Decision for dispute CAC-UDRP-102252

Case number	**CAC-UDRP-102252**
Time of filing	**2019-06-07 09:49:55**
Domain names	**futuragenetics.com**

Case administrator

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

Complainant

Organization	**FuturaGene Limited**

Complainant representative

Name	**JUDr. Petr Holy**

Respondent

Organization	**Boca Trading s.r.o.**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns EU word trademark no. 10327328 FUTURAGENE, registered in classes 1, 31, 35, 42, 44 and 45, including scientific and technological services and research and design, industrial analysis and research and medical services ("Complainant's Trademark"). In addition, Complainant owns several similar national trademarks registered, inter alia, in the United States, Canada, Israel, Australia and Japan.

The disputed domain name <futuragenetics.com> was registered on 3 December 2014.

FACTUAL BACKGROUND

From the evidence submitted by both parties along with their statements in these proceedings, the Panel took into account the following facts:

(a) from the extract from the Companies House and screenshot of Complainant`s website submitted by the Complainant, the Panel found that the Complainant, is a legal entity residing in the UK, active in the field of agricultural biotechnology, genetics research and related services in particular, it delivers genetically enhanced crops that improve and protect yields for forestry, biofuels, biopower, and agriculture;

(b) from the extract from the EUIPO trademark database submitted by the Complainant the Panel confirmed that the Complainant owns the Complainant's Trademark, from WIPO Global Brands Database the Panel also ascertained that the Complainant owns similar national trademarks, inter alia in the United States, Canada, Israel, Australia and Japan;

(c) from the extract from the Whois database submitted by the Complainant the Panel found that the Complainant also owns domain name <futuragene.com> registered on 12 March 2001. From screenshots provided by the Complainant as well as the Respondent and from its own examination of the website, the Panel further found that through such website services of the Complainant are offered;

(d) from the Registrar Verification dated 4 June 2019 the Panel inferred that the disputed domain name was registered on 3 December 2014 and that it is owned by the Respondent (registered through privacy / proxy registration service WhoIsGuard Inc.);

(e) from the screenshots provided by the Complainant and the Respondent as well as from its own examination the Panel learnt that under the disputed domain name a website is operated where services consisting of analysis of human DNA for probability of certain diseases are offered using the brand name "Futura Genetics" while the Israeli-based company DNA AND U LTD is shown as operator of such website;

(f) from the order documents and related photographs provided by the Complainant the Panel found that in May 2018 the Complainant conducted a test purchase from the Respondent's website ordering a DNA test kit which was duly delivered to the person who ordered the product;

(g) from the cease and desist letters submitted by the Complainant the Panel learnt that in November 2018 the Complainant sent several cease and desist letters to various persons and entities involved in the operation of website futuragenetics.com demanding that they cease and desist from the alleged infringement of Complainant`s Trademark and unfair competition conduct;

(h) from the trademark application dated 10 July 2019 submitted by the Respondent the Panel inferred that the Respondent filed an application no. 018092479 for EU figurative trademark Futura Genetics with device in classes 9, 41 and 42;

(i) from the extracts from EUIPO database submitted by the Respondent the Panel learnt that there are several other registered EU trademarks containing the term "futura" or "future";

(j) from the traffic analysis submitted by the Respondent the Panel found that in the period from 1 May 2015 through 10 July 2019 the website <futuragenetics.com> received usually under 10,000 page views a day with peaks in June 2017 and August 2018 reaching over 20,000 page views a day; from its own examination of Internet archive service archive.org the Panel also found that the snapshots of futuragenetics.com website exist since 3 October 2016 showing in principle the same content as today, i.e. offer for genetics analysis services; and

(k) the Respondent also submitted variety of materials, such as product invoices, evidence of participation in conventions, advertisements, referrals from other websites and independent reviews of its products which confirm Respondent`s activities in the field of genetics analysis services under the brand Futura Genetics.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

THE COMPLAINANT

In addition to the above factual assertions, the Complainant also contends the following:

1) the disputed domain name is confusingly similar to Complainant`s Trademark as well as to Complainant`s domain name

<futuragene.com>. Also the services provided by the Respondent are similar to those provided by the Complainant (and covered by Complainant`s Trademark);

