Panel Decision for dispute CAC-ADREU-007201

Case number	CAC-ADREU-007201
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Domain names	mouboots.eu

Case administrator

	Lada Válková (Case admin)

Complainant

Organization	Mou Limited

Respondent

Name	Franziska Hirsch

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 pending or concluded proceedings concerning the disputed domain name.

FACTUAL BACKGROUND

The disputed domain name 'mouboots.eu' was registered on October 19, 2015. The Respondent is a German resident and is the holder of the disputed domain name.

The Complainant is a company from United Kingdom. One of the internet site operated by the Complainant (www.moulondon.com) shows that the Complainant advertises and sells footwear and various accessories under the brand MOU.

The Complainant is a proprietor of several registered and valid trademarks comprising the word MOU, namely:
- UK national trademark 'mou' stylized; No. 2432785; application date: September 16, 2006; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid;
- UK national trademark 'mou' stylized; No. 2513487; application date: April 8, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid;
- UK national trademark 'mou' stylized; No. 2511429; application date: March 18, 2009; covering goods in class 18 of the Nice classification; status: registered and valid;
- European Union trademark (EUTM) 'mou' stylized; No. 8164204; application date: March 18, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid;
- EUTM 'mou' stylized; No. 8575607; application date: September 8, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid.

The Complainant filed a complaint seeking the transfer of the disputed domain name to itself on April 21, 2016 and amended the complaint upon request by ADR Center on May 9, 2016. The notification on the commencement of the ADR procedure was sent to the Respondent on May 10, 2016. However, the Respondent failed to respond to the notification and the complaint within the set time limit.

A. COMPLAINANT

The Complainant maintained to be the proprietor of the following registered trademarks valid in the European Union: (1) UK national trademark 'mou' stylized; No. 2432785; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; (2) UK national trademark 'mou' stylized; No. 2513487; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; (3) UK national trademark 'mou' stylized; No. 2511429; covering goods in class 18 of the Nice classification; (4) EUTM 'mou' stylized; No. 8164204; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; and (5) EUTM 'mou' stylized; No. 8575607; covering among others: clothing, footwear, headgear in class 25 of the Nice classification.

The Complainant also asserted that it owns several domain names comprising the element MOU which were registered before the disputed domain name, such as buymou.com, mouboot.info, mou-boot.info, mouboot.us, mou-boot.us, mou-boots.biz, mouboots.info, mou-boots.org, mouboots.us, mou-online.com and others.

The Complainant invoked also UK common law rights of passing off based on the use of the brand MOU for footwear and accessories, acquired reputation and goodwill in the brand MOU. Related to this argument, the Complainant argued as follows:
- The Complainant has significant online presence with its websites at www.moulondon.com and www.mou-online.com which feature also on-line store for MOU branded products.
- The Complainant's brand MOU is well regarded in the fashion industry and endorsed by celebrities, such as Cameron Diaz and Gwyneth Paltrow.
- The Complainant makes wholesale sales of MOU branded products in various countries of EU, including Germany, UK, France and Belgium.
- The Complainant operates various social media accounts, including that on Facebook.

The complainant contended that the disputed domain name is similar to the Complainant's trademarks and unregistered rights, because it contains the word MOU, whereas the additional element of the disputed domain name BOOTS is merely descriptive of the relevant goods and does not enable consumers to distinguish between the Complainant's rights and the disputed domain name.

The Complainant also argued that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never granted any license to the Respondent to use the brand MOU or to register any domain name.

The Complainant stated that the disputed domain name had been registered and has been used in bad faith, because the Respondent must have been aware of the Complainant's rights and use of the brand MOU at the time of registration of the disputed domain name. Furthermore, the disputed domain name has clearly been used for a website imitating the genuine brand MOU, with a purpose to deceive the customers into mistakenly believing that the products offered at that internet site are genuine products MOU of the Complainant.

The Complainant requested that the disputed domain name be transferred to the Complainant.

B. RESPONDENT

The Respondent did not respond to the complaint and the notification of commencement of the ADR procedure.

DISCUSSION AND FINDINGS

1. According to Article 21(1) of Commission Regulation No. 874/2004 a registered domain name shall be revoked if that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as national trademarks or Community trademarks, and where 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.

2. According to Article 22 (11) of Commission Regulation No. 874/2004 the domain name shall be transferred, instead of revoked, if the complainant satisfies the general eligibility criteria set out in Article 4(2)(b) of the Regulation No. 733/2002, for example if a complainant is a company with its registered office or principal place within the European Union.

3. Based on statements by the Complainant and evidence submitted with the complaint, namely copies of trademark registration certificates, the Panel establishes that the Complainant indeed is the proprietor of the following registered and valid trademarks:
- UK national trademark 'mou' stylized; No. 2432785; application date: September 16, 2006; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid;
- UK national trademark 'mou' stylized; No. 2513487; application date: April 8, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid;
- UK national trademark 'mou' stylized; No. 2511429; application date: March 18, 2009; covering goods in class 18 of the Nice classification; status: registered and valid;
- EUTM 'mou' stylized; No. 8164204; application date: March 18, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid; and
- European Union trademark (EUTM) 'mou' stylized; No. 8575607; application date: September 8, 2009; covering among others: clothing, footwear, headgear in class 25 of the Nice classification; status: registered and valid.

