Decision for dispute CAC-UDRP-101153

Case number	CAC-UDRP-101153
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Domain names	eameschairinspired.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vitra Collections AG

Complainant representative

Organization	Meyerlustenberger Lachenal

Respondent

Organization	WHOISPROTECTOR INC.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of numerous trademark registrations for EAMES which are protected for furniture in Class 20. ("the EAMES trademarks".) The trademark registrations have been established by registration certificates that have been adduced as evidence by the Complainant and which the Panel accepts. Those registrations include the following:

(a) International Registration No.510388 for EAMES.

(b) UK Trademark No.1460181 for EAMES..

(c) Swiss Trademark No.P-351455 for EAMES ("the Swiss EAMES) trademark".)

The most longstanding of the trademarks is the Swiss EAMES trademark registered on 16 February 1987.

It is clear that the EAMES trademarks have been inspired by the surnames of the two renowned designers Ray and Charles Eames and that accordingly they have become well known and famous trademarks.

FACTUAL BACKGROUND

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The Complainant was established in 1950 in Germany and is the manufacturer and retailer of the works of famous furniture designers including Ray and Charles Eames. The Complainant's website , www.vitra.com , displays the works of Ray and Charles Eames among others and it is clear from that website that it actively promotes their works and achievements, so much so that its Vitra Campus and Vitra Design Museum are situated at Charles-Eames-Str. 2 D-79576 Weil am Rhein and its VitraHaus is situated at Ray-Eames-Str. 1D-79576 Weil am Rhein. The Complainant is the owner of the exclusive rights for, inter alia, Europe on all furniture designed by the Eames brothers including many iconic pieces. The Complainant's website also reveals that the collection in its Vitra Design Museum is based on the estates of the Eames brothers, among other renowned designers.

The disputed domain name was registered by the Respondent on 15 May 2010. The domain name has resolved in the past to the Respondent's website. Respondent has referred to various dealings between the parties that led to changes being made to the contents of the site and to the fact that it has since then ceased to use the domain name. It does not presently appear to resolve to an active website. The Respondent also relies on the dealings between the parties to argue that it is unfair for the Complainant to change its position and that the proceeding should be terminated. As will be seen, the Panel's opinion is that the proceeding should continue in the usual manner.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant made the following contentions.

1. To summarize, the Complainant has sufficiently established its rights in the trademark EAMES. As the domain name eamesinspiredchair.com registered by the Respondent consists of the identical element EAMES, it has to be qualified as confusingly similar and, moreover, partially identical to Complainant's trademarks. The highly descriptive term “chair” for products in class 20 does not at all confer the required minimum degree of distinctiveness to the domain name, but increases the chance of incorrect attributions to Complainant’s products.

2. To the best of Complainant’s knowledge, the Respondent has not been commonly known by the domain name EAMES. To the contrary, the Complainant is very well known under the trademark EAMES. The trademark has become a well-known brand and, therefore, an asset that represents a most valuable goodwill exclusively owned by the Complainant.

3. The Respondent has no connection to the Complainant or its trademarks and therefore no interest in a domain name containing "EAMES". The Respondent is making no legitimate non-commercial or fair use of the domain name, but is rather misleading and diverting consumers by giving the impression to be connected to the Complainant, since both the Respondent and the Complainant are furniture retailers. Therefore, the Respondent is also tarnishing Complainant’s trademarks and good reputation.

4. The Respondent registered the disputed domain name on 15 May 2010, and therefore well after the priority dates of all of Complainant’s EAMES trademarks. The Respondent must have been aware of Complainant’s trademarks and the reputation associated with the trademark EAMES.

5. It is extremely unlikely that the Respondent has chosen the domain name eameschairinspired.com incidentally, as the domain name apparently refers to the chairs designed by Ray and Charles Eames.

In view of the fact that Complainant’s trademarks are registered for furniture and that Complainant is offering design furniture, Respondent's domain name eameschairinspired.com under which furniture (above all chairs) are offered for sale, is capable of creating a likelihood of confusion as to source, sponsorship, and affiliation with Complainant’s trademark EAMES.

6. As a result, the Respondent is commercially benefiting from the connection the consumer assumes between the disputed domain name eameschairinspired.com and Complainant's trademark EAMES and as such evidences bad faith registration and use. The Complainant offering sofas under the disputed domain name is taking advantage of the fame of the EAMES trademarks for high grade design furniture. The Respondent is therefore seeking commercial gain out of the disputed domain name registration by using Complainant’s good reputation.

