Panel Decision for dispute CAC-ADREU-005648

Case number	**CAC-ADREU-005648**
Time of filing	**2010-03-16 15:33:36**
Domain names	**dayco.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Dayco Europe S.r.L., Mr Gianfranco Lorenzini**

Respondent

Organization / Name	**Titan MPA Ltd, Simon Webb**

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 become aware of any other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The company under the name “Dayco Europe Srl” having its registered office in Chieti Scalo, Italy and being the licensee of the Company “Dayco Products LLC” filed on March 16, 2010 a Complaint (hereinafter called “The Complainant”) against the registration of the domain name “dayco.eu” which has been filed on July 28, 2008 on behalf of the company under the name “Titan MPA Ltd” having its registered office in Yorkshire, United Kingdom (hereinafter called “The Respondent”).
The Complainant requests the Panel to order the transfer of the domain name “dayco.eu” to the Complainant.

The Respondent did not file any response in consideration of due process.

On May 31, 2010, the Czech Arbitration Court appointed the undersigned herewith as a Panelist in response to the above actions.

A. COMPLAINANT

The Complainant claims that:
a. The Complainant is the licensee of the following registered trademarks that are rightfully held and legally valid in the name of Dayco Products LLC: United Kingdom Trademark Reg. no 1454566 (DAYCO) in class 7, 1454567 (DAYCO) in class 12 no. 1583274 (DAYCO) in class 17 and community Trade Mark Reg. no. 4455416 DAYCO in class 7, 12 and 17 which are in full force and effect,
b. the disputed hereto domain name dayco.eu is identical to the registered trademarks DAYCO which are legally held by the Complainant,
c. the Respondent did not present any legitimate interests in respect of the disputed domain name dayco.eu. Neither is the Respondent known to have any prior legitimate interests and rights upon the domain name at hand, nor does it make a legitimate non-commercial use of the domain name dayco.eu,
d. The Respondent has both used and registered the domain name in bad faith. As to bad faith at the date of registration of the domain name, the Respondent knew or must have known by its own admission as a distributor of the Complainant’s DAYCO goods without any regard for the Complainant’s registered trademark rights, and yet registered the name without any regard for the Complainant’s registered trademark rights. Ever since it’s registration by the Respondent, the Respondent has used the domain name in bad faith in the sense that it has parked the name at a website and has attracted internet traffic to the site under the name from customers or potential customers. All these actions in our view fall within one of the defined instances of bad faith activity described in Section 11(f)(4) of the .eu Alternative Dispute Resolution Rules. Moreover, the Complainant’s company made a telephone approach to the Respondent to see whether the Respondent would be willing to transfer the domain name without any recourse. The Respondent replied by indicating that it required as minimum payment the amount of 10.000 Euros for the transferring of the domain name at hand. This fact in our view falls within the defined instances of bad faith activity provisioned in Section 11(f)(1) of the ADR Rules.

B. RESPONDENT

The Respondent did not file any response in consideration of due process.

DISCUSSION AND FINDINGS

1. According to art. 22(11) of the Regulation and art. 11(b) of the ADR Rules "…In the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002……".

2. According to art. 21(1) of Regulation 874/2004 (hereinafter called "The Regulation") and art. 11(d) of the ADR Rules, "a registered domain name shall be subject to revocation, using an appropriate extra-judicial 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, such as the rights mentioned in Article 10(1), and where it (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith." The domain name shall be identical to the textual or word elements of the prior right name.

3. According to art. 21(2) of the Regulation "a legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where (a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so; (b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law; (c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law."

4. According to art. 21(3) of the Regulation "Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where (a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or (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 or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that (i) a pattern of such conduct by the registrant can be demonstrated; or (ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or (iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated."

5. According to art. 10 of the Regulation "1. ....."Prior rights" shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works. "..... 2. The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists."

6. According to art. 4(2)(b) of the Regulation 733/2002 "the Registry shall register domain names in the .eu TLD through any accredited .eu Registrar requested by any (i) undertaking having its registered office, central administration or principal place of business within the Community, or (ii) organization established within the Community without prejudice to the application of national law, or (iii) natural person resident within the Community;

7. According to art. 11(a) of the ADR Rules "a Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules."

8. The Panel clarifies herewith that -i) the burden of proof is on the Complainant's side (see ADR 1304 "KEMET", 3510 "BIGDUTCHMAN", 1250 "voca" cases) and -ii) the Complainant has, at least, to present a prima facie evidence to shift the burden of proof to the Respondent (see ADR 2888 "GERMANWINGS" case).

9. According to art. 22(10) of the Regulation and art. B10 of the ADR Rules "Failure of any of the Parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty."

