Panel Decision for dispute CAC-ADREU-006585

Case number	CAC-ADREU-006585
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Domain names	jack-wolfskinsjacket.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

There is no knowledge of other legal proceedings concerning the disputed domain name which are pending or which have been decided.

FACTUAL BACKGROUND

1. The Complainant

1.1 The information available to the Panel shows that the Complainant is one of the leading producers of outdoor apparel and equipment in Germany and Europe with a history of more than 25 years of production and sale of the aforementioned goods. As a result, the Complainant has acquired a considerable reputation in Germany and Europe.

1.2 The product portfolio of the Complainant covers all kind of outdoor equipment, especially clothing, footwear and headgear. All of the goods manufactured and distributed by the Complainant are labelled with the trademark “Jack Wolfskin”. The Complainant offers its products for sale in several web-shops under domain names containing the element “Jack Wolfskin”, such as “jack-wolfskin.de” and “jack-wolfskin.com”. Around the world, the Complainant’s products are sold through approximately 4000 retail outlets in the specialized outdoor and sports equipment trade and more than 600 Jack Wolfskin franchise stores.

1.3 The Complainant owns numerous trademark registrations containing the designation Jack Wolfskin such as the German trademark 1049490 “Jack Wolfskin” with a priority of 23/08/1982, Community trademark registration 6733208 “Jack Wolfskin” with a priority of 06/03/2008 and Community Trademark registration 3034915 “Jack Wolfskin + paw device” with a priority of 31/01/2003.

1.4 These trademarks are registered inter alia for clothing, footwear and headgear in class 25 and in some cases also for the corresponding retail services of class 35. The Complainant uses the marks widely as is shown e.g. under the ccTLD “jack-wolfskin.de” and the online shop operated under that domain.

2. The Respondent

2.1 The Respondent is the registered owner of the domain “jack-wolfskinsjacket.eu”. The Respondent uses the domain for commercial purposes. It is apparent from the website of “jack-wolfskinsjacket.eu” that the Respondent operates a web shop offering articles of clothing under the domain name in question. On the website and under the domain “jack-wolfskinsjacket.eu”, the Respondent makes abundant use of the trademarks “Jack Wolfskin” and “Jack Wolfskin + paw device”, registered for the Complainant as German and Community trademark registrations.

2.2 Yet there is no indication that the Respondent owns any trademark, tradename or any other rights in the designations “Jack Wolfskin” or “Jack Wolfskin + paw device”. The Respondent has no rights or legitimate interests in respect of the domain name. There is no relationship between the Respondent and the Complainant. The Respondent is neither a licensee of the Complainant nor has the Respondent otherwise obtained any authorization to use the trademark and/or tradename “Jack Wolfskin”.

2.3 There is no link – commercial or otherwise – between the Complainant and the Respondent. The Respondent is not an authorized dealer of the Complainant. The Complainant must assume that the products labelled with the mark “Jack Wolfskin” respectively “Jack Wolfskin + paw device” offered in the web shop under the domain “jack-wolfskinsjacket.eu” are counterfeits. Moreover, the “layout” of “jack-wolfskinsjacket.eu” is similar to the typical online-shop of the Complainant. Additionally, the Respondent uses (unauthorized) pictures from the website of the Complainant, showing models of the complainant wearing “Jack Wolfskin” articles of clothing. Moreover, and as apparent from the homepage of “jack-wolfskinsjacket.eu”, the Respondent uses phrases like for example “Jack Wolfskin Onlineshop”, pretending to be an official dealer of the Complainant.

2.4 The Respondent thus creates the false impression that the website under “jack-wolfskinsjacket.eu” is operated by the Complainant or a person connected to the Complainant. Neither is the case. The Complainant is in no way connected to the website “jack-wolfskinsjacket.eu” and/or the goods being offered under this domain name. Additionally, the Respondent was the owner of websites under the domain names “cheapjackwolfskin.eu” and “wolfskinsjacket.eu” and the Complainant successfully acted against the Respondent in Cases No. 6449 (decision of 25/02/2013) and 6580 (decision of 07/01/2014). In both cases the Panel ordered the transfer of the domain names to the Complainant.

A. COMPLAINANT

1. The domain name is confusingly similar to the trademarks of the Complainant
The domain name “jack wolfskinsjacket.eu” is nearly identical to the aforementioned trademarks registered for the Complainant. The domain name “jack-wolfskinsjacket.eu” is dominated by the element “jackwolfskins”. The additional element “jacket” is obviously descriptive for the offer on the domain in dispute (inter alia jackets). The signs “jackwolfskins” and “Jack Wolfskin” are nearly identical. Therefore, the signs for comparison are nearly identical as far as their distinctive components are concerned and, thus, confusingly similar.

2. The Respondent has no rights or legitimate interest in respect of the domain name
The Respondent has neither rights nor a legitimate interest in respect of the domain name, nor is his name “Jack Wolfskin”, nor is he a licensee of the Complainant nor has he been otherwise authorized to apply for or to use the domain name “jack-wolfskinsjacket.eu”.

