Panel Decision for dispute CAC-ADREU-007585

Case number	CAC-ADREU-007585
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Domain names	BMWNAVI.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization	Bayerische Motoren Werke AG

Respondent

Name	Stefan Markus

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

No other proceedings are known to the Panel.

FACTUAL BACKGROUND

The Complainant Bayerische Motoren Werke AG (BMW) is a long-established manufacturer of vehicles, headquartered in Germany and with operations throughout the world. Amongst other things, its products are marketed through a network of dealers, again in multiple jurisdictions. It operates websites at a number of domain names (e.g. BMW.COM and BMWGROUP.COM).

BMW's trademarks include, inter alia, the mark BMW first registered in Germany in 1917 (221388) and a number of EUTMs (e.g. 000091835, issued in 2000, and a figurative mark containing the text BMW, 014015143).

A. COMPLAINANT

The Complainant submits that the disputed domain name <BMWNAVI.EU> should be transfered.

Regarding the first aspect of Article 21 of Regulation 874/2004 ('the Regulation'), the Complainant argues that the disputed domain name is confusingly similar to the BMW mark, because it contains the entire mark. Furthermore, it is submitted that the remainder of the disputed domain name (the string 'navi') does not challenge the confusing similarity, on the grounds that it is a generic or descriptive term which is itself related to the navigation software made and marketed by the Complainant (in the form of an abbreviation for 'navigation'). Finally, the Complainant asks that the suffix .eu be disregarded for the purposes of this analysis in accordance with established practice.

Secondly, the Complainant proposes that the disputed domain name was registered in bad faith (and so in breach of article 21(b)). It classes the registration as 'speculative and abusive' and contends that the Respondent would have been aware of the Complainant's rights. It argues that use is in bad faith on account of the intentional attraction of users, for commercial gain, by creating a likelihood of confusion with the Complainant's registered mark, and also the disruption caused by the advertising of unauthorised products, which it argues is unfair competition.

Finally, the Complainant declares that the Respondent has not been authorised by the Complainant to use the mark, and has no legitimate interest in the disputed domain name (in terms of article 21(a)).

The Complainant emphasises its belief that the Respondent uses the disputed domain name for a commercial website 'selling unauthorized, counterfeit versions of BMW’s navigation software and activation/FSC codes'.

B. RESPONDENT

The Respondent has not participated in these proceedings.

The Complainant makes reference to a number of positions taken by the Respondent, identified through perusal of the Respondent's website. The website is not currently live.

DISCUSSION AND FINDINGS

The Panel is first required to confirm that the Complainant holds relevant rights. This is easily done; as set out above, the Complainant holds a number of trade marks under German and EU law concerning the string 'BMW'; such rights are demonstrably within the scope of 'prior rights' as set out in article 10 of the Regulation.

It is then necessary to consider whether the disputed domain name is, for the purposes of article 21(1) of the Regulation, 'identical or confusingly similar to' the name in which the Complainant holds rights. It is not the case that the disputed domain name is identical to the Complainant's names. No evidence has been supplied to allow a Panel to conclude that the text 'BMWNAVI' is a name in which the Complainant holds a trade mark or other relevant right. However, the Panel does find that the disputed domain name is confusingly similar to the Complainant's name BMW. The Complainant correctly submits that no emphasis should be placed on the .EU top-level domain. Regarding the text 'navi', this meets the requirement for confusing similarity, because it is a descriptive term. It is not always the case that a descriptive term would automatically mean a finding in favour of a Complainant. In this case, however, it is open to the Panel to accept the Complainant's submission that it is descriptive of the navigation services it provides. This case is therefore similar to a number of earlier decisions under the Regulation, including Case 06585 Jack Wolfskin Ausrüstung für Draussen vs Wolfskin Apparels Co. Ltd (comparing 'jack-wolfskinsjacket' with the mark JACK WOLFSKIN), and Case 05126 Avery Dennison Corporation vs Dotasterisk Ltd (comparing 'averygraphics' with the mark AVERY).

(There is, as set out in the second edition of the Overview of CAC Panel Views on Selected Questions of the ADR for .EU Domain Name Disputes (p. 40), and further discussed in T Bettinger and A Waddell (eds), Domain Name Law and Practice (2nd edn, Oxford University Press 2015) (para IIIG.112), no consensus view on whether to have regard to the content of the website at a disputed domain name when considering confusing similarity. As such, without needing to resolve this debate, the Panel makes the present finding on the basis of the Complainant's submission, without reference to the Complainant's analysis of the content of the Respondent's website).

The Panel is next required, by article 21(1)(a) of the Regulation, to consider the possibility that the Respondent had used the name 'in connection with the offering of goods and services', if it was commonly known by the disputed domain name, or if it was 'making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of' the name in which the Complainant has rights. As the Respondent has not participated in proceedings, it would be difficult to find that such use was present (see e.g. Case 07202 Otokar Otomotiv ve Savunma Sanayi vs Gbenga Osoba). The Complainant highlights (and dismisses) the Respondent's statement (on its website) that it provides an 'enthusiast' site. Screenshots, including the disclaimer text, were provided by the Complainant. This is potentially an important point, as there are situations whereby such a site could meet the requirements for legitimate use and/or provide a response to an allegation of bad faith.

