Panel Decision for dispute CAC-ADREU-007278

Case number	CAC-ADREU-007278
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Domain names	veluxglazing.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	VKR Holding A/S

Respondent

Name	Andrew Hooper

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 pending or decided legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, VKR Holding A/S, a company incorporated under the laws of Denmark, owns a multinational business that manufacturers and sells roof windows and ancillary products and services (including installation services) under the mark VELUX. The business has been carried on continuously since 1941. The business is now extensive and the Complainant spends over EUR 8 million on marketing each year.

The Complainant has registered the word mark VELUX in the UK since 1950 (UK 691115) and in the EU (EU955609 since 2000 and EU 651869 since 2004). The Complainant has also registered a logo consisting of the letters VELUX in white capitals on a red background in the EU since 2007 (EU 5260229).

The disputed domain name was registered by the Respondent in 2010 without the Complainant's consent and is directed to a website at <www.homeroofing.co.uk>. The domain name <homeroofing.co.uk> is also owned by the Respondent and the website advertises a business of repairing roofs and installing VELUX roof windows.

The Respondent's website states amongst other things: "As a 5 star Velux installer and part of the Velux installer partnership you can be assured of a 1st class installation and consumer care." The Respondent had previously been a registered installer under a scheme operated by the Complainant known as the "VELUX Five Star Installer Partnership", but this scheme is no longer active and all connection between the Complainant and the Respondent was severed in November 2015.

The Respondent has previously registered the domain names <veluxfitters.co.uk>, <veluxglazing.co.uk> and <veluxinstaller.co.uk>, which were held by the Nominet Dispute Resolution Service to be abusive registrations in 2011, and the domain name <veluxservicing.co.uk> which was held by the Nominet Dispute Resolution service to be an abusive registration in a decision dated 15 April 2016. The Respondent has also registered the domain names <velux.london> and <veluxglazing.com>.

The Complainant wrote to the Respondent demanding that he transfer the disputed domain name (as well as some of the other domain names mentioned above) on 9 September 2015 and 6 November 2015 but did not receive any reply.

A. COMPLAINANT

The Complainant contends that the disputed domain name is confusingly to its mark VELUX in which it has both registered and unregistered rights. The Complainant points out that (apart from the .eu top level domain suffix) the disputed domain name consists of

its mark together with the word "glazing" which is descriptive of its main product and service.

The Complainant submits that the disputed domain name was registered by the Respondent without any rights or legitimate interests in the name. The Complainant points out that the Respondent registered it without the Complainant's consent although it was well aware of the Complainant's rights in the mark VELUX. The Complainant adds that the use of the disputed domain name to promote the Respondent's business is not a fair use and misleadingly diverts customers.

The Complainant alleges that the disputed domain has been registered and is being used in bad faith. In the Complainant's view, the disputed domain name is intentionally being used to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's name and mark. The Complainant adds that the Respondent was well aware of the Complainant's rights in the mark VELUX and that the prominent use of this mark on the Respondent's website creates the impression that the Respondent's business is endorsed by, affiliated with or otherwise connected with the Complainant.

B. RESPONDENT

The Respondent did not respond to the Complaint.

DISCUSSION AND FINDINGS

In accordance with Article 22(11) of EU Regulation 874/2004 ("the Regulation"), the Panel must decide whether the registration of the disputed domain name is speculative or abusive as defined in Article 21 of the Regulation. Under Article 21 a registration is speculative or abusive if

I. 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 EU law, and either

II(a). the domain name has been registered by the holder without rights or legitimate interest in the name, or

II(b). the domain name has been registered or is being used in bad faith.

The Panel finds that the Complainant has rights under EU and UK national law in the name VELUX in the form of EU and UK registered trademarks. The Panel further finds that the disputed domain name is confusingly similar to this name, from which it differs only in the addition of the word "glazing", which is descriptive of products supplied by the Complainant under this name, and the .eu top level domain name suffix. Many Internet users would assume that the disputed domain name locates a website of the Complainant. Accordingly the condition in the first sentence of Article 21(1) of EU Regulation 874/2004 (condition I as set out above) is satisfied.

The Panel also finds that by directing the domain name to his website the Respondent is misleading Internet users into believing that his website and business are still endorsed by the Complainant when they are not. The website fails to make it clear that the Respondent is not endorsed by the Complainant and contains an express statement to the effect that he is endorsed by the Complainant, namely "As a 5 star Velux installer and part of the Velux installer partnership you can be assured of a 1st class installation and consumer care." It is not disputed that the Respondent is no longer an authorised dealer or fitter of the Complainant's products.

In all the circumstances, the panel finds that the domain name has been intentionally used to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's name VELUX as to the source, sponsorship, affiliation or endorsement of this website.

In these circumstances and in accordance with Article 21(3)(d) of the Regulation, the Panel finds that the domain name is being used by the Respondent in bad faith. The condition in Article 21(1)(b) of the Regulation (condition II(b) as set out above) is therefore satisfied and it is unnecessary to consider whether the alternative condition in Article 21(1)(a) is also satisfied. The registration of the disputed domain name is a speculative and abusive registration within the meaning of Article 21.

The Complainant has applied for the disputed domain name and satisfied the eligibility criteria in Article 4(2)(b) of EU Regulation 733/2002 since it has its registered office in the EU. It is therefore appropriate to direct transfer of the disputed domain name 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 VELUXGLAZING.EU be transferred to the Complainant.

This decision shall be implemented by the Registry within thirty days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a mutual jurisdiction.

PANELISTS

Name	Jonathan Turner

DATE OF PANEL DECISION 2016-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: veluxglazing.eu

II. Country of the Complainant: Denmark, country of the Respondent: UK

III. Date of registration of the domain name: 5 November 2010

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 UK, reg. No. 691115), registered on 28 July 1950 in respect of goods in classes 6 and 19
2. Word EU trademark , reg. No. 955609, registered on 31 March 2010 in respect of goods in classes 6, 7, 9 and 11.
3. Word EU trademark, reg. No. 651869, registered on 16 July 2004 in respect of goods and services in classes 6, 9, 16, 19, 20, 22, 24, 37, 41 and 42.
4. Combined EU trademark (logo), reg. No. 5260229, registered on 12 June 2007 in respect of goods and services in classes 19, 20, 24 and 37.

V. Response submitted: No

VI. Domain name is 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. Not determined
2. Unnecessary

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Domain name has been intentionally used to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with the Complainant's name VELUX as to the source, sponsorship, affiliation or endorsement of this website (Art. 21(3)(d) of Regulation 874/2004).

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