4. All cited trademarks were applied for registration before the disputed domain name was registered on October 19, 2015, so they had enjoyed earlier legal protection in the EU.

5. The disputed domain name is confusingly similar to all cited trademarks, because it is obviously composed of two parts. The first part MOU does not have any particular meaning in English, but indicates the brand MOU used by the Complainant and is identical to the word element of the cited trademarks. The second element BOOTS merely describes the product which is advertised and sold under the Complainant's trademark MOU. It is important that four of the cited trademarks (UK 2432785, UK 2513487, EUTM 8164204, and EUTM 8575607) cover footwear in class 25, so their scope of protection extend to boots as well. Although the cited trademarks comprise graphic elements in addition to the word element MOU, namely typeface and designed letter O, their dominant distinctive element is the word MOU itself.

6. The Complainant asserted that no license was granted to the Respondent to use any of the cited trademarks or to register a domain name comprising the brand MOU. Given that the Respondent failed to respond to the complaint, the Panel has no reason to doubt that assertion. The Complainant provided evidence of a prima facie lack of rights or legitimate interests on the part of the Respondent, so the Panel concludes that the Respondent had acquired the registration of the disputed domain name without any rights or legitimate interest in that name.

7. From evidence submitted with the complaint, namely copies of the genuine MOU websites, the Complainant's MOU brand profile and press releases and copies of the Complainant's MOU profile pages on Facebook, the Panel concludes that the Complainant is running a serious business advertising and selling footwear and accessories under the brand MOU with significant press appearances and celebrity endorsements. Consequently, the cited trademarks have definitely become a known brand with reputation for footwear and accessories among consumers at least in UK, but possibly also in USA and throughout European Union.

8. The Panel finds that the Respondent registered and used the disputed domain name in bad faith. In the light of the use of the brand MOU by the Complainant and acquired reputation by this use, it seems almost impossible that the Respondent would register the disputed domain name by mere coincidence. The Complainant submitted also copies of the web site with on-line store at the disputed domain name, where the footwear, including boots, was sold under the brand MOU, which was identical in every detail with the cited trademarks and the brand used by the Complainant. It is significant that both, the Complainant's genuine web sites and web site at the disputed domain name, were in English language and had prices expressed in British pounds, so it is obvious that they were both targeting at least one common group of consumers, namely UK consumers. Taking all these objective facts into consideration, the Panel concludes that the disputed domain name has been used in bad faith within the meaning of Articles 21(3)(d) of the Commission Regulation 874/2004.

9. The Complainant asserted to be a UK company, but did not submit any documents to support this assertion. The Panel exercised its discretionary right to conduct its own investigation according to Paragraph B 7 (a), of the ADR Rules, and checked the legal status of the Complainant in the publicly available online database at https://beta.companieshouse.gov.uk/search/. The Panel discovered that in the UK there is only one company named Mou Limited, with the registered office address at Basement 32 Woodstock Grove, London, Uk, W12 8LE, United Kingdom, which is the same address as stated in the complaint. Therefore, the Panel concludes that the Complainant indeed is a UK registered company and consequently satisfies the general eligibility criteria under Article 4(2)(b) of the Regulation No. 733/2002 to be the holder of the .eu top level domain name.

10. Given that the registration of the disputed domain name was speculative and abusive according to Article 21(1) of the Commission Regulation No. 874/2004, and the Complainant satisfies the general eligibility criteria under Article 4(2)(b) of the Regulation No. 733/2002, the Panel grants the Complainant's request and transfers the disputed domain name to the Complainant according to Article 22(11) of the Commission Regulation No. 874/2004.

DECISION

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

PANELISTS

Name	Gregor Macek

DATE OF PANEL DECISION 2016-07-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: mouboots.eu

II. Country of the Complainant: United Kingdom, country of the Respondent: Germany

III. Date of registration of the domain name: 19 October 2015

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. combined trademark 'mou' registered in UK, reg. No. 2432785, for the term 10 years, filed on 16 September 16 2006, registered on 15 June 2007 in respect of goods and services in classes 3, 24 and 25
2. combined trademark 'mou' registered in UK, reg. No. 2513487, for the term 10 years, filed on 18 April 2009, registered on 16 October 2009 in respect of goods and services in classes 3 and 25
3. combined trademark 'mou' registered in UK, reg. No. 2511429, for the term 10 years, filed on 18 March 2009, registered on 11 September 2009 in respect of goods and services in class 18
4. combined EUTM, reg. No. 8164204, for the term 10 years, filed on 18 March 2009, registered on 11 December 2009 in respect of goods and services in classes 3, 18 and 25
5. combined EUTM, reg. No. 8575607, for the term 10 years, filed on 8 September 2009, registered on 22 February 2010 in respect of goods and services in classes 3, 18 and 25

V. Response submitted: No

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 did not grant any rights to the Respondent. The Respondent failed to provide any evidence of rights or legitimate interest in the Domain Name although it was duly given a chance to do so.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Respondent registered domain name and used it to set up an online store offering identical products with the Complainant's, namely boots, and under the brand MOU which was identical with the Complainant's trademarks and used brand, thereby misleading consumers into mistakenly believing that offered goods were genuine.

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