2) already at the time of registration of the disputed domain name the declared owner was falsified, and therefore the registration has been done on behalf of non-existent entity;

3) the real present owner of the disputed domain name is unreachable personally, in written communication or by phone, and is using all available techniques to hide its headquarters and contact information;

4) the real owner of the disputed domain name failed to react to any of the attempts made on behalf of the Complainant to solve this situation amicably;

5) the present situation is damaging to the Complainant and also to the consumers, causing their confusion, detrimental to the reputation of the Complainant and its trademarks and exploiting the business experiences and success of the Complainant;

6) the registration and usage of the disputed domain name is being done in bad faith, resulting in unfair exploitation of the Complainant and its business and confusing the consumers and competitors;

7) DNA AND U LTD., who allegedly filed the response, is a third party that lacks any standing before the Panel in this case. This is merely another attempt of the true owner of the disputed domain name to hide and avoid the legal consequences of its infringing activity;

8) DNA AND U LTD. was established in 2018, and has no evident connection to the disputed domain name subject of this case, which was allegedly registered by that company back in 2014, a statement which is clearly false;

9) Mr. Efi Binder, a shareholder and director at DNA AND U LTD. received a physical copy of the cease and desist letter sent by the Complainant. However, ignored the letter and now DNA AND U LTD claims that it did not receive a copy of the letter, a statement which is clearly false; and

10) as mentioned in the Complaint, after the letter was sent to the owner of the domain name and accepted by Mr. Binder, the holder of the domain name <FUTURAGENETICS.COM> was hidden by using a foreign entity in Panama in order to make it difficult for the Complainant to enforce its legal right against the infringing activity of the owner.

THE RESPONDENT:

In addition to the above factual assertions, the Respondent also contends the following:

1) the disputed domain name is not confusingly similar to Complainant’s Trademark. There are substantial differences between Complainant’s Trademark and disputed domain name, the goods/services offered by each party under their respective trademarks, the relevant customers of each party, and trade channels through which each party offers its goods/services making confusion between Complainant’s Trademark and disputed domain name highly unlikely. Furthermore, the term “future” is descriptive in the context of science and technology, and therefore, limits the scope of protection of Complainant’s Trademark specifically to the goods/services under which it is registered;

2) the Respondent has legitimate interests in the disputed domain name. The Respondent has been using the disputed domain name consistently for more than four years as its primary means for marketing and selling Respondent’s goods/services, which are not related to Complainant’s goods/services whatsoever. The Respondent’s business relies heavily on the disputed domain name. During the entire period in which the disputed domain name is active, Respondent has never received a single inquiry from customers related to Complainant or Complainant’s goods/services, and Complainant did not claim any such inquiries were received by Respondent nor provided any evidence to support such claim;

3) the disputed domain name has been registered and used in good faith. The Respondent has been using the disputed domain name in connection with a bona fide offering of its goods/services for several years before any notice of the dispute, and the Respondent have been commonly and internationally known by the disputed domain name thanks to ongoing investment of substantial efforts and resources in promoting the disputed domain name and Respondent's trademark. When choosing its commercial name, the Respondent was not aware of the Complainant, and in any way, could not benefit from any similarity to Complainant's Trademark, to the extent such similarity exists; and

4) the Complaint was filed in bad faith and in unreasonable delay (latches). The Complainant has filed the Complaint in bad faith knowing the Respondent has a longstanding legitimate business operating under the disputed domain name, not related in any way to Complainant's goods/services and not causing any confusion with Complainant's Trademark. The Complaint was filed after the disputed domain name has been actively and consistently used by Respondent for more than four years, a period during which the Respondent has invested tremendous efforts and resources for establishing reputation in its trademark and disputed domain name.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to the Complainant's Trademark within the meaning of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not shown that the Respondent has 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 not 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.

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

Paragraph 4(a) of the Policy requires that a complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (first UDRP element); and

(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name (second UDRP element); and

(iii) the disputed domain name has been registered and is being used in bad faith (third UDRP element).

However, before the Panel proceeds to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in these proceedings, it will address the issue of the identity of the Respondent, as there appears to be some uncertainty between the parties in this this regard.

