Panel Decision for dispute CAC-ADREU-007815

Case number	CAC-ADREU-007815
Time of filing	2020-01-19 17:09:14
Domain names	hiram-floors.eu

Case administrator

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

Complainant

Organization	Hiram GmbH von Saucken

Respondent

Organization	Traegulvcentret Aps

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

There are no other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the German company Hiram GmbH von Saucken.

The Complainant owns the rights to the trademark HIRAM FlOORS acquired through use over a substantial period of time, as well as through the following registrations: HIRAM FLOORS, registered in Germany under number: 3020192293324, or goods in classes 19 and 27, and HIRAM FLOORS registered as European Union trademark under number 018123631 for goods in class 19.

The Complainant furthermore owns the domain name <hiram-floors.com>.

A. COMPLAINANT

The following is a verbatim copy of the filed Complaint:

"The Respondent has previously had business with my client. The registration and ownership of the domain of the Respondent is therefore done knowingly in bad faith, as the Respondent had every knowledge of my client and all the rights of my client.

As my client owns these trademarks, though registration and use, the Respondent is therefore not allowed to register and own the domain name, as this is a direct violation of the rights of my client.

Further to the dispute, the content on the domain of the Respondent is in direct violation of my client as well, on multiple grounds. First of all, the Respondent is using the name and trademarks of my client on the domain. This is a violation.

Second, the Respondent is using an image of my clients logo, that violates the copyright of my client.

Third and final, the Respondent is slandering the name and brand of my client on the disputed domain, which again is a direct violating of the rights of my client.

Considering the above, it is my firm belief, that the domain of the Respondent should be revoked, as it is in every way a violation of the rights of my client, Hiram GmbH von Saucken, and of their rights to Hiram Floors."

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

According to ADR Rules Paragraph B11 “Basis of the decision” ” A Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules”.

Pursuant to ADR Rules paragraph 11 (d) “Basis for decision”:

“(d) The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that:

(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”.

A. The disputed domain name is identical or confusingly similar to a name of which a right is recognized or established by the national law of a Member State and/or Community law

The disputed domain name is identical to the Complainant´s registered trademark HIRAM FLOORS, since it contains this mark in its entirety.

The first requirement of Article 21(1) of the Commission Regulation (EC) 874/2004 and of Paragraph B11(d)(1)(i) of the ADR Rules is therefore met.

B. Respondent registered the disputed domain name without rights or legitimate interests in the name.

The Respondent is a Danish company whose business is to supply and mount wooden floors. The Respondent´s registered company name is TræGulvCentret ApS and they appear to use TræGulvCentret as their trading name. It is thus immediately apparent that the Respondent does not have any independent rights to the disputed domain name.

According to the Complainant, the Respondent has previously done business with the Complainant, which is confirmed by the information that is presented on the website under the disputed domain name. On the website the Respondent thus puts forward a strong criticism of the Complainant, a criticism that apparently is based on the Respondent´s experience when doing business with the Complainant. The headline and the first paragraph on the website reads: "Supplier Warning – Hiram Floors no go supplier" and "TræGulvCentret strongly warns any customers/clients to not make any trade with Hiram Floors from Germany".

The Complainant contends that by doing so "the Respondent is slandering the name and brand of my client on the disputed domain name, which again is a direct violating of the rights of my client". Although the Complainant does not explain this contention further and despite the lack of response, the Panel finds that the case gives reason to consider, whether it constitutes a legitimate interest to register a domain name that is identical to the registered trademark of a former business partner and to subsequently use the domain name for a website that expresses criticism of the holder of the trademark.

Article 21(2) of the Commission Regulation (EC) 874/2004 contains examples of when such legitimate interest may be present. The said article reads:

"A legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where:
(a) 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;
(b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;

(c) the holder of a domain name 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 on which a right is recognised or established by national and/or Community law."

The only relevant issue to consider in this case, is whether the criteria mentioned in point (c) are met. Both natural and legal persons have the right to express their opinion on how a specific company or brand owner conducts its business. They may register and use a domain name for that purpose, provided that the use of the domain name does not mislead consumers or harm the reputation of the company or the brand. In view of this Panel the registration and use of a domain name that comprises only of the criticized company´s trademark, i.e. without any derogatory term, will indeed be able to mislead internet users, since these users will expect that the domain name is used by the holder of the trademark or by someone who is authorized to do so by the holder of the trademark.

In this particular case there is also no doubt that the registration and the use of the disputed domain name is liable to harm the reputation of the Complainant´s trademark. As the following quote from the websites illustrates this is even the explicit intention of the Respondent: “TræGulvCentret has never made a such a supplier warning on the internet before, however, we feel a need now to warn any other clients who intent to go into business with Hiram. Don’t do it!” The Panel notes in this context that the website is available in 12 languages 11 of which are languages of states that are members of the European Union, which increases the risk of misleading the internet users and of harming the Complainant.

C. The disputed domain name has been registered or is being used in bad faith.

Based on the content of the website, some of which has been quoted above, the Panel finds that the disputed domain name was not only registered but is also being used in bad faith, in the meaning of Article 21(1)(b) of the Regulation (EC) 874/2004 and of paragraph B11(d)(1)(iii) of the ADR Rules.

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 <HIRAM-FLOORS.EU> be revoked.

PANELISTS

Name	**Knud Wallberg**

DATE OF PANEL DECISION 2020-01-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: hiram-floors.eu

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

III. Date of registration of the domain name: 30 August 2019

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Figurative trademark registered in Germany, reg. No. 3020192293324, for the term HIRAM FLOORS, filed on 09 September 2019, registered on 09 October 2019 in respect of goods in classes 19 and 27.
2. Figurative CTM, reg. No. 018123631, for the term HIRAM FLOORS, filed on 11 September 2019, registered on 11 January 2020 in respect of goods in class 19

V. Response submitted: No

VI. Domain name is identical 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 used by the respondent for website that fiercely critizises the Complainant in a way that may mislead internet user and harm the Complainant´s trademark

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

1. Yes
2. Why: The Respondent clearly states on the website that the domain name was registered and is used in order to "warn" others against doing business with the Complainant.

IX. Other substantial facts the Panel considers relevant: -

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: -

XII. Is Complainant eligible? Yes