Decision for dispute CAC-UDRP-100601

Case number	**CAC-UDRP-100601**
Time of filing	**2013-05-17 11:28:56**
Domain names	**mustijamirri.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Musti ja Mirri Oy**

Complainant representative

Organization	**Berggren Oy Ab**

Respondent

Organization	**Roberts Online Company Ltd**

FACTUAL BACKGROUND

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

The Complainant, Musti ja Mirri Oy, is the owner of European trademark registration, CTM No. 009367186 MUSTI JA MIRRI as well as international trademark registration No. 1052375 MUSTI JA MIRRI designated in Norway and the Russian Federation. The Complainant is also the owner of Finnish trademark registrations No. 244216 MUSTI JA MIRRI (device) and No. 249254 MUSTI JA MIRRI Muista häntä (device). The Complainant owns “Musti ja Mirri” as a registered company names “Musti ja Mirri Oy” (Company ID 1083808-5) and “Musti ja Mirri Group Oy” (Company ID 2339317-7) in Finland and is also the owner of domain names mustijamirri.fi, mustijamirri.net, mustijamirri.info and mustijamirri.org. Domain name mustijamirri.fi has been registered to the Complainant since 13 February 2001.

The true and correct copies of the registration certificates and/or true and correct copies of printouts from public official registration databases of the MUSTI JA MIRRI mark in the European Union, Norway, the Russian Federation and in Finland and Musti ja Mirri from Finnish trade register as well as a printout on 17 May 2013 from the Finnish Business information System (Yritystietojärjestelmä, YTJ) identifying the current and former address of business for Musti ja Mirri Oy were provided.

The trademark MUSTI JA MIRRI has been used visibly in the promotion, marketing and sale of products by Musti ja Mirri Oy and its franchising partners since 1988. The trademark is widely known among relevant group of consumers as well as businesses due to being the largest pet shop chain in Finland. Printouts from the website of the Complainant and other

copies of marketing material were provided in evidence.

The trademark MUSTI JA MIRRI has been in use by Musti ja Mirri Oy and its predecessors since the year 1988 and applied and registered as a trademark by Musti ja Mirri Oy since the year 2008. The trademark MUSTI JA MIRRI is widely known among the relevant group of consumers in Finland. The company name Musti ja Mirri Oy (Company ID 1083808-5) has been registered on 16 June 1998. The geographical coverage of the trademark protection has been expanded along the growing business of Musti ja Mirri Oy. The disputed domain name mustijamirri.com is identical to the trademark MUSTI JA MIRRI in which Musti ja Mirri Oy has prior rights.

The Complainant, Musti ja Mirri Oy, submits the following:

Musti ja Mirri Oy has made good faith efforts to establish whether the Respondent, Robert's Online Company Ltd might have any rights or legitimate interest in the name "Musti ja Mirri", but no such rights have been found. According to the searches conducted by Musti ja Mirri Oy in the Internet and in the trademark databases, Robert's Online Company does not have any rights to the name "Musti ja Mirri" or to the corresponding domain name mustijamirri.com. Further, the name "Musti ja Mirri" bears no connection to the trade name or any other sign used and owned by Robert's Online Company.

As presented in the Background section Robert's Online Company originally directed the disputed domain name to their website koiralle.fi but removed that after the initial cease and desist letter from the Complainant. This shows Robert's Online Company's use of, and demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services after registration of the disputed domain name. Currently the disputed domain name mustijamirri.com has been directed by Robert's Online Company to landing page which contains a variety on pay-per-click links to both pet and non-pet related sites, including a large variety of such sites which are directly competing with the Complainant's business. This makes it clear that Robert's Online company is intentionally gaining commercial monetary profit from the use and registration of the disputed domain name and is intentionally benefiting from the Complainant's registered well-known brand and trademark MUSTI JA MIRRI, as well as causing detriment and damage to the Complainant's well-known brand and trademark MUSTI JA MIRRI Printouts of the current mustijamirri.com landing pages' content from 6 May 2013 and printouts from web sites explaining the purpose and functionality were provided.

The Respondent, Robert's Online Company is not commonly known by the disputed domain name and, according the Complainant's knowledge does not hold any trademark, company name or any other relevant rights to the name which corresponds to the domain name. Robert's Online Company has no relation to Musti ja Mirri Oy or their business other than in a competitive manner by operating the previously mentioned online pet shop in web site koiralle.fi.

