Panel Decision for dispute CAC-ADREU-007202

Case number	**CAC-ADREU-007202**
Time of filing	**2016-08-26 09:39:21**
Domain names	**otokar.eu**

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Name	**Gbenga Osoba**

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 proceeding regarding the disputed domain name.

FACTUAL BACKGROUND

The Complainant Otokar Otomotiv ve Savunma Sanayi A.Ş which is one of the subsidiaries of KOÇ HOLDING A.S., which is presented as "the Turkey's largest industrial and services group in terms of revenues, exports, share in Istanbul Stock Exchange and number of employees".

The Complainant, as being one of Koç Holding's subsidiaries is providing solutions special to the needs of the customers with its own technology, design and applications since 1963. The Complainant operates over 2000 employees at the factory built on a land of 552,000 m2 in Sakarya, Turkey. The Complainant has been manufacturing buses for public transportation, semitrailers for transportation and logistics industry and tactical wheeled vehicles and tactical armored vehicles for the defense industry. The Complainant is today present in the automotive and defense industries with products protected with intellectual property rights. Being a leader in the transportation industry and the land vehicles in the defense industry in Turkey, Otokar is the main contractor in the Design and Prototype Development Project of ALTAY, the national battle tank of Turkey.

The Complainant defined itself as Turkey's largest private and 100% domestically owned company in defense industry with its products being in use on 5 continents and in more than 60 countries. As of the year 2015, with an 16,4% increase compared to the same period of previous year, the Complainant generated a total of TRY 1.433,9 million.

The Complainant is also known as the first intercity bus manufacturer in Turkey, revolutionizing the relevant industry. The Complainant's armored cars and military Land Rovers are also well-renowned and used by the Turkish Air, Land and Naval forces.

Furthermore, OTOKAR is a well-known brand around the world as well. Otokar Europe was established in 2011 in France, company name being Otokar Europe SAS at the address of Rue du Noyer 24, Parc Les Scientifiques De Roissy Lot A-3 95700 Roissy-en-France. As "Otokar" branded vehicles are distributed in more than 60 countries, on 5 continents, the sales and service network spreads over more than 200 destinations. According to the reports on the 2015 fiscal year, the Complainant's export revenue is over 140 Million USD.

The Complainant's trademark "OTOKAR" has been registered firstly on July 02, 1996 before the Turkish Patent Office (TPO). Following this registration, "OTOKAR" mark and its derivatives have been subject to several other registrations on various goods and services.

The Complainant claims to have rights in inter alia these word trademarks:

(i) EU TM No. 009348731 “OTOKAR ULTIMO”, registered on February 11, 2011 in class 12;

(ii) EU TM No. 009348772 “OTOKAR ARMA”, registered on February 11, 2011 in class 12;

(iii) International TM No. 1054049 “OTOKAR”, registered on August 03, 2010 in classes 12 and 37.

The Complainant is also the legal owner of the domain name <otokar.com> reserved since at least 2001.

Furthermore the Complainant claims it uses “OTOKAR” as trade name since at least 1963.

The Complainant filed a complaint (the “Complaint”) with the Alternative Dispute Resolution centre (the “Centre”) for .eu domain name disputes on April 20, 2016. The Centre sent a notification of fees unpaid on April 25, 2016 which remedies was acknowledged on May 2, 2016. A minor notification of deficiency of the Complaint was issued and remedied by filing an amended Complaint on May 11, 2016. The proceedings were commenced on May 16, 2016 in accordance with paragraph B2 (a) of the ADR Rules. The Centre appointed Mr David-Irving Tayer as the sole panellist in this matter on July 27, 2016.

The disputed domain name was registered on April 10, 2006.

A. COMPLAINANT

The Complainant claims that the disputed domain name <otokar.eu> is identical to the complainant’s "OTOKAR" mark because the domain name wholly incorporates the word "OTOKAR".

Furthermore, the Complainant claims that when registering the disputed domain name the Respondent knew that “OTOKAR” was the commercial name and well-known registered trademark of the Complainant.

The Complainant also indicates that it has not licensed or otherwise permitted the respondent use the mark “OTOKAR” or to apply for or use any domain name incorporating that trade/service mark. The Respondent has no relationship with or permission from the Complainant for use of its marks. The Complainant has prior rights in that trade/service mark, which precede respondent’s registration of the domain name. The Respondent has acquired no trademark or service mark rights in name “OTOKAR” and, there is no common knowledge (as an individual, business, or other organization) that the Respondent is known by the disputed domain name.

According to the Complainant the only interest which can be imagined for a person, not having an apparent particular connection to the trademark “OTOKAR”, in registering the domain name <otokar.eu> is to somehow create a connection to the Complainant and its trademark “OTOKAR”. The Respondent is clearly aware of the Complainant’s extensive goodwill and reputation in its service and trademark “OTOKAR” and its other derivatives. Even though the holder of the disputed domain is recorded as Gbenga Osoba, the disputed domain actually resolves into a website with a caption “DOMAIN FOR SALE” showing information regarding another Turkish company called BMC Otomotiv Sanayi ve Ticaret A.Ş. which in fact operates in transportation industry as well. It is come to the attention that this website apparently a copy-paste creation of BMC Otomotiv Sanayi ve Ticaret A.Ş.’s official website www.bmc.com.tr.

