# Panel Decision for dispute CAC-ADREU-006970

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| Case number | CAC-ADREU-006970 |
| Time of filing | 2015-11-12 13:02:23 |
| Domain names | anvelope-michelin.eu |

## Case administrator

Lada Válková (Case admin)

## Complainant

Organization

## Respondent

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| Organization | PREMIUM ANVELOPE SERVICE-ROTI S.R.L. |

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 that are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a French multinational company operating worldwide and is a leading global manufacturer of motor vehicle tyres. The Complainant also has a well established reputation as a publisher of maps, travel, restaurant and hotel guides. In addition, the Complainant is well known for Michelin stars awarded to restaurants in its red guides.
The Complainant has had a presence in Romania since 2001. The Complainant has subsequently expanded its operations in the country to incorporate two additional factories and now employs about 3,000 employees in Romania.
Tyres are produced by the Complainant under the mark “MICHELIN” of many different types and under various sub-brands.
The Complainant is the current registered proprietor of many trade marks for MICHELIN including Community Trade Mark registration No 004836359 in multiple classes registered on March 13, 2008.
Additionally the Complainant owns a number of domain names incorporating its MICHELIN trade mark, particularly <michelin.com> (date of registration December 1, 1993) and <michelin.ro> (date of registration April 16, 2007) (collectively, “Michelin Domains”).

The present dispute concerns the domain name <anvelope-michelin.eu> (“the disputed domain name”). “Anvelope” is a Romanian word that translates into “tyre” in English.
The Respondent registered the disputed domain name on January 20, 2012.
In addition to the disputed domain name, the Complainant has established through WHOIS searches that the Respondent has also registered the following domain names:
1. <anvelope-michelin.com>;
2. <anvelope-michelin.net>; and
3. <bf-goodrich.ro>
On April 2, 2012, the representatives for the Complainant sent a cease and desist letter by registered post and by email to the Respondent seeking a transfer to the Complainant of the disputed domain name. Three further reminders were sent but no response was received from the Respondent.

A. COMPLAINANT

Identical or Confusingly Similar Name
The Complainant asserts that the disputed domain name is identical or confusingly similar to the Complainant’s trade mark, which has been found to be “well-known” and “famous” in a number of previous UDRP decisions, (see for example: Compagnie Générale des Etablissements Michelin (Michelin) v Oncu, Ibrahim Gonullu, WIPO Case No.D2014-1240 and Compagnie Générale des Etablissements Michelin (Michelin) v Rosa Chen). The Complainant states that its trade mark enjoys a worldwide reputation, particularly in Romania.

The Complaint asserts that the disputed domain name incorporates the Complainant's trade mark in its entirety and that earlier panels have considered this sufficient to establish that a domain name is identical or confusingly similar. The Complainant contends that the generic term "anvelope" used in the disputed domain name links to goods manufactured by the Complainant, does not serve to distinguish the disputed domain name from the Complainant's sphere of commercial activity and that it is well established in preceding WIPO decisions that adding a descriptive term to a Complainant's trade mark "doesn't influence the similarity between a trademark and a domain name" (see WIPO Case No. D2012-1453, Eurodrive Services and Distribution N.V. v Transure Enterprise Ltd, Host Master and Above.com). The Complainant says that in addition, the use of the hyphen to intersect the word "anvelope" from the Complainant's trade mark, does not operate to dispel any confusion that might arise. In fact, the Complainant further asserts that Internet users will believe that the disputed domain name is endorsed or affiliated with the Complainant because it incorporates the Complainant's trade mark and uses a word describing the goods made by the Complainant. In support of this, the Complainant relies upon previous panel decisions that have concluded that hyphenation in domain names is "insufficient to distinguish a domain name from a complainant's trade mark because the dominant portion of each domain name remains the complainant's trade mark" (see WIPO Case No. D2006 – 0768, Kabushiki Kaisha Toshiba dba Toshiba Corporation v WUFACAI).
The Complainant further states that the addition of a gTLD or country specific code such as ".eu" is not sufficient to differentiate the disputed domain name from the Complainant's trade mark and is not an element taken into account when assessing any similarity between the disputed domain name and the Complainant's trade mark.

