Panel Decision for dispute CAC-ADREU-007226

Case number	CAC-ADREU-007226
Time of filing	2016-06-28 15:12:21
Domain names	telelotobilietutikrinimas.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	UAB Olifeja

Respondent

Organization	MendesSoft

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 other legal proceedings.

FACTUAL BACKGROUND

1.
The dispute relates to the domain name <telelotobilietutikrinimas.eu> ("the Domain Name").

2.
The Complainant having its registered office in the Republic of Lithuania asserts that it is the owner of the following registered Lithuanian trademarks ("the Trademarks"):
a) word mark “TELELOTO“, registration No. 59473 (applied on 20 August 2008, registered on 18 March 2009);
b) word mark „TELELOTO“, registration No. 33265 (applied on 29 May 1997, registered on 1 June 1999);
c) figurative mark “TELELOTO“, registration No. 33266 (applied on 29 May 1997, registered on 1 June 1999);
d) word mark “VIKINGŲ LOTO“, registration No. 62980 (applied on 28 April 2010, registered on 27 December 2010);
e) figurative mark “VIKINGŲ LOTO“, registration No. 64281 (applied on 20 January 2011, registered on 23 November 2011).

The Complainant provided as evidence bilingual (Lithuanian/English) database printouts for the Trademarks, according to which the Trademarks are registered for goods and services in classes 28 and 41 amongst others for games, gambling and organization of lotteries.

3.
The Complainant asserts that it uses the Trademarks when organizing lotteries TELELOTO and VIKINGU LOTO. The official site for these lotteries, so the Complainant is <https://perku.perlas.lt/lt/index>, where consumers (buyers of lottery tickets) can verify the results and, if any, prizes.

4.
The Complainant asserts that the Trademarks are used on a website accessible under the Domain Name without consent from the Complainant, including in the Domain Name itself.

5.
The Complainant furthermore makes the allegation that data (results) which supposedly allow consumers to check the tickets of lotteries TELELOTO and VIKINGU LOTO for prize winnings are used on the website accessible under the Domain Name and which in most cases were incorrect and thereby misleading the consumers. The Complainant states that it received numerous complaints from

the consumers (both oral and written ones).

A. COMPLAINANT

In its Complaint the Complainant makes the following legal arguments:

6.
The Lithuanian Law on Trademarks states that the owner of a trademark has an exclusive right to forbid the use of any mark identical to the registered trademark for identical goods and (or) services in commercial operations without the owner's consent.

7.
The marks used on website accessible under the Domain Name were identical to Trademarks registered by the Complainant and services marked with these marks are identical to services for which the Trademarks are registered and used by the Complainant as the owner of the Trademarks. The Trademarks TELELOTO had been applied to and registered before registration of the Domain Name and the use of the website.

8.
The Complainant asserts that use of the Trademarks in the Domain Name as well as the contents of the website constitute an infringement of exclusive rights of the Complainant as the owner of Trademarks as well as causes damage to the Complainant (including reputational damages caused through misleading consumers – buyers of lotteries' tickets, who are misled by incorrect information given on the website when checking whether the ticket won a prize).

9.
The Complainant argues that cases of illegal use of trademarks in domain names of internet sites falls under the Regulation (EC) No. 874/2004 of 28 April, 2004. Part 1 of Article 21 of this Regulation stipulates that a registered domain name may be revoked when such name is identical or misleadingly similar to the name to which, according to member states' and (or) European Union law, the right indicated in Part 1 of Article 10 is acknowledged or established and such name was registered by its owner not having the rights or legitimate interests in such name, or such name was registered or is being used in bad faith. According to item d) of Part 3 of Article 21 of the same Regulation, the bad faith, within the meaning of the above mentioned Part 1 of Article 21 of this Regulation may be determined where the domain name was intentionally used to attract internet users for commercial gain to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established by national and/or Community law, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name.

10.
The Complainant deems it evident from the printouts from the website accessible under the Domain Name (provided in – presumably – Lithuanian only) that the only purpose of the Respondent is to attract internet users for commercial gain by misleading and confusing them in such a manner, where internet users consider that they access official website of the Complainant. Also, the bad faith of the Respondent is, in the opinion of the Complainant, demonstrated by the fact that when verifying the lotto tickets the internet users are misled by false/incorrect information contained at the Site (the Site does and cannot provide correct information on the results of the lotto games).

