Panel Decision for dispute CAC-ADREU-007416

Case number	CAC-ADREU-007416
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Domain names	incose.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization	Gesellschaft für Systems Engineering e.V. German Chapter of INCOSE

Respondent

Organization	Loft 33 / Groep Securex

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. The requested suspension for negotiations between the parties was granted. The Complainant informed that the negotiations ended without an arrangement. The Respondent was given extra time to react to the Complainant´s conclusion. The Respondent didn't submit a further statement.

FACTUAL BACKGROUND

The Complainant is the German Chapter of the International Council on Systems Engineering, with the acronym INCOSE. It is a non-profit membership organization founded to develop and disseminate the interdisciplinary principles and practices that enable the realization of successful systems (www.incose.org). The Complainant was founded in 1997. The Complainant is owner of Union TM word: 004 587 846 INCOSE since Oct. 16th 2006 which is in use as Complainants website shows. The Complainant's Union trademark "INCOSE" is protected for goods in class 16 and services in classes 41 and 42; among others for the services "arranging and conducting of conferences, congresses and symposiums" and for the goods "books".

The Respondent is an event organizer. Respondents name INCOSE stands for “International Conference on Sustainable Employability”. The Respondent is the registered owner of the disputed domain name since July 8, 2015. This contested domain was and is used for commercial purposes, for marketing an International Conference on Sustainable Employability which took place on September 14 to 16, 2016 in Brussels and for which a "Book of Abstracts" is still offered for free.

A. COMPLAINANT

According to the Complainant, the Respondent is using the identical disputed domain name intentionally to attract Internet users for commercial gain in the same business field, books and conferences, as the Complainant is acting.

The Complainant’s European Union trademark 004 587 846 INCOSE has not only been used together with the text „International Council on Systems Engineering“ as insinuated by the Respondent. It has rather been used in form of the simple word „INCOSE“ or in form of a figurative sign comprising only „INCOSE“ together with and without a country name of the respective INCOSE chapter. It has also been used for symposiums, conferences and workshops as well as for books.

The Respondent has no legitimate interest in the name INCOSE as it does not own trademark rights in the word INCOSE and as the use of INCOSE under the disputed domain name is a clear trademark infringement of the Complainant's EU trademark and is thus not a legitimate use of the domain name in the sense of Art. 21 (2) of the Commission Regulation (EC) No 874/2004.

The Complainant argues introducing and using a new name in the commercial field requires carrying out a search for earlier third party rights in this name; this duty to take care applies also for registering and using a domain name. Registering and using a domain name

identical to a third party's registered trademark for identical goods/services is obviously a trial to disrupt the professional activities of a competitor (here an organizer of congresses).

The Complainant notes that according to Art. 21 of the Commission Regulation (EC) No 874/2004 a registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, 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 Community law 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.

B. RESPONDENT

The Respondent rejects the claims of absence of rights, legitimate interest or bad faith use.

The Complainant and the Respondent are currently implicated in a separate legal discussion in relation to the validity of the trademark “INCOSE”. This dispute was started by a letter on behalf of the Complainant dated 20 March 2017. A formal reply was sent on behalf of the Respondent by letter dated 31 March 2017. No further correspondence has been sent by the Complainant in the context of this separate dispute. It is reasonable to assume the Complainant acknowledges the absence of infringement.

The Respondent believes that INCOSE has no distinctive character and consequently, the trademark cannot be invoked in this disputed domain name procedure pursuant to article 12 (b) of Council Regulation. This provision prohibits invoking a trademark to prohibit someone from using signs which are not distinctive.

At the very least, the Respondent can demonstrate that it has a legitimate interest in the disputed domain name and that it has not registered the disputed domain name in bad faith.

The trademark INCOSE lacks distinctiveness argued the Respondent.
The Respondent claims legitimate interest. It says, "Indeed, according to article 21.2.a, a legitimate interest within the meaning of article 21.1 is demonstrated when “prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so”.

Accordingly, the Respondent has registered the disputed domain name. Since then, it has used the disputed domain name to launch a conference on Sustainable Employment taking place on 14th and 16th September 2016. The conference took place in Brussels and was aimed at gathering academics and professionals to debate the topic. A book gathering the abstracts of each of the talks was created and is still available for free online. The objective of the Respondent is to organise such an event biennially. The Respondent has therefore actively used the disputed domain name since it registration, and intends to continue to do so as such.

Finally, the name INCOSE has been chosen as the acronym INCOSE stands for “International Conference on Sustainable Employability”. The disputed domain name is therefore in direct connection with the offering of goods of services offered such as organisation of conferences, publication of a book or conference materials.

In the case no. 7110, Havenbedrijf Amsterdam NV v. Jelte Rintjema (“Poortvanamsterdam”), the ADR panel has explicitly reached the conclusion that the descriptive nature of the words implied a legitimate interest. This decision can be applied in the same manner to “INCOSE – International Conference on Sustainable Employability”, as the acronym is linked to the description of the activities.

