- <dinerscard.com>, registered on 9 August 1999;
- <dinerscard.org>, registered on 28 July 2000;
- <dinerscard.biz>, registered on 23 August 2004;
- <dinerscard.net>, registered on 17 May 2009; and
- <dinerscard.co.uk>, registered on 3 March 2008.

The Domain Name was registered on April 7, 2006.

A. COMPLAINANT

Complainant has made the following contentions:

Diners Club International Ltd. (“Diners Club”) is a leading provider of financial services to individuals, small businesses and large

corporations through many channels of trade, including but not limited to, credit and charge card services. The credit and charge cards issued by Diners Club are accepted in over 200 countries and at over 13 million locations around the world. Diners Club offers to its card holders a highly acclaimed loyalty rewards program. The credit cards issued by Diners Club's licensees are accepted at over one million ATMs and are issued in 64 local currencies. Diners Club has over 8 million individual cardholders. Over half of the Fortune 500 companies hold corporate cards issued by Diners Club. The principal customers of Diners Club include frequent business travelers, corporations, service establishments, travel managers, state and local governments, travel agents, colleges and universities, and individuals.

Diners Club has used the DINERS trademarks extensively and continuously since 1950 in Europe and throughout the world. Consequently, the DINERS trademarks and brands have become famous in Europe and throughout the world in relation to financial, credit and charge card services and in the restaurant industry. These trademarks have obtained the status of notorious marks and therefore enjoy liberal protection under the Paris Convention.

The Domain Name is confusingly similar to the Complainant's DINERS trademarks.

The Domain Name incorporates the Complainant's registered mark DINERS in its entirety. The only difference is the addition of the descriptive word CARDS. As the Diners Club core business relates almost entirely to card services (e.g. credit card and loyalty cards), the word CARDS is entirely descriptive of the Diners Club core business and does not distinguish the Domain Name from the registered mark DINERS. Therefore the Domain Name is confusingly similar to the Complainant's registered mark DINERS.

The confusing similarity of the Domain Name with the DINERS trademarks will inevitably lead to a misrepresentation resulting in third parties associating the Domain Name with the Complainant's group, Diners Club.

The Respondent has registered the Domain Name without Rights or Legitimate Interests in the Domain Name.

The Respondent is not affiliated or related to Diners Club or the Complainant in any way, nor is the Respondent licensed by Diners Club or the Complainant or otherwise authorised to use the DINERS trademarks or to apply for or use any domain name incorporating any of them.

The Domain Name was registered by a subject only identified by the e-mail address orgbutzbach@yahoo.com, which is not affiliated or related to the Complainant. The original holder has never used the Domain Name nor demonstrated any intention to use it legitimately for non-commercial purposes. Instead, it transferred the Domain Name to the Respondent after its registration. Neither the original holder nor the Respondent are known or active under any DINERS trademark nor do they have any legitimate rights to the Domain Name. The Respondent became the owner of the Domain Name over 6 months prior to the initiation of the ADR Proceeding.

The Domain Name was registered and acquired by the Respondent long after the DINERS trademarks became famous. The Domain Name was registered the day after the sunrise period ended, which indicates that the original registrant was aware of the Complainant's group's rights in the marks and was attempting to obtain a blocking registration preventing the Complainant's group from reflecting its DINERS trademarks in a corresponding domain name at the earliest possible opportunity or with the intention of selling, renting or otherwise transferring the Domain Name to the Complainant.

To the best of the Complainant's knowledge, the Domain Name has never been actively used by the Respondent. At the time of writing, the Domain Name displays a basic holding page when accessed.

The Respondent has not acquired any trade mark rights in the Domain Name, nor is the Respondent commonly known by it. The Respondent has never operated any bona fide or legitimate business under the Domain Name and is not making a protected non-commercial or fair use of the Domain Name.

The Domain Name was registered and is being used in bad faith.

It is inevitable that any use of a domain name which incorporates any of the DINERS trademarks in its URL will cause confusion in the minds of the public, leading them to mistakenly believe that the Domain Name and the Respondent's business is somehow associated or connected with the Complainant. Moreover, internet users will assume that the Domain Name is associated with the Complainant's group when this is not the case.

It is a reasonable inference that the Respondent's purpose of registration and use was to either disrupt or create confusion for the Complainant's business in bad faith pursuant to ADR Rule B 1(b)(10)(i)C.

Given the fame and notoriety of the Diners Club brand and the DINERS trademarks, the Respondent must have been aware of the existence of the Diners Marks. This is further substantiated by the fact that the Domain Name was registered on the first day after the expiration of the Sunrise Period (April 7, 2006).

It is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent that would not be illegitimate, either as passing off or an infringement of the DINERS trademarks.

It is unlikely that the Domain Name was registered or acquired for any reason other than trying to profit from the reputation of Complainant's group by selling renting or otherwise the transferring the Domain Name to it.

