



CPR Institute for Dispute Resolution

COMPLAINANT

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File Number: CPR0316

Date of Commencement: July 16, 2003

Domain Name(s): opval.com

Registrar: EASYSYSPACE LTD

vs.

Single Panelist: Gonzalo F. Gállego Higuera

RESPONDENT

Intrasoft International Limited
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Before Gonzalo F. Gállego Higuera, Single Panelist

PROCEDURAL HISTORY

The Complaint was filed with CPR and, after review for administrative compliance, served on the Respondent on July 16, 2003. The Respondent did not file a Response on or before the due date, August 6, 2003. On August 7, 2003, CPR sent Respondent notice of his failure to provide a Response and that a single Panelist would be appointed pursuant to Uniform Domain Name Dispute Resolution Policy ("UDRP") Rule 6(b). I was appointed Arbitrator pursuant to the UDRP and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including, the Complaint (dated July 1, 2003); certain e-mails in relation to the absence of a Response to the Complainant; a Procedural History; and e-mail correspondence regarding whois information from the registrar, I find as follows:

FINDINGS

Respondent's registered domain name "opval.com", was registered with EASYSYSPACE LTD on October 8, 2001. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, in Paragraph 4(a), that each of the following three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

IDENTITY/CONFUSING SIMILARITY:

Paragraph 4(a) of the UDRP requires the Complainant to "assert" the existence of three elements which must be established in order to appreciate the existence of an abusive registration of a domain name. However, the Complainant is not only required to "assert" the existence of these three elements but - according to Paragraph 4(a) "in fine"- must also "prove that each of these three elements are present". Therefore, the UDRP imposes the burden of proof on the Complainant, who must prove the existence of the elements mentioned in Paragraph 4(a) of the UDRP in order for the Complainant to succeed in its claim. The fact that the Complainant bears the burden of proving the existence of the elements required by Paragraph 4(a) of the UDRP, is commonly accepted in the Decisions taken by the Panels under the UDRP (See, e.g. EK Success, Ltd. vs. Wang Yi-Ching, Case No CPR 0314. CPR June 12, 2003; Goldline International, Inc. vs. Gold Line, Case No D2000-1151. WIPO January 4, 2001), not including proof of the element required in Paragraph 4(a)(ii) of the UDRP (i.e. the Respondent has no rights or legitimate interests in respect of the domain name) for which the Panels have taken different approaches (See, e.g. Do The Hustle, LLC vs. Tropic Web, Case No D2000-0624. WIPO August 21, 2000).

Within the aforementioned three elements, Paragraph 4(a)(i) of the UDRP requires the Complainant to prove that the disputed domain name "is identical or confusingly similar to a trademark or service mark in which the complainant has rights". Therefore, under section (i) of Paragraph 4(a) of the UDRP, the Complainant must "assert" and also "prove" the following conditions in order to be successful in its claim:

- (a) The Complainant has rights over a trademark or service mark.
- (b) The disputed domain name is identical or confusingly similar to such trademark.

In the case at hand, the Complainant alleges and evidences - Exhibit (vii) of the Complaint - that the Respondent is the holder of the domain name "opval.com". On the other hand, the Complainant argues and proves - Exhibit (ix) of the Complaint - that the Complainant has produced a software package called "Opval" which, according to the information provided in the Complaint, is an option evaluation and risk management package widely used in the commodity markets.

Although the Complainant does not expressly assert the existence of this identity or confusingly similarity, this Panel considers that it is evident that the disputed domain name "opval.com" and the name used by the Complainant for the identification of the aforementioned software package "Opval" are identical or, at least, confusingly similar. Therefore, this Panel accepts that the identity or confusing similarity between the disputed domain name "opval.com" and the name "Opval" has been proven for the purposes of Paragraph 4(a)(i) of the UDRP.

However, as mentioned above, Paragraph 4(a)(i) of the UDRP does not only require the Complainant to prove the identity or confusing similarity of the disputed domain name and a name used by the Complainant (as would be the case of the name "Opval") but also to evidence that such name is a trademark or service mark in which the Complainant has rights.

In general terms, the Panelists have identified three conditions with regard to the requirements which must be fulfilled by a name in order to be considered as a "trademark or service mark in which the complainant has rights" for the purposes of Paragraph 4(a)(i) of the UDRP, as follows:

- (a) The name must perform the function of distinguishing the goods or services of one person in trade, from the goods or services of any other person in trade. (See e.g., Brisbane City Council vs. Warren Bolton Consulting Pty Ltd., Case No D2001-0047. WIPO, May 7, 2001).
- (b) The name has either: (A) been registered as a trademark; or (B) not been registered as a trademark but can be considered as a common-law mark. (See e.g., Jensen Research Corporation vs. Future Media Architects, Inc., Case No CPR00 0310. CPR, May 20, 2003).
- (c) The Complainant has, up the date on which the disputed domain name was registered, either: (A) trademark rights over the name registered as a trademark; or (B) common-law rights over the name considered as a common-law mark. (See e.g., Peter Frampton vs. Frampton Enterprises, Inc. Case No D2002-0141. WIPO, April 17, 2002).

