Decision for dispute CAC-UDRP-100610

Case number	CAC-UDRP-100610
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Domain names	smorava.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	S MORAVA Leasing, a.s.

Complainant representative

Organization	Feichtinger Žídek advokáti s.r.o.

Respondent

Name	Radek Procházka

OTHER LEGAL PROCEEDINGS

The Complainant refers in its Complaint to proceedings brought in the Czech courts for a preliminary injunction in relation to the use of the disputed domain name (the ”Domain Name”) "until a final decision by this tribunal". No further details are provided in this respect. As matter stand and pursuant to paragraph 18 of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), the Panel considers that there is no good reason why it should not proceed to issue a decision in the matter.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of Czech registered trade mark no 246376 with a registration date of 26 August 2002 for the word mark “S MORAVA” in class 36.

FACTUAL BACKGROUND

The Complainant is a leasing company based in the Czech Republic. It operates a website to promote its activities from the domain name <smorava.cz>. However, recently this has taken the form of redirecting internet users to a website operating from the domain name <ersteleasing.cz>.

The Domain Name was registered on 26 February 2013. It appears to be registered in the name of an individual who gives an address in Brno in the Czech Republic.

It is clear that the Respondent is involved in a dispute with the Complainant about its termination of a number of leasing contracts with “Delete s.r.o.”. “Delete s.r.o.” would appear to be a company at one time controlled by the Respondent but which is now the subject to insolvency proceedings.

The Domain Name has been used by the Respondent for a website both in Czech and German that is critical of the Complainant. The website contained various allegations against the Complainant, the flavour of which is apparent from the use of headings such as “Broken Promises and Immoral steps” and “Unjustified invoicing”. The Respondent also appears to have used the website to call upon other persons who might have complaints about the Complainant’s alleged conduct to “undertake a joint action against the Complainant”.

On 22 May 2013, the Complainant’s lawyers wrote to the Respondent contending that the Domain Name infringed the Complainant’s trade mark and the content of the website operating from the Domain Name was defamatory and unlawful. A similar letter was sent from the Complainant to the Respondent on 7 June 2013.

No website is operating from the Domain Name as at the date of this decision. Presumably this is due to the injunctive relief that the Complainant has sought in the Czech courts and is referred to under the heading “Other legal Proceedings” earlier on in this decision.

PARTIES CONTENTIONS

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COMPLAINANT

The Complainant contends that the Domain Name is identical to its trade mark. It also contends that given the way that the Domain Name has been used, the Respondent has no rights or legitimate interest in the Domain Name. The argument put forward appears to be that there can be no right or interest in a domain name that is being used in a webpage “to damage the goodwill of the Complainant and to gather as many other persons as possible, who are ready to join the actions of the Respondent against the Complainant”

So far as bad faith and registration is concerned, the Complainant repeats its allegations that the website shows that the Domain Name was registered to damage the Complainant’s goodwill. However, it also asserts that the use of the Domain Name infringes its trade mark. Further it also contends that the Respondent “had [the] Complainant’s trademark in mind when registering the Domain Name, which is therefore registered and is being used in bad faith.”
The Complaint also contains contentions as to the appropriate language of these proceedings. These are dealt with in greater detail in the “Procedural Factors” section of this decision.

RESPONDENT

The Respondent’s Response is short and, therefore, it is convenient simply to reproduce it is full. He asserts through his lawyers as follows:

“The Respondent is of the opinion that the Claimant’s Claim does not correspond to the current state of the facts; and the Respondent is further of the opinion that the current legal circumstances may be significant for deciding the case. On 1 September 2013, the Claimant changed its business name to Erste Leasing, a.s., according to the evidence in the Commercial Register. This means that the Claimant does not use the disputed domain for the conduct of its business, and the Respondent believes that whether or not the Claimant holds a corresponding trademark is fully irrelevant. Using a domain does not per se constitute trademark infringement, the more so that the smorava.com domain does not correspond to the trademark. The Respondent does not derive any profits from using the disputed domain and the domain is wholly unrelated to the Respondent’s business. The Respondent uses the Smorava.com domain for information purposes only, not for offering goods or services and certainly not for offering goods or services similar to, or confusable with, the goods or services offered by the Claimant. Referring to the Claimant’s registration in the Commercial Register (full entry), the Respondent also considers it worthy of note that the Claimant has ceased using the brand name “S Morava” in 2002. The

registration entry can be found at www.justice.cz."

RIGHTS

The Panel accepts that a sensible reading of the Domain Name is as the name and trade mark of the Complainant, combined with the ".com" tld.

The Panel notes that the Respondent claims that the "smorava.com domain does not correspond to the trademark". However that assertion is not really explained and makes little sense.

As to the Respondent's claim that the Complainant has stopped using the S MORAVA mark, even were that true, it would not mean that the Complainant has lost its trade mark rights in that term. Under European trade mark law, a trade mark can be liable to revocation in circumstances where it has not been used for 5 years. However, there is no suggestion that this is the case so far as S MORAVA mark is concerned.

In the circumstances the Complainant easily satisfies the requirement of paragraph 4(a)(i) of the Policy that the Domain Name be identical or confusingly similar to a trade mark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

Neither party puts forward a particularly compelling case so far as rights or legitimate interests is concerned. The Respondent does not really address this at all. Even if the Complainant has recently decided to rebrand its business, that does not give the Respondent any right in that term.