RESPONDENT:

The Respondent made the following contentions.

1. The complaint appears to incorrectly identifying WHOISPROTECTOR INC as the Respondent and owner of the domain name eameschairinspired.com. In fact, the owner of the domain name is ICON INSPIRED LIMITED, a limited company incorporated in the United Kingdom.

2. According to the Respondent Domain name is neither identical nor confusingly similar to the protected mark for the Complainant’s failed to meet standard of proof.

3. The Respondent has rights and/or legitimate interest in the domain name(s)

Categories of issues involved:

Use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services

4. The Respondent acknowledges that claims have been made by the Complainant. However, the Respondent takes the view that the Complainant has no good grounds for objecting to the Respondent's descriptive use of the name EAMES in the Respondent's domain name and the Claimant's allegations are denied in their entirety.

5. The Respondent has legitimately held the domain name eameschairinspired.com since May 2010 and this domain name has been used since then to offer for sale items of replica furniture in the United Kingdom, which the Respondent is fully entitled to do under current UK law.

Alleged Infringement of registered trade marks:

6. With regards to the Complainant's various trade mark registrations, the Respondent takes the view that the Complainant has sought to obtain exclusive rights to the common generic names that are used to describe or refer to particular furniture designs or styles. The Respondent refers to Article 7(d) of Council Regulation (EC) No. 40/94, which prohibits the registration of trade marks “which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade”.

7. The name EAMES has been used for many decades by numerous manufacturers to describe particular furniture designs and styles. As such, these names have now become generic and the Complainant's trade mark registrations would appear to be liable to be declared invalid on the ground that they are contrary to Article 7(d) of the Regulation (EC) No. 40/94.

8. Moreover, under Article 12 of the same Regulation, a trade mark owner is not entitled to prevent the use of “indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service” (Article 12(d)).

9. Along with many other furniture manufacturers and suppliers, the Respondent uses these names to describe items of furniture. As such, the Respondent does not consider that any infringement of the Complainant's trade mark registrations has taken place.

10. In summary, the Respondent does not believe that the Complainant has any valid grounds for complaint, but is simply seeking to restrict legitimate competition and obtain an unjustified monopoly in the production of generic furniture designs.

11. In addition, the Respondent was involved in negotiations, as long ago as 2010, with the Complainant's UK lawyers (RPC). As a result of these negotiations, the Respondent made various changes to the website as a result of the letter it received from RPC and, after the Respondent had confirmed the changes to the website with them, (including the use of “inspired” and “reproductions” to qualify the reference to the “Eames” trade mark), they informed the Respondent that they were “grateful for the changes made to your Eames Inspired website as a result” of the previous correspondence. The clear implication of the correspondence was that the Complainant was happy with the changes that had been made to the website and no longer had any objections to the Respondent's continued use of the domain name or to the name "Eames" within the website. It is unfair for the Complainant to suddenly change its position more than three years later.

12. Nevertheless, in order to avoid a prolonged dispute, the Respondent has requested that the domain name eameschairinspired.com be deleted and has ceased using the domain name as of Tuesday 16th February 2016.

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). That is so for the following reasons.

It has been established by evidence accepted by the Panel that the Complainant has rights in a series of registered trademarks for EAMES set out in more detail above. It is not necessary for the Complainant to rely on one trademark alone, but it has in particular emphasised that the Swiss trademark is its oldest one in the EAMES family of domain names and that it was registered on 16 February 1987, many years prior to the registration of the disputed domain name. Accordingly, the Complainant has more than satisfied the requirement that it shows rights in a trademark or service mark whether the trademark relied on is the Swiss trademark or any of the other trademarks of which evidence has been provided.