The Respondent refers to The Court of Justice of the European Union disscussing the use of abbreviations as trademark. The Court reaffirmed in a decision C-90/11 and C-91/11 of the 15th March 2012, “if the letter sequences at issue were perceived by the relevant public to be abbreviations of the word combinations with which they were juxtaposed, those sequences could not be more than the sum of all the elements of the mark, taken as a whole, even though they might be considered to have distinctive character in themselves. On the contrary, according to the Court, such letter sequences occupied only an ‘ancillary position’ in relation to the word combination to which they were attached.”

DISCUSSION AND FINDINGS

1. According to Article 22 (11) of the Regulation (EC) No 874/2004 an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21 of the aforementioned or the decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No. 733/2002.

In the present case, the Complaint has been brought against the Registrant. Therefore, the question is whether the use of the domain is

speculative or abusive within the meaning of Article 21 the Regulation (EC) No 874/2004. According to this disposition and Paragraph B 11 (d) (1) of the ADR.eu Alternative Dispute Resolution Rules (the "ADR Rules") the Complainant bears the burden of proving the following:

(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.

The Complainant contends and provides evidence that it is the owner of a EUTM 004587846 INCOSE, registered on October 16, 2006. The disputed domain name consists of the word "incose" and the suffix .eu. Thus, the Panel holds that the disputed domain name is identical to a name in which the Complainant has legitimate right recognised by the national law of Germany as well as by the Community law.

With respect to the alleged registration of the disputed domain name without rights or legitimate interest, the Panel holds as follows: The Respondent did not prove any formal or other positive right to a INCOSE denomination. The registration itself is no right and creates none without perceptible use or preparing measures.

The disputed domain name is the Complainant's name of firm and is registered and used as a trade name. Hence, "INCOSE" is a name for which the following rights are recognised within the German legal system. The protection of trade names is granted under §§ 5, 15 Markengesetz (Trade Marks Act) whereas the registered name of a company is protected by §§ 17 et seqq. of the Handelsgesetzbuch (German Commercial Code).

The term INCOSE is an acronym and for that distinctive and fulfils the function of a name. In this regard, distinctiveness means that the firm name is capable of creating the association with a specific company amongst others (Baumbach/Hopt, HGB, § 18, No. 4). Nevertheless the nature of an acronym inhabits that it could have a different sense. To solve the conflict the rule of priority especially in trade name and trademark law is established.
Therefore, the Panel holds that the Respondent registered the disputed domain name without rights or legitimate interest within the meaning of Article 21, paragraph 1, letter a) of the the Regulation (EC) No 874/2004. The present case is different to acronym domain names caseS like no. 05282 KEDKE, and no. 05374 CARIVE. where a classical domaingrabber was Respondent.
Here the Complainant insists that the Respondent registered the disputed domain name not only without rights and legitimate interest but in bad faith and that, therefore, such registration is speculative and abusive within the meaning of Article 21 of the the Regulation (EC) No 874/2004. Even if the intention of creating a likelihood of confusion of the Respondent is not obvious, it is evident that the Respondent disregarded the Complainant's European Union trademark 004 587 846 INCOSE, which was registered prior to the disputed domain name. The Complainant uses this trademark in the identical commercial field to offer simmilar goods such as books and similar services such as conference organisation. If the Respondent had used the disputed domain name for non-commercial purposes or for different goods then it would have been no bad faith. However, it is possible to create an acronym of the name "International Conference on Sustainable Employability" in a different way, e.g. with the first letters of each word ICOSE. Thus, the cited ECJ decisions are not applicable in the present case. On the other hand the disputed domain name is not to transfer because the acronym INCOSE could be used in a different way so the Complainant´s interests are sufficient protected if INCOSE.eu is not used by the Respondent for purposes in the trademark classes 16 and 41.

2. Conclusion

The parties attached to Complaint/Response relevant documentation supporting and proving its arguments.

Given the foregoing, the Panel holds that indications and evidence exist that the disputed domain name was registered for the evident purpose without rights or legitimate interest in the disputed domain name and in bad faith. But there exists no legitimate Complainant's interest in transferring the disputed domain name. A fair use of the disputed domain is still possible far of the protected goods and services the Complainant holds a word trademark. Hence, a legitimate use of a third party or the domain name holder beyond the context of international trademark classes 16 and 41 is possible. Whatsoever the Complainant has already an identical domain name. Though there is no blockade of using the Complainant's company name or his trademark in the internet. Therefore, the Respondent is not to treat like a domaingrabber.

DECISION

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

the disputed domain name shall be revoked.

PANELISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2017-06-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: incose.eu

II. Country of the Complainant: Germany, country of the Respondent: Belgium

III. Date of registration of the domain name: July 8, 2015

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. 004 587 846, for the term [incose], registered on October 16, 2006 in respect of goods and services in classes [16, 41 and 42]

V. Response submitted: Yes

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 right to create an acronym is limited when a prior right for the same business purposes

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: the Respondent violated his obligation to search for identical Domains and Trademarks because he used the contested domain for the same commercial purposes as the Claimant is using its trademark.

IX. Other substantial facts the Panel considers relevant: None.

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: suspension requested by the Complainant

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