THE RESPONDENT

The named Respondent in these proceedings is the company Boca Trading s.r.o., which is now trading as Europayments

Finance s.r.o. (as it appears from the Czech Commercial Register extract submitted by the Complainant, the company changed its name in 2013). Under the Policy, the Respondent is defined as the holder of a domain-name registration against which a complaint is initiated. The Respondent asserts that the "true owner" of the disputed domain name is an Israeli-based company DNA AND U LTD. and that Europayments Finance s.r.o. (Boca Trading s.r.o.) was only an intermediary used for disputed domain name registration.

From the website operated under the disputed domain name it indeed appears that the company DNA AND U LTD. is the operator of such website. However, for the purposes of these UDRP proceedings, the Respondent is the company Boca Trading s.r.o. (now trading as Europayments Finance s.r.o.) as the holder of the disputed domain name at the time when the complaint was made. The response to the complaint appears to be made on behalf of DNA AND U LTD. although it has been submitted through the electronic platform using the login of the Respondent. The Complainant argues that such company has no standing in this dispute. The Panel concurs, however, it does not mean that the Panel should disregard the response.

The response was filed through the platform using the login of the Respondent and has been found administratively compliant by the Czech Arbitration Court. Therefore the Panel considers it to be a procedurally valid statement of the Respondent. Although the disputed domain name is apparently used by a company different from the Respondent, the Panel assumes that such use is based on the consent of the Respondent which is being confirmed by the fact that the Respondent filed (or allowed filing of) the response apparently prepared by an attorney acting on behalf of DNA AND U LTD.

Arrangement that a domain name is held by a different entity than operator of the website under such domain name is not uncommon. However, for the purposes of UDRP proceedings concerning such domain name, the registered domain name holder is responsible for use of the domain name by such other entities. Therefore, for the purposes of these UDRP proceedings the Panel considers statements made by DNA AND U LTD. in its response as made by the Respondent and for the sake of simplicity refers to both Boca Trading s.r.o. (Europayments Finance s.r.o.) and DNA AND U LTD. as the Respondent.

RIGHTS

The test of identity / confusing similarity of the disputed domain name with the Complainant's Trademark under the first UDRP element is a relatively straightforward comparison. UDRP panels typically consider this to be a threshold test concerning a trademark owner’s standing to file a UDRP complaint, i.e., to ascertain whether there is a sufficient nexus to assess the principles captured in the second and third UDRP elements. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Issues such as the strength of the complainant’s mark or the respondent’s intent to provide its own legitimate offering of goods or services without trading off the complainant’s reputation, are decided under the second and third elements (please see WIPO Jurisprudential Overview 3.0, section 1.7).

The Panel stresses that the purpose of UDRP proceedings is not to resolve complex trademark disputes between the parties. Therefore, the test under the first UDRP element is not comparable, for example, to the global assessment of likelihood of confusion used by EUIPO when examining oppositions against trademark applications.

From this perspective, the Panels concurs with the Complainant that the disputed domain name is confusingly similar to Complainant's Trademarks. First 10 letters of both signs are identical. Both terms "Futuragene" and "Futura Genetics" clearly refer to the "future" and "genetics". Complainant's Trademark is therefore similar to disputed domain name visually, phonetically, as well as conceptually.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (please see, for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has failed to make such prima facie case. Moreover, the Respondent, to the satisfaction of the Panel, has shown that it has legitimate interest in the disputed domain name.

Under paragraph 4(c)(i) of the Policy, legitimate interest is demonstrated in case that, before any notice of the dispute, the Respondent has used or demonstrably prepared 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. From the evidence available in these proceedings it is clear that the Respondent operates a website under the disputed domain name where it sells the genetics analysis services under the brand Futura Genetics. The website started operation in October 2016 at the latest, therefore well before initiation of these proceedings and well before cease and desist letters issued by the Complainant. As evidenced by the test purchase conducted by the Complainant as well as invoices provided by the Respondent, such services are actually performed and no evidence submitted in these proceedings suggests that they are fake or otherwise illegitimate.

In order to establish legitimate interest, offering of goods and services through the website under the disputed domain name must be bona fide. The Complainant argues that this bona fide offering does not exist as the brand Futura Genetics infringes Complainant's Trademark and constitutes unfair competition conduct against the Complainant.

