Decision for dispute CAC-UDRP-101546

Case number	CAC-UDRP-101546
Time of filing	2017-05-19 13:53:31
Domain names	dunaarena.com, dunaarena.org, duna-arena.com, duna-arena.org

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	The State of Hungary represented by the Hungarian National Asset Management Inc.

Complainant representative

Organization	Rátky & Partners Attorneys

Respondent

Name	Dr. Csaba Postásy

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings, pending or decided, relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant, the State of Hungary, is the owner of the Hungarian trademark “Duna Aréna” No. M1701013, dated March 27, 2017, covering goods and services in classes 16, 25, 28 and 41.

FACTUAL BACKGROUND

On February 21, 2017, the Complainant announced the name of a facility it had built and owns, called Duna Aréna, located in Budapest, Hungary. This facility was built in order to welcome the FINA World Championship. On the same day, the Respondent registered the disputed domain names:

- <dunaarena.com> (at 5:10 PM),
- <dunaarena.org> (at 5:24 PM),
- <duna-arena.com> (at 5:48 PM),
- <duna-arena.org> (at 5:51 PM).

The Respondent also registered the domain names <dunaarena.hu> and <duna-arena.hu>, subject to an alternative dispute resolution procedure, before another center, in Hungary.

The Respondent does not contest that the announcement occurred before registration of the disputed domain names, which currently resolve to websites under construction.

On March 27, 2017, the Complainant filed the Hungarian trademark “Duna Aréna” No. M1701013 for goods and services in classes 16, 25, 28 and 41, currently under protection.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant, the State of Hungary, argues that the Respondent has “maliciously” registered domain names – including the disputed domain names – identical or confusingly similar to the name of the facility it revealed publicly earlier on the same day.

The Complainant contends that the Respondent has not made any attempt to use the disputed domain names in a legitimate way, since all of them resolve to a page bearing the mention “UNDER CONSTRUCTION FOR WORLDWIDE COMMERCIAL PURPOSE”.

Finally, the Complainant states that the disputed domain names were registered in order to obtain significant amounts of public funds in exchange for their transfer. In this regard, the Complainant mentioned that it was contacted by the Respondent, who offered to sell the disputed domain names to the Complainant.

RESPONDENT:

The Respondent argues that, when he registered the disputed domain names, there was no protected trademark on the sign “Duna Aréna”.

The Respondent admits that he registered these domain names on the same day of the public announcement made by the representative of the Hungarian Governement. However, he specified that he did so in order to establish a commercial network based in Hungary, with the help of international investors. “Duna Aréna” seemed to be “well-meaning” for this network.

The Respondent contends that, until the day of the public announcement, the name of the new facility had not been revealed by the Complainant. He also wonders why the Complainant did not register the disputed domain names before the announcement.

The latter specified that the disputed domain names were free and available for registration, and not in any sort of public use or under protection of a trademark. He also notes that Complainant filed the “Duna Aréna” trademark about one month after the announcement.

The Respondent admits that he contacted a representative of the Complainant on March 30, 2017. Nonetheless, he said that he offered to “hand over” the domain names and not to sell them.

Finally, the Respondent states that “Duna” is the name of the largest river in Hungary and that countless other enterprises use this name.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 disputed 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 disputed 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

I Rights

Under the test of confusing similarity, a Complainant must only show that it owns valid trademark rights and that the disputed domain names are susceptible of generating a likelihood of confusion with such a trademark. Time is not to be taken into consideration under this criterion, in the sense that even if a trademark is subsequent to a domain name, such a factor does not have any impact to state that there exists a risk of confusion.

Indeed, point 3 (ix)(1) of the UDRP rules provides that a Complainant must indicate “the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights”. A parallel can be drawn with the CAC’s <.eu> Overview, which states in its II. 5. that “in more recent decisions, the panels held that (…) it is not required that the trademark/service mark was registered before the domain registration but it is sufficient that the mark is in full effect at time of the complaint”.

In the present case, the Complainant has demonstrated that it owns valid trademark rights in Hungary on the sign “Duna Aréna” No. M1701013, filed on March 27, 2017, under protection.