No rights or legitimate interest in the name
The Complainant asserts that the disputed domain name resolves to an inactive website and therefore the Respondent cannot be using the disputed domain name in connection with a bona fide offering of goods and services or demonstrate preparations to use the disputed domain name in this way.
Further, the Complainant says that the Respondent has not been commonly known by the name "Michelin", is not a licensee of the Complainant or otherwise authorised to use the Complainant's trade mark, or to seek registration of, or use any domain name incorporating the Complainant's trade mark. The Complainant points to established precedent that in the absence of a licence or express permission from the Complainant to use a famous trade mark, genuine legitimate use of the domain name cannot be inferred (see for example WIPO Case No. D2010-0138, LEGO Juris A/V v Domain Park Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master that held that in the absence of a licence or authorisation of any kind by the complainant to use its trade marks or apply for a domain name incorporating those marks, no bona fide use of the domain name by the Respondent could be found).
The Complainant contends that the Respondent registered the disputed domain name without rights or legitimate interests in respect of the domain name and that further, the disputed domain name is so close in comparison to the Complainant's trade mark that it is inconceivable that the Respondent registered it with the intention of commencing legitimate and non-commercial activities through it Moreover, the Complainant states that the Respondent lacks any prior rights in the disputed domain name and that the Complainant's registration of both its trade mark and the Michelin Domains precedes the registration of the disputed domain name by some years.
Lastly the Complainant points out that the Respondent did not reply to its cease and desist letter or reminders and the Respondent has not availed itself of its rights to respond in this Case pursuant to Article 22 (8) of the Regulations or Paragraph B.3 (a) of the Rules and the appropriate inference to draw is that this is because it lacks any right or legitimate interest in the disputed domain name.
Bad Faith Registration or Use
Registration
The Complainant asserts that the Respondent has registered the disputed domain name in bad faith.
The Complainant states that it and its trade marks are famous throughout the world and it is implausible that the Respondent was not aware of them at the time he registered the disputed domain name and a quick internet or trade mark search would have uncovered the existence of both the Complainant and its trade marks.
Further the Complainant states that the corresponding registrations of the domain name <bf-goodrich.ro> which entirely reproduces another of the Complainant's famous trade marks proves that the Respondent was aware of the Complainant at the time he registered the disputed domain name. The further inclusion of "anvelope" referencing the goods manufactured by the Complainant is stated by the Complainant to be additional evidence that the Respondent knew of the Complainant, its trade marks and goods and services at the time he registered the disputed domain name,
Given the worldwide reputation of the Complainant, the Complainant states it is "hard to believe" that the Respondent was ignorant of its existence.
Lastly the Complainant points out that the Respondent should have provided an explanation for its choice of the disputed domain name in this Case following submission of the Complaint, this combined with the lack of response by the Respondent to the cease and desist letters or the Complaint indicate registration of the disputed domain name in bad faith.
Use
The Complainant asserts that the Respondent is using the disputed domain name in bad faith and that the Complainant's and its trade marks are so widely-known that the Respondent's primary motive in registering the disputed domain name must be to take unfair advantage of the goodwill and reputation of the Complainant's trade mark.
The Complainant contends that the passive holding of the disputed domain name does not preclude a finding of bad faith and that it is

well established that panel should look at the surrounding circumstances in which a domain name is being held, without any apparent use or purpose and that in such cases the panel should pay close attention to the behaviour of the Respondent, particularly his lack of response to the cease and desist letters, lack of involvement in ADR proceedings and attempts to conceal his identity, which the Respondent appears through WhoIs searches to have done.

