Decision for dispute CAC-UDRP-101125

Case number	CAC-UDRP-101125
Time of filing	2015-12-01 12:46:16
Domain names	ad6.media

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Raincat Online Services

Complainant representative

Organization	SCP AUGUST DEBOUZY

Respondent

Name	fluder

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware, except legal proceedings that may be pending, according to the Complainant, arising from the following circumstances.The Complainant states that it sent a complaint to the auction market website "sedo.com" to require the withdrawal of the disputed domain name from the list of domains to be sold on that website. The auction market accepted to remove the disputed domain name from its website. However, another similar complaint arose and has been filed with the auction market website Dynadot for the same reasons as those regarding the complaint to "sedo.com". The Panel is not aware of any legal proceedings that may have arisen from those complaints.

IDENTIFICATION OF RIGHTS

Trademarks

The Complainant is the holder of two Community Trademarks ("CTMs") issued by the Office for the Harmonisation in the Internal Market for AD6MEDIA registered since November 2, 2012 under numbers 011316312 and 011316437 in classes 9 (Electronic advertising displays and apparatus) and 35 (Advertising; advertising research services; dissemination of advertising matter; rental of advertising space; advertising services provided via the Internet; rental of advertising space on-line or via electronic advertising displays or apparatus; dissemination of advertising for others via an on-line electronic communications network) which both predate the disputed domain name registered on April 9, 2015.

In this respect and further to EC Regulation No 207/2009, the Complainant is the only entity to be authorized to use and

exploit its trademarks and/or allow any third party to do so.

FACTUAL BACKGROUND

Factual Grounds

The following statements are taken from the Complaint.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Complainant claims the domain name is confusingly similar to its trademarks on a visual and aural comparison. According to the Complainant, the disputed domain name is very similar to the Complainant's trademarks AD6MEDIA. Indeed, the disputed domain name is composed of the elements "AD6" that refers directly to the Complainant's trademark. In addition, the term "MEDIA" is used as the extension in the disputed domain name, which tends to create a likelihood of confusion with the protected prior trademark.

Furthermore, the Complainant claims the Respondent does not have any rights or legitimate interest in the disputed domain name.

In that respect the Complainant contends, the Respondent is not an affiliate and/or licensee of the Complainant. Therefore, the Respondent does not have any right in the disputed domain name that is identical to the Complainant's protected trademark.

Finally, the Complainant claims the disputed domain name has been registered and is being used in bad faith.

According to the Complainant, the disputed domain name is currently registered for sale on the registrar website after being removed from the auction marketplace website sedo.com on the request of the Complainant. The Respondent does not intend to use the disputed domain name in relation with an offer of goods and/or services. Therefore, the disputed domain name has been registered and is currently used in bad faith. In addition, according the Whois record of the disputed domain name, the Respondent's email address is associated with 1577 domains. This tends to demonstrate that the Respondent is currently trying to benefit from the registration of several domains and has not intent to use them in relation with an offer of goods and/or services.

RESPONDENT:

The Respondent filed a Response and in it the Respondent made the following contentions.

According to the Respondent, the disputed domain name is neither identical nor confusingly similar to the protected mark for the following reasons:

The ICANN rules only apply to what’s left of the dot. Otherwise this is an abuse of the administrative proceeding. Under general policies if you have a trademark on “Merry Christmas” you can make a sunrise claim on MerryChristmas.Christmas but not Merry.Christmas.

In support of its claims the Respondent refers to the decision of the arbitration panel of ISNIC Zoetis Products, LLC, no. 1/2013. his dispute concerned the domain name registered Zoet.is with the .is extension. And the Panel conclusion was "if the suffix "is" were viewed as part of the website name in this context it would be unavoidable to view the dot that separates the word "zoet" from the suffix as a part of the website name. This leads to the conclusion that the registered trademark cannot be viewed as identical with said website name. It is thus not possible to take the view that the condition is satisfied that the website name be transferred as claimed is identical to the registered trademark. The claim of the complainant that the website name be transferred must therefore be rejected."

