# Decision for dispute CAC-UDRP-101841

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| Case number | CAC-UDRP-101841 |
| Time of filing | 2018-01-22 09:03:20 |
| Domain names | blackmeetic.com |

## Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |

## Complainant

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| Organization | MEETIC |

## Complainant representative

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| Organization | Nameshield (Laurent Becker) |

## Respondent

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| Name | Olawale Fatoke |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the following trademarks, among others:

- French trademark registration No. 3505029, "MEETIC", registered on June 6, 2007, for goods and services in classes 3, 14, 18, 20, 21, 25, 28, 29, 30, 31, 32, 33, 43;

- European Union trademark registration No. 10145654, "MEETIC", registered on December 1, 2011, for goods and services in classes 9,16,38,39,41,45;

- European Union trademark registration No. 5046594, "meetic" (figurative), registered on June 21, 2007, for goods and services in classes 9,16,38,39,41,43,45;

- United States Patent and Trademark Office registration No. 4299896, registered on December 5, 2001, for goods and services in class 45;

- International trademark registration No. 783549, "MEETIC", registered on May 27, 2002, for goods and services in classes 9,16,38,39,41,45; and

- International trademark registration No. 1089074, "MEETIC", registered on July 22, 2011, for goods and services in classes 9,16,38,39,41,45.

The Complainant is also the owner of numerous domain name registrations containing the term "MEETIC". The main domain name used by the Complainant is <meetic.com>.

The Disputed domain name was registered by the Respondent on July 5, 2016.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant was founded in November 2001 and is a leading online dating service in Europe, with about 6.5 million visitors in 15 countries and 13 languages.

The Complainant is the owner of the trademark "MEETIC" (see above section for details).

The Complainant operates on the Internet through various domain names, the main being <meetic.com>, registered on October 30, 2001.

The Disputed domain name was registered by the Respondent on July 5, 2016.

The Disputed domain name points to an online dating service focused on the back community.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that:

- the Disputed domain name is confusingly similar to its "MEETIC" trademark;

- the Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

- the Disputed domain name has been registered and is being used in bad faith.

For all these reasons, the Complainant requests that the Disputed domain name be transferred to it.

RESPONDENT:

The Respondent contends that:

- due to the difference between the Complainant's trademark and the Disputed domain name, there is no risk of confusion between "MEETIC" and "BLACKMEETIC";

- the Complainant has no trademark rights on the Disputed domain name because domain names are registered on a "first-come, first-served" basis and the Disputed domain name is a simple combination of three generic words in three different languages;

- the Respondent's intention of helping the African community by operating a free online dating service dedicated to that community is a legitimate interest in respect of the Disputed domain name; and

- the Disputed domain name was not registered or used in bad faith because the Respondent did not know MEETIC before the notification of the complaint and if he had known MEETIC beforehand he would have chosen another domain 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

(iii) The Disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "MEETIC", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed domain name itself to the Complainant’s trademark.

The Disputed domain name differs from the Complainant’s trademark "MEETIC" only by the addition of the word "black", and of the top-level domain ".com". It is well established that where the relevant trademark is recognizable within the domain

name, the addition of other non-distinctive terms does not prevent a finding of confusing similarity (see, for example, WIPO case No. D2008-2002).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

The addition of the word "black" at the beginning of the Disputed domain name suggests a reference to black communities.

The Panel accepts the Complainant's submission that the addition of the word "black" does not change the overall impression that the Disputed domain name seems to be connected with the trademark "MEETIC".

For the above-mentioned reasons, the Panel does not agree with the Respondent's contentions that there is no risk of confusion between "MEETIC" and "BLACKMEETIC".

As regards the Respondent's assertion that the Complainant has no trademark rights on the Disputed domain name because domain names are registered on a "first-come, first-served" basis and the Disputed domain name is a simple combination of three generic words in three different languages, the Panel points out that the "first-come, first-served" rule may be applied, for example, to disputes concerning a generic word (see, for example WIPO case No D2014-1937) but not to cases like the present one where a trademark is clearly identifiable in the domain name. Furthermore, the Panel does not consider credible the Respondent's argumentation that the Disputed domain name contains the word "MEETIC" by mere coincidence and that the word "BLACKMEETIC" was chosen because it is the combination of the English word "black" with the Igbo word "mee" (which according to the explanation given by the Respondent would mean "do") and the Efik word "tic" with special characters (which according to the Respondent's undocumented assertion would mean "love").

