Panel Decision for dispute CAC-ADREU-007151

Case number	CAC-ADREU-007151
Time of filing	2016-04-01 12:40:27
Domain names	bmw-navigation.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Name	Jiri Svec

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 which relate to the disputed domain name.

FACTUAL BACKGROUND

- The disputed domain name <bmw-navigation.eu> was registered by the Respondent on 18 October 2013.

- The Complainant, Bayerische Motoren Werke AG (BMW AG), is a holder of a word “BMW” Community Trade Mark, filing date 1 April 1996, registration date 25 February 2000, trademark no. 000091835, registered for classes 1-18, 20-30, and 32-42 (hereinafter referred to as "trademark"). The “BMW” also constitutes a distinctive part of the Complainant's company name abbreviation under which it operates worldwide.

- The Respondent is an individual based in the Czech Republic, who used the disputed domain name for offering unauthorised navigation data updates together with likely illegally created activation codes (FSC/Freischaltcode).

- The Complainant seeks transfer of the disputed domain name from the Respondent and maintains that the Respondent has registered the disputed domain name without rights or legitimate interest in the name and has acted in bad faith in registering and using it.

- In response to the Complaint the Respondent deleted the DNS records and website content, made the site inaccessible and expressed that he has no interest to renew the disputed domain name after its expiry date.

A. COMPLAINANT

The Complainant contends as follows:

- The Complainant requests the transfer of the disputed domain name <bmw-navigation.eu> as it was registered in a speculative and abusive manner, pursuant to Article 21(1) Commission Regulation (EC) No 874/2004 (the “Regulation”).

- The disputed domain name <bmw-navigation.eu> contains the renowned company name “BMW” and the worldwide protected and well-known trademark “BMW” followed by the merely descriptive, non-distinctive term “navigation”. Therefore, the disputed domain name is identical in its distinctive part and confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law.

- The disputed domain name <bmw-navigation.eu> has been registered without rights or legitimate interest in the name and trademark “BMW” together with the descriptive term “navigation”, and it has been registered and is being used in bad faith.

- The requirements of Article 21(2) of the Regulation are not fulfilled by the Respondent. The Respondent offers pirated navigation data updates that infringe copyrights thereto, together with illegally created activation codes (FSC/Freischaltcode). Respondent is neither allowed by nor in any way related to Complainant or its BMW distribution network. Therefore, the Respondent has no legitimate interest to use the disputed domain name in the manner described above.

- The Respondent's bad faith may be demonstrated in at least the provisions of the Article 21(3) (c) and (d) of the Regulation. The Respondent has registered the disputed domain name in order to establish an illegal business that is disrupting the professional activities of the Complainant. The Respondent is selling counterfeit, illegal updates for BMW navigation and intends to attract customers by using the trademark of BMW in the domain name together with the descriptive element "navigation".

- The Respondent is a professional counterfeiter. The disputed domain name needs to be transferred to Complainant in order to stop Respondent's illegal business.

The Complainant presented the following evidence, which has been assessed by the Panel:

(1) Link to the Complainant's website (www.bmw.com);
(2) Excerpt regarding BMW (word), Community Trade Mark, filing date 1 April 1996, registration date 25 February 2000, trademark no. 000091835, registered for classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42;
(3) Screenshots of the website (available on internet address containing the disputed domain name) with the Respondent's content.

B. RESPONDENT

The Respondent provided a brief response to the Complaint which merely reads in its relevant part: "I deleted DNS records and website content. Site is now unreachable. Domain expiry at end of October 2016. I don't renew it."

No other reasoning or statement was provided by the Respondent.

DISCUSSION AND FINDINGS

1. DOMAIN NAME IDENTICAL OR CONFUSINGLY SIMILAR TO A NAME IN RESPECT OF WHICH A RIGHT IS RECOGNIZED

Since the domain name and the Complainant's trademark are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term "BMW" accompanied by a word "navigation" is confusingly similar to the Complainant's trademark.

The threshold test for confusing similarity involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant "BMW" element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant's trademark and such domain name. Addition of non-distinctive element - a word "navigation" - cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and business and thus the likelihood of confusion still exists.

The ".eu" top-level suffix in the domain name is disregarded under the confusing similarity test as it is a technical requirement of registration.

Therefore, the Panel holds that the disputed domain name is identical in its distinctive component and at the same time confusingly similar as a whole to Complainant's trademark, i.e. to a name in respect of which Complainant's right is recognised.

