Decision for dispute CAC-UDRP-100149

Case number	CAC-UDRP-100149
Time of filing	2010-04-13 11:18:02
Domain names	AMATERI.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Amateri.cz s.r.o.

Complainant representative

Organization	Jansa, Mokrý, Otevřel & partneři v.o.s.

Respondent

Name	Brian Muir

OTHER LEGAL PROCEEDINGS

The Respondent appears to have previously been involved in litigation in the United States, the nature and relevance of which is discussed is addressed in greater detail in this decision.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of Czech registered trade mark no 288060 dated 22 February 2007 and Slovak registered trade mark no 218217 for the word AMATÉŘI dated 8 June 2007 in classes 38, 41 and 41.

FACTUAL BACKGROUND

1. The Complainant is a company based in the Czech Republic. It is the successor in business to a business that has since 2003 operated a website using the domain name <amateri.cz>. “Amatéři” is Czech for “amateurs”. The website allows users to upload and share erotic photographs and videos. By 2009 its website had achieved 58 million visits in that year.

2. In 2008 the Complainant registered the domain name <amateri.com> (the ”Domain Name”) in order to expand and promote the website in other countries. It used the Domain Name in relation to its services until January 2010 when due to error the registration was allowed to expire.

3. The WhoIs information for the Domain Name records that the Domain Name was re-registered on 6 January 2020. The Respondent is listed as the registrant and appears to be an individual who gives an address in San Diego, California.

4. Following re-registration, the Domain Name was initially offered for sale on the “Snapnames” auction web site. The Complainant offered to buy the Domain Name in an email dated 12 January 2010 but received no response.

5. As at the date of this decision no webpage appears to be operating from the Domain Name

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PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Complainant contends that the Respondent is a serial domain name speculator. It claims that the Respondent has been the subject of proceedings in the United States District Court for the Northern District of Illinois, Eastern Division (Case No 05C 2889). It appends various papers in relation to those proceedings. These include copies of injunctions ordered by the court in June 2005 and May 2006 that are, inter alia, directed at the Respondent. The injunctions contain certain restrictions on the manner in which the Respondent can promote sexually explicit content. The Complainant also claims that by reason of those injunctions the Respondent has been ordered to restrain from registering new domain names “without any preliminary notifications to the counsel”.

2. The Complainant contends that by the time of the Complaint, the Domain Name displayed a web page which displayed a list of links to erotic websites. However, it appends no evidence in support of that assertion.

3. The Complainant asserts that this use of the Domain Name involves an infringement of its Czech and Slovak trade marks.

4. By reason of these facts it contends that the Domain Name was registered in bad faith and without any legitimate interest. It further contends that the rapidity of the registration of the Domain Name “indicates that the [R]espondent uses the software for grabbing the expired domains.

5. The Complainant also filed a non-standard supplemental submission in this case. However, for reasons explained later on in this decision, it is not necessary to record the contents of that submission.

RESPONDENT:

6. The Respondent disputes the contention in the Complaint that he was enjoined in the identified US proceeding from registering domain names “without opposing counsel’s consent” and further claims that in any event the relevant injunction expired in July 2009.

7. The Response then contains a number of denials. These include the statement:

“Respondent is not in the business of purchasing expired domain names and then reselling them for profit. This is not the purpose of Respondent's business”

However the Respondent does not go on to state what his business is.

8. He then proceeds to make a number of legal contentions. Reference is made to the decisions of Milwauke Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store, WIPO Case No. D 2002-0774 and Weber Stephen Products Co. v. Armitage Hardware, WIPO Case No. D2000-0197 that are said to be authority for the proposition that:

“the jurisdiction of the arbiter is limited to providing a remedy in cases of ‘the abusive registration of domain names’, also known as ‘cybersquatting’”.

9. He claims that the Complainant has “failed to establish” circumstances indicating bad faith. He next refers to Ultrafem, Inc. v. Warren Royal, NAF Case No. 97682, which is said to be authority for the proposition that ”[a]bsent direct proof that the domain name was registered solely for the purpose of profiting from a complainant’s trademark rights, there can be no finding of bad faith registration and use”.

10. The Respondent also relies upon the following quote from Goldberg & Osborne v. The Advisory Board Forum, Inc., WIPO Case No. D2001-0711:

“Trademark rights are not coextensive with the rights to a domain name and thus trademark holders do not have the absolute right to reflect their mark in a domain name.” Id.

