Panel Decision for dispute CAC-ADREU-007316

Case number	CAC-ADREU-007316
Time of filing	2017-01-04 10:10:10
Domain names	maersk-cargo.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	A.P. Moller - Maersk A/S

Respondent

Organization	Hoster Node

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 proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a worldwide conglomerate, founded in April 1904 and operating in some 130 countries with a workforce of over 89,000 employees. The Complainant is involved in a wide range of activities in the shipping, logistics, and oil and gas industries and has been the largest container ship operator and supply vessel operator in the world since 1996. The Complainant's headquarters are situated in Copenhagen, Denmark.

The Complainant is the owner of EUTM no. 3483039 for the word mark MAERSK registered on 27 June 2006 covering, in part, transport, packaging and storage of goods, and cargo loading and unloading in class 39. The Complainant is also the owner of Danish trademark registration no. VR 1956 00383 for the word mark MAERSK registered on 10 March 1956 along with a portfolio of other registered trademarks covering a wide variety of global territories. The Complainant uses the domain name <maersk.com>, originally created on 10 October 1995, for its business. The Complainant’s logo, a white star against a black square background featuring rounded corners, is the subject of various figurative registered trademarks owned by the Complainant including, for example, EUTM no. 3483013 registered on 17 April 2007 covering, in part, transport, packaging and storage of goods, and cargo loading and unloading in class 39.

Little is known regarding the Respondent. The name “Hoster Node” is listed in both the name and organisation fields of the WHOIS data for the Domain Name along with an address in London, United Kingdom. The Domain Name was created on 10 August 2016 and has been used for a website which bears to be the online presence of an entity named Maersk Cargo Company S.A. under the title “Transport and Logistics solutions worldwide”. The said site features the Complainant’s star logo along with prominent use of the name and mark MAERSK. The Complainant states that neither the Domain Name nor the associated website are in any way affiliated with its business. The Complainant produces an entry from an online resource named “Scamwarners” which suggests that the corresponding domain name, <maersk-cargo.com>, also created on 10 August 2016 with the same registrar, has been used in connection with a fraudulent escrow scheme connected to the shipping of vehicles.

The Complaint was filed on 28 September 2016. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for the Domain Name on 30 September 2016. On 30 September 2016, EURid replied in a non-standard communication confirming that the Domain Name <maersk-cargo.eu> was registered with eNom, Inc, that the current Registrant of the Domain Name was the Respondent, that the Domain Name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the Domain Name was English. It also provided the full details from the WHOIS database for the registrant and registrar technical contacts.

On 4 October 2016, the Czech Arbitration Court conducted a formal compliance review in respect of the Complaint and found it to be deficient. Accordingly, on the same date, the Czech Arbitration Court notified that the Complaint had a deficiency. On 4 October 2016, the Complainant filed an amended Complaint which was duly submitted to a formal compliance review by the Czech Arbitration Court on 6 October 2016 and found to be in compliance. Accordingly, the formal date of commencement of the ADR Proceeding was 6 October 2016 and a Notification of Complaint and Commencement of ADR Proceeding was issued to the Respondent on that date. This stated that a Response was to be submitted within 30 working days. On 13 October 2016, the Czech Arbitration Court filed a nonstandard communication noting that the Respondent had not logged on to the online platform within 5 days of its sending notice of the ADR Proceeding by email and that notice of the ADR Proceding had therefore been sent to the Respondent by post on 12 October 2016. The deadline for filing of the Response was noted as being 5 December 2016. On 25 November 2016, the Czech Arbitration Court filed a nonstandard communication reminding the Respondent of the deadline for the Response. No formal Response was filed and on 6 December 2016, the Czech Arbitration Court issued the Notification of Respondent's Default. This stated, inter alia, that the Czech Arbitration Court would proceed to appoint an ADR Panel, that the Panel and the Complainant would be informed of the Respondent's default and that the ADR Panel would decide in its sole discretion whether or not to consider the Respondent's defective Response (if submitted). It also stated that the Respondent had a right to challenge the said Notification within a period of 5 days. The Respondent did not challenge the said Notification within the appointed period.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the appointed Panel on 15 December 2016, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ("ADR Rules") and the date by which a decision on the matter was due, which was specified as 16 January 2017.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 20 December 2016.

