Panel Decision for dispute CAC-ADREU-007186

Case number	CAC-ADREU-007186
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Domain names	www.nowamowa.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	NEW SPEECH Dawid Tomaszewski

Respondent

Organization	Porodnia logopedyczna Nowa Mowa s.c. M.Kapuscinska, K.Wanke

FACTUAL BACKGROUND

Relevant facts can be summarised as follows:

The Complainant offers logopaedic and education services related to the treatment of speech impediment and courses. It is the registered owner of the Polish trade mark NOWAMOWA no 258091 registered with priority since June 4, 2012 in Class 16 for books and publications, Class 38 for Internet information and wireless communication services and Class 41 for education services relating to speech impediments. It has produced evidence that it has been using the NOWAMOWA registered trade mark in trade since 2003 when it registered nowamowa.com and promoted its mark on Polish radio.

The Respondent registered the domain name nowamowa.eu ('the Domain Name') on January 16, 2012. It has used the Domain Name to offer logopaedic services in competition with the Complainant.

A. COMPLAINANT

The Complainant's case can be summarised as follows:

The Complainant seeks transfer of the Domain Name as it has been registered and used in bad faith without legitimate interest pursuant to Article 21 (1) Commission Regulation (EC) 874/2004.

Complainant is a sole entrepreneur operating from 2002 under Polish law conducting business in the field of logopaedics including paramedic treatment of speech impediments. It is the owner of

nowamowa.com since July 16, 2003;
nowamowa.pl since July 26, 2008;
newspeech.com since April 30, 2004;
newspeech.pl since January 22, 2015;
newspeech.org since January 26, 2015.

NOWAMOWA is now so linked to the minds of the relevant public with speech impediment treatment and education services provided by the Complainant that the Complainant started to promote it outside Poland. Amongst others the Complainant registered domains containing NEWSPEECH being the translation of NOWAMOWA into English and NEWSPEECH was registered as a European trade mark.

The Complainant has undertaken extensive marketing activities including television and radio programmes, advertisements and newspaper articles and brochures to increase the recognition of its mark amongst customers.

The Respondent also offers logopaedic services. The Domain Name was registered about ten years after the Complainant began offering its services under the NOWAMOWA mark

The Complainant claims the Respondent has registered the Domain Name to unfairly affect the Complainant by using the Complainant's mark in the Domain Name attached to a site offering competing logopaedic services to target the Complainant's customers. Since the Respondent is in the same specialised field as the Complainant the Respondent must have known about the Complainant's mark. The Respondent is using the Domain Name to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trade mark. The Respondent does not have a legitimate right or interest in the Domain Name.

The Complainant issued a pre-trial summons demanding that the Respondent cease using the Domain Name and transfer it to the Complainant but the Respondent did not react.

B. RESPONDENT

The Respondent did not submit a Response in these proceedings.

DISCUSSION AND FINDINGS

A Procedural Order was issued by the Panel on August 8, 2016 requiring the Complainant to resubmit exhibits in chronological order translated into English. This was duly done by the set deadline of August 15, 2016 and the time for the Panel’s decision extended until August 29, 2016 in accordance with Paragraphs B7 (a) of the Rules.

Under Article 21 (1) of Commission Regulation (EC) No 874/2004 ("the Regulation") in order to succeed under this dispute resolution procedure a Complainant must show that the Domain Name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law and the Domain Name:

(a) has been registered by its holder without rights or legitimate interest in the name; or

(b) has been registered or is being used in bad faith.

The Complainant is the proprietor of the NOWAMOWA trade mark in Poland exclusive right no 258091 registered as a word trade mark with priority since June 4, 2012 in Class 16 for books and publications, Class 38 for Internet information and wireless communication services and Class 41 for education services relating to speech impediments. Furthermore, it has produced evidence to show that it has traded under the NOWAMOWA mark since 2003.

