

.nz Dispute Resolution Service

DRS Reference: 1387

EUTELSAT S.A.

v

Cui LONG

Key words –

Identical trade mark - registered trade mark – unfair registration – offer to sell domain name – pattern of registrations – links to competitor websites.

Registrar: Netim

1. Parties

Complainant:

EUTELSAT S.A.
70, rue Balard
PARIS
FRANCE

Represented by: Enora MILLOCHEAU, NAMESHIELD

Respondent:

Cui LONG
CHINA

Registrar: Netim

2. Domain Name

eutelsat.nz

3. Procedural history

- 3.1.** The Complaint was lodged on 29 April 2020 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 29 April 2020. The domain was locked on 29 April 2020, preventing any changes to the record until the conclusion of these proceedings.
- 3.2.** No Response was received from the respondent.
- 3.3.** The Complainant paid Domain Name Commission Limited the appropriate fee on 20 July 2020 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

- 3.4. Andrew Brown QC, the undersigned, (“the Expert”) confirmed to the DNC on 29 July 2020 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.

4. Factual background

- 4.1. Branded ‘EUTELSAT’, the Complainant states it is one of the leading operators in the commercial satellite business. Its fleet of 39 satellites serves broadcasters, video service providers, telecom operators, ISP’s and government agencies operating across Europe, Africa, Asia and the Americas. These satellites are used for video broadcasting, satellite newsgathering, broadband services, and data connectivity. The Complainant states it has a support team of over 1,000 industry professionals from 46 countries, and that its services cover the majority of the globe (including Australia and New Zealand). The Complainant operates a website at <https://www.eutelsat.com>.

Depiction	Country	TM No.	Registered	Nice Classification
EUTELSAT	International	479499	20 June 1983	07,09,12,16,35,38,41
EUTELSAT	International	777505	31 December 2001	09, 16, 35, 37, 38, 41, 42
EUTELSAT	New Zealand	760943	19 December 2006	09, 35, 37, 38, 41, 42

- 4.2. The Complainant claims rights in its trade mark EUTELSAT extending back to 1983. The Complainant is the owner of the following trade marks relevant to its ‘EUTELSAT’ brand:

- 4.3. These are hereafter collectively referred to as the ‘EUTELSAT Mark’.
- 4.4. The Complainant also owns several domain names, including <eutelsat.com>, registered since 29 October 1996, and <eutelsat.co.nz> registered since 20 November 2012.
- 4.5. The disputed domain name was registered on February 12, 2020. It resolves to a parking page with commercial links related to the Complainant’s activities. The Complainant states the Disputed Domain Name is also offered for sale on the website

5. Parties’ contentions

a. Complainant

- 5.1. The Complainant asserts that the disputed domain name is identical to its EUTELSAT Mark because the ccTLD ".nz" is irrelevant to the analysis.
- 5.2. The Complainant states that the Respondent has no rights or legitimate interests in the Disputed Domain Name. It is not related to the Complainant's business nor does the Complainant carry out any activity for, nor have any business with the Respondent.
- 5.3. The Complainant contends that the Respondent's registration and use of "EUTELSAT" in the Disputed Domain Name is for the purpose of obtaining an unfair advantage through purported association with the Complainant's internationally established brand. The Complainant contends that the Respondent registered the Disputed Domain Name to create a likelihood of confusion with its EUTELSAT Mark.
- 5.4. The Complainant's evidence is that an online search of the term "EUTELSAT" resolves to multiple websites associated with the Complainant. The Complainant asserts that these search results, the distinctiveness of its EUTELSAT Mark, and its international reputation in that mark, mean it is reasonable to infer that the Respondent was aware of the EUTELSAT Mark when it registered the Disputed Domain Name. This assertion is further supported by the evidence that the parking page to be found at the Disputed Domain Name has links to the sort of commercial activities the Complainant is involved in, for example "Satellite Communication".
- 5.5. The Complainant states the parking page located at the Disputed Domain Name contains links to the Complainant's competitors' activities. By resolving to a parking page with commercial links related to the type of services provided by the Complainant, and by offering of the Disputed Domain Name for sale on the website, the Complainant argues the Respondent's registration and use of the Disputed Domain Name takes unfair advantage of or is unfairly detrimental to the Complainant's Rights. The Complainant suggests that internet users seeking out the Complainant's Eutelsat website may be misled to believe there is an association between the Respondent's website and the Complainant's brand, and that this is unfair and prejudicial to the Complainant because it takes advantage of the Complainant's goodwill and could damage its reputation.
- 5.6. Finally, the Complainant's evidence is that the Respondent is engaged in a pattern of registrations of domain names comprising third-party trade marks overseas, and that this registration is therefore one of a pattern.

a. Respondent

- 5.7. There was no Response to the Complaint.

