

# **.nz Dispute Resolution Service**

**DRS Reference: 1309**

**PROJETCLUB**

**v**

**BandeeXoft Kft**

## **Key words -**

### **Identical or similar trademark**

Registered mark – well-known mark – identical

### **Unfair Registration**

Offer to sell – refusal to transfer after “cease and desist” request – likely to confuse, mislead or deceive

## **1. Parties**

### **Complainant:**

PROJETCLUB  
4 boulevard de Mons 59650  
Villeneuve d'Ascq  
France

Represented by M. Alexandre Nappey of Scan Avocats, Paris, France

### **Respondent:**

BandeeXoft Kft  
András FODOR  
Czobor utca, 39/A  
1147 Budapest Hungary

(Not represented)

## **2. Domain Name/s**

EASYBREATH.CO.NZ

## **3. Procedural history**

The Complaint was lodged on 06 July 2018 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 09 July 2018. The domain was locked on 09 July 2018, preventing any changes to the record until the conclusion of these proceedings.

No Response was received.

The Complainant paid Domain Name Commission Limited the appropriate fee on 30 August 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Sir Ian Barker QC, the undersigned, (“the Expert”) confirmed to the DNC on 03 September 2018 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

The Complainant is a subsidiary of DECATHLON, a large French corporation which sought to file the Complaint in its name. However, the owner of the registered trade mark is PROJETCLUB so the Expert has changed the name of the Complainant for that reason and a further explanation of this change can be found in the following clause’

#### **4. Factual background**

- 4.1. The Complainant, PROJETCLUB is a subsidiary company of DECATHLON, a French corporation which is one of the largest manufacturers and retailers of sporting equipment and accessories in the world. Established in 1976, DECATHLON operates in some 1171 stores in 38 countries with some 78,000 employees and annual sales of nearly 10 billion euros.
- 4.2. DECATHLON designs and manufactures, inter alia, products for water sports, including diving and snorkelling. In 2014 it produced the EASYBREATH snorkelling mask to improve underwater breathing. This product has been successfully marketed in many countries and is available to people in New Zealand through Decathlon’s Australian website.
- 4.3. The Complainant has an International Trademark, registered on 10 June 2014 for the word EASYBREATH. Priority date under the Paris Convention is 10 December 2013. New Zealand is one of the designated jurisdictions under the Madrid Protocol. Hungary (where the Respondent is domiciled) is also designated.
- 4.4. The Complainant (or DECATHLON) owns numerous domain names consisting of or incorporating the word EASYBREATH such as <easybreath.fr>, registered on 23 October 2013.
- 4.5. The Disputed Domain Name was registered on 25 July 2016. It originally resolved to a webpage which redirected users to a page which showed copies of the Easybreath masks with the mention “coming soon”. More recently, the Disputed Domain Name resolves to a webpage which indicates that the Disputed Domain Name is for sale.
- 4.6. Neither the Complainant nor its parent company gave the Respondent any kind of authority or permission to reflect the registered trade mark in the Disputed Domain Name. The Respondent is not an authorised distributor for the products of the Complainant or its parent company.
- 4.7. Lawyers for the Complainant have sent several letters to the Respondent requiring him to “cease and desist”. On 6 September 2017, the Respondent told the lawyers that he did not believe that the Complainant had a registered

trade mark in New Zealand and that he had clients who wanted to sell the product there. He refused to transfer the Disputed Domain Name as requested for reimbursement of registration costs and offered to sell it for “a fair price”. The Respondent ignored further letters from the Complainant’s lawyers refusing his offer to sell the Disputed Domain Name.

## **5. Parties’ contentions**

### **a. Complainant**

- 5.1. The Disputed Domain Name is identical to the Complainant’s registered trade mark with no other words added.
- 5.2. The Disputed Domain Name is an unfair registration because it is a blocking registration which prevented the Complainant from registering in New Zealand a domain name incorporating its registered trade mark .
- 5.3. The exact coinciding of the Disputed Domain Name and the Complainant’s trade mark cannot be coincidental.
- 5.4. The Respondent registered the Disputed Domain Name in order to sell it for an excessive amount. The Disputed Domain Name is being used in a way which misleads and/or confuses internet users into thinking that the Respondent has some connection with the Complainant or its parent.
- 5.5. The Respondent clearly knew of the Complainant’s rights since he claimed in his correspondence with the Complainant’s lawyers that his “Clients” had contacted the leadership of DECATHLON to market the mask in New Zealand.