A. COMPLAINANT

The Complainant seeks a decision transferring the Domain Name to the Complainant.

The Complainant asserts that the Domain Name is identical or confusingly similar to its MAERSK trademark. The Complainant submits that the Respondent has no rights or legitimate interest in the Domain Name and that the Domain Name has been registered and/or is being used in bad faith.

The Complainant relies on its various registered trademarks in the mark MAERSK. The Complainant contends that the Domain Name fully incorporates the said registered mark with the addition of the descriptive word "cargo" that means "the freight carried by a ship, an aircraft, or another vehicle". The Complainant submits that the addition of the said descriptive word to the Domain Name does not change the fact that the Domain Name is confusingly similar to the Complainant's trademark, especially since the descriptive term describes services that the Complainant offers, such as sea freight. The Complainant notes that its position on the addition of a descriptive word to a registered mark is supported by the decisions of previous ADR proceedings in analogous circumstances. The Complainant adds that the addition of ".eu" to a registered mark is insignificant to its confusing similarity.

The Complainant submits that the Respondent has created a website from which similar goods and services to those of the Complainant are marketed under a similar name, incorporating the Complainant's MAERSK mark, and using a similar figurative mark as a logo to that of the Complainant. The Complainant indicates that the services allegedly offered by the Respondent are in direct competition to the Complainant's services. The Complainant asserts that it has not authorized, licensed, or otherwise permitted the Respondent to use the trademark MAERSK mark or its figurative mark, neither in the Domain Name nor in the business name used on the corresponding website. The Complainant points out that the Domain Name was registered in 2016, yet the Respondent claims on its website that it has been trading since 2001. The Complainant adds that it is not possible to find anything about the company featured on the said website and asserts that this indicates that such company does not exist. The Complainant also submits that the said company's alleged subsidiaries as listed on the website do not exist and adds that this has been confirmed by the Complainant's local agents in the various countries concerned. The Complainant asserts that the Respondent cannot therefore claim to have been commonly known by the Domain Name.

The Complainant narrates the terms of the "Scamwarners" online resource and submits that this shows the website associated with the Domain Name is a scam website for a company which does not exist. The Complainant asserts that this type of fraudulent advertisement is a misuse of the Complainant's goodwill and is not a bona fide offering of goods or services, nor a legitimate non-commercial or fair use. Instead, it seeks to deceive the Complainant's customers.

The Complainant contends that the Respondent's choice of a confusingly similar variation of the Complainant's mark supports a finding

that the Respondent was specifically targeting the Complainant's business, products and services, showing actual knowledge of the Complainant's brand and also its MAERSK registered mark, which the Complainant argues is strong evidence that the Domain Name was registered in bad faith. The Complainant also indicates that the fact that the company represented on the website associated with the Domain Name does not exist is also indicative of registration or use in bad faith.

The Complainant submits that the alleged use of the website to invite the Complainant's customers to pay for shipping services that they have never received suggests that the Respondent seeks to exploit the goodwill of the Complainant and to misrepresent itself as the Complainant, which are also indicative of use in bad faith.

The Complainant asserts that the Respondent's use of its MAERSK word mark and its figurative mark indicate that the Respondent is seeking to create the impression that the Respondent is operating under the sponsorship, affiliation or endorsement of the Complainant, which is aggravated by the use of the Domain Name to offer competing products and services. The Complainant adds that it has already received complaints from its customers who have confused the Respondent's website with that of the Complainant. The Complainant submits that these matters are also indicative of use of the Domain Name in bad faith.

B. RESPONDENT

The Respondent did not file a Response to the Complaint.