6. Discussion and findings

- 6.1. The Complainant is required to satisfy the Expert on the balance of probabilities that it has met the requirements of paragraph 4 of the Policy, namely 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."

a. Rights

6.2. The term “Rights” is defined in paragraph 3 of the Policy:

“**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business.”

6.3. As set out at 4.2 of this decision, the Complainant has registered trade marks for the mark “EUTELSAT” both in New Zealand and as international registrations. A trade mark registered in New Zealand is a right enforceable under New Zealand law. The Complainant has qualifying ‘rights’ in respect of its EUTELSAT Mark.

b. Identical or similar

6.4. The Disputed Domain Name <eutelsat.nz> is identical to the EUTELSAT Mark because the ccTLD “.nz” is irrelevant to the analysis (see DRS No. 1181, *Salvatore Ferragamo S.p.A v. Yan Sun*), and the Disputed Domain Name and the EUTELSAT Mark are otherwise exactly the same.

6.5. The requirements in paragraph 4.1.1 of the Policy are therefore satisfied.

c. Unfair registration

6.6. Unfair Registration is defined in paragraph 3 of the Policy as follows:

“**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.”

6.7. The key issue for determination is whether the Complainant is able to meet either of the limbs of Unfair Registration as defined in paragraph 3 of the Policy. For the reasons below, the Expert is satisfied the Disputed Domain Name was an Unfair Registration.

i. Respondent’s Awareness of EUTELSAT Mark

6.8. There is no evidence that the Respondent is commonly known by Eutelsat, or that it is legitimately connected with a mark similar to the Disputed Domain Name. The EUTELSAT Mark is distinctive. The Disputed Domain Name is identical to the EUTELSAT Mark. A simple online search of “EUTELSAT” resolves to numerous websites associated with the Complainant. The Complainant has an international reputation and is well known in its field. The Expert considers that the Respondent was aware of the EUTELSAT Mark when it registered the Disputed Domain Name. In this regard the Expert takes into account the lack of response from the Respondent.

ii. Disputed Domain Name offered for sale for significant sum

6.9. 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 of the Policy.

Pursuant to the invitation in the Complaint the Expert has viewed the website located at the Disputed Domain Name. This website offers the Disputed Domain Name for sale for a price of US \$1,771. Pursuant to paragraph 5.1.1(a) of the Policy, acquiring a domain name primarily for the purposes of selling it for an amount in excess of out-of-pocket expenses, is one indication of unfair registration:

- 5.1.1. Circumstances indicating that 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.

6.10. The sum of US \$1,771 is well in excess of any likely out-of-pocket expenses that could have been incurred by the Respondent.

iii. Pattern of Registrations

6.11. Paragraph 5.1.3 of the Policy lists 'a pattern of registrations' as one of the other categories of unfair registration:

- 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;

6.12. The evidence is that the Respondent has previously engaged in a pattern of registrations of domain names comprising third-party trade marks overseas (see *Ruby Life Inc. v Cui Long* WIPO Case No. D2019-0358 at 5.C where it was said of the same Respondent that the "Respondent has used domain names consisting of the trademarks of others as domain names in the past, and has been previously found to be acting in bad faith in so doing. Such conduct occurring repeatedly such that it demonstrates a pattern of bad faith"). The Disputed Domain Name is part of this pattern of registrations, and that this is evidence of unfair registration under paragraph 5.1.3.

iv. Links to Competitors' websites

6.13. The parking page located at the Disputed Domain Name is said to contain links to the Complainant's competitors' websites. It is not clear from the Complaint whether these links are pay per click. The evidence to the Complaint provides a screenshot of the Respondent's website, which appears to contain hyperlinks to, inter alia, 'Communication', 'Satelite' [sic], 'TV Sat', 'Sat', 'Satellite Communication'.

6.14. The Expert has been unable to verify that the links are to competitors' websites, as the website at the Disputed Domain Name has been changed, and now offers the domain name for sale without providing any links. In the absence of any response from the Respondent, the Expert is prepared to take the Complainant's screenshot as prima facie evidence of links to the Complainant's competitors, and therefore prima facie evidence of use in a manner which was unfairly detrimental to the Complainant's Rights.

6.15. For all of these reasons, on the balance of probabilities the Expert finds that the Disputed Domain Name constitutes an Unfair Registration.

7. Decision

7.1. For the foregoing reasons, the Expert orders that the Domain Name <eutelsat.nz> be transferred to the Complainant.

Place of decision

Auckland

Date

12 August 2020

Expert Name

Mr Andrew Brown QC

A handwritten signature in blue ink, appearing to read "Andrew Brown".

7.2. Signature