So far as the Complainant's contentions are concerned, they seem to amount to an assertion that the Respondent can have no rights or legitimate interests in a domain name used to criticise the Complainant, particularly if that criticism is defamatory. However, the Panel is not in a position to judge the truthfulness or otherwise of the Respondent's claims and even if it were, it is simply not the Panel's role to either determine such an issue.

That said, the fact that the Domain Name is being used for a criticism site does not mean that the Respondent has a legitimate interest in the Domain Name. The position is somewhat more complex. A convenient summary of the competing issues and arguments here are to be found at paragraph 2.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (the "WIPO Overview"). This describes two views of the issue as follows:

"View 1: The right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trademark. That is especially the case if the respondent is using the trademark alone as the domain name (i.e, <trademark.tld>) as that may be understood by Internet users as impersonating the trademark owner. Where the domain name comprises the protected trademark plus an additional, typically derogatory term (e.g., <trademarksucks.tld>), some panels have applied View 2 below."

and

"View 2: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and noncommercial."

It is perhaps fair to say that View 1 is the prevailing view so far as non-United States panelists are concerned and has also been adopted by many United States panellists particularly where one or both of the parties is not from the United States. Of the cases cited in support of View 1, one of these decisions was by this Panel (i.e. 1066 Housing Association Ltd. v. Mr. D. Morgan, WIPO Case No.D2007-1461). In that decision this Panel argued that there is no good justification for different views on this issue based on geography and in cases where a Domain Name comprises no more than the trade mark of the entity criticised together with ".com" (or some other tld), the respondent using the domain name for a criticism site should not be treated as having a right or legitimate interest in the domain name. The reason why no right or interest exists in such circumstances is not because the site contains speech that is critical of the trade mark owner. It is that by using the trade

mark alone in the domain name, the registrant is impersonating the trade mark owner to draw internet users to that site. There is no right or legitimate interest in impersonating another.

It is for this reason that the Panel concludes that the Respondent has no right or legitimate interest in this case. Accordingly, the Complainant has made out the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

Given the findings in relation to rights and legitimate interests and given that there seems to be no dispute that the Domain Name was registered by the Respondent for use in connection with a criticism site, it follows that the Domain Name has been both registered and used in bad faith. Again that bad faith arises out of the fact that the Domain Name has been registered and used so as to impersonate the Complainant with a view to drawing internet users to the site of the Respondent.

Accordingly, the Complainant has made out the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

This case has been procedurally complicated by the fact that although the parties are both Czech, and the Domain Name has been used for a Czech language website and the registration agreement for the Domain Name is Czech, the Complainant has nevertheless asked for the language of these proceedings to be English.

The question of the language of proceedings under the UDRP is governed by paragraph 11 of the Rules. This provides:

“(a) unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.”

Accordingly, as the language of the relevant registration Agreement the language of these proceedings are Czech subject to the Panel determining otherwise. A panel has a wide discretion in this respect but it cannot decide the matter in an arbitrary fashion. Any decision must be by reference to the “circumstances of the administrative proceeding” and a mere request by one of the parties is insufficient.

Here the Complainant has put forward various arguments as to why this case should proceed in English. The first is that “[t]he Respondent uses English which is evident from the email address provided to the registrar (support@carena.cz)”. The second is that DELETE s.r.o., is represented in the insolvency proceedings by a law firm that provides its services in English as well as Czech”.

The Panel is not convinced by these arguments. There is insufficient evidence before the Panel that the Respondent is familiar with the English language and it is not an inference that the Panel is prepared to draw from the use of a single English word in an email address. So far as the Respondent’s lawyers are concerned, the firm of lawyers being used in the insolvency proceedings appears to be different from the firm of lawyers being used by the Respondent in these proceedings. It is questionable whether even if the same firm of lawyers was being used this would be a good enough reason by itself to order a change in the language of the proceedings.

Ultimately in a series of Procedural Orders the Panel decided practically to deal with the matter as follows:

(a) To order the Complainant to file a translation of the Complaint into Czech;

(b) To provide the Respondent with a chance to file a further submission in response to the Complaint in English or Czech (it did so in Czech).

(c) To deem the language of the language of the proceedings to be English after the Respondent had filed an additional submission.

(d) To order the Complainant to translate the additional submission of the Respondent into English.

The Panel was assisted in this respect by the Czech Arbitration Court, which produced Czech translations of the procedural orders made.

In this way the Panel believes that the Respondent has been given a full opportunity to participate in these proceedings and has not been disadvantaged by the fact that initially the Complaint was filed in English. Even then the Panel has some concerns about the fact that this approach means that this decision is given in English and a question arises as to whether the Respondent will understand the reasons why it has lost the Domain Name in this case. However, the Panel understands that the Czech Arbitration Court will provide an automatic translation of this decision to the Respondent and a full translation of the Principle Reasons section of this decision.

PRINCIPAL REASONS FOR THE DECISION

This is a case where the Domain Name takes the form of a trade mark of the Complainant combined with the ".com" tld. It was registered and used by the Respondent for a criticism website. In deciding this case the Panel adopted View 1 in paragraph 2.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions. The registration and use of this type of domain name for a criticism site does not provide a registrant with a right or legitimate interest in the domain name. The reason is that in registering and using the Domain Name the Respondent was impersonating the trade mark owner with a view to drawing internet users to the Respondent's website. Such registration and use is also registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SMORAVA.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2013-10-16

Publish the Decision