In relation to the name "Opval", this Panel considers that the Complainant has proven that such name fulfils the first of the above three requirements - i.e. paragraph (a) -. It is clear from the documentation provided in the Complaint - especially from the brochure included as Exhibit (ix) - that the name "Opval" is used by the Complainant in order to distinguish its software

option evaluation and risk management package in the market.

With respect to the second requirement listed above - i.e. paragraph (b) - the Complainant has not provided any proof which evidences that the name "Opval" has been registered as a trademark. The Complaint states that the Complainant "*has sought the registration of Opval as a trademark*" but has not offered any evidence in relation to the existence, content or date of such application for registration.

On the other hand, the Complainant alleges that the name "Opval" has been used by it for the last 17 years in order to identify the Complainant's software package. This continuous use of the name "Opval" for the identification of the Complainant's product may entail the Complainant to acquire common-law mark rights over the name "Opval" (See e.g. Sealstore.com L.C. vs. Sealpool Limited. Case No FA0101000096535. NAF, March 8, 2001). These common-law rights would be sufficient to fulfill the requirement stated in paragraph (b) above. However, the Complainant has made no effort to prove that the name "Opval" has been used for the identification of its software package for alleged period of 17 years.

Therefore, this Panel finds that the Complainant has not proven that the name "Opval" is a registered trademark or a common-law mark. Thus, the requirement mentioned in letter (b) above has not been evidenced.

Finally - with respect to the third requirement listed in paragraph (c) above - the Complainant has not proven that the name "Opval" was registered as a trademark (or that such registration was applied for) or used as a common-law mark prior to the registration by the Respondent of the disputed domain name "opval.com" (i.e. on October 8, 2001, according to the Exhibit (vii) of the Complaint). Proof of the existence of trademark rights which predate the disputed domain name, has been identified by several Panel Decisions as being essential under Paragraph 4(a) of the UDRP (See e.g., John Ode d/b/a ODE and ODE - Optimum Digital Enterprises vs. Intership Limited, Case No D2001-0074. WIPO, May 1, 2001). "*Some panelists have interpreted paragraph 4(a)(i) of the Policy to require proof of trademark rights in existence as of the date on which the disputed domain name was registered or acquired. Other panelists consider present-day trademark rights sufficient under paragraph(a)(i), but require proof of trademark rights that predate the domain name in order to satisfy the bad faith registration requirement contained in paragraph 4(a)(iii)*" (Jensen Research Corporation vs. Future Media Architects, Inc. Case No CPR00 0310. CPR, May 20, 2003).

This Panel agrees with the above approach. According to either view of the UDRP, the Complainant must prove that it had trademark or common-law mark rights over the name "Opval" as of the date of registration of the disputed domain name "opval.com", and it failed to do so.

As a consequence of the above, this Panel concludes that the Complainant has not proven that the name "Opval" is a trademark or service mark in which it has rights. Therefore, the Complainant has failed to meet the requirement provided in Paragraph 4(a)(i) of the UDRP.

According to Paragraph 15(a) of the Rules for UDRP "*A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable*". In the absence of proof in relation to the existence of a "*trademark or service mark in which the complainant has rights*" as required by Paragraph 4(a)(i) of the UDRP, this Panel considers that it is not possible to make the finding that the disputed domain name "opval.com" is identical or confusingly similar to a protected trademark of the Complainant. The same criteria have been established by other recent Panels Decisions with which this Panel agrees (See e.g., Surefire marketing, Inc vs. Anthony Sama, Case No CPR 00 0315; EK Success, Ltd. vs. Wang Yi-Ching, Case No CPR 0314. CPR June 12, 2003; Greg Lloyd Smith vs. Lucky Allan Short, Case No CPR 0207. CPR March 21, 2002 and Jensen Research Corporation vs. Future Media Architects, Inc., Case No CPR00 0310. CPR, May 20, 2003).

Since the Complainant has not proven the first of the elements required in Paragraph 4(a) of the UDRP, this Panel considers that it is not necessary to make a decision with respect to the second and third elements provided in the same Paragraph of the UDRP.

Notwithstanding the above conclusion, this Panel would like to point out that this Decision is based on the lack of proof with respect to the existence of a trademark or service mark over which the Complainant has rights, but it neither denies nor affirms the existence of such trademark or service mark rights. The Complainant may well have a legal claim against the Respondent, but it has not alleged a viable UDRP claim as has failed to satisfy the requirement of demonstrating trademark or service mark rights which is essential under Paragraph 4(a)(i) of the UDRP. In any case, nothing prevents the Complainant from resubmitting its claim in a new case supported by proper evidence.

CONCLUSION

In light of the absence of a finding that the registered domain name is identical or confusingly similar to Complainant's protected mark, I find in favor of the Respondent.

REMEDY

Complainant's request to transfer the disputed domain name "opval.com" is hereby DENIED.

August 18, 2003

Gonzalo F. Gállego Higuera
Single Panelist

Date