B. RESPONDENT

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

DISCUSSION AND FINDINGS

Under Article 21 (1) of the Regulation and Paragraph B.11 (d) (1) of the ADR Rules, the Complainant must prove the first of the following criteria and a further additional element in order to be entitled to a transfer of the disputed domain name:
i) The domain name is identical or confusingly similar to a name in respect of which a right is recognised 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.
The Respondent was required by Article 22 (8) of the Regulation and Paragraph B.3 (a) of the Rules to submit a response within 30 working days of the Complaint being delivered. No response was provided by the Respondent and therefore in accordance with Article 22 (10) of the Regulation and Paragraph B.10 (a) of the Rules, the Panel is entitled to accept the claims of the Complainant and pursuant to Paragraph B.10 (b) of the Rules to draw such inferences from the Respondent's failure to submit a response as it considers appropriate. The Panel therefore finds in the absence of a response to the Complaint, that the Complainant's assertions of fact are accepted.
A. Identical or Confusingly Similar
It is widely recognised and supported by previous panel decisions that the gTLD suffix (".eu") can be disregarded in assessing any similarity between the disputed domain name and the Complainant's trade mark as it is a technical requirement of registration. These elements are incapable of performing any distinctive function and so are not considered in making any determination.
The first part of the assessment considers the straightforward aural and visual similarity of the disputed domain name and the Complainant's trade mark in order to decide if they are identical and then considers whether they can be considered confusingly similar to Internet users to the extent that there is a risk that they will consider there is a link between the disputed domain name and the Complainant or the goods and services offered by it.
The Complainant is the owner of the trade mark registration for MICHELIN as referred to above. It therefore has a right recognised and established by national and community law in the name MICHELIN which is a prior right in accordance with Article 10 (1) of the Regulation.
The word "anvelope" (that is "tyre" in Romanian) directly references the goods manufactured by the Complainant and for which the Complainant is well known internationally and creates a perception in the mind of Internet users of a commercial link, association or affiliation between the disputed domain name and the Complainant which has no basis in reality; see Segway LLC v Chris Hoffman, WIPO Case No.D2005 – 0023 which found that the addition of a generic word to a trade mark owned by a complainant to create a domain name consisting of multiple words, implies a relationship between the words and will increase rather than decrease the likelihood of confusion.
As in previous decisions, the addition of the hyphen between "anvelope" and the Complainant's trade mark does not serve to sufficiently differentiate the disputed domain name from the Complainant's trade mark (see for example, WIPO Case No. D2014-1588 BHP Billiton Innovation Pty Ltd v Charleswang).
The disputed domain name incorporates the Complainant's trade mark entirely. It is well established that a domain name that wholly incorporates a trade mark can be considered to be confusingly similar to such trade mark. Neither the addition of anvelope nor a hyphen between this word and the Complainant's trade mark sufficiently distinguishes the disputed domain name, because the dominant portion of the disputed domain name remains the Complainant's trade mark.
The addition of the generic top level domain suffix "eu" exists for purely functional reasons and so is not relevant to the assessment of the similarity of the disputed domain name with the Complainant's trade mark. It is well established that these elements are incapable of performing any distinctive function and should not be considered in making any determination; see WIPO Case No. D2006 – 0768, Kabushiki Kaisha Toshiba dba Toshiba Corporation v WUFACAI which stated that country suffixes are generally recognised as geographical indicia denoting that territory, and the addition of such a suffix to a trade mark is non-distinctive.
For these reasons the Panel finds that the disputed domain name is confusingly similar to MICHELIN, being a name in which the Complainant has rights within the meaning of Article 21 (1) of the Regulation.
B. Rights or Legitimate Interests
Article 21(2) of the Regulation and Paragraph B.11 (e) of the ADR Rules set out a non-exhaustive list of circumstances, that if found by the Panel may demonstrate the Respondent's rights or legitimate interest to the disputed domain name for the purposes of Article 21 (1) (a) of the Regulations and Paragraph B.11 (d) (1) (ii) of the Rules. These are as follows:

(a) prior to any notice of the dispute or ADR procedure, a domain name holder has used the domain name or 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 domain name holder 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 or Community law;

(c) the domain name holder 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 or Community law.
The disputed domain name resolves to an inactive page and therefore is not capable of referencing any legitimate commercial activities of the Respondent. The Panel has not been provided with any evidence that would indicate that the Respondent has ever used the disputed domain name to resolve to an active website offering tyres or related services. There is no evidence that the Respondent has used or intends to use the disputed domain name in connection with the offering of goods or services or has made any demonstrable preparation to do so.
This Panel has seen no evidence that the Respondent has been commonly known by the disputed domain name. The Panel notes from the results of the WhoIS searches at Annex 1 of the Complaint that the Respondent's organisation is listed as Premium Anvelope Service-Roti S.R.L, which the Panel understands to be a limited liability company incorporated in Romania and whose name broadly translates into English as "Premium Tyre Service". The Respondent can at best, only claim to have been commonly known by the "anvelope" part of the disputed domain name, this being a generic descriptor of the goods offered by the Complainant.
The Respondent is not licensed by the Complainant or authorised by the Complainant to use its trade mark. The Complainant's registration and use of its trade mark substantially pre-dates the registration of the disputed domain name. There is no evidence that the Respondent is making a legitimate, non-commercial use of the disputed domain name. On the contrary, the Respondent's registration and use of the disputed domain name appears to be deliberately calculated to invoke a connection with the goods and services of the Complainant to harm the established reputation of a name on which the Complainant has a right recognised by national and community law.
In the absence of evidence before the Panel that the Respondent can bring himself within any of the circumstances given in Article 21 (2) of the Regulation and Paragraph B.11 (e) of the Rules the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.
C. Registered and Used in Bad Faith
Registration in Bad Faith
In accordance with Article 21 (3) (b) of the Regulation and Paragraph B.11 (f) (1) of the Rules bad faith can be demonstrated in circumstances where a domain name is registered in order block registration of a domain name by the holder of a name in respect of which, a right is recognised by national or Community law, from reflecting this name in the corresponding domain name provided that:
(i) a pattern of such conduct by the registrant can be demonstrated; or
(ii) the domain name has not been used in a relevant way for at least two years from the date of registration.

