Panel Decision for dispute CAC-ADREU-006449

Case number	CAC-ADREU-006449
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Domain names	cheapjackwolfskins.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KG

Respondent

Organization	Wolfskin apparels co. ltd

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

none

FACTUAL BACKGROUND

The Complainant is a registered company named “Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KG” and is based in Idstein/Taunus, Germany. The Complainant uses the domain jack-wolfskin.de for commercial purposes and is the owner of several German and Community Trademarks containing “JACK WOLFSKIN” and is using them.

The Respondent registered the domain name “cheapjackwolfskins.eu” in October 2012 under the name of Wolfskin apparels co. ltd. and offers clothing and goods of the Complainant.

On 20th of February 2013, the Complainant initiated ADR proceedings. The Complainant, represented by Harmsen Utescher, Patent Law Firm, Henrik Dirksmeier, submitted a complaint against the Respondent claiming that the Respondent registered the “cheapjackwolfskins.eu” domain name without rights or legitimate interest and in bad faith and that, therefore the registration should be declared abusive within the meaning of Article 21 of EC Regulation No. 874/2004 (hereinafter “Public Policy Rules”).

The Czech Arbitration Court did not receive any Respondent’s communication within the deadline and the Respondent was finally notified to submit its Response.

According to the ADR Rules, Paragraph B3 (f), the Respondent and the Complainant were informed by the case administrator of the Respondent’s default. The Respondent did not react even within the following five days after receiving this notification (i.e. it did not challenge the notice of Respondent’s Default according to Paragraph B3 (g) of the ADR Rules).

A. COMPLAINANT

According to the Complainant, the Respondent is using the confusingly similar Domain Name intentionally to attract Internet users for commercial gain.

The disputed name is the Complainant’s name of firm and is also used as a trademark. Hence, “JACK WOLFSKIN” is a name for which the following rights are recognised within the German and Community legal system. The protection of trade names is granted under §§ 5, 15 Markengesetz (Trade Marks Act) whereas the registered name of a company is protected by §§ 17 et seqq. of the Handelsgesetzbuch (German Commercial Code). It’s also granted under Art. 9 Abs. 1 a), Art. 98 CTMR.

- the term in question is distinctive and fulfils the function of a name. In this regard, distinctiveness means that the firm name is capable

of creating the association with a specific company amongst others (Baumbach/Hopt, HGB, § 18, No. 4).

- The Complainant is a limited liability company (Kommanditgesellschaft) registered in the German companies´ registry of the civil court Amtsgericht Wiesbaden, HRB 19421 and is the user of the domains e. g. jack-wolfskin.de, jack-wolfskin.uk.co for company purposes.

- The Complainant is the owner of

the Community Trademark “Jack Wolfskin”, EM 6733208, with priority as of 06 March 2008
the Community Trademark “Jack Wolfskin + paw device”, EM 3034915 with priority as of 31 January 2003
the German Trademark “Jack Wolfskin” DE 1049490, with priority as of 23 August 1982

The Respondent registered the disputed domain name without rights and legitimate interest in the name and established a website with an e-shop similar to the Complainant’s website using the Complainant’s Trademarks without authorization and with a confusingly similar layout, elaborated according to Paragraph B 1 (b) (10) of the ADR-Rules

The Respondent uses wordings like for example “Jack Wolfskin Onlineshop”, pretending to be an official dealer of the Complainant

The present complaint is based on the fact that the domain name “CHEAPJACKWOLFSKINS.EU” is partly identical to the name “JACK WOLFSKIN” which is protected under German and Community law. Even if the full name “Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KG ” would have to be considered, the domain name would still be confusingly similar to the related trademarks and company name. The use of terms identical or similar to the protected names causes a substantial danger of confusion between the enterprises in question.

Legitimate interests in using the name "Jackwolfskins” cannot be found on the part of the Respondent. It is also apparent that the Respondent has used the domain name in connection with outdoor retail in Europe as well.

The Complainant insists that the Respondent registered the domain name without rights and legitimate interest and in bad faith and that, therefore, such registration is speculative and abusive within the meaning of Article 21 of the Public Policy Rules. Intention of creating likelihood of confusion of the Respondent is obvious.

The Respondent, Wolfskin apparels co. ltd., provided a postal address in Italy, a phone number in Germany and a registrar in U.S.A.. The address and the telephone number mentioned in the official database of EURID are faked.

B. RESPONDENT

The Respondent failed to provide its Response within the required deadline and did not respond in any way.

DISCUSSION AND FINDINGS

1. According to Article 22 (1) (a) of the Regulation (EC) No 874/2004 an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21 of the aforementioned or the decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No. 733/2002. Following Article 22 (11) of the Regulation (EC) No 874/2004 the ADR panel shall decide that the domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

In the present case, the Complaint has been brought against the Registrant. Therefore, the question is whether the use of the domain is speculative or abusive within the meaning of Article 21 the Regulation (EC) No 874/2004. According to this disposition and Paragraph B 11 (d) (1) of the ADR.eu Alternative Dispute Resolution Rules (the “ADR Rules”) the Complainant bears the burden of proving the following:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith.

