Decision for dispute CAC-UDRP-100661

Case number	CAC-UDRP-100661
Time of filing	2013-09-13 10:13:20
Domain names	onefashionoutlet.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	One Fashion Outlet 1 s.r.o.

Complainant representative

Organization	Bukovinský & Chlipala, s.r.o.

Respondent

Organization	(Ivan Carnogursky) IPEC Management , s.r.o

Respondent representative

Organization	Čarnogurský ULC s.r.o.

OTHER LEGAL PROCEEDINGS

No legal proceedings exist.

FACTUAL BACKGROUND

The Complainant is a company that constructs an outlet city located in Voderady, which is known as One Fashion Outlet and is supposed to be opened on October 30, 2013.

The Respondent is a competitor constructing another outlet city located nearby Senec – this outlet city is known as D1 Outlet City.

The Complainant alleges that the Respondent has registered and is using the disputed domain name in bad faith trying to attract possible clients of the Complainant.

PARTIES' CONTENTIONS:

COMPLAINANT:
1. The domain name is identical to a trademark in which the Complainant has right;
2. The Respondent has no rights and no legitimate interests in respect of the domain name;
3. The domain name has been registered and is being used in bad faith.

Each of the abovementioned three elements is present in this case.

Ad 1.
The predecessor of the Complainant – company ONE Fashion Outlet s.r.o. is registered as the only registered owner of the national trademark one FASHION OUTLET. The trademark is registered in trademark registry kept by the Industrial Property Office of the Slovak Republic under the No.: OZ 235055.

The Complainant as the legal successor of the company ONE Fashion Outlet s.r.o. is the only holder of the rights to the trademark one FASHION OUTLET.

Moreover, under the business name of the Complainant the outlet city called One Fashion Outlet is in construction and this outlet city is planned to be opened for public on October 30, 2013.

Ad 2.
According to the search via www.nic.com the current owner of the domain name www.onefashionoutlet.com is Mr. Ivan Čarnogurský and organization IPEC Management, s.r.o., i.e. the Respondent. The Respondent has no other rights nor any legitimate interests in respect of the domain name onefashionoutlet.com, because:

a) The Respondent’s business name is completely different – IPEC – Management, s.r.o.,
b) The outlet city which is realized by Respondent is called D1 outlet (it is located nearby the D1 highway).

The only thing which the Complainant and the Respondent have in common is the same business project – construction of the outlet city.

Ad 3.
The Complainant points out that the registered domain name onefashionoutlet.com with direct redirection to the website www.d1outlet.sk is a clear violation of fundamental principles of law and morality .This action of the Respondent must be considered as usage of the domain name in bad faith, because:

a) The Respondent by using the domain name has intentionally attempted to attract, for commercial gain, Internet users to its web site, and

b) It is obvious that the Respondent by redirection to its website www.d1outlet.sk uses the domain name for the purpose of disrupting the business of the Complainant.

On July 07, 2013 it was published that the outlet city ONE Fashion Outlet will be opened as of October 30, 2013. As of the mentioned date it was expected that potential customers or business partners would like to gain more information about outlet city ONE Fashion Outlet. The Complainant has the overview of the approaches to the site www.onefashionoutlet.sk proving that the amount of potential customers or business partners has been increased after the press release and the similar amount of potential customers or business partners could be misled by using the site www.onefashionoutlet.com because this web site has been redirected to www.d1outlet.sk – as a web site of the competitive project of the Respondent.

The Complainant already sent to the Respondent the notice on the abandonment of unlawful conduct related to respective

domain name onefashionoutlet.com, which was delivered to the Respondent as of June 24, 2013. The Complainant was called to the immediate abandonment of the infringement of Complainant's right and to transfer the domain name to the Complainant. The Respondent did not respond to the notice at all. The Complainant also hereby declares that the copy of this motion was dispatched to the Respondent.

The Complainant as a developer of the outlet city called One Fashion Outlet and the legal successor of the owner of the trademark ONE FASHION OUTLET by this motion seeks the protection against the violation of its rights in order to preserve its business name, trademark rights as well as to gain the protection against unfair competition and other misconduct in connection with the usage domain www.onefashionoutlet.com.

RESPONDENT:

The Respondent strongly disagrees with the allegations made by the Complainant and asks the Complaint to be dismissed.

The main reasons are as follows:

Ad 1.
The domain name is identical to the trademark in which the Complainant has right.

Trademark of the Complainant was filed for registration on 27 September 2010. It was registered almost three years later on 03 April 2013 under No. OZ235055. The Respondent points out the uncommon length of the registration process of this trademark. Based on this fact, the Industrial Property Office of the Slovak republic must have examined the fulfilment of legal requirements for a long period of time (i.e. originality of the name).

It must be added, at the time of filing, the Respondent has already registered several domain names including onefashionoutlet.com. The registration of the disputed domain name was made on 08 July 2010.

