# Decision for dispute CAC-UDRP-101348

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| Case number | CAC-UDRP-101348 |
| Time of filing | 2016-11-21 11:26:20 |
| Domain names | tsoukernik.com |

## Case administrator

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| Name | Aneta Jelenová (Case admin) |

## Complainant

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| Name | Leon Tsoukernik |

## Complainant representative

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| Organization | Havel, Holásek & Partners s.r.o., advokátní kancelář |

## Respondent

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| Organization | Intellectual Frontier Society |

OTHER LEGAL PROCEEDINGS

None.

IDENTIFICATION OF RIGHTS

Complainant asserts common law trademark rights to the surname “Tsoukernik” under which he is known for his services.

FACTUAL BACKGROUND

The Complainant is an entrepreneur and chairman of the Board of a casino and a group of companies based in Prague, Czech Republic. The Complainant is active in the business field of Gambling and Lotteries. His surname is Tsoukernik according to his Passport and permanent Residence Card. The Complainant is born 1973.

On September 13th, 2016 the Respondent registered the disputed domain name under the address of the US Company Domains By Proxy LLC. He uses the domain <tsoukernik.com> for noncommercial purposes and offers information about the Complainant. This information on <www.tsoukernik.com> damages the reputation of Mr. Tsoukernik, asserted the Complainant.

The Complainant, represented by Havel, Holásek & Partners s.r.o., advokátní kancelář, filed a complaint against the Respondent claiming that the Respondent registered the <tsoukernik.com> domain name without rights or legitimate interest and in bad faith. Therefore the registration should be declared abusive and the disputed domain name transferred to

the Complainant.

The Respondent provided the ADR court with a § 5 Rules Response claiming free speech but without supporting explanation or arguments in this regard.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:
Complainant principally makes the following assertions:

- The disputed name is the Complainant's personal name, his surname. Hence, "TSOUKERNIK" is a name for which the following right is recognised within the Czech legal system. The protection of personal names is granted under Act no. 89/2012 Civil Code whereas the surname of a natural person is protected by Article 10 of the Czech Carter of Fundamental Rights and Freedoms.

- The Respondent registered the disputed domain name without rights and legitimate interest in the name and established a website with offending content.

- The complaint is based on the fact that the disputed domain name is identical with the Personal Name of the Complainant which is in commercial use in Complainant's branch.

- The Complainant insists that the Respondent registered the domain name without rights and legitimate interest and in bad faith.

RESPONDENT:
The Respondent claims that he has a legitimate interest in using the contested domain name based on free speech. The Respondent, Mr. Simon Lee, representing the Intellectual Frontier Society, registered the disputed domain name.

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 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, 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).

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

It is necessary for the Complainant, if he is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

(i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
(ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to establish whether the Complainant has discharged the burden of proof in respect of the three elements referred to above.

With respect to Complainant's rights, the alleged registration of the Domain Name without rights or legitimate interest and bad faith, the Panel holds as follows:

A. Identical or Confusingly Similar

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). The panel verified the presented company data. The panel was convinced that the Complainant is a well-known person in this tiny business branch of the Czech Republic. The relevant public is here in the Gambling scene even smaller, hence the proof is easily done.

This case has similarities with CAC cases Nos. 100464 and 100498 referring to the fact that Personal Names are the relevant right to bear the claim.

The Complainant has not registered his surname "Tsoukernik" as mark with a government authority or agency, but trademark registration is not necessary to establish rights under the Policy paragraph 4(a)(i). Registration is not required as long as the Complainant can establish common law rights through proof of sufficient secondary meaning associated with the mark (see CAC case No. 100464 or SeekAmerica Networks Inc. v. Masood, WIPO Apr. 13, 2000, D2000-0131 (finding that the Policy does not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist).

In Monty and Pat Roberts, Inc. v. J. Bartell Case No. D2000-0300 the Panel found that factors such as the maintenance of a website in the name of the Complainant, the publication of a number of successful books and appearances on television and in film by the Complainant were sufficient to show the requisite use and recognition of the Complainant's name. Similarly, in the subsequent case of Steven Rattner v. BuyThisDomainName (John Pepin) Case No. D2000-0402 the Panel found that the Complainant's use of his personal name in connection with the provision of investment banking and corporate advisory services was sufficient to establish the creation of a common law right.

In this case the Complainant has demonstrated that he bears the name Tsoukernik and has a business and reputation in the gambling industry as a professional. The requested evidence concerning the Personal Name was submitted. The Complainant's Passport is an official document which fulfils the requirements upon common law rights.

The Panel finds that under the circumstances this is adequate to support a finding of common law rights or secondary meaning in his name for the purposes of the Policy and notes that the disputed substantive element of the domain name is identical to his name (see CAC case No. 100498).

The Complainant has, to the satisfaction of the Panel, shown that the Domain Name is identical to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

B. Rights or Legitimate Interest

The Complainant has, to the satisfaction of the Panel, shown 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).

The Respondent has no right to register the disputed domain because it is not his personel name or trademark. Free speech

is given in cases like NAF Decision vom 11.04.2014, Claim Number FA14030001547828. But the target groups will see the domain name across various sectors merely as an indication of origin and intended purpose. But there is no legitimate interest to pretend a different origin or ancestry.

Here, obviously, the Respondent registered the disputed domain name having the Personal Name of the Complainant in mind. If the Respondent's intention was to offend the Complainant and if this intention was covered by freedom of speech is according to the Policy beside the point. Therefore it is not necessary to prove the genuine truth of the assertions or false pretences.

In an earlier decision, Estée Lauder, Inc. v. Hanna, WIPO, September 25, 2000, Case No. D2000-0869, it was found that "the respondent may well, and likely does, have extensive rights of free speech to provide a platform to criticize Complainant …. The contents of Respondent's websites may also be a perfectly legitimate use of those rights. But […] Respondent's free expression rights do not here give it a right or legitimate interest in the domain names at issue."

So it is here. Respondent's free expression rights are not affected. These rights do not include the right to register a, from Respondents point of view, foreign domain name.

Therefore, the Panel holds that the Respondent registered the disputed domain name without rights or legitimate interest in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

C. Registered and used in 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).

This case has similarities with CAC cases No. 100464 and No. 100498. In both previous cases the panel decided to transfer the disputed domain to the Complainant.

Evidence regarding Respondent's bad faith is very strong too.

First, Respondent has knowingly registered and is using the identical Domain Name intentionally to offend and hurt the Complainant. Under this url users expect information from the Complainant, not about him (see WIPO Case Barcelona.com No. D2000- 0505). This provoked confusion as well and shows Respondents bad faith.

In the Panel's view in CAC case No. 100498 the registration of an identical domain name to the Complainant's name or mark for this purpose is not legitimate and only serves to divert Internet users without affording them any initial notion that this site is not connected with the Complainant, but rather is a criticism site. Had the Respondent wanted to present a bona fide criticism site then it would have been well advised to have included some negative modifier in its domain name and to have restricted itself to objective and reasoned criticism on its website.

Second, the Respondent is using a hidden identity.

Third, the Complainant said that the posted information is incorrect and the use of a portrait photo was without consent. This contention is without proof but the Respondent failed responding so far. Hence, it shall be deemed to be allowed.

Fourth, the Respondent is blocking the Complainant in respect to the disputed domain name. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the disputed domain name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TSOUKERNIK.COM**: Transferred

## PANELLISTS

| Name | **Dr. jur. Harald von Herget** |
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DATE OF PANEL DECISION 2016-12-28

Publish the Decision