2. Default

According to the ADR Rules, Paragraph B3 (f) the Respondent and the Complainant were informed by the case administrator of the Respondent's default. The respondent did not react even within the following five days after receiving this notification (i.e. it did not challenge the notice of Respondent's Default according to Paragraph B3 (g) of the ADR Rules).

Therefore the Panel shall decide according to Paragraph B10 (a) of the ADR Rules if the default qualifies as grounds or is a reason to accept the claims of the other party.

The Panel decides in this case yes, it is a reason to accept the claim of the other party.

3. Alleged Registration of Domain Name without Rights and Legitimate Interest

With respect to the alleged registration of the Domain Name without rights or legitimate interest, the Panel holds as follows:

A. Rights

The Respondent did not prove any formal or other positive right to a JACK WOLFSKIN denomination. The registration itself is no right and creates none without perceptible use or preparing measures.

B. Legitimate Interest

According to Article 21, paragraph 2 of the Regulation (EC) No 874/2004 a legitimate interest may be demonstrated where (a) prior to any notice of the ADR proceedings, the Respondent has used the domain name, or a name corresponding to the domain name, in connection with the offering of goods or services, or has made demonstrable preparation to do so; (b) the Respondent, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law; (c) the Respondent is making a legitimate and non-commercial, or fair, use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

The Panel is of the opinion that even if the Respondent had or has a relation to the Complainant (as a worker or any other) the services offered by the Respondent are highly abusive and illegal, because trying to gain money for non-existing license is a criminal act.

The Panel agrees with ADR Case No. 04318 (E-AIRFRANCE), where the ADR panel held that the fame of the mark AIR FRANCE was strong evidence that the holder registered the domain name with the complainant's trademark in mind.

Here the Respondent also must have registered the disputed domain name having the - not famous but well-known – trademark in mind.

Therefore, the Panel holds that the Respondent registered the cheapjackwolfskins.eu domain name without rights or legitimate interest within the meaning of Article 21, paragraph 1, letter a) of the Regulation (EC) No 874/2004.

4. Respondent's bad faith

This case has similarities with 04052 TARKETT-COMMERCIAL.EU, 04568 ZOTT-SALE.EU or other cases with decisions based on likelihood of confusion such as 04925 NYU.EU.

Evidence regarding the Respondent's bad faith is very strong too.

First, the Respondent is using the confusingly similar Domain Name intentionally to attract Internet users for commercial gain (sponsored links on its web site).

Second, the Respondent is using an address confusingly similar to the addresss of the dealer of the Complainant

Third, the Respondent is using the layout of the web content confusingly similar to the logo of the Complainant and thereby it links its domain to the domain of the Complainant.

Fourth, the Complainant tried unsuccessfully to contact the Respondent. The Respondent's failure to respond to the allegations in the Complainant's earlier cease and desist letter constitute bad faith, and the Respondent's failure to provide correct contact information also is an evidence of bad faith.

5. Conclusion

The Complainant attached to its Complaint relevant documentation supporting and proving its arguments.

Given the foregoing, the Panel holds that indications and evidence exist that the disputed domain name was registered without rights or legitimate interest in the name and in bad faith.

Because the Complainant is an entity eligible to be the holder of .eu domain name in accordance with the Par. 4(2) b) of Regulation 733/2002, the Panel orders that the domain name cheapjackwolfskins.eu be transferred to the Complainant in Germany.

DECISION

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

the domain name cheapjackwolfskins.eu be transferred to the Complainant

PANELISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2013-06-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: cheapjackwolfskins.eu

II. Country of the Complainant: Germany, country of the Respondent: Italy

III. Date of registration of the domain name: 23 October 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 CTM, reg. No. EM 6733208, for the term “Jack Wolfskin”, registered in 2008 in respect of goods and services in classes 25, 35 and

2. company name: Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KG

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: see VIII.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Complainant, Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KG, is an outdoor material and clothing producer for more than 25 years and the holder of several Community and national trade marks JACK WOLFSKIN. The Respondent, Wolfskin apparels co. ltd, registered the disputed domain name and created a confusingly similar shop-website in the layout and is unlawfully using the Complainant’s trademarks. The Respondent didn’t react to the Complainant‘s contentions. The trade mark JACK WOLFSKIN is a well known mark in the outdoor branch, therefore, the Panel concluded that the Respondent is likely to have been aware of corresponding prior rights of the Complainant. The Panel found many evidence of bad faith and ordered the disputed domain name to be transferred to the Complainant.

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

XII. [If transfer to Complainant] Is Complainant eligible? Yes