Decision for dispute CAC-UDRP-101090

Case number	**CAC-UDRP-101090**
Time of filing	**2015-10-07 09:44:58**
Domain names	**storvikaqua.com**

Case administrator

Name	**Kateřina Navrátilová**

Complainant

Organization	**Storvik Aqua AS**

Respondent

Organization	**Tetsuo Kaneko**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings the Panel which are pending or decided and which relate to the disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant relies on its company name "Storvik Aqua SA" as well as several domain names consisting of the name "Storvik Aqua". The Complainant also relies on common law or unregistered rights in the name "Storvik Aqua".

FACTUAL BACKGROUND

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

The Complainant is a Norwegian company established in 1994 that trades internationally under the name "Storvik Aqua" in the field of aquaculture. Originally a subsidiary of Storvik AS which was established in 1913, the Complainant operates its main websites at www.storvik.no and www.storvikaqua.no and owns a number of domain names consisting of the terms "storvik" and "storvikaqua", including <storvik.no> and <storvikaqua.no> as well as <storvikaqua.co.uk>, <storvik-aqua.com>, <storvikaqua.cl> and <storvikaqua.cn>.

The Respondent is an individual based in Japan that appears to be in the business of acquiring domain names.

The disputed domain name is <storvikaqua.com> (the Domain Name). It was originally registered by the Complainant in 2012, but it was allowed to lapse by the Complainant in mid-2015 and was subsequently acquired by the Respondent on 27 May 2015. The Domain Name is at the time of writing of this decision pointing to a website displaying text in Japanese and pictures of women in business attire.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts that the Domain Name and its name "Storvik Aqua" are identical except for the space between "Storvik" and "Aqua". The Complainant further states that the Domain Name will be associated with the Complainant, since internet users are likely to search for the Complainant under the ".com" extension instead of the ".no" country code extension for Norway, especially as the Complainant was previously the owner of the Domain Name.

The Complainant asserts that the Respondent has set up a website that has no connection to the Domain Name and therefore the Complainant believes that the Respondent is engaging in domain name speculation.

The Complainant further states that it uses the domain name <storvikaqua.no> for its Scandinavian customers and that the website associated with the Domain Name is very damaging to its business and reputation. The Complainant highlights that it is the owner of several other domain names consisting of the terms "storvik" and "storvikaqua", including <storvik.no>, <storvikaqua.no>, <storvikaqua.co.uk>, <storvik-aqua.com>, <storvikaqua.cl> and <storvikaqua.cn>.

RESPONDENT:

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 trade mark 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

Language of the Proceedings

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement is Japanese and so the language of the proceedings should be Japanese, unless otherwise agreed by the parties. The Complaint, however, was filed in English. Further to the Center's notification of the Complaint's deficiency, the Complainant submitted a request to change the language of the proceedings into English based, inter alia, on the following reasons:

1) The Complainant is a Norwegian company and translating the Complaint into Japanese would cause unnecessary delay and cost;

2) The Complainant considers that English will be a neutral language and that the spirit of the Policy is to consider both parties' level of comfort. The Complainant refers to WIPO Case No. D2005-0057 wherein it was stated that "The Panel’s discretion must be exercised in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding be not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.";

3) The Complainant further asserted that the Respondent was the owner of several hundred domain names many of which were in Roman characters and therefore the Complainant believes that the Respondent is familiar with the English language (the Respondent has provided a list of domain names owned by the Respondent).

The Provider sent the written notice to the Respondent in both English and Japanese. Therefore, the Respondent had an opportunity to respond but chose not to do so. Having considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, the Panel accepts the Complaint in English and shall render its decision in English. See paragraph 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

Additional submission

Paragraph 12 of the Rules provides that "in addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties".

On 11 December 2015, the Panel issued an order requesting the Complainant to provide additional evidence of unregistered trade mark rights by 22 December 2015 and gave the Respondent an opportunity to provide a submission specifically in relation to the Complainant's additional submission by 4 January 2016.

On 21 December 2015 the Complainant provided the additional evidence requested. The Respondent did not respond by the aforementioned deadline.

The Panel has therefore taken into consideration the additional evidence submitted by the Complainant.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the Domain Name, the Complainant must prove the following three elements:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

(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.

Paragraph 15(a) of the Rules provides that the Panel shall decide a 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. Furthermore, paragraphs 10(b) and 10(d) of the Rules provide that the Panel shall ensure that the parties are treated with equality and shall determine the admissibility, relevance, materiality, and weight of the evidence.

Paragraphs 10(a) and 10(c) of the Rules also provide that the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules and shall ensure that the administrative proceeding takes place with due expedition.

