Panel Decision for dispute CAC-ADREU-007023

Case number	CAC-ADREU-007023
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Domain names	gefanuc-parts.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	FANUC UK Limited

Respondent

Name	june bottom

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 relating to the disputed domain name.

FACTUAL BACKGROUND

Complainants are part of the FANUC international group of companies that provides automation products and services, such as robotics and computer numerical controls.

First Complainant was incorporated in Japan in 1972 and is proprietor of the following FANUC trademarks:
• UK word mark FANUC registered under no. 910676 on 13 June 1967 for goods in class 9;
• UK word mark FANUC registered under no. 1182663 on 1 October 1982 for goods in class 7;
• UK word mark FANUC registered under no. 2337783 on 15 July 2003 for goods in classes 7 and 9; and
• International word mark FANUC registered under no. 948323 on 11 June 2007 for goods and services in classes 7, 9, 37 and 42.

Second Complainant has traded in the UK under the name FANUC and FANUC Robotics since 1982 and operates the website “www.fanucrobotics.co.uk”. Second Complainant, inter alia, offers servicing and spare parts for FANUC systems.

Respondent is a holding company and proprietor of the disputed domain name <gefanuc-parts.eu>. Respondent’s subsidiary Pennine Automation Spares Ltd. sells and repairs FANUC parts and operates the website “Fanuc Parts & CNC Fanuc Repair Center” under its primary domain name <cncspares.com>. The disputed domain name redirects to Pennine Automation Spares Ltd.’s website under <cncspares.com> (hereinafter the “Pennine Website”).

Second Complainant on 13 February 2014 sent a cease and desist letter to another entity, namely Pennine Automation Ltd., demanding the takedown of its website and the transfer of several domain names which contained the FANIC trademarks, namely <fanucspares.com>, <fanuc-spares.com>, <fanuc-parts.co.uk>, <fanuc.li> and <fanuc-spares.co.uk>. The cease and desist letter did not include the disputed domain name.

Respondent registered the disputed domain name on 10 April 2014.

A. COMPLAINANT

Complainants contend that Respondent is connected to both Pennine Automation Spares Ltd. and Pennine Automation Limited. Complainants further contend that due to this connection or common control, Respondent and both Pennine entities are to be seen as one, or at least Complainants attribute any statement or behavior of either Pennine entities and Respondent to each other without further distinction.

The disputed domain name redirects to the Pennine Website that blatantly copies Complainants' website in terms of color scheme, branding and layout. This website uses headings such as FANUC CNC UK – EUROPE" and "Fanuc Parts & Fanuc Repair Center" and only in very small black font disclaims any affiliation with FANUC. The contact page refers to Pennine Automation Spares Ltd.

The disputed domain name wholly incorporates First Complainant's word marks and Second Complainant's unregistered mark FANUC. Any similarity is neither dispelled by the prefix 'GE', which refers to the joint venture between General Electric and Fanuc, nor by the affix '-parts', which is a descriptive term denoting spare parts for Complainants' products.

Complainants contend that Respondent lacks a right or legitimate interest in the disputed domain name and assert that Respondent as a reseller must make a bona fide offering of goods and services and meet the criteria set forth by other Panels, most primarily in the Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903 (the "Oki Data case"), which was ruled under the Uniform Disputed Resolution Policy. Complaints argue that Respondent has failed the requirement to accurately and prominently disclose Respondent's relationship with Complainants, by mimicking Complainants' branding and by giving the impression of an official connection. Such connection is insufficiently disclaimed by statements made on the website. Complainants further content that Respondent lacks a right or legitimate interest in the disputed domain name and assert that Respondent is not commonly known by the name comprised in the disputed domain name. Neither is there evidence of any legitimate and non-commercial or fair use of the disputed domain name. On this basis Complainants claim to have made a prima facie case that warrant the burden of proof to be shifted to Respondent.

In addition to a lack of legitimate interest in the disputed domain name, Complainants contend that Respondent has registered or used the disputed domain name in bad faith. Complainants invoke article 21(3)(c) and (d) of Regulation (EC) 874/2004 and Complainants assert that Respondent uses the disputed domain name to run a business in open competition with Complainants in the sale of Complainants' spare parts. Complainants further assert that Respondent is seeking to create the impression that it is operating under the sponsorship, affiliation or endorsement of Complainants.

B. RESPONDENT

Respondent acknowledges that it is the holding company of Pennine Automation Spares Ltd, i.e. the entity operating the Pennine Website (to which the disputed domain name redirects). Respondent further confirms that its operates as a group with Pennine Automation Spares Ltd., as can be inferred from Respondent's statement in plural: "contact page clearly has our trading name displayed pennine automation spares".