2. ALLEGED REGISTRATION OF DOMAIN NAME WITHOUT RIGHTS AND LEGITIMATE INTEREST

With respect to the alleged registration of the disputed domain name without rights or legitimate interest, the Panel holds as follows:

A. Rights

The Respondent did not show existence of any formal rights to a “BMW” denomination.
Based on general Internet search, the Respondent is not commonly known by the disputed domain name, on contrary, the majority of results lead to the Complainant´s domain names.

B. Legitimate Interest

According to Article 21, paragraph 2 of the Regulation a legitimate interest may be demonstrated where (a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name 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 holder of a domain name, 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 holder of a domain name 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.

As shown and documented by the Complainant with copies of the disputed domain name website, the Respondent offered activation codes (FSC / Freischaltcode) for all CIC and NBT navigation systems and updates of all BMW Road Maps. The Complainant confirmed that the Respondent did not have Complainant’s consent nor it was in any way related to Complainant or its BMW distribution network.

In light of the above, the Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in the name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name.

Given the foregoing, the Panel holds that the Respondent registered the disputed domain name without rights or legitimate interest within the meaning of Article 21 (2) of the Regulation.

3. ALLEGED REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH

As described above, the Respondent used the disputed domain name to attract BMW customers, offering among others unauthorised updates for BMW navigation. Given the fact that after the Complaint was filed the Respondent actively deleted the DNS records and website content, made the site unreachable and declared no intention to renew the disputed domain name after expiry date, it is in Panel’s view unlikely that the Respondent acted in good faith.

In addition, since offering of unauthorised activation codes (FSC / Freischaltcode) to public is likely to be considered as a copyright infringement in light of the Article 6 of the Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society (as implemented by EU Member States), the Panel, on balance of probabilities, holds that the disputed domain name has been registered and subsequently used for illegitimate purposes.

To conclude, the Panel holds that the domain name was registered primarily for the purpose
of disrupting the professional activities of a the Complainant and at the same time the disputed domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website by creating a likelihood of confusion with Complainant's trademarks; such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website.

Given the foregoing, the Panel holds that bad faith was demonstrated within the meaning of Article 21 (3), letter (c) and (d) of the Regulation.

4. CONCLUSION

In light of the above, the Panel holds that indications and evidence exist that the disputed domain name was registered and is being used, without rights or legitimate interest in the name and in bad faith.

As a remedy sought under the Complaint, the Complainant requires the disputed domain name to be transferred from the Respondent to the Complainant. The Complainant has proved satisfaction of the general eligibility criteria set out in Article 4 (2) (b) of Regulation (EC)

No 733/2002 of the European Parliament and of the Council. Moreover, the Complainant provided the Panel with evidence proving that the Complainant uses a company name identical to the disputed domain name and that it owns the “BMW” Community trademark (now EU Trademark) with rights established by Community law (due to prior registration of the abovementioned Community trademark) and German law (through the company name).

As the Complainant meets the requirements for the transfer of the disputed domain name, as defined within Article 22 (11) of the Regulation and, consequently, in Article 4 (2) (b) of Regulation (EC) No 733/2002 of the European Parliament and of the Council on the implementation of the .eu Top Level Domain and has also provided evidence that substantiates the formal rights of the Complainant with regard to the disputed domain name, the Panel orders the transfer of the domain name <bmw-navigation.eu> from the Respondent to the 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 BMW-NAVIGATION be transferred to the Complainant.

PANELISTS

Name	**Baker & McKenzie, v.o.s., JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2016-04-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Disputed domain name: bmw-navigation.eu

II. Country of the Complainant: Germany, country of the Respondent: Czech Republic

III. Date of registration of the domain name: 18 October 2013

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

word “BMW” Community Trade Mark, filing date 1 April 1996, registration date 25 February 2000, trademark no. 000091835, registered for classes 1-18, 20-30, and 32-42.

V. Response submitted: Yes

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: The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in the name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Respondent used the disputed domain name to attract BMW customers, offering among activation codes (FSC / Freischaltcode) for CIC and NBT navigation systems and updates of all BMW Road Maps. The Complainant confirmed that the Respondent did not have Complainant’s consent nor he was in any way related to Complainant or its BMW distribution network. Panel therefore holds that the domain name was registered primarily for the purpose of disrupting the professional activities of a the Complainant and at the same time the disputed domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website by creating a likelihood of confusion with Complainant's trademarks; such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website.

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. Is Complainant eligible? Yes