Decision for dispute CAC-UDRP-100417

Case number	CAC-UDRP-100417
Time of filing	2012-03-07 09:49:42
Domain names	мтел.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Mobiltel EAD

Respondent

Organization	"-" (a hyphen)

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other or any relevant legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant says it is the owner of the following registered trade marks.

1. National Trade Marks, registered in the Republic of Bulgaria:

№ 44709 - Mtel (combined), filing date 04.07.2002, date of registration: 08.05.2003;
№ 44708 - Mtel (combined), filing date 04.07.2002, date of registration: 08.05.2003;
№ 57044 - Mtel (combined), filing date 17.12.2004, date of registration 15.12.2006; and
№ 57045 - Мтел (combined), filing date 17.12.2004, date of registration 15.12.2006.

2. Community Trade Marks ("CTM"), registered in Office for the Harmonization in the Internal Market ("OHIM"):

№ 006502751 - M-TEL, filing date 11.12.2007, date of registration 21.02.2009;
№ 006500797 – Mtel, filing date 10.12.2007, date of registration 14.02.2009;
№ 006500482 - M-TEL, filing date 10.12.2007, date of registration 14.02.2009; and
№ 006500938 - M-ТЕЛ, filing date 10.12.2007, date of registration 14.02.2009.

3. International Trade Marks, registered with the World Intellectual Property Organization (WIPO):

№ 955870 – Mtel, date of the registration 03.03.2008.

(together "The Marks").

The Marks are well known marks in the Republic of Bulgaria.

The Complainant also claims rights arising from its use of the Marks in trade since 1995. The Complainant also relies on its use of its own domain name, mtel.bg.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT:

The Complainant is the original telecommunication operator in Bulgaria providing electronic communication services under the Commission for Regulation of the Communications: Permission Nos. 01392/08.04.2009, 01393/08.04.2009, 01395/08.04.2009 and 01357/05.02.2009. It was also the first company in Bulgaria with a license to provide telecommunication services through a GSM network.

The Complainant's Financial Reports for 2009 and 2010 value the Marks at BGN 514 383 000.

The Complainant's domain name is mtel.bg.

The domain мтел.com ("the Disputed Domain Name"), was registered by the Respondent ("-" with administrative contact Ivan Yurukov) on 16 December 2009 and since 01.11.2011, has been hosted by Godaddy.com LLC where it benefits from a privacy shield for WHOIS information.

On 17.10.2011, the Respondent, through its administrative contact, Mr. Ivan Yurukov, sent an e-mail to the Chief Executive Officer of the Complainant, Mr. Andreas Maierhofer, in which the Respondent threatens the Complainant unless it acquires the Disputed Domain Name.

The Disputed Domain Name resolves to a web site used for collecting complaints about the Complainant. It describes itself as a: “Forum where you can share opinions and impressions” and includes several open threads (only the administrator can open a thread) about issues related to the Complainant`s services, e.g. "Why there is a problem with the invoices?" and "How you were deceived in a store and you received something you did not want" and "Here you can share all the conditions of the Mentel which mislead the user".

On the web site, the Complainant is called "Mentel", which mimics the pronunciation of the Marks, but also suggests the Bulgarian phrase for deception.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

A. COMPLAINANT:

A.1 Rights

The Complainant says the Disputed Domain Name is identical to the mark Мтел in the Cyrillic alphabet and similar to the mark Mtel in the Romain alphabet and is also phonetically similar.

The Complainant says the suffix .com must be ignored and cites CAC Decision No. 100191 and UDRP case Am. Int'l Group, Inc. v. Domain Admin Ltd, FA 1106369 NAF 13/31/07 and Isleworth Land Co. v Lost in Space, SA, FA 117330 NAF 27/9/02.

A.2 Legitimate rights and interests

The Complainant says there are no grounds for legitimate rights and interests in the Disputed Domain Name under the UDRP at 4(c) (i)-(iii).

A.3 Bad Faith

The Respondent registered the Disputed Domain Name in bad faith in order to sell it to the Complainant as demonstrated by the email of 17 October 2011.

The Respondent's bad faith is evident from the injury it causes to the reputation and business of the Complainant by the unfounded accusations and criticisms of the Complainant and its services.

The Respondent's bad faith is evident from the perception that the Disputed Domain Name creates that the site is an official site of the Complainant and the Respondent misleads consumers who believe they are communicating complaints to the Complainant. There are many official channels for raising complaints with the Complainant.