Thus - according to the Respondent - the first condition 4(a)(i) is not satisfied.

Furthermore, the Respondent claims rights and/or legitimate interest in the disputed domain name.

This domain was registered in the US, and there is no trademark in the US, so it is free to use it in US. And so the Respondent believes to have rights to register it in the US.

The Respondent claims that AD6 is an acronym and the Complainant does not hold the exclusive rights for the words “ad6” for every category of use in the world. Furthermore the Respondent provides claims that Ithere are many of trademarks including word “ad6” registered all around the word but only provides evidence of one figurative trademark which is not registered by the Complainant. "AD6" term has different meanings as the other registered trade marks provided for the same trade mark show and would not necessarily be associated with the objector. Such terms are legitimately subject to registration as domain names on a ‘first come, first served’ basis.

Thus, the second condition 4(a)(ii) is not satisfied

Finally, the Respondent claims the disputed domain name has not been registered and used in bad faith.

The Respondent claims it registered the disputed domain name only to promote New gTLD Program and especially dot MEDIA extension, not for commercial gain, or to create a likelihood of confusion.

This is important for the success of the new domain extensions, that a lot of companies embrace new gTLDs and know the dot MEDIA potential, making it the perfect choice for anyone looking to create an online presence.

New gTLDs and especially dot MEDIA extension will open up new space in which companies can improve security, build trust and authenticity, embrace new business opportunities, and support new business models, and they have to know it, that's why we registered this domain, to focus on it.

Therefore, the Respondent is of the opinion that whether they buy the domain from the Respondent or via UDRP, the only thing that counts is that they use it and dot MEDIA will become more relevant and popular, which Respondent claims to be its goal.

Moreover, the Respondent emphasizes that price of $500 is not considered as a commercial gain. The Respondent did not request a valuable consideration in excess of out-of-pocket costs. It is a relatively modest sum, far removed from the sort of amounts which were typically sought by "cybersquatters".

The sum $500 fairly represents the intrinsic value of the domain name, lower than median price across all sales in SEDO market place which is $616, and the lost opportunity costs associated with its sale. Thus the Panel cannot conclude that our price can be described as a "hold-up" as an economist would use that term.

In Chanel v Goldman, Case No. D2000-1837 (WIPO feb. 13, 2001) the panel declined to hold the respondent in "bad faith" for offering to sell her domain name for $738 " to cover the cost of registration and Respondent's attorney fees". The Panel ruled that "the amount requested does not seem in excess of out-of-pocket costs directly related to the domain names"

The Respondent claims its domain names are not used to target the types of products sold by any specific trademark holder. Accordingly, based upon the website associated with the disputed domain name, only made to explain why new gTLDs are essential, the Panel cannot identify any way in which the Respondent could be said to have intentionally created a likelihood of confusion with the Complainant’s mark as the Complainant contends.

The Complainant has not presented evidence that the Respondent is attempting to disrupt the business of a competitor.

According to the Respondent, the Complainant has not presented evidence that the Respondent, for commercial gain, have intentionally attempted to attract Internet users to his website or other online location by creating a likelihood of confusion as to Complainant acting as source, sponsor, affiliate or endorser of his website or online location.

Thus, the third condition 4(a)(iii) is not satisfied.

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 Complainant contends it filed a complaint with the auction marketplace website Dynadot requesting the withdrawal of the disputed domain name from the list of domains to be sold. Paragraph 18(a) of the Rules gives the panel discretion to suspend, terminate or continue an UDRP proceeding where the disputed domain name is the subject of other pending legal proceedings. In that regard, it should be noted that the object of such proceedings was not the status (cancellation or transfer) of the domain name, but only the withdrawal of the disputed domain name from the list of domains to be sold on a specific website. Therefore, the Panel shall proceed to a decision on the administrative proceeding.

Furthermore, by nonstandard communication dated December 10, 2015 the Complainant submitted additional statements. Pursuant to Paragraph 12 of the Rules the Panel has discretion whether to accept an unsolicited supplemental filing from either party. For the statements of the Complainant made in its supplemental filing doesn't shed any new light on case itself the Panel - bearing in mind the need for procedural efficiency - finds the unsolicited supplemental filing inadmissible.