Moreover, there is scope under the Regulation for sites that act as resellers being able to make out a case under article 21(1)(a). The decision under the UDRP in D2001-0903 Oki Data v ASD is often referred to in decisions concerning the Regulation. See Case 07168 Re-Logic v Kenneth Buhrs; Case 06869 Schiess Tech v Razvan Zofota; Case 06574 Norcross Safety Products v JP Lebon; Case 05957 LEGO v Jeff Fidler; see also, at the WIPO AMC but concerning .eu, Case DEU2017-0005 Schleich GmbH v Cosch BV. Moreover, it is an important principle of EU intellectual property law, and trade mark law in particular, that the exclusive rights of rightsholders do not act to stifle competition; see for instance article 14(1) of Regulation 2017/1001 on the European trade mark (proprietor cannot prohibit honest third party use of mark the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark where, inter alia, use of the mark 'is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts'.

The Oki Data test contains four questions:

(a) The use involves the actual offering of goods and services in issue;
(b) The site sells only the trademarked goods;
(c) The site accurately and prominently discloses the registrant's relationship with the trademark holder.
(d) The Respondent must not try to "corner the market" in domain names that reflect the trademark.

While there is a need for caution in the application of the UDRP test in the context of the Regulation (given slight differences in applicable wording), the test provides useful guidance for a Panel in ensuring that the possibility of a legitimate use is considered. In the present

case, however, the Respondent has not participated, and the Complainant has supplied a Declaration that it conducted a test purchase and confirmed that the subject of the purchase (software and activation codes) was counterfeit. (The Panel does note that the Complainant relies heavily upon earlier cases, pertaining .eu and more generally, where BMW navigation software, similarly alleged to be counterfeit, was at issue. The Panel places limited weight upon this, given the need to consider the facts of a possible legitimate use in each and every case; put simply, the fact that an unconnected earlier Respondent has failed regarding the same or similar product or service does not mean that the Complainant will always prevail against a later Respondent).

The facts of this case do not sit easily with the typical 'reseller' case, where although there may be scope for unauthorised resale, this is normally predicated on the service being otherwise lawful. (Compare, for instance, the emphasis placed upon the 'genuine' nature of the toys in question in Case 05957 LEGO v Jeff Fidler). Moreover, the screenshots provided, as in the decision in Schleich GmbH v Cosch BV, indicate that the Respondent has not 'accurately and prominently disclose(d)' the relationship with the Complainant. The Complainant's logo is included, and the disclaimer text is positioned further down the page; moreover it is not as clearly worded as it needs to be (referring to the site as an enthusiast site, which conflates two possible legitimate uses - enthusiasm and aftermarkets).

On the basis of the Complainant's submissions (not contradicted by the Respondent), and the Panel's assessment, it is not possible to identify, in the terms set out in article 21(2), that 'a legitimate interest... [has been] demonstrated'. As such, the Panel finds that the disputed domain name has 'been registered by its holder without rights or legitimate interest in the name' (article 21(1)(a)).

It is not therefore necessary for the Panel to find registration or use in bad faith (article 21(1)(b)). However, regarding this matter, the Complainant has made submissions (without identifying provisions of the Regulation) clearly corresponding to two aspects of possible bad faith in the non-exhaustive list set out in the Regulation:

article 21(3)(c): 'the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor'

article 21(3)(d): 'the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a [name], such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name'

The Panel finds that the strongest case is found in respect of article 21(3)(d). It appears that the website operated by the Respondent is designed to attract users, through the disputed domain name, to a commercial site, with very limited efforts made to make users aware of its status as a provider of unauthorised (and allegedly unlawful) products and services, rather than a site authorised by the Complainant. The evidence referred to above in the consideration of legitimate use is also relevant in the assessment of bad faith.

There is however limited evidence from which registration for the primary purpose of disruption can be found. The Complainant raises, but does not develop, an argument regarding unfair competition.

The Complainant, established in Germany, has requested transfer of the disputed domain name to it. It is appropriate for the disputed domain name to be transferred to it as it requests, under the terms of article 4(2)(b)(i) of Regulation 733/2002 and articles 2 and 22(11) of Regulation 874/2004.

DECISION

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

PANELISTS

Name	**Prof. Daithí Mac Síthigh**

DATE OF PANEL DECISION 2018-02-14

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, with an address in Germany, sought the revocation of the disputed domain name <BMWNAVI.EU>, which was registered on 17 January 2010. The Respondent, with an address in the United Kingdom, did not participate. The Complainant relied upon its trade marks registered in Germany and the European Union. It demonstrated that the disputed domain name was confusingly similar to its protected rights, as it was a combination of its mark and a term descriptive of its relevant products and services. Rights or

legitimate interests of the Respondent could not be identified, although the Panel considered whether the Respondent's declaration (on its website) that it was providing an 'enthusiast' site, and/or the reseller scenario set out in the Oki Data decision under the UDRP, could provide such grounds. The Panel noted the Complainant's submissions regarding bad faith, accepting that had it been necessary to do so, a plausible case had also been made out under this heading. The Complainant being eligible on the grounds of its establishment in the European Union, transfer was ordered.