

Decision for dispute CAC-UDRP-100765

Case number	CAC-UDRP-100765
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Time of filing	2014-03-06 12:18:43
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Domain names	virtualexpo.com
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Case administrator

Name	Lada Válková (Case admin)
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Complainant

Organization	Virtualexpo
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Complainant representative

Organization	CHAIN AVOCATS
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Respondent

Organization	Kwangpyo Kim - Mediablue Inc
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Respondent representative

Organization	ESQwire.com, P.C.
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OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant relies upon a number of trade marks that incorporate or comprise the term VirtualExpo. They include:

(i) Community Trade Mark No 4783981 published on 19 June 2006 and registered on 20 November 2006 for the word mark VIRTUALEXPO in classes 35, 38 and 42; and

(ii) International; (Madrid) trade mark no 1173812 applied for on 28 May 2013 and designating China, Russia, in classes 35, 38, 41, 42, taking the form of a device mark combining the terms “Virtual” and “Expo” with a design representing the countries of the world

Each of these trade marks is registered in the name of one Benoît Thiercelin.

FACTUAL BACKGROUND

The Complainant is a French company with a registration date of 2 August 2000 and located in Marseille France. It organises "virtual exhibitions" and "virtual trade shows" and operates from a website using the domain name <virtual-expo.com>.

The Domain Name was first registered in May 1996. As at 23 April 2010 the Domain Name was registered in the name of CyberDeal Inc, a company with an address in New York.

In June 2010, M. Corentin Benoit Thiercelin commenced UDRP proceedings at WIPO against the then registrant of the Domain Name (see M. Corentin Benoit Thiercelin v. CyberDeal, Inc., WIPO Case No. D2010-0941). The lawyers for that individual in the WIPO proceedings were the same as those currently representing the Complainant in the current proceedings. In the WIPO proceedings Mr Thiercelin claimed to control the activities of the Complainant.

On 10 August 2010 the panellist in the WIPO proceedings, rejected the Complaint and made a finding of Reverse Domain Name Hijacking. The reason given for that finding was as follows:

"The Complainant knew that the Domain Name was registered nearly 10 years before the Complainant acquired his registered rights, no attempt was made to demonstrate the existence of any earlier rights nor was any attempt made to address the issue arising from the disparity in dates. It simply was not mentioned. Instead, a flagrantly insupportable claim was made as to the Respondent's bad faith intent at time of registration of the Domain Name and the Panel can only assume that it was hoped that the Panel would miss the point. "

The Domain Name was acquired by the current Respondent in September 2010. The Respondent would appear to be a company based in Korea managed by one "Kwang Po Kim".

Thereafter the Domain Name was registered behind a "privacy shield" operated by Whois Privacy Services Pty.

It would appear that at all material times the Domain Name has been used for a pay-per-click webpage. As at January 2014 the links displayed on that page (presumably when viewed from France) were as follows:

China Exhibition, Expo Trade Shows, International Exhibitions, Expo Booth, Free Domain Registration, Line Array, Power Plant, Coal Power, Enterprise Domiciliation, Societe Domiciliation

On 17 January 2014, the Complainant's lawyers sent a letter before action to Whois Privacy Services Pty demanding the lifting of the privacy shield and the transfer of the Domain Name to the Complainant. Whois Privacy Services Pty did not reply to that letter.

Further, it would appear that the Domain Name has been made available for sale by the Respondent. At some point prior to the commencement of these proceedings the Complainant offered to purchase the Domain Name for US\$ 8,000 but received a response stating that "the offer is too low to be presented to the seller".

The Complainant filed a complaint in these proceedings on 25 February 2014. In response to the CAC's registrar verification request, the registrar of the Domain Name revealed the underlying registrant of the Domain Name to be the Respondent.

A Response was filed on 10 April 2014.

On 16 April 2014 the Complainant sought to file a short supplemental submission to reply to the Response.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant refers to various trade marks said to be “owned by the Complainant”. However, no explanation is offered as to why these are instead in the name of Mr Thiercelin nor is any attempt made to explain the relationship between Mr Thiercelin and the Complainant.

The Complainant claims that it has “continued to expand all around the world” and to have “gained an important notoriety in France and abroad”. However, no evidence is offered to support that contention nor is there any disclosure of the level of its sales either in France or elsewhere.

The Complainant contends that the Domain Name is identical to the trade marks relied upon.

The Complainant further contends that the Respondent has no rights or legitimate interests in the Domain Name, asserting that none of the examples of rights or legitimate interests in paragraph 4(c) of the UDRP apply in this case. It further relies upon the fact that neither Whois Privacy Services Pty nor the Respondent responded to the Complainant’s letter before action.

So far as bad faith registration and use is concerned, the Complainant contends that the date of transfer of the Domain Name to the Respondent is the date of registration for the purposes of assessing bad faith. It claims that at that time the Respondent was “able” at that time “to know the Complainant’s trade[]mark and the infringement to intellectual property rights he was committing by registering this domain name”. So far as bad faith use is concerned, the Complainant relies upon the pay-per-click landing page displayed from the Domain Name, which is said to redirect internet users to competitors of the Complainant.

