Decision for dispute CAC-UDRP-101088

Case number	CAC-UDRP-101088
Time of filing	2015-10-20 12:39:24
Domain names	femco.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Femco Holding B.V.

Complainant representative

Name	Bart Van Besien

Respondent

Name	Gregory Ricks

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is holder of
- Benelux trademark FEMCO with registration number 0538851 of July 1, 1994 for goods in classes 6, 7 and 8, including metal bolts, nuts, plugs and pipes;
- US trademark FEMCO with serial number 75548068 of June 27, 2000 for bolts, nuts and plugs of metal; metal pipes in class 6;
- Canadian trademark FEMCO with registration number TMA780540 of October 25, 2010 for goods in classes 6 and 7, including metal bolts, nuts, plugs and pipes; and
- International trademark FEMCO with registration number 1066797 of 22 December 2010 for goods in classes 6, 7 and 8, metal bolts, nuts, plugs and pipes, designating Australia, the People's republic of China, Switzerland, the European Community, Japan and Norway.

FACTUAL BACKGROUND

The Complainant is a Dutch company, founded in 1983, which owns and uses the FEMCO trademarks identified above.

The Respondent registered the disputed domain name <femco.com> (the "Domain Name") on March 11, 1996. The Domain Name reverts to a parked domain, containing pay-per-click advertisements.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Domain Name is identical (or at least confusingly similar) to the Complainant's trademarks FEMCO as identified above.

2. The Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent has not acquired trademark rights in connection with the Domain Name. The Respondent is not commonly known by the Domain Name. The Complainant did not authorize the registration or use of the Domain Name. There is no connection between the Respondent and the Complainant. The Respondent is not making a legitimate non-commercial or fair use of the Domain Name. There is no active use of the Domain Name, which is a parking page containing pay-per-click advertisements, benefiting the Respondent, while some of the links are redirecting to sites that are or may be offering products competing with those of the Complainant.

3. The Domain Name was registered and is being used in bad faith. There is a combination of factors that prove the Respondent’s bad faith, such as that the Domain Name is offered for sale on a public auction site without any indication of a prior legitimate interest in the Domain Name; the Domain Name is a parking site containing only sponsored links to other sites; Respondent blocks the Complainant from using the Domain Name corresponding to its trademarks and engages in a pattern of such bulk registrations; Respondent does not use the Domain Name actively; Respondent creates a likelihood of confusion with the Complainant’s trademarks and deliberately trades off the goodwill of the Complainant; Respondent attempts to conceal its identity; Respondent provided false contact information; there is lack of any evidence of good faith use; Respondent is a domain name grabber.

4. The Complaint was originally filed against Whois Privacy Corp. of Nassau, Bahamas. The Registrar, however, reported the Respondent being the actual name of the Domain Name’s registrant. Consequently, the Center asked the Complainant to correct the Complaint by including the Respondent as respondent in this matter. The Complainant did file a letter as Nonstandard Communication, claiming that Whois Privacy Corp. was the registrant at the time the Complaint was filed and that it is only after being notified of the Complaint that the Registrar disclosed another owner of the Domain Name. The Complainant notified the Center that it prefers not to change the Respondent’s name in the Complaint as the Complainant filed the Complaint against the Respondent as identified in the WHOIS records and thus met with its obligations under Paragraph 3(b)(v) of the Rules. The Complainant stressed that the proxy service was used by the Respondent with the sole purpose of masking the real owner and identity of the Domain Name holder. Proxy service providers register a domain name on behalf of the registrant and then license the use of the domain name to the registrant. The contact information in the WHOIS directory for domain names registered through proxy services is that of the proxy service provider. Neither the UDRP nor the UDRP Rules deal with the recent phenomenon of privacy proxy services. These Rules do not provide guidance on how to deal with the issues caused by such services.

RESPONDENT:
1. The Respondent alleged that he registered the Domain Name almost twenty years ago because of the generic nature of the domain name, "fem" being an acronym or short for female and "co" being short for company, and the short length.

2. The Respondent only received one correspondence from the Complainant, besides related to this dispute, on June 22, 2011, which was over 15 years after the Respondent registered the Domain Name. The Respondent argues that the Complaint should be rejected because of latches.

3. The Respondent further asserts that had he searched the US trademark database when he registered the Domain Name on March 11, 1996, he would not have found any trademarks listed for the Complainant, and therefore could not have

registered the Domain Name in bad faith. The Complainant does not have a monopoly on the term "femco". There are numerous companies named Femco, the oldest dating back to 1958 and in the same type of business as the Complainant.

