

Alternative Dispute Resolution (ADR)

DECISION

2010-01-18

TICKETNUMBER

355

APPLICANT

Jem og Fix A/S

7100 Vejle

Denmark

Counsel:

Otello Law Firm/Martin H R

8200 Aarhus N

Denmark

OPPONENT

Terramonte Corporation/Paul T

234 Charlestown

KN

MATTER

Alternative Dispute Resolution for the domain name <jemogfix.se>

.SE decides as follows

DECISION

The domain name <jemogfix.se> is transferred to the Applicant Jem og Fix A/S.

BACKGROUND TO THE DISPUTE

The disputed domain name was first registered on April 16, 2009.

The Applicant, having trademark rights to the mark JEM & FIX, filed an Application for alternative dispute resolution regarding the domain name <jemogfix.se> on December 2, 2009.

The Opponent has not responded within the given deadline.

On January 11, 2010, Petter Rindforth was appointed as the sole Adjudicator in this matter. The Projected Decision Date was February 11, 2010.

CLAIMS

The Applicant claims that the disputed domain name <jemogfix.se> shall be transferred to the Applicant, Jem og Fix A/S.

FACTS OF THE CASE / PARTIES' CONTENTIONS

Applicant

The Applicant, founded in 1986, claims to be a well-known low-cost, "Do-it-yourself" hardware store with 88 stores in Denmark (the first one opened in 1988) and Sweden.

The Applicant is the owner of the following trademark registrations:

CTM No. 2 876 969 "jem & fix" (figurative), registered on April 29, 2004 for goods in Classes 2, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21

Swedish national registration No 376 642 "jem & fix" (figurative), registered on November 25, 2005 for services in classes 35 and 37

The Applicant is also the owner of the following pending application:

Pending CTM Application No. 8 723 959 "JEM & FIX" (word) filed on December 1, 2009 for goods and services in Classes 2, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21, 35, 37

Appendix 2 – 4 of the Application shows excerpts from the official CTM-Online and Swedish PRV register.

The Applicant further refers to its domain name registrations <jemochfix.se> (registered on October 22, 2001), <jemfix.se> (registered on October 21, 2005), <jemfix.com> (registered on January 20, 2005), and <jemogfix.dk> (registered on May 12, 1998). Copies from the official Whois-records provided as Appendix 5 – 8 of the Application.

The Applicant argues that the disputed domain name is confusingly similar to its company name and trade mark JEM & FIX, explaining that the phonetic expression of the trade mark in Danish is “JEM OG FIX”.

The Applicant claims that <jemogfix.se> is used by the Opponent to earn money by exploiting Internet users who are seeking the Applicant's website, that the language of the web site is in Danish, and that the advertises / links at the disputed web site are regarding the same type of goods as sold by the Applicant.

The Applicant states that the Opponent: has no rights for or legitimate interest in the disputed domain name or the term JEM OG FIX, has no trademark rights, is not known by the said term and has no license from the Applicant to use JEM OG FIX in Sweden.

Finally, the Applicant states that the Opponent has registered and is using <jemogfix.se> in bad faith, as it is – according to the Applicant – clearly directed toward Danish consumers with the purpose of using the similarity of the web sites to exploit the Applicants business. The Applicant accuses the Opponent to be a cybersquatter, with over 1 500 registered domain names, such as <huyundai.dk>, <staoll.dk>, and <faceboob.dk> (Appendix 9 – 11 showing Whois information for the said domain names).

Opponent

The Opponent has not contested the allegations of the Applicant.

FINDINGS OF THE ADJUDICATOR

A domain name may, in accordance with .SE's Terms and Conditions of Registration paragraph 6.4(c), in connection to an ADR proceeding be cancelled or transferred to the Applicant requesting such proceeding if

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

Identical or Confusingly Similar

The Applicant has established rights in the **jem & fix** trademark in Sweden through the abovementioned Community Trademark Registration No. 2 876 969 and the Swedish National Registration No. 376 642.

The pending CTM Application No. 8 723 959 is filed after the registration of the disputed domain name. Although the fact that a disputed domain name pre-dates an established trademark right does not *per se* disqualify an applicant to file an Application for dispute resolution under the ATF, the Adjudicator finds no reason to take this *pending* application into further consideration, as the Applicant has established registered trademark rights prior to the registration of <jemogfix.se>.

The Applicant has also referred to its company name rights. The Applicant is a Danish company, registered with the Danish CVR and these rights are not in legal force in Sweden, and can therefore not be considered in this dispute. There are no evidence filed that the said company name is well-known as such in Sweden.

The relevant part of the domain name is <jemogfix>, consisting of the words JEM and FIX from the Applicant's trademark, and the term "og". "Og" is similar to its English and Swedish equivalence "and" and "och", common and obvious transliterations of the ampersand (&). Although "og" as such may not – for a Swedish reader – obviously associate to "och", it is still phonetically almost identical and its meaning between JEM and FIX is clear. In this context, <jemogfix> is literally identical to **jem & fix**, and therefore confusingly similar to the Applicants trademark.

Accordingly, the Adjudicator finds that the domain name is confusingly similar to the Applicants trademark **jem & fix**.

Rights or Legitimate Interest

The Opponent is obviously not an authorized agent or licensee of the Applicant's products or services and has no other permission to apply for any domain name incorporating the trademark **jem & fix**.

By not submitting a Response, the Opponent has failed to invoke any circumstance which could demonstrate any rights or legitimate interests in the domain name.

In addition, the fact that the domain name resolves to a web page (partly) displaying information and services in competition with the Applicant, is not a bona fide offering of goods and services and such use can therefore not establish any rights or legitimate interest.

Finally, there are no indications that the Opponent is known by <jemogfix.se>, as the Whois shows the name of the Registrant/Opponent as Terramonte Corporation / Paul T.

The Adjudicator therefore concludes that the Opponent has no rights or legitimate interests in the domain name.

Registered or Used in Bad Faith

The Applicant, a company registered in Denmark, claims to be well-known with 88 stores in Denmark and Sweden, but offers no supporting evidence of the alleged notability or presence in Sweden.

The Opponent seems to be based in Charlestown, St. Kitts & Nevis, in the Caribbean.

Normally, it would have been hard to find any indications of bad faith from a company/person based in the Caribbean, vis-à-vis a local Scandinavian company. However, the Opponent -having used the disputed domain name for a pay-per-click site with links in Swedish and Danish to competitors of the Applicant, is obviously well informed of the Scandinavian market and of the Applicant's business.

The Opponent has transliterated the ampersand into Danish, and created a domain name that is literally identical to the Applicants trademark. Although it may be argued that JEM & FIX is not a very strong trademark as such for the specific business of “do-it-yourself” stores, it is in fact a registered trademark. In the absence of any Response from the Opponent, this Panel is prepared to accept as a fact that the Applicant is a least locally known, and concludes that there are strong indications that the Opponent registered the disputed domain name specifically with the Applicant in mind.

A further indication of the Opponent’s bad faith registration is the existence of other domain names held by the Opponent, or persons closely related to the Opponent, which seems to be based on misspelled trademarks of others.

Although it is not necessary to deal also with the question of bad faith use, the Adjudicator notes that the Opponent has in fact used <jemogfix.se> for a site with information and links – presumably commercial – to various do-it-yourself and low cost hardware sites, therewith using the fact that Swedish and Danish customers looking for the Applicant may well be confused by Opponent’s web address.

The Adjudicator concludes that the Opponent registered and has used the disputed domain name in bad faith.

On behalf of .SE

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Petter Rindforth