# Panel Decision for dispute CAC-ADREU-005665

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| Case number | **CAC-ADREU-005665** |
| Time of filing | **2010-04-01 14:07:01** |
| Domain names | **oanda.eu** |

## Case administrator

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| Name | **Tereza Bartošková** |

## Complainant

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| Organization / Name | **OANDA Corporation, Mr Matt Peter David Seymour** |

## Respondent

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| Organization / Name | **Domain Directors Europe Ltd, Domain Administrator** |

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

The Complainant in this ADR Proceeding is OANDA Corporation, a Delaware USA company incorporated in 1996. The Complainant's business is Internet-based foreign exchange trading and currency information services. The Complainant has over 75,000 trading accounts with individual and institutional clients around the world and has subsidiaries in Dubai, Singapore, Canada and the United Kingdom.

The Complainant’s principal website, www.oanda.com, attracts approximately 3,600,000 unique visitors with over 40 million page views per month. The Complainant handles up to 1.5 million foreign currency transactions on its OANDA branded trading platform and handles 0.5% of the $4 trillion transactions made daily on the global foreign currency exchange market.

The Complainant is the owner of international registered trade mark no. 890601 (word mark “OANDA” - use class 36) designating inter alia the European Union and registered on 16 June 2006.

The Respondent is Domain Directors Europe Limited, a limited company with its registered office in Bristol, United Kingdom. The Respondent registered the Domain Name on 24 June, 2007. The website associated with the Domain Name displays the Registrar’s name and logo above the statement “Domain Parked with Europe Registry” together with a “Free Parking” graphic.

The Complaint was filed on 30 March 2010. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for the Domain Name on 1 April 2010. On 7 April 2010, EURid replied in a non-standard communication confirming that the Domain Name oanda.eu was registered with Instra Corporation Pty Ltd, that the current Registrant of the Domain Name was the Respondent, that the Domain Name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the Domain Name was English. It also provided the full details from the WHOIS database for the registrant and registrar technical contacts.

On 9 April 2010, the Czech Arbitration Court conducted a formal compliance review in respect of the Complaint and found it to be in compliance. Accordingly, the formal date of commencement of the ADR Proceeding was therefore 9 April 2010 and a Notification of Complaint and Commencement of ADR Proceeding was issued to the Respondent on that date. This stated that a Response was to be submitted within 30 working days.

On 1 June 2010 the Respondent filed a non-standard communication stating that the Complainant had presented excellent arguments,

and that the Respondent was prepared without prejudice to hand over the rights of the Domain Name to the Complainant's European subsidiary company or to the Complainant's legal representatives provided that they could supply a suitable European domicile. On 1 June 2010 the Czech Arbitration Court filed a non-standard communication stating that the date by which a Response should be filed was 11 June 2010 and indicating that the Complainant would be entitled to apply for a suspension of the proceedings if it wished to do so. On 2 and 3 June 2010 the Complainant filed non-standard communications applying for the proceedings to be suspended for a period of 30 days and providing the name of the Complainant's domain name manager for any transfer of the Domain Name. Accordingly, on 9 June 2010 the Czech Arbitration Court suspended the proceedings until 9 July 2010.

On 9 June 2010 the Complainant filed a non-standard communication requesting that the Respondent transfer the Domain Name to the Complainant's European subsidiary company. On 23 June 2010 the Complainant filed a further non-standard communication again requesting the Respondent to transfer the Domain Name. The Respondent did not reply to these communications.

The Respondent did not comply with the deadline to file a response and the Czech Arbitration Court notified the Respondent of its default on 15 July 2010.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the appointed Panel on 22 July 2010, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ('ADR Rules') and the date by which a decision on the matter was due, which was specified as 23 August 2010.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 27 July 2010.

## A. COMPLAINANT

The Complainant seeks a decision transferring the Domain Name to it.

The Complainant asserts that the name "OANDA" has been used by the Complainant since incorporation, and was registered as a trademark effective 17 August 2004 in the United States of America, and 16 June 2006 in Europe, Japan, Switzerland, Australia and China. The Complainant states that it is a trusted source of real-time OANDA branded currency information for 90,000 corporations, tax authorities, auditing companies, the travel industry and central banks around the world, including many Fortune 100 companies and submits that if a web browser searches against the word 'OANDA' on Google's search service the top ten listings are all related to the Complainant or its business.