### **b. Respondent**

- 5.6. The Respondent made no submissions.

## **6. Discussion and findings**

- 6.1. The dispute is governed by the following relevant portions of the Policy:

“3. Definitions ...

**Unfair Registration** means a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR
- (ii) has been, or is likely to be used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

4. **Dispute Resolution Service**

- 4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure that:

- 4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 4.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.

5. **Evidence of Unfair Registration**

5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 – 5.1.5:

- 5.1.1 Circumstances indicating the Respondent has registered or otherwise acquired the Domain Name primarily:
  - (a) for the purposes of selling, renting or otherwise transferring the 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 associated with acquiring or using the Domain Name;
  - (b) as a blocking registration against a name or mark in which the Complainant has rights; or
  - (c) for the purpose of unfairly disrupting the business of the Complainant; or
- 5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the complainant;
- 5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .nz or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;
- 5.1.4 The Complainant can demonstrate that the Respondent has knowingly given fake contact details to a Registrar and/or to the DNC; or
- 5.1.5 The Domain Name was registered arising out of a relationship between the Complainant and the Respondent, and the circumstances indicate that it was intended by both the Complainant and the Respondent that the Complainant would be entered in the Register as the Registrant of the Domain Name.”

6.2. In order to support a complaint the Complainant must satisfy three elements:

- (a) Rights in respect of a name or mark (para 4.1.1);
- (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and
- (c) Unfair registration in the hands of the Respondent (para 4.1.2).

Each of these elements is addressed below:

**6.3. Rights in respect of a name or mark (Para 4.1.1 of Policy)**

- (a) In terms of assessing whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name the Expert must consider the wording of the Policy.
- (b) The expression “Rights” is referred to in the definition of “Unfair Registration” in paragraph 3 of the Policy. It is directed to a Domain Name which “took unfair advantage of or was unfairly detrimental to Complainant’s Rights in some way”. The primary question is whether some disadvantage or detriment occurs in relation to the Complainant’s Rights.
- (c) The Complainant must establish the requisite Rights in order to establish that some form of disadvantage or detriment is likely to occur through the existence or use of the Domain Name by the Respondent.

6.4. The Complainant’s trade mark is deemed to be registered in New Zealand by virtue of the Madrid Protocol which was incorporated into New Zealand law in 2012.

**6.5. Identity or similarity (Para 4.1.1 of Policy)**

- (a) The Complainant’s Mark and the Domain Name both contain, as an essential part, the word “EASYBREATH”. The mark and the Disputed Domain Name are identical.
- (b) This ground is thus established.

**6.6. Unfair registration (Para 4.1.2 of Policy)**

- (a) The Expert needs to be satisfied that the Respondent has registered or otherwise acquired the Domain Name primarily for certain purposes.
- (b) The primary question under Rule 4.1.21 of the Policy is whether the Domain Name, in the hands of Respondent, is an Unfair Registration.

*Selling, renting or otherwise transferring the Domain Name*

6.7. The Respondent has agreed to transfer the Domain Name but only on the basis that he is paid “a fair price”. He rejected transferring the Disputed Domain Name for the reimbursement of the cost of registering the domain name.

6.8. The registration by the Respondent of the Disputed Domain Name constitutes an unfair registration, in that the Disputed Domain Name was registered primarily for the purpose of selling the Disputed Domain Name for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring the Disputed Domain Name.

*Blocking Registration*

- 6.9. The Respondent has used the Disputed Domain Name to attempt to negotiate a commercial arrangement with the Complainant. To that extent, unless and until the Domain Name was handed over, in the Respondent's hands the Domain Name amounted to a blocking registration. He prevented the Complainant from registering and using the Disputed Domain Name.
- 6.10. Under the circumstances, the Disputed Domain Name amounts to a blocking registration.
- 6.11. This is a clear case of cybersquatting where the Respondent has reproduced a well-known mark in a domain name in the hope of profiting therefrom and at the same time, confusing and misleading internet users.

## **7. Decision**

The Complainant has thus established its case and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from the Respondent to the Complainant.

### **Place of decision**

**Date** 5 September 2018

**Expert Name** Hon Sir Ian Barker QC

**Signature:**

A handwritten signature in blue ink that reads "Ian Barker". The signature is written in a cursive style with a horizontal line underneath the name.