Otherwise, 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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated December 2, 2015 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that it provided an insufficient identification of the Respondent. The notification drew attention to the registrar’s verification available in the online case file in the form of a non-standard communication dated December 2, 2015 regarding the appropriate identification of the Respondent (its State/Province and Postal code are missing).

In accordance with Paragraph 4 (d) of the Rules, the Complainant was requested to correct the above-mentioned deficiencies and submit an amended Complaint within five (5) days of receiving the notification. The amended Complaint was to be submitted using the Form "Amend Complaint" available on the CAC's on-line platform in the left-hand menu of the Case File.

On December 3, 2015 the Complainant filed an Amended Complaint and the CAC determined that in view of the amendments so made, the Complaint should be forwarded to the Respondent.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:
(i) The 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 domain name; and
(iii) The domain name has been registered and is being used in bad faith.
The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <ad6.media> is confusingly similar to the two AD6MEDIA trademarks (hereinafter referred to as "the AD6MEDIA trademark") for the following reasons. The domain name, including the new gTLD ".media", consists of the entirety of the trademark. Respondent has merely taken the first part of the AD6MEDIA trademark and registered it under the new gTLD ".media", creating a domain name that is the same as the trademark as a whole. Although it is generally accepted that a gTLD is ignored these purposes, in the present case as with some other cases arising under the new gTLDs, the addition of the gTLD underlines and emphasizes the confusingly similarity between the domain name and the trademark..

Moreover, internet users would naturally believe that the domain name <ad6.media> is linked to the Complainant's advertising activities carried on under the AD6MEDIA trademark.

The Complainant has also adduced evidence that the Panel accepts that it is the registered owner of the AD6MEDIA trademark and as such has rights in it.

The Respondent has submitted that the domain name is not identical or confusingly similar to the AD6MEDIA trademark, principally for the reason that "(t)he ICANN rules only apply to what's left of the dot". That statement, as explained above, has been the usual practice, but as has also been explained, the advent of the new gTLDs has meant that a new issue has arisen, namely whether the new gTLD should be taken into account. There is nothing in the rules to say that it must never be taken into account where the gTLD underlines and emphasizes the confusing similarity between the domain name and the

trademark. The Panel believes that in some cases, such as the present, it should be considered, especially where the presence of the new gTLD goes to make up a complete expression that is identical with a trademark.

In any event, even if the Respondent is correct on this issue, the result would be the same, as comparing only <ad6> with AD6MEDIA would still make internet users think that <ad6> was invoking the trademark AD6MEDIA.

Accordingly, the domain name is confusingly similar to the Complainant's trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.
Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the domain name <ad6.media>. That prima facie case is made out from the following considerations.

The Respondent chose for the disputed domain name, without the Complainant's authorization, the "ad6" part of the Complainant's AD6MEDIA trademark and has registered it in the ".media" extension, thus creating the domain name <ad6.media> which is the same as the AD6MEDIA trademark in its entirety .

The Complainant also advances the following additional reasons in support of its proposition that the Respondent has no rights or legitimate interests in the disputed domain name. It is first submitted that the Respondent is not an affiliate and/or licensee of the Complainant. It is then submitted that the disputed domain name is currently registered for sale on the registrar's website after being removed from the auction marketplace website sedo.com on the request of the Complainant, a communication from Sedo to that effect being annexed to the Complaint. It is also submitted that the Respondent does not intend to use the disputed domain name in relation with an offer of goods and/or services. In addition, according the Whois record of the disputed domain name, the Respondent's email address is associated with 1577 domain names , tending to suggest that the Respondent is currently trying to benefit from the registration of several domain names and has no intention to use them in relation with an offering of goods and/or services.Finally, the Complainant submits that as the Complainant is the holder of the AD6MEDIA trademark, the Complainant is the only entity authorized to use and exploit the trademark and any unauthorized use of a sign that is identical and/or similar constitutes an infringement under the applicable legislation, namely EC Regulation 207/2009.

