Panel Decision for dispute CAC-ADREU-006152

Case number	CAC-ADREU-006152
Time of filing	2012-03-18 23:07:54
Domain names	petrobras.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization	Petróleo Brasileiro S/A - Petrobras

Respondent

Organization	OEEO Networks Limitd

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

Petroleo Brasiliero S/A - Petrobras (Complainant I), a global energy company, is the proprietor of Community Trade Marks no. 003068211 ("Petrobras") and no. 003080141 ("Petrobras). Both Community Trade Marks were registered in year 2005. Petrobras International Braspetro B.V. (Complainant II) is a subsidiary of Complainant I in the Netherlands that has used the said trademarks in Europe under the authorisation and supervision of Complainant I, including in its business name.

Respondent registered the domain “petrobras.eu” on 7 April 2006. Respondent uses the domain name to host a website which includes both sponsored links as well as prominent text “petrobras.eu is available...get it now!” and “This domain is for sale”. Links “Buy this domain” and “See listing” direct one to service provider aftermarket.com where one may make offers to purchase various domain names, including the disputed domain name.

The Complainants had sent a cease and desist letter to the Respondent on 22 November 2010 demanding that Respondent cease unauthorised use of the disputed domain name. No response or action by the Respondent followed.

The Complainants have submitted this complaint requesting the transfer of the disputed domain name.

A. COMPLAINANT

The Complainants submit that the disputed domain name is a speculative and abusive registration and satisfies the requirements of Article 21 of Regulation (EC) No. 874/2004 of 28 April 2004 (the Regulation) and Rule B11(d)(1) of the ADR Rules.

Firstly, the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law. The disputed domain name is identical or confusingly similar to the PETROBRAS trade marks since the domain name consists of the PETROBRAS word mark in its entirety and differs from the PETROBRAS trade marks only by the necessary addition of the .eu TLD suffix.

Secondly, the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name. The Respondent has no rights or legitimate interest in the disputed domain name, whether by virtue of the circumstances set out in Rule B11(e) of the ADR Rules (corresponding to Article 21(2) of the Regulation)or in any way at all. There appears to be no separate business use by the Respondent of the disputed domain name beyond use in connection with sponsored links and offers to dispose of the disputed domain name. There is no evidence whatsoever that the Respondent is commonly known by the domain name.

Thirdly, the disputed domain name has been registered or is being used in bad faith. The Respondent is offering the disputed domain name for sale. Visitors to the holding page at the disputed domain name are invited to make an offer to the Respondent through the Aftermarket.com service to purchase the disputed domain name. The Complainants submit that due to the prominence in the EU of the PETROBRAS brand, the PETROBRAS trade marks and other registrations incorporating the element PETROBRAS, and the distinctiveness and uniqueness of the PETROBRAS brand indicate that it is highly unlikely that any third party other than the Complainants or those authorised by the Claimants would be able to, or would desire to, make legitimate use of the disputed domain name. There appears to be no separate use, legitimate or otherwise, of the disputed domain name beyond offers for sale of the same. Therefore, the circumstances clearly indicate that the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name to the Complainants as holders of the PETROBRAS trade marks. This is clear evidence of bad faith.

Reference is also made to the pattern of conduct of the Respondent in abusively and speculatively registering .eu domain names. The Respondent has been involved in three previous disputes under the .eu Dispute Resolution Rules regarding .eu domain names (Case 05578, Case 04725 and Case 03565), all three of which resulted in a finding that the registrations fulfilled the requirements of Article 21 of the Regulation and Rule B11(d)(1) of the ADR Rules, and an order transferring the disputed domain name in question to the respective complainant. The facts of these cases are similar to those of the current matter.

The Respondent, by registering and/or using the disputed domain name, has created a likelihood of confusion between the Respondent's use of the domaine name and the PETROBRAS trade marks. The disputed domain name and the website hosted at the domain feature the PETROBRAS trade marks in an unauthorised way and are clearly designed to divert visitors, in particular those seeking information regarding the Complainants' European business, from the Complaints' other official websites such as www.petrobras.com.

The Complainants therefore submit that the disputed domain name is a speculative and abusive registration and satisfies the requirements of Rule B11(d)(1) of the ADR Rules and Article 21 of the Regulation.

Complainant II is a company which meets the eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002. The disputed domain name should therefore be transferred to the Complainant II under B11(b) of the ADR Rules and Article 22(11) of the Regulation.

B. RESPONDENT

On 17 February 2012 the Respondent submitted his reply where he referred to the fact that the parties had reached an amicable resolution of the dispute. The Respondent further expressed his consent to have the disputed domain transferred to the Complainants.

DISCUSSION AND FINDINGS

In consideration of the Factual Background and the Parties' Contentions stated above, the Panel has arrived to the following conclusions:

Pursuant to Article 21(1) of the Regulation (EC) No. 874/2004 of 28 April 2004 (the Regulation) a registered domain name shall be subject to revocation[...] where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith.