11. The Respondent further contends that:

“[t]he Respondent and Complainant are clearly not in the same line of work and the r-rated.com domain was neither registered nor acquired for the purposes of diverting customers from Complainant’s rating system”,

But what the “line of work” of the Respondent is and how this statement is “clear” is once again not explained.

RIGHTS

1. The Panel accepts that the most natural reading of the Domain Name is as the Czech word “Amatéři” represented in simple Latin text together with the <.com> tld. The Panel also accepts that the Complainant is the owner of Czech and Slovak trade marks for the word “Amatéři”. In the circumstances, the Complainant easily satisfies the requirement of paragraph 4(a)(i) of the Policy that the Domain Name be confusingly similar to a trade mark in which the Complainant has rights. The Panel notes that the Respondent does not put forward any positive argument to the contrary.

NO RIGHTS OR LEGITIMATE INTERESTS

2. The Domain Name represents an ordinary word in the Czech language. The obvious question that arises is why is it that the Respondent registered this Domain Name. If a registrant intended to profits from the descriptive nature of the word or words in a domain name without intending to take advantage of a third party’s rights and reputation in that term, then it may have a legitimate interest in the domain name (see paragraph 2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions).

3. The statement in the Complaint that the Domain Name was used for a website that displayed “erotic links“ suggests that the Domain Name might at one stage have been registered and Respondent for use with a “domain name parking” or “pay-per-click” service with a view to generating “pay-per-click” revenue’. But that does not preclude the existence of a legitimate interest. On the other hand, if the domain name in question was chosen because of the similarity to a name in which a third party complainant has an interest and in order to capitalise or otherwise take advantage of that similarity, would not provide the registrant with a right or legitimate interest in the domain name (see, for example, the decision of three member panel in Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright, WIPO Case No. D2007-0267).

4. Essentially, therefore, in this a case the assessment of the existence of rights or legitimate interests boils down to the questions: (a) did the Respondent register the Domain Name with the Complainant’s mark in mind and (b) has he then deliberately used the Domain Name to take unfair advantage of the reputation of that mark. These are precisely the questions that have to be addressed in assessing the question of bad faith registration and use, and a separate assessment of the question of rights and legitimate interests adds very little.

5. For the reasons that are explained in greater detail under the heading of bad faith, the Panel has reached the conclusion that in the answer to both questions is, yes. In the circumstances, the Panel finds that the Respondent has no right or legitimate interests in the Domain Name and the Complainant has made out the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

6. As has already been stated, in order to reach a conclusion on the issue of bad faith it is necessary for the Panel to answer the questions (a) whether the Respondent register the Domain Name with the Complainant's mark in mind and (b) whether he has then deliberately used the Domain Name to take unfair advantage of the reputation of that mark?

7. The answers to these questions are not straight forward. "Amatéři" is an ordinary Czech world that might be registered for a number of purposes. Often the way in which a domain name has been actually used after registration will provide the best insight as to the motives of the registrant. Unhelpfully, the Complainant has failed to evidence its claim that the Domain Name was used for a series of erotic links. Nevertheless, the Panel is prepared to accept the Complainant's assertions in the Complaint to this effect. Such assertions can constitute evidence for the purposes of the policy (see for example, First SBF Holding, Inc. v. XC2 WIPO Case D2008-0409) and despite the general denials contained in the Response, they do not appear to be directed to this aspect of the Complainant's case.

8. It does not follow from this that the Domain Name was registered with the Complainant in mind. The word Amatéři is not one that inherently must have been chosen for use in relation to erotic content because of its association with the Complainant (particularly if the links displayed were automatically chosen – see for example, Dr Angela Stevens v Azera LLC WIPO Case No. D2008-0844). Nevertheless, the Panel has reached the conclusion that it was with the Complainant in mind that the Domain Name was registered in this case.

9. First, there is the fact that the word "Amatéři" is a Czech one, the Respondent appears to be based in the California and there is no obvious reason for the Respondent to be this word that has no obvious meaning in English. There is, for example, no claim by the Respondent that this is just one of a series of Czech words that the Respondent has decided to register for some disclosed generic purpose.

10. Second, there is the fact that the Complainant's business under the "Amatéři" name appears to be reasonable large and to have developed some degree of reputation.