Respondent contends that it sells FANUC parts which are no longer offered for sale by Complainants worldwide.

Respondent further asserts that the mark FANUC and the sign GEFANUC are two different names, and that it uses disclaimers on the Pennine Website.

DISCUSSION AND FINDINGS

The Panel has reviewed and considered the parties' submissions and annexed documents in detail before arriving at a decision.

The Panel finds that Respondent's position vis-à-vis its subsidiaries Pennine Automation Ltd. and Pennine Automation Spares Ltd. demonstrates trading as a group, as has been acknowledged by Respondent. The Panel will therefore fully attribute the Pennine Website to Respondent.

Relevant rights
The Panel is satisfied that the First Complainant holds relevant rights, to which the disputed domain name is confusingly similar.

The Panel disagrees with Respondent's contention that GEFANUC is not similar to FANUC. GEFANUC wholly incorporates the trademark and merely adds the prefix GE, referring to Complainant's prior joint venture with General Electric. Respondent did not put forward any further arguments disclaiming the confusing similarity between the disputed domain name and Complainants' FANUC trademarks, as contended by Complainants.

Legitimate interest
The Panel finds that Complainants did not make a prima facie case that the Respondent lacks legitimate interests in the disputed domain name.

Complainants contend that the appropriate test in the case of resellers and distributors requires the respondent to make a bona fide

offering of goods and services, by (a) actually offering the goods or services at issue, (b) selling only trademarked goods, (c) clearly disclosing the registrant's relationship to the trademark holder and (d) not trying to 'corner the market' in domain names similar or identical to the trademark. The Complainants refer to page 33, para 2 of the "Overview of CAC panel views on several questions of the alternative dispute resolution for .eu domain name disputes" (the "Handbook") and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903. The Panel agrees that this standard sets the appropriate test under article 21 of Regulation (EC) 874/2004.

Complainants further contend that Respondent has failed to accurately and prominently disclose Respondent's relationship with them, i.e. failed to comply with requirement three of the appropriate test. The Panel notices that Respondent assumes that a prominent disclosure is required, whereas such prominence is neither mentioned by the Handbook nor is it a prerequisite in the Oki Data case. The Panel is of the opinion that the level of disclosure does not necessarily have to be prominent, but requires a level of attention sufficiently noticeable for the relevant public.

Complainants substantiate the contended lack of disclosure by referring inter alia to the look-and-feel of Pennine Website, use of the FANUC trademark and the use of an identical favicon (a red on yellow "F" icon, visible in browser tab heading). Further, Complainants argue that use of the word 'center' (in "Fanuc Parts & Fanuc Repair Center) gives the impression that the Pennine Website is the official website for FANUC repairs.

The Panel sympathizes with Complainants' concerns in relation to the layout of the Pennine Website and the use of the FANUC favicon, which seem derived from the FANUC corporate identity. Nevertheless, Complainants must concede that the Pennine Website clearly discloses the relationship to Claimants, or rather lack thereof, on every page, thus in principle satisfying the third requirement. Complainants did not convincingly assert that such disclosure warrants the finding of a lack of legitimate interest.
Neither is the Panel convinced that the use of the word 'center' warrants a lack of legitimate interest. The Panel refers to the Oki Data case, put forward by Complainants, which concerned similar use of the term 'center'.

The Panel emphasizes that, as a reseller or distributor, Respondent in principle has a legitimate interest in using a domain name referring to the offering of Complainant's parts. Such an interest should not be confused with Respondent's limited interest in using a domain name like <fanuc-cnc.com>, which was subject of CAC Case No. 6920 (FANUC-CNC) cited by Complainants. There could very well be circumstances where a reseller's or distributor's offering is made in bad faith and can in itself not be considered bona fide. In the opinion of the Panel, Complainants did not contend that Respondent's offering of parts or repairs is unlawful nor did Complainants otherwise substantiate Respondent's lack of a bona fide offering. Rather, Complainants (convincingly) argued that Respondent's offering – albeit bona fide – infringe upon Complainants' trademarks. Such an infringement is without a doubt objectionable, but does not in itself yield a lack of legitimate interest in the disputed domain name. Were this to be true, then any online trademark infringement would result in the forfeiture of the interests in the related domain name. In the opinion of the Panel there is no basis for such a conclusion in Regulation (EC) 874/2004.
As Respondent has sufficient legitimate interest in the disputed domain name, the Panel is not required to consider Complainants' assertion that Respondent (Gefanuc Cnc Spares Ltd.) is not commonly known by the name comprised in the Domain Name (<gefanuc-parts.eu>).