Alternatively, the Domain Name was registered in order to prevent the Complainant from reflecting its trademark in a corresponding domain name, and the Domain Name has not been used in a relevant way for at least two years from the date of registration.

The confusing similarity of the Domain Name will lead traffic to be diverted to the website operated by the Respondent for commercial gain. The Respondent's actions are an intentional attempt to attract for commercial gain internet users to its website accessed via the Domain Name by creating a likelihood of confusion with Diners Club as to the source, sponsorship, affiliation and/or endorsement of its website.

With the above arguments, the Complainant requests that the Domain Name be transferred to the Complainant. Complainant asserts its eligibility to register .eu domain names under Article 4 (2) (b) of Regulation (EC) No. 733/2002, stating that it is registered in the United Kingdom, and is licensed by Diners Club to register and enforce DINERS trademarks and domain names.

B. RESPONDENT

The Respondent Dimitar Pramatarov asserts that he is now the owner of the Domain Name, which was initially registered by his uncle Yorg Butzbach, a citizen of Germany now living in Vienna, Austria, on behalf of the Respondent, who at the time of registration of the Domain Name was not eligible to register it himself.

According to the Respondent, the Domain Name has never been used since its registration and has not infringed any trademarks. The purpose of its registration was to create a web portal for Diners credit cards, to describe the types of Diners cards and services offered within the European Union, to list the issuers of these banks cards, and to enable people to leave their comments. Thus, users would quickly choose their Diners credit cards. For one reason or another, the project was not realized. Respondent's goal was never to infringe the DINERS trademarks, but simply to create a product to facilitate Internet users in pointing them in the right direction.

The Respondent notes that Complainant has not registered the Domain Name itself during the Sunrise Period. As Complainant has refrained from doing so, Respondent sees no reason why Complainant should now be entitled to get it. Respondent alleges that Complainant, having been passive for four years, is now trying to deprive Respondent - an ordinary man, who has complied with all legal requirements - of the Domain Name.

Lastly, the Respondent requests the rejection of the Complaint, and draws the attention to the fact that Complainant is an American company, while the Respondent is a citizen of the European Union.

DISCUSSION AND FINDINGS

According to Article B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that Complainant proves in the ADR proceeding that:
(i) the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and; either
(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or
(iii) the domain name has been registered or is being used in bad faith.

Identical or confusingly similar

The Panel finds from the evidence submitted with the Complaint that the Complainant's affiliated company, Diners Club International Ltd., is the proprietor of the DINERS trademarks, details of which are given above. These trademark registrations give rise to rights in the name DINERS within the meaning of Article 10 of the Commission Regulation (EC) 874/2004, i.e., rights established by Community law. As further evidenced with the Complaint, Diners Club International Ltd. has licensed the Complainant to use the DINERS trademarks on

its own behalf with regards to their enforcement, which is to be carried out by the Complainant. Therefore, the Panel finds that the Complainant has proven that it has rights in the name DINERS, in respect of which trademark rights are established by Community law.

The Panel finds that the Domain Name is confusingly similar to the DINERS trademarks. The dominant feature of both the Domain Name and the trademarks is the word DINERS, and their other elements, being descriptive or generic, do not detract from that dominance. As to the suffix ".eu", it is widely accepted that this element is not relevant for the purposes of the test for identity or confusing similarity. Therefore, the condition set forth under Article B11(d)(1)(i) of the ADR Rules is fulfilled.

Rights and Legitimate Interests

Under the ADR Rules, the burden of proof for the lack of rights and legitimate interests of the Respondent lies with the Complainant. However, the existence of negative facts is difficult to prove, and the relevant information for the Respondent is mostly in its sole possession. Therefore, the Panel holds that it is sufficient for the Complainant to make a prima facie demonstration that Respondent lacks rights or legitimate interests in the Domain Name. The burden of proof then shifts to Respondent to substantiate its rights or legitimate interests in the Domain Name.

In this case, Complainant has submitted that Respondent is not using the Domain Name in connection with the offering of goods and services, and has made no demonstrable preparation to do so. The Domain Name has not been used since its registration, and there are no indications of a connection between the Respondent and the Domain Name. The Respondent has never been licensed by the Complainant to register or use the Domain Name. In this way, Complainant has made the prima facie showing discussed above.

The Panel is of the opinion that the Respondent has failed to rebut the prima facie case established by the Complainant. As explicitly conceded by the Respondent, he was the beneficial owner of the Domain Name from its registration. The Domain Name was chosen and registered specifically in view of the Complainant and its financial products and services. This makes clear that the Respondent's plans related to the Domain Name (even if never substantiated, as he conceded himself) were based on the goodwill of the Complainant and its name DINERS. The eventual operation of a website under the Domain Name is likely to extract benefit from this goodwill without the consent of the Complainant, especially if such website is used for commercial purposes (it is noted that the Respondent has not claimed to have planned to use the Domain Name solely for non-commercial purposes). In the Panel's view, these circumstances cannot be regarded as giving rise to rights and legitimate interests of the Respondent in the Domain Name.