11. Third, there is the fact that the Respondent appears to have been subject to injunctions in proceedings in the United States. The Complainant argues that the Respondent should not have registered the Domain Name without the consent of the other party in those proceedings. This is unpersuasive. The reason is that even if this assertion is true, the Panel is unconvinced that any obligation that the Respondent may or may not have had to a third party is relation to the assessment of bad faith between the Respondent and Complainant (see Do The Hustle, LLC v. Monkey Media LLC, WIPO Case No. D2000-0625). Nevertheless, these injunctions are still significant. What they show that the Respondent has some familiarity with the business of the promotion of sexually explicit material on the internet, which in turn makes it more likely that the Respondent was aware of the Complainant's business under the "Amateri" name.

12. Last, but not least, there is the Respondent's Response itself. It is in a format which is not uncommon for responses. It involves a series of denials combined with legal argument but no real explanation of why the Domain Name was registered. There are claims by the Respondent of activity in a different business field, but the field is not identified. There is an assertion that the domain name was not registered because of its association or connection with the Complainant, but the reason for registration is not disclosed.

13. The rationale for this form of response appears to be that as it is for a complainant to prove his case, therefore it is legitimate simply to point out where he has failed to do so and raise points of law. In fact, such an approach more often than not is entirely counter-productive. Key to the assessment of bad faith is the respondent's motives and why the respondent registered the domain name. Where a respondent puts in a response, it should be relatively easy to give that basic explanation. Any sensible respondent who considers his activities to be legitimate is likely to explain what those activities are. When a respondent does not do so, but simply denies claims and puts forward points of law, then, in the absence of any good explanation for taking that approach, the natural inference is that the respondent has something to hide. In other words, a response that takes this form is likely to end up adding to a complainant's case on bad faith, rather than undermining it (See, for example, Credit Industriel et Commercial S.A. v. Demand Domains, Inc. WIPO Case No. D2009-1184).

14. To treat a response in this manner, does not involve any reversal of the burden of proof. It is simply a common sense

assessment of the respondent's actions, which together with all the other facts are relevant to the assessment whether on the balance of probabilities the complainant has made out his case.

15. In this case when considering all these issues in the round, the Panel has reached the conclusion that it is more likely than not that the Respondent registered the domain name with the intention of taking advantage of the goodwill that the Complainant had built up in the "Amateri" name. In the circumstances, the Complainant has made out its case on bad faith registration and use.

16. In coming to these conclusions there are a number of arguments that although advocated by the Complainant have not influenced the Panel's conclusions on the issue of bad faith.

17. The first is the Complainant's claims of trade mark infringement. The Panel is unconvinced that these are of any relevance to the issues in this case. The Policy and local laws as to cybersquatting and trade mark infringement are different. They do not do, and are not intended to do, the same thing. They in large part overlap and frequently a complainant who might succeed in UDRP proceedings might well have succeeded under local trademark or anti-cybersquatting law. However, as the three person panel stated in Delta Air Transport NV (trading as SN Brussels Airlines) v. Theodule de Souza, WIPO Case No. D2003-0372, "trade mark infringement and abusive registration within the meaning of paragraph 4(a)(iii) of the Policy are two different things" and "the fact that a particular set of facts may constitute trade mark infringement has of itself no bearing on whether it is an abusive registration" (see also the three person panel in Intel Corporation v. Base ltd Tihame.net WIPO Case No. D2008-1820).

18. The second is the Complainant's contention that the Respondent obtained the Domain Name through the use of automated software. Why if correct the Complainant thinks this assists rather than hams its case is not clear. However, the basis for this assertion seems simply to be that the Domain Name was re-registered shortly after it expired. The exact dates and facts that support this claim are far from clear. It is also unclear how this automated registration is said to have taken place. Ultimately, the Panel is unable to form a view on this issue and in the absence of further evidence from the Respondent as to exactly how he acquired the domain name, the Panel is not prepared to make assumptions in either party' favour in this respect.

19. Similarly, the Panel is not persuaded by the Respondent's legal arguments in this case. The Respondent has cited Goldberg & Osborne v. The Advisory Board Forum, Inc. as authority for the proposition that trade mark rights are not coextensive with the rights to a domain name ownership. The Panel agrees with this proposition, but trade mark rights being coextensive with the rights to a domain name is not the basis upon which bad faith has been found in this case.

20. As to the proposition that the cases of Milwauke Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store, WIPO Case No. D 2002-0774 and Weber Stephen Products Co. v. Armitage Hardware, WIPO Case No. D2000-0197 are said to limit the authority of a panel to cases of cybersquatting, it not clear where the Respondent is going with this argument. It begs the question what is "cybersquatting" and was recognised by the majority of the panel in Aspis Liv Försäkrings AB v. Neon Network LLC D2008-0387 the meaning of that term is "hotly disputed". One person's "cybersquatting" may be another's "fair use". Therefore, arguments as to whether something is "cybersuatting" is unlikely to be productive. They do not assist the Respondent in this case.

