Panel Decision for dispute CAC-ADREU-006492

Case number	CAC-ADREU-006492
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Domain names	oenobio.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	SANOFI

Respondent

Organization	Poussieres d'Etoiles

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, SANOFI, is a French multinational company operating in the pharmaceutical market. The Complainant is the owner of inter alia the following registered trademarks that it uses in connection to its business:

- French trademark OENOBIOL No. 1 464 375 filed on 10 May 1988 in classes 3 and 5 in respect of dietary supplements;
- French trademark OENOBIOL No. 96 656 137 filed on 18 December 1996 in classes 3, 5 and 29 in respect of dietary supplements;
- French trademark OENOBIOL No. 10 3 765 897 filed on 13 September 2010 in classes 30 and 32 in respect of dietary supplements;
- Community trademark OENOBIOL No. 009 371 345 filed on 13 September 2010 and registered on 26 June 2011, under classes 5, 29, 30 and 32 in respect of dietary supplements;
- International trademark OENOBIOL No. 715 328 filed on 10 March 1999 in classes 3, 5 and 29 in relation to dietary supplements and designating the following: Estonia, Georgia, Iceland, Japan, Lithuania, Turkey, Albania, Bosnia-Herzegovina, Bulgaria, Belarus, China, Cuba, Croatia, the Popular Democratic Republic of Korea, Liechtenstein, Latvia, Morocco, Monaco, Republic of Moldova, Montenegro, the Former Yugoslav Republic of Macedonia, Poland, Romania, Serbia, the Russian Federation, Slovenia, Slovakia, San Marino, Ukraine, Vietnam (Protocol), Algeria.

The Respondent, Poussières d'Étoiles SAS, is a communication agency located in France. The Respondent holds the disputed domain name "oenobio.eu" (the "Domain Name"). The Domain Name directs to a webpage of the PrestaShop 1.5.4.0 Installer for building an online store through the free e-commerce platform of Prestashop.com.

The Respondent registered the Domain Name on 28 January 2013. The language of the registration agreement as used by the Respondent for the registration of the Domain Name is English. The Respondent did not reply to the Complainant's contentions in the language of the ADR Proceeding and did not comply with the CAC's request, as noted in its "Notification of Deficiencies in the Response", to file the Response in English and within the specified timelines, as required by the ADR Rules.

A. COMPLAINANT

The Complainant considers the Domain Name to be confusingly similar to several marks it holds in the OENOBIOL word. The Complainant considers the Respondent not to have any rights or legitimate interest in the Domain Name and asserts that the Respondent registered and is using the Domain Name in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions in the language of the ADR Proceeding and did not comply with the CAC's request, as noted in its "Notification of Deficiencies in the Response", to file the Response in English and within the specified timelines, as required by the ADR Rules.

DISCUSSION AND FINDINGS

A. On the language of the ADR Proceeding

The Complainant had initially filed its complaint in French. The CAC notified the Complainant of the deficiencies in its complaint. According to the ADR Rules, the ADR Proceeding has to be conducted in the language of the registration agreement for the disputed domain name (ADR Rules, A 3 (a)). The language of the registration agreement as used by the Respondent for the registration of the Domain Name is English. As a result, the language of the ADR Proceeding is English. The Complainant amended its complaint and filed an English version.

The Respondent had to file its Response in English. However, the Respondent filed its reply to the Complainant's contentions in French. Moreover, the Respondent put forward several irrelevant and wrong contentions in French, such as (i) irrelevant contentions about the Complainant's alleged manipulation of the ADR Proceeding whilst the latter amended its initial complaint to an English version in accordance with the ADR Rules and at the request of the CAC and (ii) wrong contentions about the Panelist's country of origin as a French country (sic) which would allegedly require the ADR Proceeding to be continued in French.

The Respondent maintained the use of the French language even despite of the CAC's request and its explanations, as noted in its "Notification of Deficiencies in the Response", to comply with the ADR Rules and to file the Response in English within the specified timelines.