The Complainant also relies upon the fact that the Domain Name has been made available for sale, and contends that it is evident that the Domain Name was primarily registered for the purpose of selling, renting or otherwise transferring its registration to the Complainant or to a member of the public for valuable consideration in excess of any documented out of pocket costs directly related to the Domain Name.

For the reasons set out later in this decision it is not necessary to set out the Complainant’s contentions in its supplemental submission

RESPONDENT:

The Respondent refers to the previous proceeding at WIPO and accuses the Complainant of engaging in forum shopping.

The Response is lengthy and incorporates references to a very large number of UDRP cases. Nevertheless the Respondent’s position is relatively straight forward.

It contends that the Domain Name comprises two common English words; i.e. “Virtual” and “Expo” (which is said to be a shortened form of the word “Exposition”). It claims that it has used the Domain Name in accordance with that meaning. Evidence has also been filed in the form of a declaration signed by Mr Kwang Pyo Kim in which Mr Kim claims that the Domain Name, was purchased at auction because it was an “inherently valuable descriptive term”. He claims that at the time of purchase the Respondent had no knowledge of the Complainant’s marks.

Mr Kim also states that the Respondent also owns a number of Domain Names which contain the words “Virtual” (identifying 4 such domain names) or “Expo” (identifying 2 such domain names). This is claimed to be part of a portfolio of “hundreds of domain names” and that while the Respondent “develop[s] names [it] hosts them with a domain name parking service that displays pay-per-click advertising links on hosted domain names powered by its software”. That software is said to automatically generate the links “based upon the contextual meaning of the term and words contained in the domain name”.

So far as the Respondent’s legal arguments are concerned, it is not necessary to set them out in any detail, save to record the

fact that at one stage in the Response the Respondent claims that:

“Where the prior owner [i.e. Cyber] held the [D]omain [N]amed for 14 years, without interruption ... and sold it at public auction, it is a signal to the Respondent that there is no competing third-party trade[]mark claim”.

The Respondent also claims that there has been a four year delay in bringing these proceedings and that this is said to raise the inference that the Complainant did not believe the registration and use of the Domain Name to be improper.

RIGHTS

The failure of the Complainant to explain properly why it can rely upon trade marks that are not in the Complainant's name might be said to justify the Panel summarily dismissing the Complaint.

However, when both parties' submissions and the previous decision in *Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. D2010-0941 are considered in the round, it appears that Mr Thiercelin was the founder of the Complainant and that accordingly the marks relied upon are still in the name of a person who controls the activities of the Complainant today.

No explanation is given or evidence adduced to support these conclusions, although M.Thiercelin's email address is given in the Complaint as the point of contact for the Complainant. Accordingly, on this occasion the Panel will give the Complainant the benefit of the doubt that there is some form of licence arrangement between the Complainant and Mr Thiercelin as the formal trade mark owner, so that the Panel can decide the case on the more substantial issues involved.

The Panel therefore finds by inference that the Complainant has established rights in the trade marks relied on. However, parties and their advisers should remember that they must adduce evidence to support all of their contentions, that they must, in particular, prove all three of the elements specified in the Policy and that the Policy makes this clear.

So far as the Community Trade Mark No 4783981 is concerned, the only difference between the mark and the Domain Name is the “.com” TLD. In the circumstances, the Panel accepts that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights. Accordingly, the Complainant has made out the requirements of paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

It seems reasonably clear that the Respondent is a domain name trader. However, there is nothing per se illegitimate under the UDRP about trading in domain names. In general terms, such trade is only likely to fall foul of the UDRP where it involves some form of unfair taking of advantage of the trade mark rights of others.

In this case the Respondent claims that it has simply acquired a domain name that incorporates a generic or descriptive phrase which it is then using in a manner which does no more than take advantage of that generic or descriptive meaning.

The question of when and in what circumstances there may be a right or legitimate interest in the domain name comprising ordinary words or phrases, is one that is addressed in paragraph 2.2 of the WIPO Overview 2.0. This records the following to be a consensus view among WIPO panelists:

“If the complainant makes a prima facie case that the respondent has no rights or legitimate interests, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the UDRP, or any other basis for rights or legitimate interests, then the respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a dictionary word or phrase. Factors a panel tends to look for when assessing whether there may be rights or legitimate interests would include the status and fame of the trademark, whether the respondent has registered other domain names containing dictionary words or phrases, and whether the domain name is used in connection with a purpose relating to its generic or descriptive meaning (e.g., a respondent may well have a right to a domain name "apple" if it uses it for a genuine site for apples but not if the site is aimed at selling computers or MP3 players, for example, or an inappropriate other purpose). Panels have recognized that mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services), may not of itself confer rights or legitimate interests in the domain name. Normally, in

order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase)."

In this case the Respondent claims that it is genuinely using the Domain Name in connection with the relied upon generic or descriptive meaning by using the Domain Name for pay per click advertising associated with that generic or descriptive meaning; i.e. the display of links that relate to virtual exhibitions or expositions.

