Panel Decision for dispute CAC-ADREU-006430

Case number	CAC-ADREU-006430
Time of filing	2013-05-27 17:12:11
Domain names	vinci-france.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	Vinci

Respondent

Organization	None

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

To the knowledge of the Panel, there are no other legal proceedings pending or decided that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, VINCI, is a French company, active in concessions and construction in various countries. The Complainant is the holder of inter alia the following registered trademarks that it uses in connection to its business:

- word trademark registered in International (CH, EM, US), reg. No. 1073016, for the term VINCI Finance International, filed on 10 February 2011, registered on 5 May 2011 in respect of goods and services in classes 35 and 36.
- word CTM, reg. No. 010450948, for the term VINCI Concessions Stadium, filed on 15 November 2011, registered on 22 March 2012 in respect of goods and services in classes 6, 9, 16, 18, 19, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45.
- word CTM, reg. No. 7374721, for the term VINCI Autoroutes France, filed on 29 October 2008, registered on 15 April 2009 in respect of goods and services in classes 3, 6, 9, 16, 19, 35, 36, 37, 38, 39, 41, 42, 43 and 44.
- word CTM, reg. No. 9684151, for the term VINCI Highway, filed on 11 January 2011, registered on 27 May 2011 in respect of goods and services in classes 3, 6, 9, 16, 19, 35, 36, 37, 38, 39, 41, 42, 43 and 44.

The disputed domain name, <vinci-france.eu>, has been registered on 8 June 2012 and is held by the Respondent. The disputed domain name refers to a webpage, displaying the Complainant's logo and requesting to authorize the "Plugin Web Vinci" for entering the "web".

A. COMPLAINANT

The Complainant considers the Disputed Domain Name "vinci-france.eu" to be identical or confusingly similar to several marks it holds in the 'VINCI' word or word/logo.

The Complainant considers the Respondent not to have any rights or legitimate interest in the domain name, as the Respondent is not affiliated with or authorized by the Complainant, while the Respondent is referring to the Complainant and incorporating the Complainant's logo on the website linked to the disputed domain name.

Finally, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions.

DISCUSSION AND FINDINGS

The Respondent has not filed a formal Response to the Complaint. In accordance with the provisions of Article 22(10) of Commission Regulation (EC) No 874/2004 ('Regulation 874/2004') and Paragraph B10(a) of the ADR Rules, such failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a Complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21(1) of Regulation 874/2004 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

Article 21(1) of Regulation 874/2004 states that a registered domain name may 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 burden of proof rests on the Complainant. However, concerning the burden of proof regarding a lack of legitimate rights or interests the complainant only needs to establish a prima facie case. Then, the onus shifts to the respondent to rebut the assertion that the respondent lacks legitimate rights or interests. See e.g., Yakult Europe B.V. v. Mark Weakley, CAC 5156, <yakult.eu>; Diehl Stiftung & Co. KG, Ralf Kummer v. H. Klomp, CAC 5824, <diehl.eu>.

1) Identity and/or confusing similarity

Article 10(1) states that:
"[…]
"'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

The Complainant, operating under the company name “VINCI”, shows to be the holder of various community verbal and combined trademarks containing the word “VINCI” together with one or more generic terms (e.g., “VINCI Autoroutes France”, “VINCI Highway”).

The disputed domain name contains the business name of the Complainant, which is also the most distinctive and common element of several of the Complainant’s trademarks, in its entirety and combines it with a hyphen, the geographic identifier “France” and the “.eu” suffix.

It is consensus view that for assessing identity or confusing similarity, the “.eu” suffix has to be disregarded. See e.g., Diehl Stiftung & Co. KG v. H. Klomp, CAC 5824,<diehl.eu>, Bayer AG v. Zheng Qingying, CAC 4661, <bayergarden.eu>.

Also, the addition of descriptive or generic terms to a name for which a right is recognized or established by national and/or Community law does not take away the confusing similarity. See e.g., Monster Finance Limited, Rahat Kazmi v. Monster Worldwide Ireland Limited, CAC 5376, <monsterfinance.eu>, Transfer; Allianz AG v. Gailtaler Computerklinik, CAC 3207, <allianz-online.eu>, Transfer.

In the instant case, the Panel considers that the addition of “-france” to the Complainant’s business name and the most distinctive part of its registered community trademarks creates confusing similarity between the Complainant’s prior rights and the disputed domain name.

2) Rights or legitimate interest

Article 21(2) of Regulation 874/2004 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent may demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods or services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate, non-commercial or fair use of the domain name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or Community law.

In the instant case, the Complainant made a convincing prima facie case that the Respondent has no rights or legitimate interests in the

disputed domain name, as (1) the Complainant has given no license or permission to the Respondent to use the Complainant's trade mark in a domain name; and (2) Respondent is displaying the Complainant's name and logo on the website linked to the disputed domain name without any authorization or affiliation to the Complainant.

According to the Panel nothing in the record indicates that the Respondent has any rights or legitimate interests in the disputed domain name. There is no indication of a legitimate or fair use associated to the disputed domain name.

As a result, Complainant has made a prima facie case that Respondent has no right or legitimate interest in the disputed domain name and Respondent has failed to provide proof to the contrary.

3) Bad faith registration or use

In view of this finding, it is not necessary for the Panel to consider whether the Domain Name is also subject to revocation under Art 21(1)(b) of Regulation 874/2004 (dealing with the question whether the Domain Name was registered or is being used in bad faith).

Request to transfer

The Complainant has requested transfer of the disputed domain name. Pursuant to Article 22(11) of Regulation 874/2004 the Complainants must satisfy the general eligibility requirements set out in Article 4(2)(b) of Regulation 733/2002 before they may be found entitled to a transfer of the disputed domain name. In accordance to these eligibility requirements the disputed domain name may only be transferred to an:

(i) undertaking having its registered office, central administration or principal place of business within the Community, or
(ii) organisation established within the Community without prejudice to the application of national law, or
(iii) natural person resident within the Community.

In the present case, the Complainant is an undertaking with registered offices within the Community. As a result the Complainant satisfies the eligibility criteria and that the Panel may order to transfer to this Complainant.

DECISION

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

the domain name VINCI-FRANCE.EU be transferred to the Complainant.

PANELISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2013-05-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: vinci-france.eu

II. Country of the Complainant: France, country of the Respondent: Finland

III. Date of registration of the domain name: 08 June 2012

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark registered in International (CH, EM, US), reg. No. 1073016, for the term VINCI Finance International, filed on 10 February 2011, registered on 5 May 2011 in respect of goods and services in classes 35 and 36.
2. word CTM, reg. No. 010450948, for the term VINCI Concessions Stadium, filed on 15 November 2011, registered on 22 March 2012 in respect of goods and services in classes 6, 9, 16, 18, 19, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45.
3. word CTM, reg. No. 7374721, for the term VINCI Autoroutes France, filed on 29 October 2008, registered on 15 April 2009 in respect of goods and services in classes 3, 6, 9, 16, 19, 35, 36, 37, 38, 39, 41, 42, 43 and 44

4. word CTM, reg. No. 9684151, for the term VINCI Highway, filed on 11 January 2011, registered on 27 May 2011 in respect of goods and services in classes 3, 6, 9, 16, 19, 35, 36, 37, 38, 39, 41, 42, 43 and 44
5. company name: VINCI

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: No authorization to use the Complainant's trademark. The Respondent is unrelated to the Complainant, but is referring to Complainant's trademark on the website associated to the disputed domain name without indications of any legitimate or fair use.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. no decision

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: absence of response by Respondent

XII. Is Complainant eligible? Yes