Therefore and in accordance with the ADR Rules, A 3 (c), the Panel has disregarded all documents submitted in other languages than the language of the ADR Proceeding, without requesting their translation. In addition, the Panel did not order that documents submitted in languages other than the language of the ADR Proceeding be accompanied by a translation into the language of the ADR Proceeding (ADR Rules, A 3 (d)) because the Respondent attested that it would not be able to provide any translation.

B. On the Domain Name dispute

The ADR Procedure relates to the domain name "oenobio.eu" (the "Domain Name"). The Respondent registered the Domain Name on 28 January 2013 and is the holder of the Domain Name.

1. In accordance with Article 21.1 of the Regulation (EC) No 874/2004 (the "Regulation 874/2004"), it should be established whether the Domain Name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law (i.e., the rights mentioned in Article 10.1 of Regulation 874/2004).

The Complainant has a right to the name "oenobiol", inter alia in various registered trademarks and domain names. The Domain Name is confusingly similar to the "oenobiol" trademarks and domain names of the Complainant. The only difference between the trademarks and domain names of the Complainant and the Domain Name "oenobio.eu" is the deliberate omission - which is also only subtly perceptible visually and orally - of the final letter "l" at the end of the word "oenobiol". From a visual and a typographical point of view, this omission should be considered entirely insignificant given that the letters and words in themselves have a very similar appearance. The registration by the Respondent of the Domain Name, which varies from the marks and the domain names of the Complainant in only one single letter, is additionally symptomatic of a practice referred to as "typosquatting". Case law establishes that domain names that are not identical but very similar to an earlier right (generally a well-known trademark) and that are registered to benefit from any typing errors or omissions on the part of the internet user to divert the Complainant's clientele to other sites, create confusing similarity between an applicant's prior rights and the disputed domain name. See e.g., Microsoft Corporation v. Microsof.com, WIPO Case No. D2000-0548 (transfer) and for equivalent decisions delivered by the CAC: Arla Foods amba v. juulandersen.com, CAC 4917, <arlafood.eu> and Sony Ericsson Mobile Communications AB v. Eva Povysilova, CAC 4539, <sonyericson.eu>.

The Panel considers that the omission of the letter "l" at the end of the word "oenobiol" so that it reads "oenobio", is without any doubt insufficient to prevent any likelihood of confusion between the trademarks and domain names of the Complainant, and the Domain Name registered by the Respondent.

2. Further, the Panel needs to assess whether at least one of the other two elements of Article 21.1 of the Regulation 874/2004 are met. It should be established whether the Respondent registered the Domain Name without rights or legitimate interest in the name “oenobio” or whether the Respondent registered or used the Domain Name in bad faith (Article 21.1 (a) and (b) of the Regulation 874/2004).

a) The Panel is of the opinion that it is significantly demonstrated that the Respondent registered the Domain Name without rights or legitimate interest in the Domain Name.

It appears that:

- The Respondent has not used the Domain Name or a name corresponding to the Domain Name in connection with the offering of goods or services or has made demonstratable preparation to do so until now (Article 21.2 (a) of the Regulation 874/2004). The Domain Name directs to a webpage of the PrestaShop 1.5.4.0 Installer for building an online store through the free e-commerce platform of Prestashop.com.
- The Respondent has not been commonly known by the Domain Name until now (Article 21.2 (b) of the Regulation 874/2004).
- The Respondent is not making a legitimate and non-commercial or fair use of the Domain Name (Article 21.2 (c) of the Regulation 874/2004).

b) The Panel is of the opinion that it is sufficiently demonstrated that the Respondent registered or used the Domain Name in bad faith.