As to the entity named Dinerscards Ltd. which appears in WhoIs information in respect of the registrant of the Domain Name, the Panel notes that the Respondent has not mentioned it in his response. Rather, it is clear from the Respondent's submission that he is acting as a physical person. In addition, the Panel has not found information of any company with such name registered in Bulgaria. Therefore, the Respondent has not established that it is commonly known by the Domain Name.

Taking the above circumstances into account, the Panel finds that the Respondent has registered the Domain Name without rights or legitimate interests in it.The condition set forth under Article B11(d)(1)(ii) of the ADR Rules is therefore fulfilled as well.

Bad Faith

The Panel notes that, in case Respondent is found to have registered the Domain Name without rights or legitimate interests in it, it is not necessary to investigate Respondent's possible bad faith under Article B11(d)(1)(iii) of the ADR Rules. However, for the sake of completeness, the Panel decided to rule on this issue as well.

As noted in ADR Case No.02235: "Given the Complainant's rights to the use the name "Palmer's Cocoa Butter" in Europe, there are only a limited number of ways in which the Respondent could use the domain name that would not be in bad faith. ... If the domain name was used for any commercial purpose (including the offering of the domain name for sale, or for sponsored links or affiliate sales) this would therefore be evidence of bad faith." The Panel finds that the same reasoning applies here as well. Complainant has established its rights in the name "DINERS" for the territory of the European Union, and this name is obviously well-known and easily recognized by consumers of financial services related to credit cards. The Domain Name is confusingly similar to the DINERS trademarks, so it is likely that Internet users would expect it to be affiliated to or approved by Diners Club, especillay given the numerous similar domain names registered by the Diners Club group. The Respondent has himself stated that the purpose of the registration of the Domain Name was to make a web portal dedicated to the Diners Club cards, and the Complainant has never given its approval to such project. In these circumstances, it is difficult to conceive of any good faith use of the Domain Name by the Respondent that would be legitimate. Rather, it is more likely than not that the Respondent has either registered the Domain Name with the intent to extract commercial gain from the goodwill of the DINERS trademarks and of the Diners Club group, by attracting Internet users to his website, or has registered the

Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to the Complainant.

Therefore, the Panel accepts that the Respondent has registered the Domain Name in bad faith, and the condition set forth under Article B11(d)(1)(iii) of the ADR Rules is also fulfilled.

Now, the Panel turns to the Respondent's argument that the Complainant has not registered the Domain Name itself during the Sunrise Period, and has not carried out any actions against the Respondent for four years thereafter, as a result of which the Complainant was not eligible to bring the present proceeding against the Respondent. The Panel does not accept these arguments. To do so would mean that, in order to protect its rights, a company would have to register all imaginable variants of its trademarks combined with terms descriptive of its business. As to the four years of inaction by the Complainant, the Panel notes that under Article 53 of Council Regulation (EC) No.40/94, the period of acquiescence should be at least five years, and it has not expired yet.

As the Complainant is a company established in the United Kingdom, it satisfies the general eligibility criteria for registration of the Domain Name set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002. Therefore, Complainant is entitled to request the transfer of the Domain Name to itself.

DECISION

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

PANELISTS

Name	**Assen Zahariev Alexiev**

DATE OF PANEL DECISION 2010-05-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This Decision relates to the domain name DINERSCARDS (the "Domain Name").

The Complainant Discover Financial Services (UK) Limited is part of the Diners Club group and is licensed by Diners Club International Ltd. (“Diners Club”) - a leading provider of financial services, including but not limited to, credit and charge card services. The Complainant requests the transfer of the Domain Name.

The Panel has made the following findings:
- the Domain Name is confusingly similar to the Complainant’s DINERS trademarks, as it incorporates their distinctive element DINERS in its entirety;
- the Respondent has no rights or legitimate interests in the Domain Name, as the Domain Name was chosen and registered specifically in view of the Complainant and its financial products and services, the Respondent's plans related to the Domain Name were based on the goodwill of the Complainant and its name DINERS, and the eventual operation of a website under the Domain Name is likely to extract benefit from this goodwill without the consent of the Complainant, especially if such website is used for commercial purposes;
- the Domain Name was registered in bad faith, as it is more likely than not that the Respondent has either registered the Domain Name with the intent to extract commercial gain from the goodwill of the DINERS trademarks and of the Diners Club group, by attracting Internet users to his website, or has registered the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to the Complainant.

On these grounds, and in view of the fact that the Complainant is established in the European Union, the Panel has ordered the transfer of the Domain Name to the Complainant.