The Complainant concludes that for these reasons the OANDA brand is, and was at the date of registration of the Domain Name, extremely well known within the financial and foreign exchange industry in Europe and worldwide in relation to foreign exchange services. The Complainant also submits that the name OANDA is highly distinctive and not descriptive and that the word has no meaning in the English language, or any other language to the Complainant's knowledge.

The Complainant asserts that in March 2009 it was in the process of establishing OANDA Europe Limited and identified the Domain Name. The Complainant was concerned that the Domain Name was identical to its OANDA mark and that as such the Complainant's potential new clients for localised foreign exchange services may be confused thereby.

The Complainant asserts that the Respondent is a subsidiary of the registrar of the Domain Name, only has a mailing address in Europe and has no rights or legitimate interests in the Domain Name. The Complainant notes that the website associated with the Domain Name is a registrar's parking page. The Complainant wrote to the Respondent on 11 February 2010 asserting that the registration of the Domain Name was speculative or abusive pursuant to Article 21 of Regulation (EC) No 874/2004. The Respondent did not reply to that letter.

## B. RESPONDENT

The Respondent did not file a formal Response to the Complaint. However, the terms of its informal response by way of a non-standard submission are noted in the factual background above.

## DISCUSSION AND FINDINGS

1. Preliminary - No Response

The Respondent has not filed a formal Response to the Complaint. In such an eventuality, the effect of the provisions of Article 22(10) of

Commission Regulation (EC) No 874/2004 ('Regulation 874') and Paragraph B10(a) of the ADR Rules is that the failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a Complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21(1) of Regulation 874 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. Applicable provisions

This Complaint is brought under the auspices of Regulation 874 and the ADR Rules. Article 22(1)(a) of Regulation 874 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21.

Article 21(1) states that a registered domain name may be subject to revocation 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.

Article 21(2) provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) states that:

"[…]

"'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."

Article 22(11) states that 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. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 ('Regulation 733').

Article 4(2)(b) of Regulation 733 provides the following general eligibility criteria:

(i) undertaking having its registered office, central administration or principal place of business within the Community, or

(ii) organisation established within the Community without prejudice to the application of national law, or

(iii) natural person resident within the Community.

Paragraph B11(d)(1) of the ADR Rules provides as follows:-

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State 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."

It is clear from the applicable provisions that the burden of proving that a .eu domain name registration is speculative or abusive lies with the Complainant. Accordingly, the first question for the Panel is whether the Complainant has proved that the 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.

3. Rights - identical or confusingly similar

The Complainant has provided evidence that it is the owner of international registered trade mark no. 890601 (word mark “OANDA” - use class 36) designating inter alia the European Union and registered on 16 June 2006. The Panel finds that this is a name in respect of which a right is recognised by Community law and it is clearly identical to the Domain Name, disregarding the top level domain '.eu' as is customary for the purposes of comparison.

4. Respondent's Rights or Legitimate Interest

Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent might demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods and services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate, non-commercial or fair use of the domain name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or Community law.

The Complainant asserts that OANDA is highly distinctive and not descriptive, that the word has no meaning in the English language or any other language to the Complainant’s knowledge and that, while the website associated with the Domain Name is currently parked, the Respondent failed to reply to correspondence asserting that the registration of the Domain Name was speculative or abusive. The Panel considers that this constitutes a prima facie case that the Respondent does not have rights or legitimate interest in the Domain Name.

The Panel takes the view that where a prima facie case has been made out by the Complainant it falls to the Respondent to provide an explanation of its rights or legitimate interest in the domain name, if any. The Respondent has failed to submit a Response to the Complaint and there is no evidence on the record which indicates that Respondent might be able to satisfy any of the tests in Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules. On the contrary, the Respondent appears to accept the Complainant’s argument that it has no such rights or legitimate interest in the Domain Name (albeit on a without prejudice basis) by virtue of the non-standard communication of 1 June 2010 described in the factual background above.

