



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

— ADNDRC is a charitable institution limited by guarantee registered in Hong Kong

Decision Submission

English Print

Decision ID	DE-0200005
Case ID	HK-0200006
Disputed Domain Name	www.europet.com
Case Administrator	natalielee
Submitted By	M Scott Donahey
Participated Panelist	M Scott Donahey

Date of Decision	19-10-2002
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The Parties Information

Claimant	Europet Benelux, B.V.
Respondent	Theera Theerakulchai

Procedural History

On August 15, 2002, the Hong Kong office of Asian Domain Name Dispute Resolution Centre ("ADNDRC") received the Complaint form filed by the Complainant Europet Benelux, B.V. ("Complainant"). On August 20, 2002, the Hong Kong Office of ADNDRC transmitted the Complaint to the Respondent, Theera Theerakulchai ("Respondent").

The Hong Kong Office of ADNDRC received payment in the correct amount for a single-person panel. On August 21, 2002, the Hong Kong office of ADNDRC served a Notification of the Commencement of the Proceedings on Respondent. Service of the Notification of the Commencement of the Proceedings was simultaneously made on ICANN and the Registrar, Tucows.

On August 21, 2002, the Hong Kong Office of ADNDRC requested Tucows to confirm that the domain name at issue was registered by Respondent and that the registration agreement provides for resolution under the Uniform Domain Name Dispute Resolution Policy (the "UDRP"). On August 21, 2002, Tucows confirmed the above. On September 24, 2002, the Hong Kong Office of ADNDRC requested that the parties rank the five candidates for Panelist in order of preference. On September 24, 2002, the Hong Kong Office of ADNDRC received from the parties the rankings of the five candidates in order of preference.

On September 10, 2002, the Hong Kong Office of ADNDRC received the Response, and on September 11, 2002 it served its Acknowledgment of the Receipt of Response and forwarded the Response to the Complainant. On October 3, 2002, pursuant to the Hong Kong Office of ADNDRC Supplemental Rules, Art. 8(4), the Hong Kong Office of ADNDRC appointed Mr. M. Scott Donahey, as the highest mutually ranked candidate, to serve as Panelist and notified the parties of the Panel' s appointment. All documents submitted by both Complainant and Respondent were sent to Panelist by email, fax and courier.

Factual Background

For Claimant

Complainant is private limited company incorporated in the Netherlands. Complainant is a leading manufacturer and retailer of pet related products both in Europe and WorldWide. Claimant also has appointed distributors and agents to market products under the EUROPET trademark in many countries, including the United States, Singapore, and Hong Kong. Since 1990 it has had a distributor and agent in Thailand operating under the name Europet (Thailand) Company Limited. Complaint, Annex III. Complainant has expended significant sums in advertising the trademark EUROPET

around the world and has realized significant income from the sale of EUROPET trademarked items. Complaint, Annexes IV, VII and VIII. Claimant has registered its EUROPET mark in several countries, including Canada, application filed July 20, 1998, and registration issued August 23, 2001. Complaint, Annex V. The mark, EUROPET, has also been registered with the European Community, effective January 31, 2000. Id. Complainant, through its agent in Thailand, has applied for a trademark in Thailand. Complaint, Annex VI.

When Complainant learned that Respondent had registered the domain name at issue, it sent Respondent a cease and desist letter, demanding that Respondent surrender the domain name to Complainant. Complaint, Annex X. Respondent refused.

For Respondent

Respondent is an individual resident of Bangkok, Thailand. Respondent registered the domain name at issue in October 1998. Respondent contends that the name was registered for the purpose of hosting a web site to display photographs and journals of his honeymoon to Europe in 1997. He added the "t" to Europe both because it represented his last name and also could stand for "trip."

Respondent has failed to develop a web site in the four years that he has held the registration, allegedly because of a "lack of time and financial resources."

Parties' Contentions

Claimant

Complainant contends that the domain name at issue is identical to the fanciful mark EUROPET in which Complainant has rights. Complainant contends that Respondent has no rights or legitimate interests in respect of the domain name at issue. Complainant contends that Respondent registered and is using the domain name in bad faith.

