Decision for dispute CAC-UDRP-100355

Case number	CAC-UDRP-100355
Time of filing	2012-01-19 17:38:39
Domain names	genericshop24.ORG

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	mProvement B.V. (also) GenericShop24.Com

Complainant representative

Organization	Gravendeel Advocaten BV

Respondent

Name	Ralf Plummer

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided that relate to the domain name <www.genericshop24.org> (the "Disputed Domain Name").

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the domain name <“www.genericshop24.com”>. From this website the Complainant sells assorted pharmaceutical products. The Complainant does not currently own any registered trade marks for GENERICSHOP24. A Community Trade Mark (“CTM”) Application for the trade mark GENERICSHOP24 is currently pending. The Complainant asserts common law rights in the trade mark.

FACTUAL BACKGROUND

The Complainant is a company with its legal seat in Hilversum, Netherlands. The Complainant submits that the Disputed Domain Name, which is currently registered in the name of the Respondent, should be transferred to it. In support of this, the Complainant alleges that the content on the Respondent’s website infringes its copyright as the content on that website is identical to that at www.genericshop24.com. The Complainant further alleges that the Respondent, through the text on its website, is deliberately creating a false impression that its website is associated with the Complainant’s website, thereby misleading the public. The Complainant also alleges trade mark infringement in the word mark GENERICSHOP24, and fraud.

In the original Complaint, the Respondent was listed as Ralf Plummer. However, due to a subsequent assignment of the

Disputed Domain Name, the Amended Complaint lists Ralf Plummer, or in the alternative, Linh Wang as Respondent.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

Under paragraph 4(a)(i) of the Policy, the Complainant must prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. This is a two part test. While it is accepted by the Panel that the trade mark and the Disputed Domain Name are confusingly similar, the Complainant has failed to prove, to the satisfaction of the Panel and for the reasons outlined below, that it has rights in the trade mark GENERICSHOP24 for the purposes of the Policy.

Because this is an essential element of the claim, it is not necessary to deal with paragraphs 4(a)(ii) and (iii) of the Policy (see Pet Warehouse v Pets.com, Inc., WIPO Case No. D2000-0105).

NO RIGHTS OR LEGITIMATE INTERESTS

In light of the Panel's finding above, it is unnecessary for the Panel to address this issue.

BAD FAITH

In light of the Panel's finding above, it is unnecessary for the Panel to address this issue.

PROCEDURAL FACTORS

The Complainant has listed Ralf Plummer and Linh Wang as Respondents in the Amended Complaint because the Disputed Domain Name appears to have been transferred in the meantime to Linh Wang. The Panel is satisfied that both Respondents have been served appropriately as required under the Rules.

The Panel is therefore satisfied that all procedural requirements under the Policy and the Rules have been met and there is no reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant does not currently own any registered trade marks for the word mark GENERICSHOP24. Its pending CTM for GENERICSHOP24 does not constitute trade mark rights for the purposes of the Policy.

Accordingly, in order to demonstrate trade mark rights, the Complainant must establish common law rights in the mark through proof of secondary meaning, or acquired distinctiveness. Relevant evidence which may prove secondary meaning can include the amount of sales made under the mark, the length of time it has been used in the course of trade, the nature and extent of advertising which makes use of the mark, consumer surveys and media recognition (Amsec Enterprises, L.C. v Sharon McCall, WIPO Case No. D2001-0083). Specific examples of use of the mark will also be helpful in establishing secondary meaning. The Complainant has failed to provide any such evidence in its Amended Complaint; only the following bald assertions have been made:

1. “the wbsite [sic] text pretends to represent the genericshop24.com company, which name has been embodied in the trademark and tradename of mProvement BV and therefore remains important.”

2. “Complainant has a right to its yet registered Trade Name in the Netherlands and Germany (first unregistered but rights derived out of the use do apply).”

3. “Complainant has a right to its yet registered Trade Mark in the Netherlands and Germany (first unregistered but National i.e. Benelux and German rights derived out of the use do apply, and also based on advertising and publicity prior to the EU mark application of 14.12.2011).”

4. “The disputed domain name contains Complainant's trademark and tradename in full, together with some generic terms, which meaning is related to Complainant's business. Therefore, the disputed domain name is confusingly similar to Complainant's trademark and trade name.”

These assertions are unsupported by evidence, and fall well short of the standard of proof typically required under the Policy to show that the Complainant has the requisite common law or usage rights in respect of the trade mark GENERICSHOP24 (see eg, Continental Casualty Company v Andrew Krause / Domains by Proxy, Inc. WIPO Case No. D2008-0672). In particular, no attempt has been made by the Complainant to support the claims that “rights derived out of the use do apply” or that rights “based on advertising and publicity” exist.

The Panel further notes that a trademark application is not sufficient evidence to establish that the Complainant has rights in that mark for the purposes of the Policy (see eg, Alpine Entertainment Group, Inc. v Walter Alvarez WIPO Case No. D2006-1392; First Tuesday Limited v The Startup Generator and Christopher Stammer, WIPO Case No. D2000-1732; Monty and Pat Roberts, Inc. v J. Bartell, WIPO Case No. D2000-0300).

Accordingly, the Panel finds that the Complainant has failed to demonstrate that it owns relevant trade mark rights under the Policy, thus failing to fulfil the requirements of the first element of the Policy.

The Panel notes that if the Complainant considers that it has a case for copyright infringement, unfair competition or fraud against the Respondent, then these matters are beyond the scope of the Policy, and should be pursued through national courts.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **GENERICSHOP24.ORG**: Remaining with the Respondent

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2012-03-05

Publish the Decision