Therefore, the Panel considers that the Disputed domain name is confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in the Disputed domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in the Disputed domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

In particular, the Complainant states that:

- it does not carry out any activity for the Respondent;

- the Respondent is not affiliated to the Complainant;

- the Respondent does not have any business with the Complainant;

- the Respondent has not been authorized to use of the Complainant's trademark;

- the Respondent is not commonly known by the Disputed domain name.

The Respondent submits that he is not interested in competing with the Complainant because he would like to bring together African people for free, while the Complainant offers a paid dating service for European people. The Respondent argues that his intention of helping the African community by operating a free online dating service dedicated to that community is a legitimate interest in respect of the Disputed domain name.

The Panel accepts the Complainant's submissions that the Respondent does not appear to be known by the Disputed domain name, has not been authorized by the Complainant in any way to use the trademark "MEETIC", does not have any business with the Complainant, is not affiliated with the Complainant and does not carry out any activity for the Complainant.

The Panel notes that it is well established that, even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively suggests sponsorship or endorsement by the trademark owner (see, for example, WIPO case No. D2016-1698).

In this regard, the Panel takes the view that the Disputed domain name could suggest to Internet users that the Respondent is affiliated with, sponsored, or endorsed by the Complainant, active in the online dating field. Such inference is reinforced by the Respondent's use of the website, which consists in an online dating website. Because the Disputed domain name invokes a suggestion of affiliation with the Complainant, such use is not fair, is not legitimate, and does not give rise to rights or legitimate interests, regardless of whether the service offered is free or paid.

Therefore, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or other evidence of rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [Disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [Disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [Disputed] domain name; or

(ii) [the Respondent] [has] registered the [Disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [Disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [Disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

The Complainant submits that in the Respondent's website there is no disclaimer about the lack of any relationship with the Complainant.

The Complainant adds that the Respondent gets personal information from Internet users through ihis website.

The Complainant contends that the Disputed domain name was registered in order to create a likelihood of confusion with the Complainant and its trademark.

The Complainant argues that the Respondent, by profiting of the notoriety of the Complainant's trademark, uses the Disputed domain name to offer services in direct competition with the Complainant.

The Complainant, given the notoriety of the trademark "MEETIC", considers that the Respondent was aware of the Complainant's trademark at the time of the Disputed domain name registration and, in any case, the Respondent should have carried out a trademark search prior to the registration of the Disputed domain name.

The Complainant submits that the Respondent registered and uses the Disputed domain name in bad faith by disrupting the Complainant's business and creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed domain name.

The Respondent, who lives in London, states that the the Disputed domain name was not registered or used in bad faith because he did not know MEETIC before the notification of the complaint and if he had known MEETIC beforehand he would have chosen another domain name.

The Panel observes that the lack of disclaimer is linked to the fact that the Respondent stated to ignore the trademark "MEETIC".

The Panel points out that the fact that the Respondent's website collects personal information is intrinsically linked to the operation of any dating website.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden.

Having this in mind, the Panel accepts the Complainant's argument that the Disputed domain name was registered in order to create a likelihood of confusion with the Complainant and its trademark. Indeed, taking into account the distinctiveness and reputation of the trademark "MEETIC", it is extremely difficult to conceive that the Respondent was not aware of the Complainant's rights in the trademark "MEETIC" when registering the Disputed domain name. It also appears extremely unlikely that the Respondent decided to register the Disputed domain name as combination of three words in three different languages, as explained above.

The Panel agrees with the Complainant's assertion that the Respondent, by profiting of the notoriety of the Complainant's trademark, uses the Disputed domain name to offer services in direct competition with the Complainant and that the Respondent registered and uses the Disputed domain name in bad faith by disrupting the Complainant's business and creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed domain name.

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BLACKMEETIC.COM**: Transferred

## PANELLISTS

| Name | **Michele Antonini** |
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DATE OF PANEL DECISION 2018-03-12

Publish the Decision