It is clear that the disputed domain name is not identical to the Swiss EAMES trademark or indeed to any of the EAMES trademarks as the domain name includes several words other than the trademarks. The question therefore arises whether it is confusingly similar to the trademark. The test to be applied is whether an objective bystander making a comparison between the domain name and the trademark and disregarding all extraneous factors would conclude that the domain name would reasonably be taken as invoking or referring to the trademark. When that test is applied it is clear that the domain name brings the EAMES trademark to mind and would certainly be assumed to be referring to that trademark. That is so because the EAMES trademark is embodied in its entirety in the trademark without any change to the spelling of the mark, although it has added two other words, namely "chair" and "inspired". Moreover, the trademark is clearly a famous one because of the fame of the Eames brothers and their renowned achievements in the field of design and that as a consequence virtually any reference to Eames would be taken by the design community and the community as a whole as a reference to the famous Eames designs by Ray and Charles Eames. It must also be remembered that not only is the word " Eames" used in the domain name, but it is used in juxtaposition with the word "chair", thus clearly invoking the famous Eames chair designed by and intimately associated with the Eames brothers. Taken as a whole, the domain name means that the goods and/or services being brought to mind are inspired by the famous Eames chair which in turn is covered by the Complainant's trademarks for EAMES. Finally, the inclusion in the domain name of the word "inspired" indicates clearly that what the domain name is intended to invoke is a product or service, not peripheral to the Eames chair, but integral to it.

For reasons of completeness, the Panel adds that another principle universally applied by UDRP panels is that generic top level domains such as ".com" are disregarded when making the comparison at issue.

The Panel therefore finds that the disputed domain name is confusingly similar to the EAMES trademarks on which the Complainant relies.

The Complainant has thus made out the first of the three elements that it must establish.

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).

It is now well established that in determining whether the Respondent has rights or legitimate interests in a domain name, the onus is initially on the Complainant to make out a prima facie case that the Respondent has no such rights or interests and the onus then shifts to the Respondent to rebut that case if it can.See Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also AOL LLC v. Gerberg, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) ("Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.").

The Panel finds that Complainant has made out a prima facie case that arises from the following considerations:
(a) Respondent has chosen to take Complainant's EAMES mark and to use it in its domain name and has added the words "chair" and "inspired" which do not detract from the confusing similarity that is clearly present by using the trademark but suggests that the domain name is referring to goods or services that are integral to the chairs encompassed by the Complainant's EAMES trademarks;
(b) Respondent registered the disputed domain name on 15 May 2010 ;
(c) According to the Respondent itself, the domain name has been used to offer for sale items of replica furniture in the United Kingdom;
(d) Complainant submits that Respondent engaged in the aforementioned activities without the permission or authority of Complainant and has adduced evidence to that effect which the Panel accepts. The Panel therefore finds that Respondent registered and is responsible for the use that has been made of the domain name and that this occurred without the permission or authority of Complainant;
(e) Complainant also argues that Respondent is not commonly known by the domain name and the Respondent has not contested that position. Thus, the Panel finds that Respondent is not commonly known by the <eameschairinspired.com> domain name.

As the Complainant has made out a prima facie case, it remains to be seen if the Respondent has rebutted.

The Respondent relies on several grounds for contending that it can rebut the prima facie case. The first is that it attacks the Complainant's trademark. In doing so it relies on Article 7(d) of Council Regulation (EC) No. 40/94, which prohibits the registration of trade marks "which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade". Article 7(d) provides that certain marks shall not be registered including:

"1.:
...
(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade; ..."

Accordingly, the Respondent concludes that the Complainant's trademark "... would appear to be liable to be declared invalid."

The Panel does not accept that argument. It is as well established as any principle under the UDRP that a respondent may not take issue with the registration of a trademark. Panels traditionally and for good reason accept that if evidence is adduced that a trademark has been registered with a national authority the trademark should be accepted as valid. See Victoria's Secret Stores Brand Mgmt., Inc. v. Machuszek, FA 945052 (Nat. Arb. Forum May 7, 2007) (finding that

“Complainant has established rights in the VICTORIA’S SECRET mark through [multiple] registrations [with the USPTO] under Policy ¶ 4(a)(i).”) . Thus, even if there were any ground shown as to why the trademark should not have been registered, which has not been shown, the Panel would not proceed as if it were invalid and the more so when the highest the Respondent puts it is to say that the trademark "was liable to be declared invalid." But in any event the clause relied on has not been made out because it has not been shown that EAMES has "become customary in the current language or in the bona fide and established practices of the trade; ...". There is no evidence to that effect and it seems highly unlikely to be so. The Respondent is presumably arguing that EAMES has become generic or descriptive, but the Panel does not accept that there is any evidence at all to that effect and nothing to show that it is the case, other than the Respondent's assertion. The Respondent also submits that the reason why the Complainant's trademark is liable to be declared invalid is that "(t)he name EAMES has been used for many decades by numerous manufacturers to describe particular furniture designs and styles. As such, these names have now become generic..." Matters such as that just alleged are capable of being proven one way or the other by evidence, but no such evidence has been brought forward and it seems to the Panel highly unlikely that EAMES is now used in the broad a generic sense for which the Respondent contends.