The Panel disagrees.

First it must be noted that the Complainant's Trademark is not particularly distinctive with respect to genetics research services, i.e. the services for which it is invoked by the Complainant in these proceedings. It is comprised of two components "futura" and "gene". Futura is a term coming from Latin or Spanish clearly evoking future endeavors, the innovation, even to an English speaker. As biotechnologies and genetic research are considered innovative industries, this term is to a large extent descriptive. The term "gene" apparently refers to genes or genetics and as such it is also descriptive for genetics research services. Such low distinctiveness of Complainant's Trademark substantially decreases the likelihood of confusion with the disputed domain name.

Also, the Complainant rather generally refers to the genetics research services as the area of business where the conflict of Complainant's Trademark with the Respondent's brand occurs and argues that their co-existence may result in confusion of competitors and consumers. However, the actual use of Complainant's Trademark is narrower than that. According to Complainant's website, the primary products of the Complainant are genetically enhanced crops. The Respondent offers testing of human DNA to ascertain probability of certain diseases, i.e. clearly different services. Such fact, in the Panel's opinion, further decreases the likelihood of confusion.

In a situation like this, additional circumstances beyond just similarity of Complainant's Trademark to disputed domain name would have to exist to conclude that the Respondent attempts to exploit Complainant's Trademark and thus does not use disputed domain name for bona fide offering of goods and services. The Panel however found no such circumstance. There is nothing at the website <futuragenetics.com> suggesting that the Respondent is anyhow affiliated with or sponsored by the Complainant. Futura Genetics brand uses a logo which is clearly different from the logo of the Complainant. The name of the entity operating <futuragenetics.com> website is also clearly shown on the website.

The Panel therefore concludes that:

(a) Complainant's Trademark is of low distinctiveness with respect to the goods and services in question;

(b) goods and services for which the Complainant's Trademark is actually used are different from those offered under the disputed domain name; and

(c) the Respondent sufficiently differentiated its website and brand from Complainant's Trademark.

As a result, the Panel found that the Respondent has been using the disputed domain name for bona fide offering of goods and services prior to any notice of this dispute, which establishes its legitimate interest in the disputed domain name.

BAD FAITH

The Panel found that the Respondent has legitimate interest in the disputed domain name which is sufficient ground to reject the complaint.

Only for the sake of completeness, the Panel also briefly addresses the issue of bad faith of the Respondent in registration and use of the disputed domain name. Besides the trademark infringement and unfair competition (which is discussed above) the Complainant infers bad faith of the Respondent from registration of disputed domain name via proxy service and under a false identity, failure to respond to Complainant's cease and desist letters, or deliberate hiding of true identity of dispute domain name owner and its headquarters.

The Panel does not concur.

Although it is true that the owner of the disputed domain name is different from the operator of the website <futuragenetics.com> and that there apparently were some changes in the structure of Respondent's business ownership over time, the Panel is not convinced that these circumstances amount to bad faith of the Respondent. Arrangement that the entity holding the domain name differs from the entity operating a website under such domain name is not uncommon. It could be used to conceal the true identity of the holder of the domain name, however nothing of such kind happened here. The identity of the Respondent was duly disclosed upon request of the Czech Arbitration Court. The identity of the website operator DNA AND U LTD. is also properly disclosed at the website and the fact that this company operates the website was also duly explained in the response to the complaint. The fact that the disputed domain name was registered under the old name of the Respondent Boca Trading s.r.o. and not its current name Europayment Finance s.r.o. can rather be amounted to an omission of the Respondent to update its registration details than bad faith; in any case, both old and new names are easily searchable in the publicly available Czech Commercial Register which the Complainant represented by a Czech attorney should certainly be aware of. Most importantly, however, at least from October 2016 the offering of services at the website <futuragenetics.com> remained principally the same as today. Although the identity of the operator of the website may have formally changed, the bona fide offering of goods and services at the website remained the same. The Panel also did not find any bad faith conduct of the Respondent in its failure to respond to Complainant's cease and desist letters.

As a result, the Panel found that the disputed domain name has not been registered and used by the Respondent in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **FUTURAGENETICS.COM**: Remaining with the Respondent

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2019-07-29

Publish the Decision