Panel Decision for dispute CAC-ADREU-007560

Case number	CAC-ADREU-007560
Time of filing	2018-01-18 14:30:12
Domain names	marimekkoale.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization

Respondent

Name	Sara Johansen

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 which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a Finnish textile and clothing design company founded in 1951 renowned for its original prints and colors.

The Complainant is the owner of a number of trademark registrations for the word "MARIMEKKO" worldwide, including the following registrations (the "MARIMEKKO trademark"):

- the EU trademark MARIMEKKO with registration No. 307496, registered on July 24, 1998 for goods and services in Nice Classes 3, 16, 18, 20, 21, 24, 25, 26, 27 and 42;
- the EU trademark MARIMEKKO with registration No. 6997712, registered on January 30, 2009 for goods in Nice Classes 3, 16, 18, 20, 21, 24, 25, 26, 27 and 28, and
- the EU trademark MARIMEKKO with registration No. 8528739, registered on March 1, 2010 for goods and services in Nice Classes 3, 6, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 35 and 42.

The Complainant also owns the domain name <marimekko.com>.

The Respondent registered the disputed domain name on November 18, 2016.

The disputed domain name is used in connection with a website offering clothing and related products for sale.

A. COMPLAINANT

According to the Complainant, the content available on the website at the disputed domain name is an on-line store pretending to sell MARIMEKKO designs. Thus, the disputed domain name is being intentionally used to attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion with MARIMEKKO.

According to the Complainant, the disputed domain name <marimekkoale.eu> starts with the trademark MARIMEKKO. The second element ALE of the disputed domain name is a Finnish word meaning "a sale, a bargain, a discount". Therefore, the expression "ALE" is, in fact, descriptive for the website, suggesting that there is a sale of MARIMEKKO products. The expression "ALE" is commonly used in the consumer market where the Complainant operates. It is also likely that Finnish consumers may search on-line for MARIMEKKO designer items on sale with the exact search words "marimekko ale". The language on <marimekkoale.eu> website is Finnish meaning that it is targeted for the Finnish consumers. Thus, due to the likelihood of confusion internet users are attracted to the address

<marimekkoale.eu>.

The Complainant submits that the trademark MARIMEKKO is a well-known trademark in Finland. For proof, the printouts from the List of Trademarks with Reputation of Finland as well as general information on the list from the official website of Finnish Patent and Registration Office are attached.

The Complainant also claims that MARIMEKKO products are sold in about 40 countries. In 2016, brand sales of the products worldwide amounted to EUR 199 million and the company's net sales were close to EUR 100 million. Roughly 160 Marimekko stores serve customers around the globe.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. It is inconceivable that the Respondent registered the disputed domain name unaware of the Complainant and its rights in the MARIMEKKO trademark.

The fact that the title of the disputed domain name <marimekkoale.eu> is "Marimekko Mekko Ale – Tilaa Edullisesti Netistä | Laukut, Mekot" translates in English as "Marimekko Dress Sale – Order Inexpensively On-Line | Bags, Dresses" clearly evidences that the Respondent is deliberately targeting the Complainant and its trademarks. Since Finnish internet users trying to find information on the Complainant’s products by using the search words could be directed to the Respondent’s domain name and the non-genuine MARIMEKKO products sold on the site.

In accordance with the ADR Rules, Paragraph B1(b)(11), the Complainant requests a decision for the transfer of the disputed domain name to it. The Complainant’s principal place of business is Finland, so the Complainant complies with the eligibility requirements set out in Art. 4(2)(b)(i) of Regulation (EC) No.733/2002.

B. RESPONDENT

The Respondent did not submit a Response in this proceeding.

DISCUSSION AND FINDINGS

According to Article 21(1) of Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules, a respondent’s registration of the disputed domain name is considered abusive and speculative if

(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.

Identity and confusing similarity

The Panel finds from the evidence submitted with the Complaint that it is the proprietor of the MARIMEKKO trademark. The Complainant's trademark registrations give rise to rights in the name MARIMEKKO within the meaning of Article 10 of the Commission Regulation (EC) 874/2004, i.e., rights established by Community law.

