Panel Decision for dispute CAC-ADREU-007691

Case number	CAC-ADREU-007691
Time of filing	2019-02-10 10:50:42
Domain names	totybags.eu

Case administrator

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

Complainant

Organization	

Respondent

Name	Andrea Gruenewald

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

Mrs. Cudini and Mr. Piedimonte informed Ms. Aguiari that they had filed a complaint-lawsuit for the crime of fraud resulting from the undelivered products purchased on the website www.totybags.eu.

Ms. Aguiari filed a petition.

FACTUAL BACKGROUND

The Complainant, Ms. Aguiari, is the owner of "TOTY BAGS di Carlotta AGUIARI", registered in Turin, via Cibrario, n. 46 bis. The Company was established in 2012 and specialized in the production and sale of handcrafted leather goods.

Ms. Aguiari is also the owner of the "TOTY BAGS" trademark, registered at the Italian Patent and Trademark Office on 11 April 2013.

The Respondent, Andrea Gruenewald, is an individual based in Germany.

At the time the Complaint was filed, the disputed domain name was used as what appeared to be an e-commerce site.

The Complainant filed a Complaint under the .EU Alternative Dispute Resolution ("ADR") procedure with the Czech Arbitration Court (CAC) on 10 October 2018. The Complaint, which was amended after the CAC identified some deficiencies, was amended and refiled on 22 October 2018. On 23 October 2018, the notice of the ADR Proceeding was sent to the Respondent.

The deadline for submitting the Response was 23 November 2018, but no answer was received. The Respondent was, therefore, identified as in default. The Panel was appointed on 16 January 2019.

A. COMPLAINANT

Ms. Carlotta Aguiari is the owner of "TOTY BAGS di Carlotta AGUIARI" (the "Company"), registered in Turin, Italy and established in 2012. The Company specializes in the production and sale of handcrafted leather goods. Since 2013, Ms. Aguiari is the owner of the 'TOTY BAGS' trademark, registered with the Italian Patent and Trademark office.

In 2012, she registered the domain name <totybags.com> and, two years later, she started using it as an e-commerce site for TOTY BAGS products.

In 2018, in two different occasions, the Complaint received complaints from customers alleging that they had purchased TOTY BAGS goods that were never delivered. Upon investigation into the issue, the Complainant realized that the orders were placed using the

domain name <totybags.eu> and not through the Company's official one (www.totybags.com). In the meantime, both customers informed the Complainant that they were pursuing their legal options regarding fraud.

In May 2018, Ms. Aguiari sent a cease and desist letter to the registrant of the disputed domain name, alleging inter alia:

1) the disputed domain name is identical to the trademark she owns;

2) the Respondent has no legitimate right or interest in registering the disputed domain name;

3) the Respondent has registered and used the disputed domain name in bad faith.

B. RESPONDENT

The Respondent failed to file a response.

DISCUSSION AND FINDINGS

Paragraph B11(d)(1) of the Rules provides that the panel shall issue a decision granting the remedy requested in the event that the complainant proves 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."

Taking each of these issues in turn, this Panel decides as follows:

(i) Identical or confusingly similar

The Complainant has provided evidence that she has registered with the Italian Patent and Trademark Office and is the legitimate owner of the name "TOTY BAGS" since 11 April 2013. She is also the rightful owner of the domain name <totybags.com> since 2012.

At the same time, the Complainant has also provided evidence showing that the company is a business operating in the production and sale of handcrafted leather goods.

The Complainant has further provided evidence of the content of the website <totybags.eu>, which shows that the Respondent trades products similar to those sold by the Company (backpacks, bags and leather goods), therefore, engaging in what appears to be a clear cybersquatting case.

On the basis of these considerations, the Panel finds that the disputed domain name is identical to Complainant's rights recognized or established by the national law of an EU Member State and/or Community law. Paragraph B11(d)(1)(i) of the Rules is therefore satisfied.

(ii) Rights or legitimate interests

The second element to consider under Paragraph B11(d)(1)(ii) of the Rules is whether the respondent has registered a domain name without rights or legitimate interests in it. Paragraph B11(e) of the Rules sets out various ways in which a respondent may demonstrate rights or legitimate interests in a domain name, without limitation, as follows:

"(1) prior to any notice of the dispute, the Respondent 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;

(2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law."

As far as the burden of proof is concerned, the Panel finds the CAC .EU Overview 2.0 to be very useful. The Panel subscribes to the majority view which provides that the Complainant only needs to establish a prima facie case concerning the Respondent's lack of rights or legitimate interests and the onus then shifts to the Respondent to rebut the Complainant's assertion (see Section I Paragraph 17 of the CAC .EU Overview 2.0).

In the Panel's view, the Complainant has established a prima facie case of lack of rights or legitimate interests, while the Respondent did not file a Response to the Complaint and has thus failed to rebut that demonstration. It should be noted that a respondent's simple failure to file a response is not a definitive indication of a lack of rights or legitimate interests, and the Panel only finds as such in light of the facts of this particular case.

The Panel finds that none of the circumstances mentioned in Paragraph B11(e) of the Rules as evidence of a Respondent's rights or legitimate interests in the disputed domain name can be inferred from the documents enclosed with the Complaint. In particular:

* The Respondent may have used the disputed domain name in question to offer goods but they did so without any authorization or license by the Complainant.
* The Respondent is evidently making a non-legitimate use of the disputed domain name with the clear intent of misleading consumers and harm the reputation of the Company the Complainant has established.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph B11(d)(1)(ii) of the Rules is therefore met.

(iii) Bad Faith

The third element that falls to be considered under Paragraph B11(d)(1)(iii) of the Rules is whether a domain name has been registered or is being used in bad faith. However it should be noted that consideration of this element is not strictly required in this particular instance as it is only necessary for a Complainant to prove either the second element under paragraph B11(d)(1)(ii) or the third element under paragraph B11(d)(1)(iii). In this case the Panel has found that the Respondent has no rights or legitimate interests in the disputed domain name under paragraph B11(d)(1)(ii), thus satisfying the conditions to issue a decision granting the remedy requested.

However, the Panel would like to make it clear that the current practice exercised by the Respondent is clearly in bad faith. The Respondent has tried, in at least two occasions, to misappropriate the legitimate rights of the Complainant by having registered a domain name that is both identical to the Complaint's trademark and it misleads consumers.

The Panel believes that the Respondent has been acting in bad faith when he registered the disputed domain name.

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 <TOTYBAGS.EU> be transferred to the Complainant.

PANELISTS

Name	**Dr. Konstantinos Komaitis**

DATE OF PANEL DECISION 2019-02-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Panel found that the Complainant had relevant rights in the domain name <totybags.eu>. Furthermore, the Panel found that the disputed domain name was identical to such rights. Paragraph B11(d)(1)(i) of the Rules was therefore satisfied.

The Panel considered on the evidence put forward by the Complainant that the Respondent had no rights or legitimate interests in the disputed domain name, and the Respondent did not reply to rebut the Complainant's prima facie case. Paragraph B11(d)(1)(ii) of the Rules was therefore met.

In view of that finding, and although the Panel did not need to consider whether the Respondent had also registered or used the disputed domain name in bad faith under Paragraph B11(d)(1)(iii) of the Rules, the Panel still believes that the Respondent acted in bad faith. The Panel therefore ordered that the disputed domain name be transferred to the Complainant.