Respondent

Respondent contends that he had never heard of Complainant or Complainant's mark and that Respondent came up with the same fanciful term serendipitously. Respondent contends that he has rights and legitimate interests in the domain name at issue because he intends to use the name to resolve to a web site at which he will display journals and photographs of his honeymoon in Europe.

Findings

Identical / Confusingly Similar

Paragraph 15(a) of the Uniform Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- 1) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) that the domain name has been registered and is being used in bad faith.

Identical or Confusing Similarity

The Panel finds that the domain name "europet.com" is identical to the mark EUROPET in which Complainant has rights, since from the very outset of the UDRP, Panels have disregarded the TLD in comparing domain names to marks. *Digitronics Inventioning Corporation v. @Six.Net Registered*, WIPO Case No. D2000-0008; *Credit Management Solutions, Inc. v. Collex Resource Management*, WIPO Case No. D2000-0029. Where the domain names are identical, the issue of likelihood of confusion is not germane. *Shirmax Retail Ltd./Detailants/Shirmax LTEE v. CES Marketing Group, Inc.*, eResolution Case No. AF0104.

Rights and Legitimate Interests

Respondent contends that he was unaware of Complainant or its marks until he was contacted by Complainant and, that this contact occurred after Respondent had independently coined the same fanciful term that Complainant had trademarked and decided to use it to resolve to a web site to commemorate his honeymoon in Europe. Although the domain name was registered four years ago, the web site has yet to be constructed.

The Panel finds that Respondent's creation story lacks credibility. In any event, in order to show rights or legitimate interests by use or preparation to use, Respondent must show "demonstrable preparations" or actual use occurring "before any notice... of the dispute." ["Any of the following circumstances . . . if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate . . . rights or legitimate interests to the domain name, . . . (i) before any notice . . . 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 . . ." UDRP, 4(c)(i).] Respondent produced no evidence of such demonstrable preparations and conceded that he had made no use of the domain name at issue.

Accordingly, the Panel finds that Respondent has no rights or legitimate interests in respect of the domain name.

Bad Faith

Respondent contends that it could not have acted in bad faith since it had no knowledge of Complainant's business name or of its trademarks. From the very beginning Panels have recognized that it may be very difficult, if not impossible, for a Complainant to prove actual knowledge in the face of denial of such knowledge by a Respondent. Thus, Panels have found constructive knowledge where the Respondent is in the same community as Complainant and should be aware of Complainant's existence and marks. See, e.g., R & A Bailey & Co. v. WYSIWYG, WIPO Case No. D2000-0375 ("The fact that the Respondent claimed not to be aware of the Complainant's trademarks at the time that he registered the name, [sic] does not assist him. First, it strains credulity to accept that Mr. MacNeill a person of Irish nationality, did not understand that Bailey's, an Irish company with an internationally recognized product, would not have intellectual property rights associated with its name and product in the United States"). In this case, while Complainant is located in another country, Complainant's agent, having the mark as part of its business name, is located in Respondent's country of residence and is marketing goods in Respondent's country of residence under the EUROPET trademark.

It has also been held that the passive holding of a domain name for a lengthy period of time with no effort to utilize the name is the equivalent of bad faith registration and use. In the leading case, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, it was established that "inaction" can constitute bad faith registration and use. Whether inaction constitutes bad faith depends on an analysis of the facts of this case. The Panel finds that where as here 1) the name is a fanciful name and that Respondent's description of creating the term is not credible, 2) where Complainant's agent had been operating in Respondent's country for some years and marketing products under Complainant's trademark, and 3) where Respondent has taken no steps to use the domain name in the four years since it was first registered by Respondent, the inaction by Respondent constitutes bad faith registration and use.

Accordingly, the Panel finds that Respondent's inaction constitutes bad faith registration and use. UDRP, 4(b)(i).

Status

www.europet.com

Domain Name Transfer

Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4(i) of the UDRP, the Panel requires that the registration of the domain name "europet.com" be transferred to the Complainant.

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