So far as pay-per-click (or "PPC") activity is concerned, paragraph 2.6 of the WIPO Overview 2.0 describes the consensus view as follows:

"Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" [see also paragraph 3.8 below] or from "legitimate non-commercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder. As an example of such permissible use, where domain names consisting of dictionary or common words or phrases support posted PPC links genuinely related to the generic meaning of the domain name at issue, this may be permissible and indeed consistent with recognized sources of rights or legitimate interests under the UDRP, provided there is no capitalization on trademark value (a result that PPC page operators can achieve by suppressing PPC advertising related to the trademark value of the word or phrase). By contrast, where such links are based on trademark value, UDRP panels have tended to consider such practices generally as unfair use resulting in misleading diversion."

Here the Panel accepts that the most natural reading of the Domain Name is as the English terms "virtual" and "expo" in combination. Therefore, in this case to satisfy the requirements of paragraph 4(a)(ii) of the UDRP, the Complainant must show on the balance of probabilities that the Domain Name is being used to take advantage of its trade marks rather than any descriptive meaning of the phrase "Virtual Expo".

Ultimately, the Panel is of the view that the Complainant has failed to make out a case in this regard. The phrase "Virtual Expo" appears to the Panel to be *prima facie* descriptive of the exercise of the provision of virtual expositions and exhibitions via the internet.

The Complainant appears to contend that the term is somehow distinctive of the Complainant, but there is no real evidence before the Panel to support that contention. It does not appear to the Panel to be a particularly unusual or striking combination of words.

There is, of course, the Complainant's marks themselves. Perhaps those marks themselves might be considered evidence of distinctiveness of the term. Nevertheless it is noticeable that although the Complainant's device mark appears to cover virtual expositions and exhibitions, the word mark on its face does not. In short, the mere fact that the Complainant has obtained trade marks that incorporate or comprise the term "Virtual Expo", is insufficient to persuade the Panel that the use of the term "Virtual Expo" alone in respect of virtual expositions and exhibitions would involve the taking advantage of any trade mark meaning of that term.

This is not to say that there are aspects of the facts of this case and the Respondent's claims that a majority of the Panel do not find curious. Amongst these is the fact that the Domain Name was purchased only very shortly after the publication of the decision in *Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. D2010-0941 in relation to the Domain Name. The Respondent claims that it should be able to rely upon "signals" arising from the fact that the Domain Name had been held without interruption for 14 years. However, in order to notice any such "signal" the Respondent would have had to engage in some investigation as to the history of the Domain Name. But if some investigation into the history of the Domain Name were undertaken, it is hard to believe that the Respondent would not also have become aware of the then recent decision concerning that Domain Name and consequentially the Complainant's marks.

However, even if the Respondent had knowledge of the Complainant's marks, the Panel is unconvinced that the Respondent's

use of the Domain Name for PPC advertising that appears to do no more than use the term “Virtual Expo” descriptively, would take unfair advantage of those marks.

In the circumstances, the Complainant has failed to make out the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

Given the Panel's finding on the issue of rights and legitimate interests, it is unnecessary to consider the issue of bad faith registration or use.

PROCEDURAL FACTORS

On 16 April 2014 the Complainant sought to file a short supplemental submission to reply to the Response. The substance of that supplemental submission was directed to the issues of (a) would could and could not be inferred from the fact that there had been previous proceedings in relation to the Domain Name before WIPO and (b) the alleged generic nature of the term “VirtualExpo”.

Paragraph 4.2 of the WIPO Overview 2.0 comments on the question of whether panels will accept supplemental filings as follows:

“Panels have discretion whether to accept an unsolicited supplemental filing from either party, bearing in mind the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case. The party submitting its filing would normally need to show its relevance to the case and why it was unable to provide that information in the complaint or response. Most panels that have allowed unsolicited filings have also tended to require some showing of ‘exceptional’ circumstances.”

In this particular case, in the opinion of the Panel the Complainant has failed to show any exceptional circumstances that would justify the consideration of further submission by the Complainant in this case. The Complainant was obviously aware of those proceedings as they were brought on its behalf by Mr Thiercelin. Not only could the Complainant have brought this to the attention of the Panel in the Complaint, but this would have been an obvious thing to do. So far as the alleged generic nature of the term “VirtualExpo” is concerned, this is an allegation that any competent domain name lawyer could and should have anticipated.

In the circumstances, the Panel have not admitted the Complainant's supplemental submission document into these proceedings.

PRINCIPAL REASONS FOR THE DECISION

The Domain Name in this case was most sensibly read as the words “Virtual” and “Expo” in combination. The Respondent was using the Domain Name in connection with pay-per-click advertising that displayed links that appeared to be consistent with the descriptive meaning of the phrase “Virtual Expo”. Further the Complainant failed to bring forward any evidence to the effect that the term “Virtual Expo”, although used for its business, was anything other than descriptive of the activity of providing virtual expositions or exhibitions on the internet. In the circumstances, the Complainant had failed to show that the Respondent did not have a right or legitimate interest in the Domain Name. Accordingly the Complaint was rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	Matthew Harris, The Hon. Neil Brown, QC, Flip Petillion
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DATE OF PANEL DECISION 2014-05-27

Publish the Decision