3. The domain name was registered and is being used in bad faith
The Respondent has registered the domain name “jack-wolfskinsjacket.eu” in bad faith. It follows from the foregoing that the domain name “jack-wolfskinsjacket.eu” was registered exclusively for the purpose of exploiting the good reputation of the Complainant and its trademark and tradename “Jack Wolfskin”. The Respondent intentionally attempts to attract for commercial gain by leading internet users to the Respondent’s web-shop by creating a likelihood of confusion with the Complainant’s marks and the trade name “Jack Wolfskin”. The web shop operated under the domain leads internet users to the conclusion that the Complainant is the operator of the online-shop and the seller of the products distributed on the domain, or at least that the Respondent is affiliated with the Complainant. Furthermore, the Complainant assumes that the products labelled with the trademark “Jack Wolfskin” offered in the web-shop are counterfeits. Additionally, there is no registration information about the Respondent on the website under “jack-wolfskinsjacket.eu”. Finally, the address und the telephone number mentioned in the official database of EURID (see above) are also a fake. The address can ´t be real and the telephone number does not exist. This can easily be proved by dialling this number.

4. General eligibility criteria as set out in Article 4 (2) (b) of Regulation (EC) No. 733/2002
The Complainant is a firm having its seat in Germany, as is apparent from the excerpt of the commercial register with respect to the Complainant.

B. RESPONDENT

The Respondent did not file a reply.

DISCUSSION AND FINDINGS

1. According to Article 22 (1) (a) of the Commission Regulation (EC) 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 this Commission Regulation. Article 22 (11) states that if the ADR panel finds that the registration is speculative or abusive as defined in Article 21, 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. These requirements are fulfilled in the case at hand.

2. The Complainant is the proprietor of, inter alia, German trademark 1049490 “Jack Wolfskin” with a priority of 23/08/1982, Community trademark registration 6733208 “Jack Wolfskin” with a priority of 06/03/2008 and Community Trademark registration 3034915 “Jack Wolfskin + paw device” with a priority of 31/01/2003.

3. The domain name “jack-wolfskinsjacket.eu” is highly similar to the aforementioned trademarks registered on behalf of the Complainant. The additional word “jacket” in the domain name is obviously and clearly descriptive for the goods being offered on the website under the contested domain name. It is also descriptive for the goods for which the Complainant’s marks are protected. The addition of such a generic term does not add a further distinctive or dominant element to the contested domain name. For that reason, the domain name is clearly dominated by the distinctive element “JACK-WOLFSKINS” which must be compared to the earlier rights registered on behalf of the Complainant. This is a recognized principle of the case law in .eu ADR proceedings as can be seen e.g. in the decisions No. CAC 4218 (olympiakos.eu), CAC 4645 (airfrance.eu), CAC 5376 (monstefinance.eu) or CAC 3207 (Allianz-online.eu). The fact that the contested domain name contains an additional letter “s” also does not change this finding as it is either the possessive “s” in “Jack Wolfskin’s” or the plural “s” in Jack Wolfskins”. Neither of these is sufficient to make the marks dissimilar.

4. The domain name “jack-wolfskinsjacket.eu” is therefore confusingly similar to the trademarks registered and protected on behalf of the Complainant.

5. The registration of the contested domain name by the Respondent on 23/10/2012 occurred without the Respondent having any legitimate right or interest in that name. This finding is based on the fact that neither did the Respondent demonstrate the existence of such a legitimate right or interest within the meaning of Article 21 No. 2 of the Regulation (EC) No. 874/2004 of 28/04/2004, nor has such right or interest otherwise been demonstrated or become apparent.

6. The Panel is therefore not required to examine whether or not the domain name has additionally been registered or used in bad faith in accordance with Article 21 No. 1(b), No. 3 of the Regulation (EC) No. 874/2004 of 28/04/2004. However, the Panel is of the opinion that on the evidence available to it and in light of the parallel decisions already issued against the Respondent cited below, such bad faith is established given the exploitation of the Complainant’s reputation, the misleading character of the website operated under the contested domain name and the obviously fake address details of the Respondent entered into the official database of EURID.

7. The Respondent was the owner of websites under the domain names “cheapjackwolfskin.eu” and “wolfskinsjacket.eu” and the Complainant successfully acted against the Respondent in Cases No. CAC 6449 (decision of 25/02/2013) and CAC 6580 (decision of 07/01/2014). In both cases the Panel ordered the transfer of the domain names to the Complainant.

8. Being a company with registered offices in Germany as evidenced by the extract from the Commercial Register, the Complainant satisfies the eligibility criteria as set out in Article 4 (2) (b) of Regulation (EC) No. 733/2002.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name JACK-WOLFSKINSJACKET be transferred to the Complainant

PANELISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2014-01-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: JACK-WOLFSKINSJACKET.EU

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

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. German trademark 1049490 “Jack Wolfskin” with a priority of 23.08.1982,
2. Community trademark registration 6733208 “Jack Wolfskin” with a priority of 06.03.2008 and
3. Community Trademark registration 3034915 “Jack Wolfskin + paw device” with a priority of 31.01.20031.

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: None demonstrated or otherwise apparent.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Exploitation of Complainant's reputation, parallel registration of infringing domains, false address details given in EURID Data base.

IX. Other substantial facts the Panel considers relevant:
Parallel decisions issued against the Respondent in cases CAC 6449 (decision of 25/02/2013) and CAC 6580 (decision of 07/01/2014).

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: --

XII. Is Complainant eligible? Yes