The Respondent also submits that :

"Along with many other furniture manufacturers and suppliers, the Respondent uses these names to describe items of furniture. As such, the Respondent does not consider that any infringement of the Complainant's trade mark registrations has taken place."

Again, the Panel cannot see how this proposition, without evidence, can assist the Respondent, especially if by " these names" the Respondent means EAMES, for in that case the use of the name to describe furniture would appear to be a breach of the Complainant's trademark.

Finally on this issue the Respondent's summary of its argument takes it no further when it contends :

"In summary, the Respondent does not believe that the Complainant has any valid grounds for complaint, but is simply seeking to restrict legitimate competition and obtain an unjustified monopoly in the production of generic furniture designs." The Complainant is not seeking to impose any restraints on "the production of generic furniture designs" but on furniture that comes within the description of goods covered by its trademark, namely EAMES furniture. In that regard, it should be noted first that the Respondent concedes that the domain name, including as it does the word Eames, has been used "to offer for sale items of replica furniture" and that "replica" means " duplicate, facsimile" and "exact copy " (The Concise Oxford Dictionary).

None of these matters is a ground for recognising that the Respondent has any rights or legitimate interests in the disputed domain name.

The Panel therefore concludes that the Respondent has not rebutted the prima facie case against it.The Complainant has thus made out the second of the three elements that it must establish.

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).

The Complainant's case on bad faith is, first, that the Respondent must have had knowledge of the EAMES trademark when it registered the disputed domain name. The Panel accepts that argument as the EAMES trademark fairly qualifies to be described as famous and it is extremely unlikely that the Respondent did not know of such a well known mark or brand at the time it registered the domain name, especially as the Respondent is engaged in the manufacture of furniture itself and has used the domain name for the sale of furniture, the same field of activity covered by the trademark. In any event, the Respondent has not submitted that it did not know of the trademark at the time of registering the domain name. Actual knowledge of a trademark has frequently been accepted by UDRP panels as evidence of bad faith registration. See, for example, America Online, Inc.v. Avrasya Yayincilik Danismanlik Ltd. NAF Case No FA 93679 (16 Mar 2000) and the cases

cited in Lindsay, International Domain Name Law ICANN and the UDRP, Hart Publishing, 2007, pp376-383. It is appropriate to make that finding on the facts of the present case.

The Complainant also in effect relies on paragraph 4(b) of the Policy and the Panel finds that the case falls squarely within that provision. Clearly the Respondent has been using the domain name to attract internet users to its site for commercial gain by creating potential confusion as to whether its site promotes goods protected by the EAMES mark.

In addition it must be remembered that paragraph 4(b) of the Policy lists only examples and not an exclusive list of circumstances giving rise to bad faith. Consequently complainants may and frequently do, rely on conduct showing bad faith registration and use within the generally accepted meaning of that expression. In the present case, the Respondent has registered and used the domain name incorporating a famous mark that it must have known of and known that it had a specific meaning and has used it without permission to sell the same goods as are covered by the trademark and has done so as part of its business and to make money. In the opinion of the Panel that conduct shows bad faith registration and use of the domain name.

The Complainant has accordingly made out the third of the three elements that it must establish.

PROCEDURAL FACTORS

The Respondent submitted that the complaint appeared to incorrectly identify WHOISPROTECTOR INC as the Respondent and owner of the domain name eameschairinspired.com but that in the Respondent's submission the owner of the domain name is ICON INSPIRED LIMITED, a limited company incorporated in the United Kingdom. However, the Panel has proceeded on the assumption that the Respondent mentioned in the Complaint and the Registrar's verification is correct.

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 has established on the evidence that it has a trademark, that the disputed domain name is confusingly similar to the trademark, that the Respondent has no rights or legitimate interests in the disputed domain name and that the Respondent registered and has used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **EAMESCHAIRINSPIRED.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2016-03-28

Publish the Decision