

Alternative Dispute Resolution (ADR)

DECISION

2011-10-21

TICKETNUMBER

504

APPLICANT

Agfa-Gevaert NV & Co. KG

50670 Köln

Germany

Counsel:

Novagraaf Belgium N.V./S.A.

1170 Brussels

Belgium

OPPONENT

Name Navigation

102 14 Stockholm

MATTER

Alternative dispute resolution regarding the domain name **agfa.se**

DECISION

The request for transfer of the domain name **agfa.se** is rejected.

BACKGROUND TO THE DISPUTE

On April 4, 2011 the domain name agfa.se was registered by the Opponent.

In an application dated May 19, 2011, the Applicant has applied for alternative dispute resolution and that the dispute should be decided by a sole adjudicator. Since the Opponent requested the matter to be tried by three adjudicators, the Applicant appointed Ms. Monique Wadsted as adjudicator. The Applicant filed a compliment to the original application, which was communicated to the Opponent.

The Opponent responded on June 27, 2001, and requested the matter to be tried by three adjudicators, and appointed Mr. Per Carlson as adjudicator.

On July 12, 2011 Peter Hedberg was appointed as the presiding adjudicator and the matter was brought to the attention of the adjudicators.

The adjudicators have communicated the question of ownership of agfa.se to the parties in order to determine to whom the Applicant has directed its claims to. The Applicant has answered the Adjudicators' invitation for comments. It has been confirmed by the Opponent that this matter shall be deemed to have been addressed to the correct party.

CLAIMS

The Applicant has claimed that the domain name agfa.se shall be transferred to the Applicant.

The Opponent has contested the claim.

FACTS OF THE CASE / PARTIES' CONTENTIONS

The Applicant

The disputed domain name agfa.se is identical or confusingly similar to series of trademarks, domain names, company names and trade names of the Applicant, including trademarks with legal effect in Sweden, e.g CTM registration no. 8820979 AGFA. The oldest, still active trademark, is dated 1923 and is registered in Australia.

Agfa-Gevaert NV & Co. KG is active in the graphical sector, the healthcare sector (medical imaging), printing and photo sector. The Applicant enjoys a worldwide reputation.

The Opponent has no rights or legitimate interests to register the domain name in question, since he does not own any trademark or domain name containing the word AGFA and has no prior right to this term. The Opponent has not been commonly known by the mark AGFA. The Applicant has not licensed or otherwise authorized the Opponent to use the name/mark AGFA.

The Opponent has registered and is using the disputed domain name in bad faith as evidenced by several factors. The AGFA trademark is exceptionally well known worldwide and far predated the Opponent's activities. The mark AGFA is so well known that that the Opponent could not ignore the existence and must have been aware of it when registering the domain name agfa.se.

The domain name agfa.se was in quarantine at the registry and Agfa-Gevaert NV & Co. KG was monitoring the release in order to register the name. The Opponent was also monitoring the release and obtained the domain name before the Applicant, on the day of the release, April 4, 2011. This action blocked Agfa-Gevaert NV & Co. KG to register the domain name and thus hindered normal business activity.

The fact that the Opponent has chosen a domain name identical to a well known trademark is *per se* a clear indication of bad faith. This also makes it clear that the Opponent's registration was done in order to attract Internet user to his website and to increase revenue in this manner. The use of the trademark AGFA by an unlicensed party as a domain name with an intention of misleading or deceiving consumers and is considered as a trademark infringement and it violates the rules of fair competition.

Agfa-Gevaert NV & Co. KG contacted the Opponent prior to this ADR procedure and requested a transfer, but the Opponent denied. This could also constitute bad faith.

The Opponent is using the domain name for a portal. This will dilute the AGFA trademark(s) and trade name and is an attack on the rights and legitimate interest of the Applicant.

The domain name holder has no other justified reason to choose the term AGFA as a domain name as it has no general linguistic meaning, nor is it an abbreviation of the Opponent's trade name.

The Opponent

Name Navigation's line of business is to register, buy, sell and develop domain names. Name Navigation holds one of Sweden's largest domain name portfolios, making the company into one of .SE's largest customers. Moreover, Name Navigation is a strategic partner of Eniro and Google, since both companies display their sponsored links on most of Name Navigation's domains.

The main reason why Name Navigation registered the domain name in question on April 4, 2011, when the domain name was released, is because it is a four letter domain name. These domain names are increasingly sought after, since all three letter domains are registered in Sweden. Furthermore, four letter domains have been shown to be valuable on other markets, e.g on the .com market.

Some of the domain names registered by Name Navigation are released by .SE after they have not been renewed by the previous owners. One can find the domain names that are about to be released on a list. The reason why .SE provides the list is to make the domain names visible for new possibilities and projects, such as the line of business of Name Navigation.

This alternative dispute resolution involves a four letter domain, that more than one participant on the market are interested in. The registration of agfa.se by Name Navigation is part of a strategy launched a few months ago, and not just an isolated registration. Name Navigation has registered four letter domains before and after the registration of agfa.se. Name Navigation had never heard of Agfa-Gevaert NV & Co. KG before it was contacted by the Opponent. Agfa-Gevaert NV & Co. KG is not known by the public, since its line of business is concentrated to business-to-business.

There is nothing in Name Navigation's actions that indicate bad faith when using the domain name. The registration has not hindered the Applicant from business activities in Sweden, since it uses the domains agfahealthcare.se and agfagraphics.se.

Agfa-Gevaert NV & Co. KG is the previous owner of the disputed domain name, but did not renew the domain name. An alternative dispute resolution shall not be the last resort when paying an overdue invoice.

FINDINGS OF THE ADJUDICATORS

A domain name may, in accordance with .SE's General Conditions of Registration paragraph 7.2 be cancelled or transferred to the Applicant in connection to an ADR proceeding if all three conditions below are met.

- a) The disputed domain name is identical or confusingly similar to a trademark, trade name or similar name right, to which the Applicant have right that are in legal force in Sweden,
- b) The disputed domain name has been registered or used in bad faith.
- c) The domain name holder has no rights or legitimate interest in the domain name.

The Adjudicators make the following assessment.

The Adjudicators find that the disputed domain name is identical to the registered CTM no. 8820979 AGFA that has legal force in Sweden.

The Applicant has stated that the trademark AGFA is exceptionally well known worldwide and that the applicant company has a worldwide reputation. On the other hand, the Opponent has alleged that the trademark AGFA and the company behind it (the Applicant) are totally unknown to the Opponent and contests the statement concerning reputation of the mark AGFA.

The Adjudicators do not find that the Applicant's statements of AGFA being exceptionally well known worldwide and of Agfa-Gevaert NV & Co. KG having a worldwide reputation are established in the matter of the alternative dispute resolution, although the Adjudicators recognise that the trademark AGFA has been used in Sweden and worldwide for a significant period of time. Furthermore, since the Opponent has not acknowledged any degree of reputation of the mark AGFA and the Applicant has not put forward any evidence regarding this fact, the Adjudicators do not find that the Applicant has proved that the Opponent, at the time of the registration of the domain name, knew or must have known that AGFA was used as trade mark by the Applicant. Further, the Applicant has not referred to any facts that constitute use of the domain name in bad faith.

Thus, Agfa-Gevaert NV & Co. KG has not proved, that the domain name agfa.se has been registered or used in bad faith. The claim for transfer of the domain name should therefore be rejected.

On behalf of .SE

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Peter Hedberg (pres.)

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Monique Wadsted

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Per Carlson