The Complainant also contends that it is highly likely that the original holder of the domain name in subject is a Turkish citizen and apparently knows the Complainant very well. It seems that the subject domain which contains the Complainants registered well-known trademark “OTOKAR” in its entirety was registered to deliberately place content associating with one of the Complaints competitors to the website in relation for personal gain.

The Complainant claims that the Respondent registered the disputed domain name with bad faith and false holder information, additionally offered the disputed domain for sale for personal gain.

According to the Complainant, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site. The Respondent has unfairly tries to take advantage of the undisputed fame of the trade/service mark “OTOKAR” associated directly with the Complainant. The Respondent could have chosen domain names adequately reflecting both the object and independent nature of its site, as evidenced today in thousands of domain names.

Finally, the Complainant states that the Respondent’s bad faith is also shown by its use of the Domain Name or lack thereof. The Respondent has placed copy-paste content taken from the Complainant’s competition BMC Otomotiv Sanayi ve Ticaret A.Ş.’s official website <www.bmc.com.tr>. The subject website contains a “DOMAIN FOR SALE” caption as well.

In the light of these demonstrations, the Complainant requests the transfer of the domain name.

B. RESPONDENT

The Respondent has not submitted a response to the Complaint.

DISCUSSION AND FINDINGS

According to Article B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that Complainant proves in the ADR proceeding that:

(i) the domain 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 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 Panel will thus examine each of this condition successively.

1- Is the disputed domain identical or confusingly similar?

The question whether the domain 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 shall be analysed.

The Complainant has proven that it is the holder of trademarks OTOKAR or OTOKAR combined with another element having both national registrations in several countries and international registration under Madrid Protocol. Though some are posterior to the date of reservation of the challenged domain names, it remains that the Complainant owns clear prior rights on the domain name <otokar.com>, registered national Turkish trademarks, all these rights comforted by further filings worldwide.

The disputed domain name with evidence is the exact reproduction of the term OTOKAR on which the Complainant owns rights.

Therefore, the domain name <otokar.eu> is identical to a name in respect of which a right of Complainant is established, and the condition set forth under Article B11(d)(1)(i) of the ADR Rules is fulfilled.

2- Has the Respondent a right of legitimate interest on the term OTOKAR?

The Complainant submits that the Respondent does not have any rights or legitimate interests in the disputed domain name because there is no evidence of bona fide use of an equivalent mark by the Respondent and the Complainant has never authorised the use of, or licensed the use of, the disputed domain name, by or to the Respondent.

Additionally, the content of the webpage presenting the website of a competitor of the Complainant and the indication of "domain for sale" bolsters the idea that the Respondent does not have any rights or legitimate interest. Should it be the contrary this would likely appear clearly on the website attached to the disputed domain name. Though the Respondent had a possibility to notify the Panel of its rights or legitimate interests in the name by filing a response to the complaint but the Respondent did not file any response in this ADR case. Similarly, the Respondent has made no claim that he is using the domain names in connection with a bona fide offering of goods and services and the domain name in question is not a mark by which the Respondent is commonly known.

As a result of the foregoing, the Panel concludes that the Complainant has established a prima facie case that the Respondent registered the disputed domain name without having any rights or legitimate interests in that name. As a result of the Respondent's failure to rebut any of the Complainant's submissions and based further on the discussion under bad faith below, and in the absence of any evidence to rebut the Complainant's case, the Panel infers that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complaint succeeds in relation to the second branch of the test under Article 21 (1) of the Regulation (EC) No 874/2004.

3- Has the Respondent registered and used the disputed domain name in bad faith?

As the Respondent has registered domain name <otokar.eu> without rights or legitimate interests in it, it is not necessary to investigate Respondent's possible bad faith under Article B11(d)(1)(iii) of the ADR Rules.

However, the Panel considers opportune to develop this point considering the factual elements.

Indeed, the Complainant submits that the Respondent replicated the website of one of the Complainant's direct competitors in the field of vehicles, undoubtedly known by the Respondent. The coincidence could not be fortuitous. Based on the Complainant's assertion that its trademark OTOKAR has been widely used for over 50 years all over the world and has been distributed under this name since at least 1963, the Panel infers that on the balance of probabilities the Respondent knew of the Complainant's "OTOKAR" mark at the date of registration in April 2006.

By using a replica of the Complainant's competitor website, the Panel finds that the Respondent has acted in blatant disregard for the Complainant's rights and knowingly in bad faith.