The Panel accepts the Complainant's contention that it is highly improbable that the Respondent did not know about it when it registered the disputed domain name. A search for the Complainant's trade mark or even a simple internet query would have quickly alerted the Respondent to the existence of the Complainant and its extensive trade mark portfolio.
It follows from the Panel's earlier findings set out above that the inclusion of "anvelope" in the disputed domain name is to directly link to the goods of the Complainant and mislead Internet users into believing the Respondent is somehow affiliated to the Complainant. This conclusion is reinforced by the registration of the additional domains <anvelope-michelin.com>, <anvlope-michelin.net> and <bf-goodrich.ro> which all directly relate to the Complainant, its trade marks, goods and services. This constitutes a pattern of such conduct engaged in by the Respondent and amounts to bad faith for the purposes of Article 21 (3) (b) (i) of the Regulation and Paragraph B.11 (f) (2) (i) of the Rules. The Panel finds that the disputed domain name was registered by the Respondent on January 20, 2012 and no evidence of any genuine and legitimate use of it has been made since this date. This is more than three years after the date the disputed domain name was registered and qualifies as a registration made in bad faith pursuant to Article 21 (3) (b) (ii) of the Regulation and Paragraph B.11. (f) (2) (ii) of the Rules.
Having established bad faith on this basis, it is not necessary to consider the Complainant's further submissions.

The Complainant had demonstrated that it had registered Community trade mark rights in the name MICHELIN and that it satisfied the general eligibility criteria for registration set out in Paragraph 4(2)(b) of the of Regulation (EC) No 733/2002; being an undertaking having its registered office or principal place of business within the Community.
Further, the Complainant had fulfilled the first requirement of Article 21 (1) of the Regulation and the subsequent requirements of Article 21(1) (a) and Article 21 (1) (b) of the Regulation. Therefore the requirements for the requested transfer of the disputed domain name to the Complainant were satisfied in accordance with Article 22 (11) of the Regulation. That was the only remedy sought by the Complainant in this Case.

DECISION

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

the domain name ANVELOPE-MICHELIN be transferred to the Complainant

## PANELISTS

| Name | Antony GOLD HGF Law LLP, Antony Gold |
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DATE OF PANEL DECISION 2015-11-12

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <anvelope-michelin.eu>

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

III. Date of registration of the domain name: 20 January 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. 004836359, for the term MICHELIN, filed on 04 January 2006, registered on 13 March 2008 in respect of goods and services in classes 1, 3, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 24, 25, 26, 34 and 39.

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: the Panel held that the disputed domain name was registered because it sought to establish a connection between the Respondent’s organisation which appeared to have some connection with tyre related goods and services, although it does not offer these for sale through a website resolved to by the disputed domain name. Such use did not demonstrate that the Respondent had a right or legitimate interest and provided positive evidence that no such right or interest existed.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the registration and use of the disputed domain name by the Respondent was without a legitimate right or interest but was instead directed at misleading Internet users into believing that there was a connection between the disputed domain name and the Complainant. The cumulative circumstances, of repeatedly registering domain name incorporating the Complainant's trade marks, passively holding the disputed domain name for a period of more than 3 years and the lack of response to cease and desist letters or the Complaint demonstrated both bad faith registration and use within the meaning of Article 21 (3) (b) of the Regulation (even in the absence of personal commercial gain by the Respondent from such use). Further and in addition to this, the disputed domain name had been registered and used to take advantage of the Complainant’s rights in and reputation of the MICHELIN mark, reinforcing the finding of bad faith.

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: N/A

XII. Is Complainant eligible? Yes