The fact that the accent on the “e” letter of the word “Aréna” is missing from the disputed domain names does not alter the likelihood of confusion (BOLLORE SA. V. Dillan Dee Jackson, CAC case No. 101494). Furthermore, the gTLDs – namely <.com> and <.org> in the present case – are not to be taken into consideration when assessing the risk of confusion since they are only a technical requirement (See e.g. Crédit Agricole S.A. v. Roy M Oishi, CAC case No. 101545). It is also true for the additional hyphen which separates the word “DUNA” and “ARENA” in the domain names <duna-arena.com> and <duna-arena.org>.

Consequently, the Panel finds that the disputed domain names are virtually identical to the Complainant’s trademark since they reproduce such trademark without any additional element to dispel the likelihood of confusion.

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

II No rights or legitimate interests

Events and timetables are of the highest importance to discuss this second criterion. To that effect, the Respondent noted in his Response: “the basis of my defense is the timeline of the (…) events”.

On February 21, 2017, the Complainant, through one of their representatives, announced the denomination of the facility which was built to welcome the 2017 FINA World Championship, a swimming competition, on Hungarian National television.

The Respondent does not contest this argument. On the contrary, he writes in his Response "(…) the representative of the Hungarian Government, Mr Baláz Fürjes publicly announces on Hungarian National Television that the central venue for the 2017 FINA World Championship (the Facility) is named Duna Aréna. This is also broadcasted by MTI, the Hungarian news agency".

On this very same day, the Respondent, a Hungarian citizen, registered the four disputed domain names, as he acknowledges himself: "the very same day, I, Csaba Postásy, the Respondent, booked and registered the disputed domain names". The latter states that he did so in the will to establish a commercial network based in Hungary and considered that "Duna Aréna" sounded appropriate for this project. The Respondent also noted that "Duna" is a geographic term. It is indeed the Hungarian name of the Danube.

Having the above in mind, it does not seem clear why the Respondent decided to register these domain names on the exact same day the announcement was made. It is not said why he specifically chose the combination of the name "Duna" and of the term "Arena". Moreover, he does not demonstrate use or preparations to use the disputed domain names in connection with any activity, which is also an indicator of the lack of rights and legitimate interest (See e.g. Organization Arla Foods Amba v. Nashan, CAC case No. 101486). Indeed, no document corroborates the business for which he claimed he registered the disputed domain names.

Although it could be questioned why the Complainant waited for so long after the public announcement before filing a trademark, the Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect to the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

III Bad Faith

a- Registration in bad faith

Being a Hungarian citizen, it seems likely that the Respondent was fully aware of the Complainant's project, since State events are usually immediately relayed by media, whether it is the paper press, Internet press, radio, television…

Furthermore, one key point here is that the Respondent actually tried to sell the disputed domain names to the Complainant.

The Complainant has produced the copy of an e-mail sent on March 30, 2017, by Respondent to the Hungarian Government Commissioner, named "www.dunaarena.hu DOMAIN NAME PROPOSAL", relating to 6 domain names incorporating the sign "DUNA ARENA".

The Respondent argues that he wanted to transfer them for free. The e-mail he sent offers for the Complainant to "take over" the disputed domain names. In the Panel's view, it seems obvious that the Respondent was willing to gain money through this offer. Indeed, he allegedly registered the disputed domain names – the day of the announcement – to start a business but less than one month later he offered them to the State of Hungary.

If registering domain names for the purpose of sale is not per se prohibited, such a purpose must be contextualized. Here, the Respondent claimed that the disputed domain names were registered for his own business but he nonetheless contacted the Complainant in order to try assigning the disputed domain names for a commercial gain, knowing beforehand that the Complainant had a particular interest in such domain names.

Hence, on the balance of probabilities, it seems to the Panel that the Respondent registered the disputed domain names, on the same day as the announcement, in order to benefit from the Complainant's notoriety and even probable necessity in the disputed domain names in order to try selling them to the Complainant.

b- Use in bad faith

The Complainant states that the disputed domain names all “redirect to the same page showing the following message to visitors: […] UNDER CONSTRUCTIONS FOR WORLDWIDE COMMERCIAL PURPOSE”. In the Panel’s view, such use is insufficient to be considered active. However, passive holding of a domain name does not prevent the Panel from finding registration and use in bad faith (See e.g. CREDIT AGRICOLE S.A. v. Alain Pattinson, CAC case No. 101459).

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DUNAARENA.COM**: Transferred
2. **DUNAARENA.ORG**: Transferred
3. **DUNA-ARENA.COM**: Transferred
4. **DUNA-ARENA.ORG**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2017-07-10

Publish the Decision