DISCUSSION AND FINDINGS

1. Preliminary - No Response

The Respondent has not filed a Response to the Complaint. In such an eventuality, the effect of the provisions of Article 22(10) of Commission Regulation (EC) No 874/2004 ("Regulation 874") and Paragraph B10(a) of the ADR Rules is that the failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a Complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21(1) of Regulation 874 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. Applicable provisions

This Complaint is brought under the auspices of Regulation (EC) 874/2004 ("Regulation 874") and the ADR Rules. Article 22(1)(a) of Regulation 874 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21.

Article 21(1) states that a registered domain name may be subject to revocation where that 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, such as the rights mentioned in Article 10(1), and where it:

(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.

Article 21(2) provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) states that:

"[...]

"'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

Article 22(11) states that in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the domain name is to be

transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002 (“Regulation 733”).

Article 4(2)(b) of Regulation 733 provides the following general eligibility criteria:

(i) undertaking having its registered office, central administration or principal place of business within the EU, or

(ii) organisation established within the EU without prejudice to the application of national law, or

(iii) natural person resident within the EU.

Paragraph B11(d)(1) of the ADR Rules provides as follows:-

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State 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."

It is clear from the applicable provisions that the burden of proving that the .eu domain name registration in question is speculative or abusive lies with the Complainant. Accordingly, the first question for the Panel in the present case is whether the Complainant has proved 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 EU law.

3. Rights - identical or confusingly similar

Article 21(1) of Regulation 874 requires that the Domain Name be identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or EU law. The Complainant’s registered EUTM for the word mark MAERSK corresponds to this definition and is incorporated in the Domain Name in its entirety. The remaining question for the Panel is whether the Domain Name is confusingly similar to such mark, given that it is clearly not identical. The Domain Name also contains the top level domain “.eu” together with a hyphen and the word “cargo”.

The Panel agrees with the Complainant’s submission that the addition of the top level domain “.eu” to a registered mark is insignificant to the assessment of confusing similarity because this is required purely for technical reasons. The Panel also agrees with the Complainant’s argument that the addition of the word “cargo”, being descriptive and non-distinctive, is insufficient in itself to avoid a finding of confusing similarity. The Panel considers that the hyphen is present in the Domain Name because spaces are not permitted for technical reasons and hyphens are a common substitution where two or more word elements are included. The hyphen therefore is a form of punctuation which also does not in itself avoid a finding of confusing similarity.

The Panel accepts the Complainant’s evidence that the word “cargo” is strongly associated with its business and furthermore that this exacerbates the potential confusion between the Domain Name and the Complainant’s MAERSK trademark.

In all of these circumstances, the Panel finds that the Domain Name is confusingly similar to a name in respect of which a right is recognised by EU law.

4. Respondent's Rights or Legitimate Interest

Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a respondent may demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods or services; (b) the respondent has been commonly known by the domain name; or (c) the respondent is making a legitimate, non-commercial or fair use of the domain

name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or EU law.

In the Panel's opinion, the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interest in the Domain Name based on its submissions that the Complainant has not authorized or permitted the Respondent to use its MAERSK trademark in the Domain Name and that the Domain Name appears to be being used for a company which does not exist and which has adopted the Complainant's business name, trademark and figurative mark to provide an air of legitimacy which it would not otherwise have.

Faced with serious allegations of registration and use of the Domain Name for fraudulent purposes, the Respondent has simply chosen to remain silent and has made no attempt to bring forward an explanation of any alleged rights or legitimate interest in terms of Article 21(2) of Regulation 874 and paragraph B11(e) or otherwise. Furthermore, the Panel is of the opinion that the case papers before it do not disclose any convincing case which the Respondent might have put forth, whether or not in terms of those provisions.

Accordingly, the Panel finds that there are no circumstances corresponding to those in Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules nor any other facts or circumstances in the present case indicating that the Respondent has any rights or legitimate interest in the Domain Name. The Domain Name registration is therefore speculative or abusive, and should be subject to revocation under Article 21(1)(a) of Regulation 874. It is not strictly necessary for the Panel to consider whether the Domain Name is also subject to revocation under Art 21(1)(b) of Regulation 874 (which requires a finding that the Domain Name has been registered or is being used in bad faith). However, for completeness, the Panel will consider this issue.

