Panel Decision for dispute CAC-ADREU-007328

Case number	CAC-ADREU-007328
Time of filing	2017-03-22 15:55:25
Domain names	prestig-e.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization

Respondent

Name	Donald Hutchison

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

1. Polish Police was informed about the factual situation by the Complainant but found no one to be convicted regarding the attempt to extort money.

2. The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

3. The Complainant is "Prestige", a limited liability company based in Sopot (Poland), selling new and used luxury cars.

4. The Respondent is "Donald Hutchison", a supposed English citizen.

5. The Complainant exploits the <prestig-e.pl> website.

6. On 23 May 2016, the <prestig-e.eu> domain name was registered by the Respondent.

7. On 13 December 2016, the Complainant requested the transfer of the domain name <prestig-e.eu>.

A. COMPLAINANT

8. The Complainant contends as follows:

9. The Complainant owns the brand "Prestige Samochody Luksusowe" and exploits the website <prestig-e.pl> which includes many advertising materials.

The Complainant did not give anybody any permission or licence to use these materials.

10. The Respondent, who is the owner of <prestig-e.eu>, created a website which:

- is confusingly similar to the Complainant's website;

- contains false information about the Complainant and about the cars he is selling.

Such acts constitute a crime of phishing and unfair competition under articles 3, 13 and 14 of Polish Act on Unfair Competition from 16th of April 1993.

11. Moreover :

- many potential customers informed the Complainant that they were interested in buying cars shown on the website <www.prestig-e.eu> whereas these cars were not sold by the Complainant;

- someone impersonating the Complainant attempted to extort money from potential clients through a request for an advance payment on an unknown bank account.

Such act constitutes a fraud, under article 286 of Polish criminal law from 6th of June 1997. It is also a violation of English Criminal Law Act.

12. The Complainant asks for a transfer of the Domain Name as it has been registered and used in bad faith without legitimate interest pursuant to Article 21 (1) Commission Regulation (EC) 874/2004 and without observing the law.

B. RESPONDENT

13. The Respondent did not submit a Response by the required deadline.

DISCUSSION AND FINDINGS

14. In consideration of the Factual Background, the Parties' Contentions stated above and its own web searches, the Panel comes to the following conclusions:

Article 21 of the Regulation (EC) No. 874/2004 of 28 April 2004 (hereafter "the Regulation") states that "a registered domain name shall be subject to revocation [...] where the 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 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".

RELEVANT RIGHTS OF THE COMPLAINANT

15. The rights mentioned in Article 10 (1) of the Regulation shall be understood to include as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers or company names (see notably TSE Systems GmbH v. Fienna Ltd, CAC 1328, <tse-systems.eu>).

16. The Panel is of the view that the documentary evidence provided by the Complainant does not clearly show that this latter owns any prior relevant rights. In particular:

- no trademark registration certificate has been provided,

- no registration certificate of the company of the Complainant (mentioning the company name) has been provided (only a power of attorney with a stamp indicating the unregistered combined trademark "Prestige" with the address of the Complainant has been communicated) in order to prove that the Complainant owns a company name in respect of which a right is recognised by Polish national law, as required by Article 10(1) of the Regulation,

- no evidence of the ownership of the domain name <prestig-e.pl> has been provided.

17. Thus, as expressly allowed by Paragraph B7 (a) of the ADR Rules, the Panel conducted his own independent investigations. In this respect:

- the Panel did not find any Polish or EU trademak "Prestige" or "Prestige Samochody Luksusowe" owned by the Complainant on public databases;

- the Panel found on the whois related to ".pl" that the owner of the <prestig-e.pl> domain name (created on 7 March 2008) is a company called "Prestige" which address and city are different from the one of the Complainant (street: Ul. Lubczykowa 8, city:81-589 Gdynia).

- However, the Panel found on Google, at the address of the Complainant, several photos of the showroom of the Complainant, dated 2012, exhibiting luxury cars and reproducing the same unregistered combined trademark as the one displayed on the website of the Complainant today (see Exhibit 10 and 11: "Prestige" clearly separated from the "tiger" drawing). On this matter, unregistered trademarks are protected in Poland under the Unfair Competition Law 1993. According to the Unfair Competition Law, the holder of an unregistered trademark can prevent third parties from using later marks on the market provided that the earlier trademark was used in the course of trade. The duration of use is not as important as the requirement that the sign be used as a trademark (i.e., in the course of trade for the goods or services for which protection is sought).

18. As a consequence, this Panel is of the view that the Complainant holds a right in the unregistered trademark "Prestige" (associated to the selling of luxury cars), at least since 2012, in respect of which a right is recognised by Polish national law, as required by Article 10(1) of the Regulation.

IDENTITY OR CONFUSING SIMILARITY

19. The domain name <prestig-e.eu> is confusingly similar to the name of the Complainant. In this respect, the use of a dash should be disregarded when assessing the identity or confusing similarity (see Rs Franchise v. Mustapha Messaouri, CAC 7257, <reparstores.eu>, about the use of an apostrophe).

20. Especially since the content of the Respondent's website (<prestig-e.eu>) is a copycat of the Complainant's website (<prestig-e.pl>) (see Zheng Qingying v. DDR Museum Berlin GmbH, Robert Rückel, CAC 5094, <ddr-museum.eu>).

21. The remaining issue is then to decide whether the domain name <prestig-e.eu> has been registered by the Respondent without rights or legitimate interest or whether it has been registered or used in bad faith by the Respondent.

LEGITIMATE RIGHTS AND INTERESTS OF THE RESPONDENT

22. The Respondent did not submit any Response and did not comply with its obligation and time periods under the ADR Rules. Thus, the Panel is not aware of any legitimate rights or interests that the Respondent could have in the domain name.

BAD FAITH

23. The Respondent exploits a website which is a copycat of the Complainant's website (exactly the same unregistered trademark, the same drawing, same "look and feel", the same interface) and which reproduces exactly the same photos of the Complainant's showroom and website.

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24. As a consequence, it is the view of this Panel that the domain name has been registered by the Respondent without rights or legitimate interest and been registered and used in bad faith by the Respondent.

25. As the Complainant, a Polish registered company, satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) n° 733/2002, the domain name <prestig-e.eu> can 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 <PRESTIG-E.EU> be transferred to the Complainant.

PANELISTS

Name	**Frédéric Sardain**

DATE OF PANEL DECISION 2017-03-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <prestig-e.eu>.

II. Country of the Complainant: Poland, country of the Respondent: England

III. Date of registration of the domain name: 23 May 2016

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

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 Respondent did not reply and did not provide the Panel with any rights or legitimate interests.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the Respondent exploits a website which is a copycat of the Complainant's website and which reproduces exactly the same photos and "look and feel" of the Complainant's website.

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant:

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