Decision for dispute CAC-UDRP-100313

Case number	CAC-UDRP-100313
Time of filing	2011-09-02 11:14:50
Domain names	leshark.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Grabal Alok (UK) Limited

Complainant representative

Organization	Shoosmiths

Respondent

Organization	Aldgate Warehouse (Wholesale) Limited

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceedings related to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered proprietor of the Le Shark Trade Marks which it acquired in 2005 together with the goodwill in the same. In particular, the Complainant relies on its registered UK national Trade Marks No.s: 2278751, 2258699, 2212056, 2302742, 1219092, 1250917, 2106573 and 2168092 and its Community Trade Marks (CTM) No.s E1356559, E2758704, E253989--(together the "Le Shark Trade Marks"). The Complainant uses the Le Shark Trade Marks to market and sell Le Shark branded clothing, accessories and other goods in class 25.

The Complainant also relies on its unregistered rights arising from the goodwill generated by the use of the name and marks in trade in the UK from 1984 to the present date.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant acquired the Le Shark Trade Marks and associated goodwill by an agreement dated 10 November 2005 with Le Shark Ltd (LSL)—the Sale Agreement.

The Respondent has the same shareholders, directors and registered address as LSL and is part of the same group. Neither LSL (nor any other group company) retained any right to use the Le Shark Trade Marks.

In or about December 2010, the Complainant became aware that the Respondent was affixing the Le Shark Trade Marks to clothing and offering them for sale. On 3 December 2010, the Complainant wrote to the Respondent and demanded it immediately cease all use of the Le Shark Trade Marks and unregistered rights. The Complainant also gave a Takedown Notice to the host of the site to which the Disputed Domain Name resolved and the site was Taken Down in December 2010.

The Disputed Domain Name has remained inactive since December 2010. However, the Registrant refused demands to transfer the Disputed Domain Name to the Complainant.

The Disputed Domain Name is identical to the Le Shark Trade Marks. The Respondent has no legitimate rights or interests in the Disputed Domain Name and further no legitimate use could be made of the Disputed Domain Name by the LSL group members since 2005 when LSL assigned the Le Shark Trade Marks to the Complainant.

The (now) inactive website at the Disputed Domain Name may cause consumers to question the legitimacy of the Complainant's business. The Disputed Domain Name suggests a commercial connection with or authorization by the Complainant. Further, the Respondent is now in liquidation. The Complainant therefore fears the Disputed Domain Name may be on-sold and it is very unlikely it could be registered and used in good faith by any third party given the Complainant’s rights. Goods or services sold under the Disputed Domain Name may be confused with the goods and services of the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Panel notes that the Respondent made a non-standard communication by an email of 15 September 2011. In that email the Respondent advised that the website/content has been removed and the Respondent is now only using the email connected to the Disputed Domain Name.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that the Respondent received notice of the Complaint by means of emails from the Case Administrator to abdellah@aldgatewarehouse.com and postmaster@leshark.com, the delivery of which is confirmed by the Respondent’s non-standard response referred to above.

The following requests for further information were made by the Panel as non standard communications.

1. The Panel requested historical WHOIS data from both parties in a non standard communication of 10 October 2011. None was provided.
2. The Panel also requested information from the Registrar and on 10 October 2011, the Registrar confirmed that the

Disputed Domain Name was transferred to it in 2007 and renewed annually in March with the last renewal on 21 March 2011.

Accordingly, the Panel is satisfied that all procedural requirements under UDRP have been met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

While many of the Le Shark Trade Marks above marks are logo or figurative marks, UK mark No. 2302742 and CTM E2734788 are word marks for LE SHARK. I am therefore satisfied that the Disputed Domain Name is identical to these marks.

The key issue in this dispute is bad faith. This requirement is derived from Paragraph 4(a)(iii) of the Policy:

“You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that: . . . (iii) your domain name has been registered AND is being used in bad faith. (emphasis added)”

Traditionally this was interpreted as requiring a conjunctive approach –so that bad faith was required at the two distinct points in time. There was authority that inferences could be drawn as to one of the periods —see e.g.Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. However more recently, some authorities have adopted a “unified“ analysis so that bad faith registration could be established “retroactively” by subsequent bad faith use. See City Views Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE, WIPO Case No. D2009-0643 and Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions, WIPO Case No. D2009-0786. These authorities and developments were discussed in Eastman Sporto Group LLC v. Jim and Kenny, WIPO Case No. D2009-1688. I refer to the excellent and able analysis in that decision. I cannot improve on it. Suffice to say that in that case, a different approach was taken –and I will adopt it here.

In Eastman Sporto Group LLC v. Jim and Kenny, WIPO Case No. D2009-1688 the Panel considered that the undertaking at Paragraph 2 of the UDRP (incorporated by reference into the registration contract) could be interpreted as a representation as at a series of successive discrete dates;-

“By applying to register a domain name, or by asking [a registrar] to maintain or renew a domain name registration you hereby represent and warrant to us that . . . (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.”

On this basis that Panel found a renewal of a domain name may be equivalent to a new registration in appropriate circumstances. That case concerned a change of use. While I have some reservations about the potential for such an approach to negatively impact the delicate balance the UDRP strikes between the ‘first come first served’ domain name system and the genuine interests of rights owners and consumer protection—I agree with the principle (cited in Eastman Sporto) discussed in PAA Laboratories GmbH v. Printing Arts America, WIPO Case No. D2004-0338 (“the benefit of an original good faith registration should not be perpetual to the point where it can cloak successors in title and successors in ‘possession' long after the original registration would have expired”).

I also note the cases where transfers of ownership among related entities have been found to be new or fresh registrations, see ehotel AG v. Network Technologies Polska Jasinski Lutoborski Sp.J., WIPO Case No. D2009-0785.

Bad Faith Registration

The WHOIS data shows the Disputed Domain Name was registered in March 1997. We do not know the identity of the Registrant in 2005 or previously nor whether it was transferred between 2005 and 2007 and this would have been helpful. This information was requested from the parties but was not forthcoming. The Complainant’s case as to the sale and

transfer of the Le Shark Trade Marks and goodwill in 2005 and covenants given at that time was not disputed and so I accept those facts as proved although I note that the Sale Agreement was not submitted. I find each renewal by the Respondent of the registration of the Disputed Domain Name after 2005 in bad faith in breach of the undertaking in Paragraph 2 of the UDRP.

Bad Faith Use

The Respondent has admitted its current use of the Disputed Domain Name for email and I find this is use in bad faith and a conscious and deliberate attempt to confuse. This certainly crosses the line delineating generally acceptable honest commercial behaviour.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **LESHARK.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2011-10-20

Publish the Decision