The Panel finds that the Respondent's conduct in replicating said website on the disputed domain name was to intentionally attract Internet users for commercial gain to the Respondent's benefit or at least to create a likelihood of confusion in Internet users minds between the products of the Complainant and those of the competitor whatsoever the Respondent is linked or not to said competitor. Purposefully going one step further and specially creating a webpage featuring the Complainant's competitors products and re-directing the disputed domain name to that webpage is plainly even more indicative of the Respondent's bad faith and intent to cause a prejudice to the Complainant.

Accordingly, the Panel finds that the Respondent used the disputed domain name in bad faith and that the Complaint succeeds under the third condition of the test under Article 21 (1) of the Regulation (EC) No 874/2004.

The remedy sought by the Complainant is transfer of the domain name <otokar.eu> to the Complainant's EU branch - Otokar Europe SAS. Following established case law, the Panel's view is that by nominating its EU branch as the transferee of the disputed domain name the Complainant through its branch incorporated in France is an entity eligible to be the holder of .eu domain name in accordance with Paragraph 4(2)(b) of Regulation (EC) No 733/2002.

DECISION

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

the domain name OTOKAR.EU be transferred to the Complainant's registered company in France Otokar Europe SAS at the address of Rue du Noyer 24, Parc Les Scientifiques De Roissy Lot A-3 95700 Roissy-en-France.

PANELISTS

Name	**david.tayer TAYER**

DATE OF PANEL DECISION 2016-08-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: [otokar.eu]

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

III. Date of registration of the domain name: 10 April 2006

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

The Complainant's marks registered before the Turkish Trademark Office listed below:

Registration No. 89377 Protection date: 06.02.1996 Renewed on: 06.02.2016 in class 12
Registration No. 164864 Protection date: 17.10.1995 Renewed on: 17.10.2015 in classes 12, 13
Registration No. 173362 Protection date: 20.06.1996 Renewed on: 20.06.2016 in class 37
Registration No. 2005 22235 Protection date: 01.06.2005 Renewed on: 01.06.2015 in classes 07, 08, 09, 12, 21, 35, 37

Registration No. 2004 07912 Protection date: 25.03.2004 Renewed on: 25.03.2014 in classes 09, 12, 37
Registration No. 2003 12203 Protection date: 20.05.2003 Renewed on: 20.05.2013 in classes 06, 07, 09, 12, 22
Registration No. 2006 20735 Protection date: 05.05.2006 Renewed on: 05.05.2016 in classes 06, 07, 12, 20, 22
Registration No. 2009 48724 Protection date: 11.09.2009 in class 12
Application No. 2016/04569 Protection date: 20.01.2016 in classes 06, 07, 08, 09, 12, 13, 16, 35, 37, 39, 40, 41, 42

The Complainant's marks registered before the EUIPO listed below:

1116726 "OTOKAR KENT" in class 12 since 14.06.2012
008595605 "OTOKAR CENTRO" in class 12 since 06.10.2009
009348731 "OTOKAR ULTIMO" in class 12 since 02.09.2010
009348772 "OTOKAR ARMA" in class 12 since 02.09.2010

The Complainant's marks registered before the WIPO listed below:

1116726 "OTOKAR KENT" in class 12 since 20.04.2009
1054049 "OTOKAR" in classes 12, 37 since 06.02.1996
1129739 "OTOKAR" in classes 12, 37 since 01.06.2005
1149429 "OTOKAR COBRA" in class 12 since 20.05.2003
1187271 "OTOKAR ARMA" in class 12 since 15.06.2009

The Complainant registered domain name "otokar.com" reserved since at least 2001.

The Complainant's company name "OTOKAR" as trade name since at least 1963.

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: The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name because there is no evidence of bona fide use of an equivalent mark by the Respondent and the Complainant has never authorised the use of, or licensed the use of, the Disputed Domain Name, by or to the Respondent.

Additionally, the content of the webpage presenting the website of a competitor of the Complainant and the indication of "domain for sale" bolsters the idea that the Respondent does not have any rights or legitimate interest. Should it be the contrary this would likely appear clearly on the website attached to the disputed domain name. Though the Respondent had a possibility to notify the Panel of its rights or legitimate interests in the name by filing a response to the complaint but the Respondent did not file any response in this ADR case. Similarly, the Respondent has made no claim that he is using the domain names in connection with a bona fide offering of goods and services and the domain name in question is not a mark by which the Respondent is commonly known.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: By using a replica of the Complainant's competitor website, the Panel finds that the Respondent has acted in blatant disregard for the Complainant's rights and knowingly in bad faith.

The Panel finds that the Respondent's conduct in replicating said website on the Disputed Domain Name was to intentionally attract Internet users for commercial gain to the Respondent's benefit or at least to create a likelihood of confusion in Internet users minds between the products of the Complainant and those of the competitor whatsoever the Respondent is linked or not to said competitor. Purposefully going one step further and specially creating a webpage featuring the Complainant's competitors' products and re-directing the Disputed Domain Name to that webpage is plainly even more indicative of the Respondent's bad faith and intent to cause a prejudice to the Complainant.

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