The Complainant also relies on the earlier decision in its favor in the CAC dealing with a .eu domain in Decision No. 05973.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical and/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 all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant's burden includes at least a prima facie showing as to lack of legitimate rights or interests even where a Respondent has not come forward.

The UDRP is derived from norms in the law of registered trade marks and it is important to occasionally test it against trade mark law as it operates in the real world. Trade mark law protects consumers from confusing the goods or services of one trader from those of another and prevents unfair competition between traders. The UDRP mirrors the law and protects as fair use-- sites operated solely in tribute or in criticism-- to ensure the right to use domain names in exercise of the right of Free Speech or Expression.

This fair use factor in the UDRP borrows scope limitations from trade mark law --which reaches only use “in trade,” “use in commerce,” “commercial use “ or use “in a trade mark sense.” This excludes use of a mark or name in a nominative (noun or name) sense—that is, to call someone by their name and make a comment about them.

For example, if a newspaper names the subject of an article (who just happens to have registered their name as a trade

mark) the paper is not thereby using the trade mark. This is a purely nominative use. This distinction is drawn also by distinguishing between use in editorial content and use in advertising. The former is not use caught by trade mark law, whereas the later might be. So trade mark law has traditionally carved non trade mark use/editorial use out of its scope. I note that the presence of commercial ads or sponsored links on a website does not change editorial content to advertising. Were it otherwise, editorial content in magazines and newspapers would fall into scope merely because the edition also carried some advertisements elsewhere. That is not how it works.

The Respondent's use is closer to the editorial analogy than the advertising one. It is nominative. The Respondent is not using the Marks –in so far as it is merely naming the Complainant and complaining about it and its services. Trade mark law never has and never should reach this conduct--as it is no function of trade mark law to stifle debate or comment.

On a rights based analysis, the Respondent's conduct is an exercise of its (and its visitors') Freedom of Expression. In the EU, that right may be qualified by states only as prescribed by law and only as necessary in a democratic society to protect the public interest or individual rights (including intellectual property and reputation) provided the qualification is proportionate. Freedom of Expression includes the right to offend and criticize. In the EU large companies must accept close scrutiny and criticism ---subject only to defamation or other speech laws (and EU law protects as compatible with Freedom of Expression, only defamation laws that require defendants to prove the truth of factual statements --and not value judgments (opinion or comment) --which cannot be proved).

The UDRP does not provide jurisdiction for dealing with injury to reputation from fact or comment or determining allegations of defamation and is concerned only with registrations in bad faith. Issues as to the injury to the Complainant's reputation are for the domestic defamation law of Bulgaria and the domestic courts of Bulgaria.

I do not accept the Complainant's contention that the public will believe that the website at the Disputed Domain Name is authorized or approved. This was the basis of the earlier .eu decision (CAC No. 05973 of 31.03.11) relied upon. Although working from translations provided to me by the Complainant of two pages only from that site, it appears to me consumers would immediately realize the site is a criticism site –not least from the play on the name of the Complainant by the use of the term "mentel."

I would find the Respondent's use is legitimate fair use except that the Complainant also relies on an email threat and I find this puts an entirely different complexion on the facts and issues above.

We were not provided with a translation of the email, however that Google translate gives the following translation:

"The attention of Mr. Andreas Maierhofer. Mtel.com own domain. Currently the site is installed on a standard index.
The domain name gives an advantage in making "seo" Optimization for Google to achieve a leading position in the search in Google and be directed traffic from visitors to the forum, which would make it one of the most popular forums.
Information on "google adwords" shows that monthly searches "Mtel" amounted to about one million. An example of such a forum can see blizoo-forum.com, which includes the ability to share in "facebook". Additional information about domain names in Cyrillic http://help.superhosting.bg/faq/30_341_bg.html A sale of the domain and it suggest to you first.
To date the site has not been published anywhere. As soon yet making seo optimization and its publication in BG all directories and social networks as well as "facebook" groups. If the proposal is interesting to you, please send a message to admin@xn--e1amby.com."

Based on this, it appears the Disputed Domain Name was being offered first to the Complainant. I regard this as neutral as to the offer (no price is mentioned). However, the implied threat that the Disputed Domain Name would out rank the official site and the fact that the threat was made prepublication, and in order to avoid publication, casts an entirely different light on the actions and intentions of the Respondent and I find bad faith is made out on the basis of this threat and that it negates any legitimate rights or interests. It appears the Disputed Domain Name and the website were created in order to ground this threat and not for any other purpose.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **мтел.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2012-04-18

Publish the Decision