4. The Respondent believes that the Complainant tries to pin him on every adverse UDRP decision against Whois Privacy Corp., while they have hundreds if not thousands of customers that use their services. This is akin to all lawsuits against John Doe are against only one person. The Respondent has used Whois Privacy Corp. since his life was threatened on two occasions because of domain names he owned, and didn't want his home address showing up in WHOIS information.

5. Offering a domain name for sale is not indicative of bad faith usage. The Respondent alleges to have been a domain name investor for twenty years and he has accumulated a few thousand domain names. He determined it would take him a couple of thousand years to develop all these domain names. He is therefore aggressively selling his domain name assets because he would rather not burden his heirs with this task and I would rather they not have to deal with people like the Complainant.

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 that 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

1. The Complainant argued that it should not have submitted an amended Complaint because the WHOIS registered indicated a privacy services as registrant and not the Respondent, who was only identified after the Complaint was filed. The Panel agrees that the Complainant complied with the requirements of the Rules, especially the requirement of Paragraph 3(b)(v) of the URDP Rules, which provides that Complainant should "[P]rovide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint (..)", when it identified Whois Privacy Corp. as the Respondent (e.g. Vanguard Trademark Holdings USA LLC and Enterprise Holdings, Inc. v. WanZhongMedia c/o Wan Zhong, CAC 100221 and paragraph 49 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")). Therefore, the Panel is of the opinion that no amended Complaint is necessary. The initial Complaint has been regularly filed. From a procedural point of view, the change of the name of the Respondent after the notification of the Complaint shall be disregarded. This does, however, not mean that the Response shall be disregarded as it has been file by the actual Domain Name holder.

2. The Respondent claimed that the Complaint should be barred by the doctrine of laches because Complainant waited nearly 20 years to initiate this proceeding. Although some panels have accepted the doctrine of laches, the majority of the panels is of the opinion that the doctrine of laches does not generally apply in UDRP proceedings and should not result in the Complaint being inadmissible (paragraph 4.10 WIPO Overview 2.0). The Panel in these proceedings sees no reason to bar the Complaint by the doctrine of laches as such, although the Panel appreciates that the considerable delay to file the Complaint makes the Respondent's intentions at the moment of registration of the Domain Name, for which the burden of proof is for the Complainant's, more difficult.

3. It is well established that the generic Top-Level Domains (“gTLDs”) may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy (e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). While accordingly ignoring the gTLD “.com”, the Panel finds that the Domain Name is identical to the Complainant's trademark FEMCO. Consequently, the first element of paragraph 4(a) of the UDRP is met.

4. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the Domain Name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the Domain Name, nor is commonly known under the Domain Name. The Respondent did not challenge such prima facie evidence. Consequently, the Panel finds that the Complainant has also satisfied the requirements of paragraph 4(a)(ii) of the UDRP.

5. Pursuant to paragraph 4(b)(iv) of the UDRP, there is evidence of registration and use of the Domain Name in bad faith where the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the FEMCO trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service offered on the Respondent’s website or location.

The Respondent admitted that at the time he registered the Domain Name there were different companies with the name, and possibly (unregistered) trademark FEMCO, although he claims that he wouldn’t have found the Complainant when he would have searched the US trademark register. The Respondent further argued that he registered the Domain Name as an acronym of “FEMale” and “COmpany”. The Panel considers that term “Femco” is neither a generic term nor known acronym and that Respondent has not provided any evidence for his alleged reason to register the Domain Name, while he was aware of companies’ names which were comprised in the Domain Name, and he admittedly had not searched a trademark database. While the trademark FEMCO was not yet registered in the United States when the Respondent registered the Domain Name, it was a registered trademark in the Benelux, and the Respondent should have considered the possibility of a conflicting trademark being registered elsewhere, especially in absence of the Respondent having any rights or legitimate interests in the Domain Name. Consequently the Respondent should have considered the Complainant’s prior right for which reason the Panel considers the registration of the Domain Name made in bad in faith.

The Panel is further satisfied that the Respondent used the Domain Name in bad faith, for the reason that the Respondent did not dispute the Complainant’s allegation that the website under the Domain Name is trading off the goodwill of the Complainant, by attracting internet users and diverting internet traffic intended for the Complainant to the Respondent’s website under the Domain Name for purposes of commercial gain, as some of the sponsored links are or may be offering products that compete with the products the Respondent is selling under the FEMCO trademarks.

Consequently, the third and last element of paragraph 4(a) of the Policy is also met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FEMCO.COM**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2015-12-21

Publish the Decision