21. Lastly, there is the Respondent's claim that the case of Ultrafem, Inc. v. Warren Royal, NAF Case No. 97682 is authority for the proposition that:

"[a]bsent direct proof that the domain name was registered solely for the purpose of profiting from a complainant's trademark rights, there can be no finding of bad faith registration and use"

22. The key words here appear to be "direct proof". The Respondent seems to be contending that only if there is evidence before the Panel that satisfies some higher test of "direct proof" can there be a finding of bad faith. As an assertion this is simply wrong. Paragraph 10 (d) of the Rules makes it clear that the Panel has a broad discretion to determine the admissibility, relevance, materiality and weight of any evidence. Further, it has also long been clear that a complainant is

simply required to show its case “on the preponderance of the evidence” or “on the balance of probabilities”.

23. Contrary to what the Respondent contends, the short decision in Ultrafem, Inc. v. Warren Royal, NAF Case No. 97682, does not provide any authority for the proposition that “direct proof” is required. Indeed, it is curious that although many respondents have sought to put forward this sort of argument in the past sometimes using identical phraselogy (see for example, Primedia Speciality Group Inc. v John Zuccarini WIPO Case No. D2002-1017) it has seldom met with any success. For example,in Yara International v. Undefined, Domain Admin, Mrs. Jello LLC WIPO Case No DTV2008-0015 the proposition was directly dismissed as “overly simplistic”.

24 In the circumstances, the Complainant has made out the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

1. There are two procedural issues that need to be addressed. The first is the status of the Complainant’s additional submission. The second is the Registrar’s conduct in this case.

Complainant’s non-standard submission

2. The Complainant’s non-standard submission seeks to respond to the Respondent’s contentions including in relation to the US litigation in Illinois.

3. The circumstances in which a panel will admit supplemental filings are limited (see for example In DK Bellevue, Inc. d/b/a Digital Kitchen v. Sam Landers, WIPO Case No. D2003-0780). However, for reasons that have been explained earlier in this decision the Panel has formed the view that it should decide these proceedings in the Complainant’s favour without the need to consider the contents of the supplemental filing and whether and to what extent it is admissible.

Registrar conduct

4. A concerning aspect of this case is the failure of Find Good Domains, Inc. (the “Registrar”) to respond to the initial registrar verification request sent to it by the CAC on 7 April 2010. Happily, it does not appear to have had any real impact on the conduct of this case. The Complainant, the CAC and the Panel have been able to proceed on the basis of the publically available WhoIs information for the Domain Name. Nevertheless conduct of this sort can threaten the proper functioning of the Policy.

5. In other cases where faced either with the non-cooperation or obstruction of registrars in the conduct of the Policy panels have considered it appropriate to invite the dispute resolution Provider to bring the relevant registrar’s conduct to the attention of ICANN so that ICANN can undertake such investigation and impose such sanctions as it considers appropriate in the circumstances. An analysis of the powers of panels and Providers and of the previous actions of panels in this respect is set out in Four Seasons Hotels Limited v. Internet bs Corporation/ Private Whois Service WIPO Case No. D2009-1657.

6. The Panel considers that this is a case where a similar approach is warranted. It therefore invites the CAC to bring the Registrar’s failure to respond to the CAC’s registrar verification request to the attention of ICANN.

PRINCIPAL REASONS FOR THE DECISION

The Complainant is a Czech company that operates a website allows users to upload and share erotic photographs and videos. It owns Czech and Slovak registered trademarks for the word AMATÉŘI. It registered the Domain Name the subject of these proceedings, but that registration was allowed to lapse. At that time or shortly thereafter the Domain Name was registered by the Respondent.

On the evidence before the Panel, the Panel concluded on the balance of probabilities that the Domain Name was registered by the Respondent with the Complainant in mind and with the intention of taking advantage of the reputation of the Complainant’s marks. That evidence included (i) the fact that the domain name had been used to display erotic links (ii)

there was no obvious reason why the Respondent who was based in California would register a domain name corresponding to a Czech word; and (iii) the fact that the Respondent's Response took the form of bare denials combined with legal argument and failed to provide any description or explanation as to why the respondent had registered the Domain Name

In the circumstances, the Panel held that the Complainant had made out the requirements of paragraph 4(a)(i), (ii) and (iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AMATERI.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2010-05-30

Publish the Decision