10. In thorough consideration of all above claims and their background in law, the Panel herewith deems just, in sync with applicable law, and decides the following:
i. Prior rights of the Complainant: According to art. 10 of the Regulation, the Complainant as a licensee following the trademark and trademark license agreement dated December 22, 2007 between the Complainant as the Licensee and company under the name Dayco Products LLC as Licensor, has prior legal right to the word “dayco” taking into consideration that the word “dayco” has been registered as UK trademark in the name of Dayco Products LLC as follows: 1454566(DAYCO) registered on June 24, 1994, 1454567 (DAYCO) registered on June 24, 19941583274 (DAYCO) registered on January 19, 1996, and on EU trademark no 004455416 (DAYCO) filed on June 21, 2005, and registered on 31.1.2008; UK trademarks are EU rights recognized under the UK’s Trademarks Act, and Community Trade Mark is an EU right, too.
ii. Taking into consideration that the word .eu does not have any distinctive character, according to art. 11(d) of the ADR Rules the domain name dayco.eu is identical with the trademark rights of the Complainant to the word “dayco.”
iii. The Complainant has prior rights to the word “dayco” following the license agreement dated December 22, 2007, taking into account that the registration of the domain name dayco.eu was filed on July 28, 2008.
iv. Rights or legitimate interests in the name “DAYCO” of the Respondent: Regarding the contentions of the Complainant that according to art. 22(10) of the Regulation the Respondent has no rights or legitimate interests in the word “DAYCO” i.e. a) The Respondent has made no legitimate offering of goods and services which is evidently understood by the fact that a print out of the website under the name dayco.eu is submitted stating that “Search listings” regarding the word dayco may be traced, and b) neither is the Respondent known nor has it made a legitimate non-commercial use or fair use of the name, which is evidently understood by the fact that though a letter of the Respondent is submitted stating that it is a distributor of the Complainant’s branded DAYCO goods, and yet no evidence of that has been filed appropriately; also, the Respondent has claimed that it intends to heavily promote Dayco products in the future.
Taking into consideration that according to art. 22(10) of the Regulation failure of any of the Parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty, the Panel contends that the Respondent has no legitimate interest in the domain name dayco.eu and that its failure to respond appropriately is thus considered as an acceptance of the truth of the claims of its counterparty.
Additionally, in other words and supplementary to the aforementioned and legally bounded claims and in consideration of art. 21 of the Regulation there is bad faith in the behavior of the Respondent as follows:
v. Bad faith of the Respondent: Following the correspondence between the Complainant and the Respondent and the Witness Statement of David Haubbard, UK & Ireland Country Manager in Dayco Srl. it becomes obvious and beyond any doubt that the Respondent is fully aware of the company Dayco since it acknowledges that it stocks a huge range of Dayco products inside two of their buildings; the Respondent made an offer suggesting either the payment of 10,000 Euros in cash or the value of 20,000 Euros in stock of Dayco Products.
Also, taking into account that according to art. 22(10) of the Regulation failure of any of the Parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty, the contentions of the Complainant that a) the domain name “dayco.eu” was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the rightholder of trademark related to the word “dayco,” and b) that the domain name “dayco.eu” was registered and used with the aim to attract Internet users for commercial gains through the Respondent’s website leveraging on a likelihood of confusion with a name “dayco” for which a right is recognized or established by national and/or Community law
In consideration of all above facts, the Panel decides that the Complainant has prima facie proven that the Respondent has no rights or legitimate interests in the domain name “dayco.eu” and said domain name has been registered in bad faith. Therefore the Complainant meets the requirements of art. 21(1) of the Regulation.
vi. In consideration of the provisions of art. 21(1) of the Regulation providing among other things that a registered domain name shall be subject to revocation if it has been registered by its holder without interest in the name and in bad faith, the domain name dayco.eu must be revoked.
vii. In addition, and in consideration of the fact that the Complainant is a company having its registered office in Italy, i.e. in the European Community, the Panel decides that the Complainant meets all the criteria according to art. 4(2)(b) of the Regulation 733/2002 and orders hereto the transfer of the domain name dayco.eu to the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name DAYCO be transferred to the Complainant
&
the domain name DAYCO be revoked

PANELISTS

Name	**Alexandra Kaponi**

DATE OF PANEL DECISION 2010-06-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Company under the name “Dayco Europe Srl” (hereinafter called “the Complainant”) filed a complaint against the registration of the domain name “dayco.eu” which was made on behalf of the company under the name “Titan MPA Ltd” (hereinafter called “the Respondent”). The Complainant as the Licensee of the Company Dayco Products LLC holds previous trademark rights in the word “dayco” which are identical with the domain name dayco.eu.

Following evidence submitted by the Complainant and taking into account the fact that the Respondent refrained from filing any response appropriately, the Respondent is ruled to have no rights or legitimate interest in the domain name dayco.eu; in other and supplementary words, the Respondent is found to have registered the domain name dayco.eu in bad faith.