5. Registration or use in bad faith

The issue of bad faith is expressed in Article 21(1)(b) of Regulation 874 and paragraph B11(d)(1)(iii) of the ADR Rules as an alternative to a lack of rights or legitimate interest which may be proved by the Complainant. Registration or use in bad faith may be proved by the Complainant. Article 21(3)(a) to (e) and the corresponding paragraph B11(f)(1) to (5) of the ADR Rules provide non-exhaustive examples which may be evidence of bad faith registration or use.

In the present case, the Complainant focuses upon the use of the Domain Name for an alleged fraudulent scheme to deceive the Complainant's customers and business partners. The Complainant shows that the website associated with the Domain Name has reproduced details corresponding to the Complainant's business, its logo and use of the MAERSK mark and that the said website claims to relate to the loading, transport and unloading of cargo, being one of the Complainant's lines of business. The Complainant indicates that it has attempted to find evidence of the existence of the organisation described on the website but has been unable to do so. At the same time, the Complainant shows that a domain name with the identical second level to the Domain Name and which was registered on the same day with the same registrar in the ".com" space has been listed on a website which warns the public about active scams.

The Panel considers that the allegation that a domain name has been used for fraudulent activities is a serious one, which requires to be supported by compelling evidence. The Panel is satisfied that the evidence produced by the Complainant covering multiple screenshots of the website, the scam warning and the WHOIS entry reported therein for the related domain name <maersk-cargo.com> satisfies that criterion. It would appear that similar evidence was presented to and accepted by the panel in the UDRP case brought by the present Complainant against the present Respondent in respect of the latter domain name: A.P. Moller - Maersk A/S v. HOSTER NODE, CAC Case No. 101296 (10 November 2016).

In the present case, the Complainant's assertions of bad faith call for an answer from the Respondent. The absence of any rebuttal on the Respondent's part, or any explanation as to its conduct, serves to fortify the Panel in its opinion that both the registration of the Domain Name, which cannot have been made in ignorance of the Complainant's rights in its registered trademarks, and the use of the Domain Name for the apparent purpose of impersonating the Complainant's company have each been made in bad faith.

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith.

Since the Complainant is an entity eligible to be the holder of a .eu domain name in accordance with Article 4(2)(b)(i) of Regulation 733/2002 (being an undertaking having its registered office, central administration or principal place of business within the EU, namely in this case Denmark) the Panel orders that the domain name <maersk-cargo.eu> be transferred 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 MAERSK-CARGO.EU be transferred to the Complainant.

PANELISTS

Name	Andrew D S Lothian

DATE OF PANEL DECISION 2016-12-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: MAERSK-CARGO.EU

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

III. Date of registration of the domain name: 10 August 2016

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 European Union, reg. No. 3483039, for the term MAERSK, filed on 30 October 2003, registered on 27 June, 2006 in respect of goods and services in classes 1, 4, 6, 9, 11, 12, 16, 35, 36, 37, 38, 39, 40, and 42.
2. word trademark registered in Denmark, reg. No. VR 1956 00383, for the term MAERSK, filed on 14 December 1955, registered on 10 March 1956 in respect of goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42.
3. figurative trademark registered in European Union, reg. No. 3483013, for a device consisting of a white star, set in a black square with rounded corners, filed on 30 October 2003, registered on 17 April 2007 in respect of goods and services in classes 1, 4, 6, 9, 11, 12, 16, 35, 36, 37, 38, 39, 40, and 42.

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. No
2. Why: The record showed no indication of any rights or legitimate interest on the part of the Respondent in the Domain Name and the Complainant had made out a prima facie case on this point arising from its lack of authorisation to use the MAERSK trademark and the fact that the Domain Name was being used for a website which featured a business that did not exist and which was impersonating the Complainant's business.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The Panel determined that the use of the Domain Name in connection with an apparent impersonation of the Complainant by the Respondent with a view to confusing the Complainant's customers into engaging with an apparently fraudulent scheme and the Respondent's actual knowledge of the Complainant's rights at the time of registration of the Domain Name demonstrated registration and use in bad faith.

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