B. RESPONDENT

11.
The Respondent did not submit a Response.

DISCUSSION AND FINDINGS

12.
According to Article 1 thereof, Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain (OJ 2002 L 113, p. 1) sets out general rules for the implementation of the .eu Top Level Domain, including the designation of a Registry, and establishes the general policy framework within which that Registry is to function. In accordance with recital 16 in the preamble to that regulation, '[t]he adoption of a public policy addressing speculative and abusive registration of domain names should provide that holders of prior rights recognised or established by national and/or Community law and public bodies will benefit from a specific period of time (a "sunrise period") during which the registration of their domain names is exclusively reserved to [those] holders … and … public bodies'. Article 5(1)(b) of Regulation No 733/2002 provides that 'the Commission shall adopt … rules concerning [inter alia] … public policy on speculative and abusive registration of domain names, including the possibility of registrations of domain names in a phased manner to ensure appropriate temporary opportunities for the holders of prior

rights recognised or established by national and/or Community law and for public bodies to register their names'. It was pursuant to that provision that the Commission adopted Commission Regulation (EG) Nr. 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration ("Regulation 874/2004").

13.
A claim for the transfer of the Domain Name to the Complainant requires, according to Art. 21(1), 22(11) Regulation 874/2004, that the Panel finds 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, such as rights mentioned in Art. 10(1) Regulation 874/2004 and that the Respondent has registered the Domain Name without rights or legitimate interests in the domain name or that the Respondent has registered or is using the domain name in bad faith.

14.
In light of the assertions made by the Complainant the Panel deems it appropriate to emphasize that, in making its decision, it is exclusively bound by the two European Regulations discussed in the previous paragraphs and the ADR Rules and ADR Supplemental Rules rendered by CAC, as far as the EU Regulations leave room for such rules. This means that the Panel decides this case exclusively on the basis of the 3-factors test according to Art. 21(1), 22(11) Regulation 874/2004, i.e. whether there is
(i) a relevant right;
(ii) the right is confusingly similar to the Domain Name;
(iii) there is either a lack of rights or legitimate interest or bad faith on the side of the Respondent.
In particular, the Panel makes no findings on "infringement" or "damages" and the references to the Lithuanian Trade Mark act made by the Complainant are irrelevant for deciding this case.

15.
The first issue that has to be dealt with is the default of the Respondent. Article 22(10) Regulation 874/2004 stipulates that the failure of any parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty, leaving the decision to the discretion of the panel. Following an accepted practice in international arbitration not to "rubber stamp" the claims forwarded by a complainant in case of the default of a respondent (cf. eg. Redfern/Hunter, Law and Practice of International Commercial Arbitration, 4th ed., at 8-46), this Panel will decide the Complaint on its merits under the assumption that the facts forwarded by the Complainant are not contested by the Respondent.

16.
Furthermore, the Panel follows the general rule that a party has to prove all facts which are favourable for and supportive of its own case. Therefore, the complainant in an ADR.eu proceeding has to establish evidence for the facts supporting a right which is identical or confusingly similar to the domain name as well as for the registration or the use of the domain name in bad faith (which is supported by the wording of Art. 21(3) of the Regulation 874/2004 stating that "bad faith […] may be demonstrated where […]".

The situation is, however, different with "rights or legitimate interest" under Art. 21(1)(a) of Regulation 874/2004. It is standing case law amongst panel decisions under the UDRP and Regulation 874/2004 that a complainant can technically not prove the absence of something, i.e. a "negative fact" and that therefore the onus shifts to the respondent to assert certain facts supporting a right/legitimate interest (which is supported by the wording of Art. 21(2) of the Regulation 874/2004 stating that "a legitimate interest […] may be demonstrated where […])". Once a respondent has done so the onus shifts back to the complainant and it is then for the complainant to provide proof that the facts asserted by the respondent are not true (cf. e.g. ADR.eu case no. 02035 – warema.eu with further references.).

17.
The Panel would further like to point out to the fact that, according to Paragraph A 3 (c) of the ADR Rules, all submissions "shall be made in the language of the ADR Proceeding or in different requested language if the Complainant proves (…) that the Respondent has adequate knowledge of such different language." However, panels are also allowed to request a translation of such submissions or disregard them without requiring a translation (cf. CAC case no. 52, yoga.eu; CAC case no. 910, reifen.eu; CAC case no. 3387, hotel.eu; CAC no. 4526, placement.eu; CAC case no. 4620, eltropuls.eu). In the absence of a response, some panels declared it to be sufficient that the panellist understood the evidence (CAC case no. 3976, abat.eu; CAC case no. 4371, simtek.eu).

The language of the Proceedings, as chosen by the Complainant, is English. This Panel takes the view that all the relevant documents and information needed to decide the case should be available in English. This Panel, taking in consideration the streamlined decision making process in ADR.eu proceedings, does not deem it appropriate to make further request for translations but expects that all the translations necessary should have been provided with the Complaint or the Amended Complaint the latest.

18.
While the Panel is satisfied that the Complainant is the owner of the Trademarks and that the Trademarks are relevant rights a Complaint can be based on, the Panel finds that the Complainant did not discharge its onus of proof that the Trademarks are identical or confusingly similar to the Domain Name.