The Respondent must have been necessarily aware of the adverse impact to the well-known trademarks and domain names of the Complainant at the time of registration of the Domain Name. The choice of the Domain Name by the Respondent cannot be a matter of chance. In addition, the Respondent appears to have adopted the Domain Name with the intention of diverting consumers for lucrative purposes by creating confusion, which, in any event, does not constitute any provision of goods and services in good faith. The Respondent thereby creates a risk of confusion between the Complainant’s trademarks and domain names “oenobiol” and the Domain Name. Several decisions of WIPO Administrative Committees and of the CAC have recognized that this consideration is, in itself, an indication of a registration and use in bad faith. See e.g., Syngenta Participations AG v. Baris Dienstverlening, CAC 5380, <syngentaseeds.eu>; Sony Ericsson Mobile Communications AB v. B-D-S, CAC 4423, <sony-ericsson.eu>; Société Air France v. ibiz hosting, CAC 4645, <airfranceonline.eu>.

Furthermore, the Domain Name directs to an inactive webpage. The webpage introduces the PrestaShop 1.5.4.0 Installer for building an online store through the free e-commerce platform of Prestashop.com. It is consensus view that the passive holding of a domain name constitutes a use in bad faith of a domain name. See e.g., Inbokss SIA v. Worldwide Trademarks BVBA, CAC 5892, <inbox.eu>; AXA v. Sylux Sylwester Domitrz, CAC 5544, <axabank.eu>; Cork City Council v. Traffic Web Holding B.V., CAC 3230, <cork.eu>.

3. The Complainant has requested the transfer of the Domain Name. According to Article 22.11 of the Regulation 874/2004, the Panel shall, in the case of a procedure against a domain name holder, decide that the Domain Name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, 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 the Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

- an undertaking having its registered office, central administration or principal place of business within the European Community; or
- an organisation established within the European Community without prejudice to the application of national law; or
- a natural person resident within the European Community.

In this case, the Complainant is an undertaking with registered offices within the Community. As a result, the Complainant satisfies the eligibility criteria. 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 "oenobio.eu" be transferred to the Complainant

within thirty calendar days of the notification of the decision to the Complainant and to the Respondent, unless the Respondent initiates court proceedings in a mutual jurisdiction as meant in Paragraph B 12 (a) of the ADR Rules.

PANELISTS

Name	GODDYN, Bart G. GODDYN

DATE OF PANEL DECISION 2013-08-08

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: oenobio.eu

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

III. Date of registration of the domain name: 28 January 2013

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 OENOBIOL registered in France No. 1 464 375 filed on 10 May 1988 in classes 3 and 5 in respect of dietary supplements;
2. Word trademark OENOBIOL registered in France No. 96 656 137 filed on 18 December 1996 in classes 3, 5 and 29 in respect of dietary supplements;
3. Word trademark OENOBIOL registered in France No. 10 3 765 897 filed on 13 September 2010 in classes 30 and 32 in respect of dietary supplements;
4. Word Community trademark OENOBIOL No. 009 371 345 filed on 13 September 2010 and registered on 26 June 2011, under classes 5, 29, 30 and 32 in respect of dietary supplements;
5. International trademark OENOBIOL No. 715 328 filed on 10 March 1999 in classes 3, 5 and 29 in relation to dietary supplements and designating the following: Estonia, Georgia, Iceland, Japan, Lithuania, Turkey, Albania, Bosnia-Herzegovina, Bulgaria, Belarus, China, Cuba, Croatia, the Popular Democratic Republic of Korea, Liechtenstein, Latvia, Morocco, Monaco, Republic of Moldova, Montenegro, the Former Yugoslav Republic of Macedonia, Poland, Romania, Serbia, the Russian Federation, Slovenia, Slovakia, San Marino, Ukraine, Vietnam (Protocol), Algeria.

V. Response submitted: Yes

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 use of the disputed domain name, Respondent not known by the disputed domain name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Typosquatting, intention of diverting consumers, inactive webpage.

IX. Other substantial facts the Panel considers relevant: No

X. Dispute Result: Transfer of the disputed domain name to the Complainant.

XI. Procedural factors the Panel considers relevant: Documents in other language than the ADR Proceeding language disregarded.

XII. Is Complainant eligible? Yes