The Panel finds that the disputed domain name is confusingly similar to the MARIMEKKO trademark. The dominant element of the disputed domain name is the word “marimekko”, which is identical to the MARIMEKKO trademark. The other element of the dispute domain name – “ale”, is descriptive and does not detract from that dominance. As to the suffix “.eu”, it is widely accepted that this element is not relevant for the purposes of the test identity or confusing similarity. Therefore, the condition set forth under Article B11(d)(1)(i) of the ADR Rules is fulfilled.

Rights and legitimate interests

Under the ADR Rules, the burden of proof for the lack of rights and legitimate interests of the Respondent in the disputed domain name lies with the Complainant. However, the existence of negative facts is difficult to prove, and the relevant information for the Respondent is mostly in its sole possession. Therefore, the Panel holds that it is sufficient for the Complainant to make a prima facie demonstration that the Respondent lacks rights or legitimate interests in the disputed domain name. The burden of production then shifts to the Respondent to substantiate its rights or legitimate interests in the disputed domain name.

In this case, the Complainant has submitted that the MARIMEKKO trademark is well-known in Finland and obviously connected with the

Complainant and its products, so this trademark is not a name that any domain registrant would legitimately choose unless seeking to create an impression of an association with the Complainant. The Complainant has established that it is likely that Finnish consumers may search on-line for Marimekko designer items on sale with the exact search words “marimekko ale”. The language on the website at www.marimekkoale.eu is Finnish, meaning that it is targeted for the Finnish consumers. Due to the likelihood of confusion internet users are attached to the address marimekko.eu.

Having reviewed the case file, the Panel is of the opinion that there is no evidence to rebut the prima facie case established by the Complainant. Rather, the evidence supports the Complainant’s contentions. The disputed domain name is confusingly similar to the MARIMEKKO trademark, and the Respondent’s website associated to it offers what appears to be products of the Complainant without disclosing the lack of any relationship or endorsement of the Respondent’s website by the Complainant. In view of this, the Panel accepts that the disputed domain name was chosen and registered specifically in view of the MARIMEKKO trademark and its goodwill in relation to designer clothing products, and that the operation of a website under the disputed domain name is likely to illegitimately extract benefit from this goodwill without the consent of the Complainant. In the Panel’s view, these circumstances cannot be regarded as giving rise to rights and legitimate interests of the Respondent in the disputed domain name.

Taking the above circumstances into account, the Panel finds that the Respondent has registered the disputed domain name without rights or legitimate interests in it. The condition set forth under Article B11(d)(1)(ii) of the ADR Rules is therefore fulfilled as well.

Bad faith registration and use

The Panel notes that, in case the Respondent is found to have registered the disputed domain name without rights or legitimate interests in it, it is not necessary to investigate the Respondent’s possible bad faith under Article B11(d)(1)(iii) of the ADR Rules.

As the Complainant is a company established in Finland, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002. Therefore, the Complainant is entitled to request the transfer of the disputed domain name to itself.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name <marimekkoale.eu> be transferred to the Complainant.

PANELISTS

Name	**Peter Gustav Olson**

DATE OF PANEL DECISION 2018-01-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: MARIMEKKOALE.EU

II. Country of the Complainant: Finland, country of the Respondent: Norway

III. Date of registration of the domain name:18 November 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. the EU trademark (word), reg. No. 000307496, for the term MARIMEKKO, filed on July 4, 1996, registered on July 24, 1998 in respect of goods and services in classes 3, 16, 18, 20, 21, 24, 25, 26, 27, 42
2. the EU trademark (figurative), reg. No. 006997712, for the term MARIMEKKO, filed on June 18, 2008, registered on January 30, 2009 in respect of goods and services in classes 3, 16, 18, 20, 21, 24, 25, 26, 27, 28
3. the EU trademark (word), reg. No. 008528739, for the term MARIMEKKO, filed on September 4, 2009, registered on March 1, 2010 in respect of goods and services in classes 3, 6, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 35, 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 disputed domain name is confusingly similar to the MARIMEKKO trademark, and the Respondent's website associated to it offers what appear to be products of the Complainant without disclosing the lack of any relationship or endorsement of the Respondent's website by the Complainant. In view of this, the Panel accepts that the disputed domain name was chosen and registered specifically in view of the MARIMEKKO trademark and its goodwill in relation to designer clothing products, and that the operation of a website under the disputed domain name is likely to illegitimately extract benefit from this goodwill without the consent of the Complainant.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. N.A
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