The Panel therefore concludes that, on the balance of probabilities, the Domain Name was registered by the Respondent without rights or legitimate interest. The registration is therefore speculative or abusive, and should be subject to revocation under Article 21(1)(a) of Regulation 874.

In view of the Panel’s finding under Article 21(1)(a) of Regulation 874, it is not necessary to consider whether the Domain Name is also subject to revocation under Art 21(1)(b) of Regulation 874 (which requires a finding that the Domain Name was registered or is being used in bad faith).

5. Transfer or revocation

The Panel has found that the Complainant has proved the required elements within Article 21(1) of Regulation 874 and the corresponding provisions of the ADR Rules. It is therefore necessary to consider whether the Domain Name should be revoked, or transferred to the Complainant.

Article 22(11) of Regulation 874 provides that the Domain Name shall be transferred to the Complainant if the Complainant applies and satisfies the general eligibility requirements set out in Article 4(2)(b) of Regulation 733.

Paragraph B1(b)(12) of the ADR Rules provides that ‘If the Complainant requests transfer of the domain name, [the Complainant shall] provide evidence that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b)’ of Regulation

733.

Paragraph B11(b) of the ADR Rules states that the 'The remedies available pursuant to an ADR Proceeding where the Respondent is the Domain Name Holder in respect of which domain name the Complaint was initiated shall be limited to the revocation of the disputed domain name(s) or, if the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b)… [of Regulation 733], the transfer of the disputed domain name(s) to the Complainant'.

In light of these provisions, the Panel can only transfer the Domain Name to the Complainant, and only where the Complainant satisfies the general eligibility criteria as provided in Article 4(2)(b) of Regulation 733. The Complainant, being a Delaware USA Corporation, does not satisfy those criteria.

In non-standard communications, the Respondent initially offered to transfer the Domain Name and the Complainant proposed a transfer to its UK subsidiary - presumably on the basis that this company satisfies the general eligibility requirements. While the Respondent may have been in a position to effect such a transfer in settlement of this matter, the Panel is unable to order that this be done. The Panel considers that the wording of Article 22(11) of Regulation 874 is entirely clear and is mandatory in effect - the domain name shall be transferred to a complainant which applies for transfer only where that complainant satisfies the general eligibility criteria. As was noted by the panel in the case of Sepracor, Inc v. Adil Akkus, case 5174 (LUNESTA) there is no provision in the ADR Rules whereby the Panel may transfer a domain name to another legal entity, even if that entity satisfies the eligibility criteria and is a subsidiary of the complainant. The domain name must therefore be 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 OANDA be revoked.

## PANELISTS

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| Name | **Andrew D S Lothian** |

DATE OF PANEL DECISION 2010-08-06

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant in this case claimed rights by way of an international registered trade mark designating inter alia the European Union for a word mark that was identical to the Domain Name (excluding the .eu top level domain). The Complainant asserted that the Respondent had no rights or legitimate interests in the Domain Name.

The Respondent had failed to reply to the Complainant's correspondence and did not file any Response in the present proceedings. However, the Respondent, in a non-standard communication, acknowledged that the Complainant had produced 'excellent arguments' and offered to transfer the Domain Name on a without prejudice basis.

The Panel found that the Domain Name was identical to the Complainant's registered trade mark. The Panel also found that the record showed no indication of any rights or legitimate interest on the part of the Respondent in the Domain Name and that the Complainant had made out a prima facie case on this point. Furthermore, the Respondent's acknowledgement regarding the Complainant's arguments in the non-standard communication also pointed to its lack of rights or legitimate interest. Accordingly, and in the absence of any formal Response or other explanation from the Respondent, the Panel found that the Respondent did not have any rights or legitimate interest in the Domain Name.

The findings on rights and legitimate interest were sufficient for the Panel to order revocation of the Domain Name in terms of Article 21(1) of Commission Regulation (EC) No 874/2004. While the Complainant had sought a transfer of the Domain Name, it did not fulfil the general eligibility criteria of Article 4(2)(b) of Regulation (EC) No 733/2002 and the Panel therefore refused this request.