19.
In the view of the Panel it is the accepted position for .eu. domain names and the UDRP that a top-level domain, such as ".eu" in the present case, has to be excluded while comparing the trademark with the domain name (cf. eg. CAC UDRP cases nos. 100004 - novotelvietnam.com; 100084 - paiement-cic.com; 100074 - michelintires.info; 100093 - asiaairfrance.com; 100259 - ECCOSHOESSHOP.COM and WIPO cases nos. D2000-1532 - brucespringsteen.com; D2002-0234 - herballife.net and DCC2003-0001 - officemax.cc).

20.
Even in light of the aforementioned principle and contrary to the assertions of the Complainant, the Trademarks are clearly not identical to the Domain Name. This is evident for the "VIKINGŲ LOTO" trademarks the Complaint relies on since the element "VIKINGŲ" does not appear in the Domain Name. As far as the Complainant relies on "TELELOTO" trademarks there is also no identity since although the Domain Name contains "teleloto", it also contains the additional elements "bilietutikrinimas", which – in combination – with "teleloto" create a different overall impression compared to "teleloto" as a stand-alone term.

21.
In the light of the facts and evidence presented by the Complainant, the Panel cannot find that the Trademarks are confusingly similar to the Domain Name. While the Panel accepts that the "TELELOTO" trademarks are completely contained in the Domain Name this does not necessarily create a confusing similarity. There are cases where the use of a third party trademark within a second level domain name may not be considered confusingly similar. This has, amongst others, be found possible in cases where the trademark was combined with elements of criticism (cf. e.g. CAC case no. 4141 – airfrancesucks.eu), in form of positive reference (such as e.g. "fan-pages", cf. WIPO UDRP case no. D2004-0001 – patbenatar.com) or as an indication of the source of the original brand product (cf. e.g. CAC case no. 5957 – harrypotterlego.eu). This Panel acknowledges that such cases heavily depend on the specific facts of the case. However, in order to decide whether the case at hand is such a case, where adding further elements to the trademark in question would lead to an overall impression that makes it clear for the consumer that there is no connection between the trademark owner and the domain name in question, therewith excluding confusion, would require an examination of the meaning of the additional elements "bilietutikrinimas". However, the Complaint neither offers a translation into English of the additional elements "bilietutikrinimas", what the Panel assumes are Lithuanian words, nor any evidence as to such meaning whatsoever. Taking in consideration the explanations as to the principles of onus of proof as applied by this Panel in paragraph 16 above and the availability of documents and information in the language of the proceedings as laid out under paragraph 17 above, the lack of evidence in English language leads the Panel to the finding that the Complainant has not discharged its onus of proof of establishing confusing similarity between the Trademarks and the Domain Name.

22.
Similar considerations as discussed in the previous paragraph with regard to confusing similarity also apply to the further requirement of a lack of legitimate interests. The Panel is of the opinion that with regard to this factor too, the Complainant should – at the very least – have provided the Panel with an English translation of the additional elements "bilietutikrinimas" as well as supporting evidence, in order to establish a prima facie case of lack of legitimate interests as explained in paragraph 16 above.

23.
As far as the Complainant tries to argue bad faith on behalf of the Respondent by alleging that the Respondent acts for commercial gain the Complaint fails to explain how such commercial gain is generated by the Respondent.

DECISION

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

PANELISTS

Name	**Dr. Uli Foerstl, LL.M.**

DATE OF PANEL DECISION 2016-09-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: TELELOTOBILIETUTIKRINIMAS.EU

II. Country of the Complainant: Lithuania, country of the Respondent: The Netherlands

III. Date of registration of the domain name: [XX Month XXXX]

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
word mark "TELELOTO",Lithuanian registration No. 59473 (applied on 20 August 2008, registered on 18 March 2009) in classes 28 and 41;
2. [word/combined/figurative] trademark registered in [country], reg. No. [number], for the term [term], filed on [XX Month XXXX], registered on [XX Month XXXX] in respect of goods and services in classes [numbers]
3. [word/combined/figurative] CTM, reg. No. [number], for the term [term], filed on [XX Month XXXX], registered on [XX Month XXXX] in respect of goods and services in classes [numbers]
4. [word/combined/figurative] CTM, reg. No. [number], for the term [term], filed on [XX Month XXXX], registered on [XX Month XXXX] in respect of goods and services in classes [numbers]
5. geographical indication:
6. designation of origin:
7. unregistered trademark:
8. business identifier:
9. company name:
10. family name:
11. title of protected literary or artistic work:
12. other:

V. Response submitted: No

VI. Domain name is/neither identical nor 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: No prima facie case

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. [No]
2. Why: No evidence

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Complaint denied

XI. Procedural factors the Panel considers relevant:

XII. [If transfer to Complainant] Is Complainant eligible? [Yes/No]