In addition, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, the Rules, the Panel shall draw such inferences therefrom as it considers appropriate.

The Panel notes that the Respondent did not reply to the Complainant's contentions. The Respondent's failure to respond,

however, does not automatically result in a decision in favour of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules.

Taking the aforementioned provisions into consideration, the Panel finds as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Panel to consider first whether the Complainant has established relevant trade mark rights. The Complainant relies on its company name and domain names. However, a company name and/or domain name registration in and of themselves are generally insufficient to establish relevant trade mark rights for the purpose of the Policy. The Complainant however also appears to rely on its unregistered trade mark rights and so the Panel is therefore required to examine whether the Complainant can lay claim to common law or unregistered trade mark rights in the term STORVIK AQUA - that is, whether such terms have acquired distinctiveness or "secondary meaning" to the extent that it identifies the Complainant's goods or services.

The Complainant has asserted that it has been trading in Norway and internationally under "Storvik Aqua" for a significant number of years in connection with fish farming equipment and has submitted evidence of its business activities and goodwill (also available on its website(s)). Furthermore, a brief search on Google's search engine reveals that most if not all references to "Storvik Aqua" refer to the Complainant.

The Panel is therefore satisfied that the Complainant has established unregistered rights in STORVIK AQUA for the limited purpose of the Policy.

The Panel is also required under paragraph 4(a)(i) of the Policy to examine whether the Domain Name is identical or confusingly similar to the Complainant's trade mark. The Panel notes that the Domain Name incorporates the Complainant's trade mark in its entirety and finds that this is sufficient to establish identity or confusing similarity for purpose of the Policy.

The top-level suffix ".com" is generally disregarded under the confusing similarity test as it is a functional element.

The Panel therefore finds that the Domain Name is identical to the Complainant's trade mark.

The Complainant has therefore satisfied paragraph 4(a)(i) of the Policy.

B. Rights or legitimate interests

Paragraph 4(a)(ii) of the Policy requires a complainant to demonstrate that the respondent has no rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy sets out a list of non-exhaustive circumstances that may suggest that a respondent has rights or legitimate interests in a domain name, including but not limited to:

"(i) before any notice to you 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 (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 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."

The Complainant has been trading under the name STORVIK AQUA for a considerable period both in Norway and internationally. The Complainant has not authorised the Respondent to make any use of its trade mark. There is no evidence that the Respondent is commonly known by the Domain Name. Furthermore, the Respondent's use of the Domain Name, as described above, cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or

fair use of the Domain Name.

The Panel therefore finds that the Complainant has made a prima facie showing that the Respondent lacks rights or legitimate interests in the Domain Name and that the Respondent has failed to rebut such a showing.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registration and use in bad faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that may indicate that the Domain Name was registered and used in bad faith, including but not limited to:

"(i) circumstances indicating that [the respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the disputed domain name; or

(ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trade mark or service 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online 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 respondent's] website or location".

The Complainant's trade mark appears to be distinctive of the Complainant's products and does not seem to have any other meaning except in relation to the Complainant. The Panel is of the view that the Respondent was likely aware or should have been aware, as would have been revealed by a brief search on an Internet search engine, of the Complainant's trade mark rights at the time of registration of the Domain Name.

The Respondent appears to be in the business of acquiring and selling domain names. Whilst the practice of acquiring and selling domain names for profit is not in itself illegitimate, it is so when the domain name in question is identical or confusingly similar to a trade mark and there is evidence that it was acquired to take advantage of its trade mark value. Furthermore, prior panels deciding under the Policy have held that "a sophisticated domainer who regularly registers domain names cannot be 'wilfully blind' to whether a particular domain name may violate trademark rights". See Mahindra & Mahindra Limited v. Portfolio Brains LLC, WIPO Case No. D2009-0209. The Panel therefore finds that the Domain Name was registered in bad faith.

The Panel also finds that the Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website, in accordance with paragraph 4(b)(iv) of the Policy.

The fact that the Complainant had inadvertently allowed the Domain Name to lapse does not eliminate the Respondent's bad faith, particularly given the distinctiveness of the Complainant's trade mark. Prior panels under the Policy have also held that "[t]he purpose of the Policy is to discourage cybersquatting, which is the use of domain names to take advantage of trademarks owned by other persons. The fact that the domain name with the same trademark had expired does not mean that the Respondent has any right to use a well-known trademark as its domain name when such use could cause confusion to consumers and damage to the owner of the trademark". See Donna Karan Studio v. Raymond Donn, WIPO Case No.

D2001-0587.

The Complainant has therefore satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STORVIKAQUA.COM**: Transferred

PANELLISTS

Name	**David Taylor**

DATE OF PANEL DECISION 2016-01-11

Publish the Decision