The Panel accepts these submissions and the evidence on which they are based. The Panel therefore finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

The Respondent has filed a Response to the claims of the Complainant and the question therefore arises whether it has rebutted the prima facie case against it on this issue. The Panel finds that the Respondent has not succeeded in doing so.

The Respondent's case in this respect is in substance that "This domain was registered in US, and there is no trademark in US, so it is free to use it in US. And so we have rights to register it in US.

Moreover AD6 is an acronym and complainant does not hold the exclusive rights for the words “ad6” for every category of use in the world. Indeed, there are many of trademarks including word “ad6” registered all around the word Annexe5. "AD6" term has different meanings as the other registered trade marks provided for the same trade mark show and would not necessarily be associated with the objector. Such terms are legitimately subject to registration as domain names on a ‘first come, first served’ basis."

The Panel does not accept those arguments. First, the domain name was not registered in the United States; it was registered with a registrar that is domiciled in the United States and as the internet is worldwide it does not matter where the registrar is domiciled and the ICANN Policy and Rules make no such distinction. Nor is there any obligation on a complainant to rely on a United States trademark even if the respondent registers the disputed domain name in a country other than the United States; indeed, such an obligation would contrary to the Policy and would negate the concept of the worldwide internet.

Accordingly, as the Panel does not accept the Respondent's arguments, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 domain name; or
(ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website 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 website or location or of a product or service on the site or location.

The Complainant has put forward several reasons why, in its submission, the Panel should find that the Respondent registered and used the disputed domain name in bad faith.

First, it was submitted that the disputed domain name is currently registered for sale on the registrar's website after being

removed from the auction marketplace website of sedo.com on the request of the Complainant, as indicated by an attached communication from Sedo. This evidence tends to suggest that the Respondent registered the domain name with the intention of selling it to the Complainant or a competitor, thus putting the Respondent in breach of paragraph 4(b)(i) of the Policy.

The Complainant then submitted that Respondent has never intended to use the disputed domain name in relation with an offer of goods and/or services. There is no evidence that the Respondent ever intended to use the domain name for an offer of goods and/or services and it appears unlikely that it ever intended to do so. Finally, the Complainant submitted that as, according the Whois record of the disputed domain name, the Respondent' email address is associated with 1577 domain names, the inference should be drawn that the Respondent is currently trying to benefit from the registration of several domain names and has no intention to use them in relation with an offer of goods and/or services.

The Panel accepts those submissions and the evidence on which they are based and finds that the Respondent registered and used the disputed domain name in bad faith.

The Respondent in reply has submitted, first, that it registered the domain only to promote New gTLD Program and especially dot MEDIA extension, not for commercial gain, or to create a likelihood of confusion. The Panel does not accept this argument as it is inherently unlikely and unpersuasive. Moreover, if that were the Respondent's true motivation, it could reasonably be expected that the Respondent would have done something with the domain name other than put it up for sale.

Secondly, even if the price of $500 was not seen as excessive, it does not negate the inference that the Respondent was more motivated by making some money by selling the domain name rather than promoting the attractions of the new gTLDs.

Thirdly, the Respondent submits that

"Our domain names are not used to target the types of products sold by any specific trademark holder." That may be so, but the fact is that internet users would assume that the domain name and the website to which it would lead were an official domain name and website of the Complainant. When the internet user finds that the domain name does not lead to a website promoting the Complainant but to a website where the domain name is for sale, he or she would naturally be confused, it would disrupt the Complainant's business and, as has already been pointed out, simply raise the inference that the Respondent did not register the domain name for altruistic reasons but to make money out of selling it.

In any event, the Panel finds that, apart from the specific criteria of bad faith set out in the Policy, the whole of the evidence shows that the registration of the domain name and the use to which it has been put by the Respondent, constitute bad faith registration and use within the generally accepted meaning of that expression.

After considering carefully all of the arguments advanced by the Respondent, the Panel is of the view that they do not defeat the Complainant's case on this issue.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AD6.MEDIA**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

2015-12-26

DATE OF PANEL DECISION 2015-12-26

Publish the Decision