Musti ja Mirri Oy has not granted Robert's Online Company any rights or license to use any of its trademarks. The use and registration of the disputed domain name has not been authorized by Musti ja Mirri Oy and Musti ja Mirri Oy does not approve of the use and registration of the disputed domain name.

Musti ja Mirri Oy considers it to be evident that the Respondent, Robert's Online Company Ltd has no rights or legitimate interests in respect of the disputed domain name.

The Complainant, Musti ja Mirri Oy, submits the following:

Earlier when the Complaint was first filed, the disputed domain name mustijamirri.com was using a Whois privacy protection service and Whois Privacy Protection Services Inc. was listed as the Registrant (Copy of the printout of the database search conducted on 8 May 2013 was provided). According to the verified information received on 22 May 2013 by the Registrar, the whois protection service has been disabled and the true and correct registrant´s Roberts Online Company Ltd´s contact details are available in the Whois as listed above.

The domain name has been registered and is being used in bad faith. The purpose of the use and registration of the disputed domain name has been, inter alia, to sell the disputed domain name to the Complainant for valuable consideration in excess

of documented out-of-pocket costs directly related to the domain name and to cause disruption to the Complainant's business. Also the purpose of the use and registration of the disputed domain has been, inter alia, an intentional attempt to attract, for commercial gain, Internet users to Robert's Online Company'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 Respondent's web site or location.

By directing the disputed domain name to a website with pay-per-click links to sites of competitors of the Complainant, Robert's Online company is intentionally gaining commercial profit from the use and registration of the disputed domain name and is intentionally benefiting from the Complainant's registered well-known brand and trademark MUSTI JA MIRRI. Further, Robert's Online Company is, by therefore mentioned actions, causing detriment and damage to the Complainant's well-known brand and trademark MUSTI JA MIRRI.

In the present case Robert's Online Company originally directed the disputed domain to their web site koiralle.fi that operates Robert's Online Company's online pet shop like described in detail in the Background section above. This demonstrates disruption to the Complainant's business at the time being and an intentional attempt to attract, for commercial gain, Internet users to Robert's Online Company's web site by creating a likelihood of confusion with the Complainant's mark as to the source or affiliation of Respondent's web site.

Further in the present case Robert's Online Company has also clearly established that Robert's Online Company is not willing to transfer the disputed domain name with the reasonable out-of-pocket costs directly related to the domain name but instead is looking for commercial value through targeting to sell the disputed domain to the Complainant with an unreasonable price request like described in detail in the Background. Firstly, Robert's Online Company has explicitly made known that the disputed domain would be on sale for 3000 EUR+VAT in response to the cease and desist letter in September 2010. Secondly, Robert's Online Company has contacted the Complainant again in March 2013 and asked about the Complainant's interest in buying the disputed domain for 4500 EUR+VAT. In connection to both events Robert's Online Company has been offered a reasonable compensation for the costs of registration of the domain and transferring the domain to the Complainant and which Robert's Online Company has not accepted. Both of these events clearly demonstrate Robert's Online Company's purpose and attempt to gain commercial value and monetary profit with the use and registration of the disputed domain name.

Further in the present case, as Robert's Online Company is doing business at least in the form of an online pet shop for dog supplies under domain name koiralle.fi, Robert's Online Company is a competitor of the Complainant and is well aware the Complainant's business in general as well as the existing company name, trademark rights and domain names prior to the registration of the disputed domain. The Complainant is the largest pet shop chain in Finland, its brand is widely known and has an established reputation and existing registered rights that Robert's Online Company has known already at the time of registration of the disputed domain name. This clearly demonstrates Robert's Online Company's purpose to intentionally cause disruption to the Complainant's business.

Based on the above, the disputed domain name should be considered as having been registered and used in bad faith by the Respondent, Robert's Online Company.

The Complainant requests the Panel to issue a decision that domain name mustijamirri.com be transferred to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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 to have 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.

The Respondent did not submit any Response by the requisite date but did submit an e-mail after the due date. In the circumstances this filing does not add anything and the Panel exercises its discretion under the Rules not to admit this e-mail.

PRINCIPAL REASONS FOR THE DECISION

Introduction

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain an order that the disputed domain name should be transferred from the Respondent to the Complainant:
1. the disputed domain name registered by the Respondent is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

On the basis of the evidence submitted by the Complainant, the Panel makes the conclusions that follow. The prima facie case submitted by the Complainant is not disputed by the Respondent.

Domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights

The Panel finds that the Complainant has demonstrated that it owns trade mark rights in MUSTI JA MIRRI by virtue of its Community word mark registration No. 9367186 on 25 February 2011. The Panel notes that the Complainant also has a Finnish combined device/word mark registration No. 244216 for the MUSTI JA MIRRI mark dating from December 2008, though it and its predecessors appear to have used the mark since 1988.

The disputed domain name is identical to the Complainant’s Community trade mark registration. Therefore the Complainant succeeds under the first element of the Policy.

Respondent has no rights or legitimate interests in respect of the disputed domain name

Paragraph 4(c) of the Policy provides a list of indicia as to whether the Respondent has rights or legitimate interests in the disputed domain name:
1. use of, or preparations to use, the disputed domain name in connection with a bona fide offering of goods or services;
2. the fact that the Respondent has commonly been known by the disputed domain name; or
3. legitimate non-commercial or fair use of the disputed domain name.

The Panel finds that the Complainant has demonstrated that the Respondent has not commonly been known by the disputed domain name. There is no evidence that the Respondent is making a bona fide offering of goods or services under the disputed domain name or that it is making non-commercial or fair use of the disputed domain name.

In circumstances where the Respondent has used the disputed domain name to resolve to a pay-per-click webpage and for

the reasons outlined below the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests. As the Respondent has not rebutted this case, the Panel finds that the Complaint succeeds under the second element of the Policy.

Domain name has been registered in bad faith

Registered in bad faith

The disputed domain name was registered by the Respondent in September 2010, almost two years after the combined word/device MUSTI JA MIRRI mark was registered by the Complainant as a trade mark in Finland. The Complainant has used the MUSTI JA MIRRI trade mark since 1988 and has submitted that it is the biggest pet shop chain in the Nordic countries. As a result, the Panel infers that the Respondent,also in the pet sector and also based in Finland, is more than likely, on the balance of probabilities, to have had knowledge of the Complainant's trade mark rights at the time of registration of the disputed domain name and in the circumstances of use as set out below, the Panel finds that the disputed domain name was registered in bad faith.

Used in bad faith

There is no evidence that the Respondent registered the disputed domain name to provide a bona fide offering of its own goods and services and in fact the disputed domain name at first linked to the Respondent's competitor website and subsequently resolved to a pay-per-click website with links to competitor websites. The delay between the Complainant's initial contact with the Respondent (its cease and desist letter in September 2010) and the current complaint is explained by the fact that the Respondent's immediate use of the disputed domain name had ceased. The Complainant decided not to take any other action in 2010 and was willing to resolve the matter amicably. It was only when the Respondent sought, for the second time, to sell the disputed domain name for considerably more than its out-of-pocket costs, and after the Complainant's counter offer had been rejected by the Respondent, that the Complainant brought these proceedings.

The evidence of repeated requests by the Respondent for payment of considerably more than its out-of-pocket costs, and the Respondent's rejection of the Complainant's counter offers, is indicative of use in bad faith. In HemNet Sverige AB v Leon Kristoffersson / Leon Henry, WIPO Case No. D2012-0339 the Panel concluded that the Respondent's offer to sell the disputed domain name to the Complainant for USD 2,000, following the Complainant's cease and desist letter to the Respondent, was evidence of bad faith. Similarly, in Yahoo! Inc v Mr. Omid Pournazar, Case No. D2012-1612 the Panel concluded that the Respondent's offer to sell the disputed domain name to the Complainant for an amount in gross excess of the registration costs was evidence of bad faith.

In these circumstances the Panel infers that the Respondent registered and used the disputed domain name not for the purpose of providing a bona fide offering of goods or services, but rather for the purpose of diverting customers to its own website and to other competitor websites. This evidence of intentionally attracting Internet users away from the Complainant's website, for commercial gain, is indicative of registration and use in bad faith under paragraph 4(b)(iv) of the Policy. Therefore the Complaint succeeds under the third element of the Policy.

Conclusion

For all the foregoing reasons, the complaint is accepted and the disputed domain name (www.mustijamirri.com) is to be transferred from the Respondent to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MUSTIJAMIRRI.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2013-07-08

Publish the Decision