The evidence provided by the Complainants shows that Complainant I is the proprietor of Community Trade Marks "Petrobras" (no. 003068211 and no. 003080141 respectively).

The disputed domain name petrobras.eu is identical to the said Complainant's Community Trade Marks since the domain name consists of the "Petrobras" word mark in its entirety and differs from the protected trade marks only by the necessary addition of the .eu TLD suffix.

Subsequently, the remaining issue is whether the disputed domain name has been registered by the Respondent without rights or legitimate interest or whether it has been registered or used in bad faith by the Respondent.

In this regard the Panel first takes into account the fact that the Respondent has submitted a response to the complaint where he has expressed his consent to have the disputed domain name transferred to the Complainants. In the response the Respondent does not claim to have any rights or other legitimate interest in the disputed domain name. The Respondent also does not make an attempt to dispute the Complainants' arguments about the Respondent having registered and using the domain name in bad faith. Thus, the Respondent has failed to put forward any indication that he has registered and uses the domain name as per rights or legitimate interest

he holds in the name or that he uses the domain name in good faith.

The Panel is of the opinion that the Complainants have demonstrated that the Respondent does indeed hold no rights or legitimate interest in the name. There appears to be no separate business use by the Respondent of the disputed domain name beyond the use in connection with sponsored links and offers to sell the disputed domain name. There is no evidence to show that the Respondent has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law.

Furthermore, the Complainants have demonstrated existence of bad faith on the side of the Respondent in the meaning of Article 21(3) of the Regulation. This is evidenced by the fact that the Respondent is offering the disputed domain name for sale. The global prominence of Complainants' business and distinctiveness in the EU of the PETROBRAS brand and trade marks, and the fact of there being no use of the domain by the Respondent for legitimate business purposes, indicate that it is indeed highly unlikely that any third party other than the Complainants would desire to make legitimate use of, and thus attempt to acquire the disputed domain name from the Respondent.

Last but not least, there is clear evidence from previous decisions under the .eu Dispute Resolution Rules involving the Respondent that there is a pattern in Respondent's behaviour where the latter speculatively registers .eu domain names with the intent of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law (See Case no. 05578, Noonan Services Group, Tomas MacGinley vs OEEO Networks Limited, Michael Koplinski (noonan.eu); Case no. 04725, Mills Brothers B.V. vs OEEO Networks Limited, Michael Koplinski (thesting.eu); Case no. 03565, Hans Beckhoff vs OEEO Networks Limited, Michael Koplinski (ethercat.eu)).

In light of the above the Panel finds that the Complainants have satisfied the requirements of Article 21(1) of the Regulation and Paragraph B11(d)(1) of the ADR Rules. Complainant II satisfies the eligibility criteria as per Article 4(2)(b) of Regulation (EC) No 733/2002 of 22 April 2002 and is therefore entitled to obtain the domain name under Paragraph B11(b) of the ADR Rules.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the ADR Rules, the Panel orders that

the domain name PETROBRAS be transferred to the Complainant II ((Petrobras International Braspetro B.V.).

PANELISTS

Name	Triin Toomemets

DATE OF PANEL DECISION 2012-03-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: petrobras.eu

II. Country of the Complainant: Brazil and the Netherlands (Complainant I and Complainant II, respectively), country of the Respondent: Great Britain.

III. Date of registration of the domain name: April 7, 2006.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. CTM "Petrobras", reg. no. 003068211, registered on 12 May 2005;
2. CTM "Petrobras", reg. no. 003080141, registered on 4 February 2005.

V. Domain name is identical to the protected right/s of the Complainants.

VI. Response submitted: Yes; Respondent consents to transfer of the domain name to Complainants.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to lack the rights and legitimate interests: There appears to be no separate business use by the Respondent of the disputed domain name beyond the use in connection with sponsored links and offers to sell the disputed domain name.

2. Rights or legitimate interests the Respondent claims to have: No such claims have been made by Respondent.
3. Does the Panel consider the Respondent to have no rights or legitimate interests: No rights/legitimate interest.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to have registered or use the domain name/s in bad faith: The Respondent is offering the disputed domain name for sale; since there is no use of the domain by the Respondent for legitimate business purposes, this indicates that the offer for sale is primarily directed at the Complainants (it is highly unlikely that any third party other than the Complainants would desire to make legitimate use of, and thus attempt to acquire the disputed domain name from the Respondent). As evidenced by prior ADR cases, there is a pattern in Respondent's behaviour where the latter speculatively registers .eu domain names with the intent of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law.
2. How the Respondent rebuts the statements of the Complainant: No rebuttal arguments by Respondent have been submitted.
3. Does the Panel consider the Respondent to have registered or use the domain name/s in bad faith: Yes

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: None