Bad faith
The Panel preliminary notes that Regulation (EC) 874/2004 also allows revocation of a speculative or abusive domain name if the holder has a legitimate interest, but has registered or uses the domain name in bad faith.

Complainants contend that Respondent is using the disputed domain name to disrupt Complainants' business (article 21(3)(c) of Regulation (EC) 874/2004) and with an intent to confuse (article 21(3)(d) of Regulation (EC) 874/2004).

The Panel first addresses the complaint that Respondent is disrupting Complainants' business by illicitly diverting or siphoning off customers. Complainants have not further substantiated this allegation and refer to CAC Case No. 6920 (FANUC-CNC), where a similar conclusion was supposedly drawn. That case, however, pertained to a domain name wholly incorporating Complainants' trademarks without an additional specification of intended purpose, such as '-parts'. Further, the Panel emphasizes that article 21(3)(c) of Regulation (EC) 874/2004 applies to a situation where a domain name is registered to disrupt professional activities of a competitor. Complainants merely refer to Respondent's current use. The Panel thus finds that Complainants have insufficiently substantiated their allegations under article 21(3)(c) of Regulation (EC) 874/2004.

Complainants further contend that Respondent has an intent to confuse and primarily refer to the Pennine Website. As such the arguments put forward by the Complainants do not appear to directly pertain to the disputed domain name, but in fact address concerns regarding the content of the Pennine Website. The Panel has already concluded that such concerns might be justified, but do not in itself warrant the conclusion that Respondent lacks a legitimate interest in the domain. Subsequently the Panel questions to what extent these

concerns regarding a website's content qualify as registration or use of the disputed domain name in bad faith (article 21(1)(b) of Regulation (EC) 874/2004).

Regulation (EC) 874/2004 does not specify the scope of behavior that should be considered when evaluating registration or use in bad faith. Examples of bad faith provided in article 21(3)(a) - (e) of Regulation (EC) 874/2004 appear to primarily refer directly to behavior in relation to the disputed domain name, such as selling or preventing another to acquire the disputed domain name. An exception is the example of article 21(3)(d) Regulation (EC) 874/2004, which refers to a likelihood of confusion as to "a product or service on the website". Nevertheless such likelihood of confusion in relation to the website is still tied to the actual use of the domain name (the example of article 21(3)(d) Regulation (EC) 874/2004 requires that the domain name "was intentionally used to attract Internet users").

The Handbook further discusses the scope of behavior to be assessed and also primarily addresses behavior directly related to the domain name, such as non-use and high volume registrations. Nonetheless, the Handbook also addresses grounds for bad faith if the respondent wants to create a false impressions of affiliation with the complainant and specifically mentions that the content of the domain name can be relevant (page 43 Handbook).

The Panel finds that Complainants did not explicitly substantiate the relation between the registration or use of the disputed domain name and the content of the Pennine Website brought forward to show bad faith. Nonetheless, Complainants have diligently set out the confusing similarity between Complainants' trademarks and the Pennine Website. The Panel is of the opinion that this level of similarity, which could be considered misleading, brings into question whether Respondent has registered the domain name for its arguably infringing website to imply an economic connection with Complainants and thus acted in bad faith. The outcome of such a question appears to be heavily dependent of one's viewpoint. Either Respondent is offering an objectionable website on its bona fide disputed domain name, or Respondent has sought to register the disputed domain name to further increase the likelihood of confusion.

In this case the Panel finds that Respondent is using the disputed domain name to add to the likelihood of confusion already created by the Pennine Website, as Respondent has chosen to use a favicon similar to the favicon used by Complainants. This favicon specifically suggests that the entered disputed domain name is part of Complainants' official domain names. For this reason the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.

DECISION

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

PANELISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2015-09-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: gefanuc-parts.eu

II. Country of the Complainant: Great Britain, country of the Respondent: Great Britain

III. Date of registration of the domain name: 10 April 2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
- UK word mark FANUC registered under no. 910676 on 13 June 1967 for goods in class 9;
- UK word mark FANUC registered under no. 1182663 on 1 October 1982 for goods in class 7;
- UK word mark FANUC registered under no. 2337783 on 15 July 2003 for goods in classes 7 and 9; and
- International word mark FANUC registered under no. 948323 on 11 June 2007 for goods and services in classes 7, 9, 37 and 42

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. Yes

2. Why: Respondent is using a domain name for bona fide offering of Complainant's parts under the trademarks, and published a disclaimer on the website under the disoputed domain name

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Respondent is using the disputed domain name to add to the likelihood of confusion with Complainant's trademarks

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant:

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