Decision for dispute CAC-UDRP-100751

Case number	CAC-UDRP-100751
Time of filing	2014-02-18 12:21:37
Domain names	myart.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	My Art

Complainant representative

Organization	CHAIN AVOCATS

Respondent

Name	Mark MIKULLITZ

OTHER LEGAL PROCEEDINGS

There has been a previous decision regarding the same domain name (100281) -- see here after for more details.

IDENTIFICATION OF RIGHTS

“MY-ART”, registered in France on June 8th, 2010 under number 3744624, for goods and services class 9; 16; 35; 38; 40; 41.

FACTUAL BACKGROUND

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

The My-Art Company has been registered on September 10th, 2010 at Bobigny, under the number B 524 782 737 Registre du Commerce et des Sociétés (RCS). Its head office is localised 11, rue Farcot – 93400 SAINT OUEN, FRANCE.

The My-Art Company has developed the website “www.my-art.com” to bring together, artists who want to sell their works and consumers who desire to buy original creations.

Since its creation, The My-Art Company has developed and invested on its internet sale business activity. Indeed, The My-Art Company is now able to propose a big amount of choice of products and offers attractive prices without sacrificing the quality of the production.

For these reasons, The My-Art Company gained notoriety in France and the brand “My-art” has a reputation among French internet consumers.

In this context, the Complainant has decided to register the following trademark in France: “MY-ART”, registered on June 8th, 2010 under number 3744624, for goods and services class 9; 16; 35; 38; 40; 41.

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.

Reason for additional fees :
This case is specific because the Complainant had already filed a complaint in the past, relating to the same domain name; this first complaint was dismissed. The new Complaint is largely similar to the first one; the main difference is that in the meantime, the domain name has been transferred. The Panel requested additional fee because this specificity needed additional work to be assessed properly.

PRINCIPAL REASONS FOR THE DECISION

The same Complainant filed a complaint in July 2011 (#100281) regarding the same domain name. This previous complaint was filed against the then-registrant, being a company registered in Portugal.

The Panel in this first case had determined that "(...) the Complainant brings acceptable evidence of bad faith use and the Respondent did not dispute this, given that no Response was filed. But in the Panel's view, the domain name cannot have been registered in bad faith, contrary to the Complainant's contentions. The disputed domain name has been registered on 18 December 1996, which is more than 13 years before the trademark of the Complainant was filed (...). It is well established that that a domain name that is registered before a trade mark right has been established cannot be found to have been registered in bad faith. The registrant would not have been aware of the complainant’s rights because those rights did not then exist (...)".

Consequently, the then-Panel found that the Complainant had not proven that the then-Respondent registered the disputed domain name in bad faith.

In the meantime, the domain name has been transferred to the actual registrant, an American citizen.

This complaint is largely similar to the previous one, although the respondent has changed. The fact that the Respondent is not the same is sufficient, in the Panel's view, to consider this complaint as a new procedure, totally separate from the

previous one, even if the arguments raised by the Complainant are largely similar to the first complaint.

Is the transfer of the domain name to a new registrant, a new registration? The question is important notably to assess (i) whether the Complainant's trademark was duly registered at the moment of the registration, and (ii) bad faith at the moment of the registration.

This Panel may not agree with the Complainant when it claims that the transfer of a domain name to a third party always amount to a new registration in this regard. The transfer may amount to a new registration, but it is not necessarily the case. It all depends on the fact of each case. It is to the Parties to present arguments and facts in order to explain that due to the circumstances surrounding the transfer, it should (should not) be considered as a new registration.
In this case, the Respondent kept silent, despite several attempts made by the Complainant. The Complainant has clearly argued in its claim that in this case, the transfer should be considered as a new registration. By keeping silent, the Respondent did not take the opportunity to convince the Panel of the contrary. The Panel therefore considers that in this case, the transfer of the disputed domain name amounts to a new registration.

The Complainant has right on the following trademark in France: “MY-ART”, registered on June 8th, 2010 under number 3744624, for goods and services class 9; 16; 35; 38; 40; 41. The Complainant has provided reasonable evidence of due registration of the TM.

The transfer was made at a moment between the first complaint (July, 2011) and today, i.e. after the registration of the complainant's trademark (June, 2010).

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE COMPLAINANT’S TRADEMARK.

The litigious domain name “www.myart.com” contains the same joined words as Complainant’s trademark, without the dash between “my” and “art”. The sole difference between the litigious domain name and the trademark of the Complainant constitutes in fact, on the dash. Moreover, the litigious domain name and Complainant’s trademark cannot be distinguished phonetically.

B. THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED BY THE RESPONDENT WITHOUT RIGHTS OR LEGITIMATE INTEREST IN THE NAME.

This assessment is notably based on the fact the Complainant claims (without being contradicted by the Respondent) that:

- The Complainant has not licensed or otherwise permitted the Respondent to use his brand or to apply for, or use, any domain name incorporating it;

- the litigious domain name is not used for any active web site (the website refers to an error message stating “Address not found”);

- the Respondent has never made any use of it and has not demonstrated that he made preparations to use the disputed domain name in connection with a bona fide offering goods or services.

C. THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED IN BAD FAITH.

Since the transfer/new registration (sometime between 2011 and today) of the litigious domain name by the Respondent intervened after the registration of the Complainant’s trademark (2010), the Respondent was able, at the time of the transfer/registration, to be aware of the Complainant’s trademark.

This is even more the case since a decision was made by a Panel relating to this domain name a few months before this transfer.

D. THE DISPUTED DOMAIN NAME HAS BEEN USED IN BAD FAITH.

This assessment is notably based on the fact that the Complainant claims (without being contradicted by the Respondent) that:

- The domain name is not used actively (“passive holding”);

- There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name.

In addition, the lack of answer from the Respondent while the Complainant is detailed and supported by attached documents supporting it, is another indication of bad faith registration and use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MYART.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2014-04-15

Publish the Decision