It should be noted that National law is relevant to the existence of prior rights, according to Article 21 (1) of Commission Regulation (EC) No 874/2004. This has been confirmed by several ADR decisions (see VIVARTIA-INDUSTRIAL & COMMERCIAL COMPANY OF FOOD PRODUCTS & CATERING SERVICES v. Anastasios Karkazis, CAC 4099, <vivartia.eu>). In that regard, there are two types of protection for unregistered marks in Poland: (i) protection as a well-known trade mark under Article 6bis of the Paris Convention for the Protection of Industrial Property (ii) and protection as an unregistered mark under the Unfair Competition Law 1993. According to the Unfair Competition Law, in some circumstances the holder of an unregistered trademark can prevent third parties from using later marks on the market provided that the earlier unregistered trademark was used in the course of business. There are no strict rules defining the use of an unregistered mark. Nevertheless, there is some guidance set out by case law. Namely these elements are to be considered: (i) the duration of

use, (ii) use in the course of business for the goods or services for which protection is sought, (iii) sufficient level of distinctiveness. As stated above, the Complainant submitted evidence that it has traded under the NOWAMOWA mark since 2003. Furthermore, the Panel states that NOWAMOWA mark is distinctive and notes that the Respondent has used the Domain Name to offer competing services to the Complainant. Therefore, the Panel holds that the Complainant has unregistered rights in the mark NOWAMOWA dating back to 2003.

Furthermore, the Panel notes that according to settled case law the Complainant can have relevant right from a trademark or service mark even if it is registered only after the domain registration for there is no specific reference to the date on which the complainant must have acquired the rights in Article 10 (1) of Commission Regulation (EC) No 874/2004 (see Piotr Warmowski v. Arcabit Sp. z o.o., Arcabit Sp. z o.o., CAC 5996, <arcabit.eu>).

The dominant part of the Domain Name comprises the term 'nowamowa' which is identical to the Complainant's trade mark. The top level domain ".eu" is ignored for the purposes of this comparison. The Domain Name is, therefore, identical to the Complainant's NOWAMOWA trade mark within Article 21 (1) of the Regulation.

The Respondent registered the Domain Name on January 16, 2012. It has not submitted any evidence of any registered rights or trade usage associating it with the name 'nowamowa''. However, the evidence shows that the Respondent has used the Domain Name to offer competing services to the Complainant and that the Respondent's company name contains term NOWAMOVA. In that regard, it should be noted that a difference is to be made between a company name and a business name. In other words, indeed it's not sufficient for a respondent to establish that a disputed domain name contains its company name but a respondent has also establish that he or she is using his or her company name as a business name, i.e. he or she is using his or her company name in the course of business on a regular basis. In that regard, the Respondent has failed to provide any evidence thereof. The Panel has therefore no information on business of the Respondent apart from those which are evident from the website to which resolves the Domain Name. As stated above, from that website itself only limited conclusions can be drawn for on the webpage there is only (i) the name of the Respondent (ii) together with its contact details and (iii) its field of business (i.e. logopeadic services). Indeed, even though this is certainly enough for the Panel to find on the balance of probabilities that the Respondent offers competing service (or at least is attempting to offer competing services); this is not enough to establish that the Respondent is actually commonly known under its company name in relevant circles. Therefore the Panel rules that on the balance of probabilities the Respondent cannot claim any legitimate rights or interests resulting from its company name.

Furthermore, given that the Respondent works in the same specialised field as the Complainant and began use of the Complainant's mark ten years after the Complainant began trading in it without providing any explanation as to why it should be able to use the Complainant’s registered mark which has been used in trade by the Complainant since 2003 the Panel agrees with the Complainant that this is not a bona fide offering of goods and service, nor a legitimate fair or non commercial usage without intent to mislead customers or harm the reputation of the Complainant's name. The Respondent has not responded with any reason why it should be allowed to use the Complainant's mark in which the Complainant has prior rights and does not appear to have rights or legitimate interests in the Domain Name within the meaning of Article 21 (2) of the Regulation.

By using the Domain Name for a competing site the Respondent is confusing customers as to the origin of its web site and the services offered thereon for its own commercial gain. As such the Respondent has registered and is using the Domain Name in bad faith and falls within the ambit of Article 21 (3) (d) of the Regulation.

DECISION

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

PANELISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2016-08-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: nowamowa.eu

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

III. Date of registration of the domain name: 16.01.12

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 registered in Poland, reg. No. 258091 for the term NOWAMOWA filed on 16.01.12, registered in Class 16 for books and publications, Class 38 for Internet information and wireless communication services and Class 41 for education services relating to speech impediments. goods and services in classes 16, 38 and 41;

2. unregistered trademark NOWAMOWA used in Poland since 2003.

V. Response submitted: No

VI. Domain name is identical 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: Using the Complainant's registered mark in competition to sell the same services with no explanation why.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Operating in the same specialised field as the Complainant the Respondent must have known about the Complainant's mark. The Respondent is using the Domain Name to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trade mark.

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. Is Complainant eligible? Yes