At the time of the domain name registration, the Respondent itself was undecided on the final business name of its fashion outlet centre. Based on this fact, the Respondent registered several other domain names, which form the combination if its business plan and business project: D1, one, fashion, city, centre, outlet.

Based on prior use and registration of the disputed domain name by the Respondent, this fact is not disputable.

Ad 2.
The Respondent has no right and no legitimate interests in respect of the domain name.
Respondent finds the allegations of the Complainant about the infringement of rights regarding the domain name not true.

Disputed domain name contains elements of the Respondent´s business project and business name: D1 Outlet City, where fashion outlet production shall be sold. Further, the Respondent points out the number (1) in words: one, forms immanent part of Respondent´s business and company name. Similarity is given.

Disputed domain name words: one, fashion, outlet still form a valid and essential part of the business project and the business activity of the fashion outlet centre D1 Outlet City.

Thus, the right and the relation of the Respondent to the domain name is undisputable.

Ad. 3
The domain name has been registered and is being used in bad faith.

Based on the facts stated above, the disputed domain name could not have been registered in bad faith.

The Respondent at the time of registration was undecided on the final name of its business project. The combination of the words registered in the domain name reflects the business name and the activity of the Respondent.

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 not shown that the Respondent has 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 not 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

All procedure requirements for administrative proceeding under UDRP were met.

PRINCIPAL REASONS FOR THE DECISION

1. The main issues under UDRP are whether:
i. the domain name is identical or confusingly similar to a domain name or a trademark or service mark in which the Complainant has rights; and
ii. the Respondent has no rights or legitimate interests with respect to the domain name; and
iii. the domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant and the Respondent. The Panel also visited all available websites and public information concerning disputed domain name, namely the WHOIS database and related trademark register database.

3. The Uniform Domain Names Dispute Resolution Policy in its Article 4 defines what has to be understood as an evidence of the registration and use of the domain name in bad faith. Namely Article 4, letter b), para. iv) has to be considered in this case.

The Rules for Uniform Domain Name Dispute Resolution Policy clearly says in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a Complaint in accordance with the Policy describing according to para (ix), sub para (iii) why the domain name(s) should be considered as having been registered and being used in bad faith.

4. The panel therefore came to the following conclusions:

a) Both the Complainant and the Respondent are active in the same field of business and are using similar expressions, logos and domains for a long period of time.

Domain names to be identical or confusingly similar

b) It is proven that the domain name is confusingly similar to the domain name used by the Complainant. This fact itself cannot be a reason for the domain name to be transferred. It is also proven that the trademark of the Complainant is to some extent similar even though combined trademark has a very much distinctive character as to the other logos, signs and/or domain names.

Respondent (not) having rights or legitimate interest with respect to the disputed domain name

c) It was not proven that the Respondent has no right with respect to the disputed domain name. It is opposite and it was proven that the Respondent had priority and has registered the disputed domain name before the registration of any other intellectual property rights of the Claimant.

d) The priority is an elementary principle which has to be always reviewed when deciding on domain names rights. It is without any doubt that in this case the priority in registering disputed domain name is with the Respondent.

e) The person (in this case the Respondent), who is registering the domain name first cannot be prima facie held liable for misusing and therefore being in a bad faith as to the domain name because his registration of the domain name was inventive and the first one.

Domain names have been registered and are used in bad faith

f) It was proven that the Respondent has acquired the disputed domain name first.

g) The panel finds that there is no justification for contesting the validity of the domain name that has been peacefully registered and used from that time.

h) In consequence, this panel finds that the Complainant has failed to show that the Respondent does not have rights and/or legitimate interests in the disputed domain name.

i) There is also no indication of bad faith in the Respondent's conduct, as said above the domain name only be similar to trade name and/or trademark is not a reason for the domain name to be transferred.

j) There is also no indication that the Respondent intended to register the trademark just for its own benefit with the aim to harm the Complainant but it was rather proven that the Respondent has registered different similar logos to protect his own business.

k) From the IP law perspective it is clear that the similar confusing domain name was used by the Respondent for a long time.

l) The Arbitration Court has an authority to decide UDRP domain names dispute. The Arbitration Court is not in the position and has no jurisdiction to decide on competition, namely unfair competition between the competitors and is strictly bound by the rules concerning UDRP. If there is any doubt about fair competition between the parties than the dispute has to be brought to the appropriate courts which can decide on the competition issues between the parties.

m) The panellist has made his own research on internet. It is clear from this research that first couple of links is always to the Complainant and Complainant's business, it is therefore doubtful whether using the domain name of the Respondent is in bad faith.

n) It has to be concluded therefore that the Respondent has registered/acquired the disputed domain name primarily for the purpose of his own benefit and therefore the Respondent is not using the domain name in a bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ONEFASHIONOUTLET.COM**: Remaining with the Respondent

PANELLISTS

Name	**Vít Horáček**

DATE OF PANEL DECISION 2013-11-01

Publish the Decision