Panel Decision for dispute CAC-ADREU-008109

Case number	**CAC-ADREU-008109**
Time of filing	**2021-03-22 08:24:28**
Domain names	**bobcatrent.eu**

Case administrator

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

Complainant

Organization	**Doosan Bobcat EMEA s.r.o.**

Respondent

Organization	**OSAUHING Klindex**

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 of which the Panel is aware of that are pending or decided and that relate to the disputed domain name. The legal proceedings referred by Complainant and Respondent do not relate to the disputed domain name.

FACTUAL BACKGROUND

1. OÜ Klindex holds the disputed domain name <bobcatrent.eu> which was registered on 19 May 2011. OÜ Klindex is using the domain name to market the rental of compact loaders, maintenance and repair of compact loaders, spare parts of compact loaders and sale of compact loaders.

2. Clark Equipment Company has registered the following trademarks:

• European Union trademark BOBCAT (No 000029371) protected as the EU trademark since 01/04/1996 (in the Republic of Estonia, with regard to Class 7 goods, since 16/02/1994 based on seniority) with respect to the goods belonging to Classes 7, 8 and 12 of the Nice Classification.

• European Union trademark BOBCAT (No. 009888298), protected as the EU trademark since 12/04/2011 with respect to the goods and services belonging to Classes 4, 28 and 37 of the Nice Classification.

3. Doosan Bobcat EMEA s.r.o., established in the Czech Republic is a licensee of aforesaid trademarks BOBCAT in Europe registered by Clark Equipment Company and is entitled, by virtue of said exclusive license to institute all appropriate proceedings to enforce such license and protect the trademark rights.

A. COMPLAINANT

The Complainant requests transfer of the disputed domain name to the Complainant because of the following grounds:

1) The disputed domain name <bobcatrent.eu> is confusingly similar to the trademarks of the Complainant as the most dominant and the only distinctive element of the disputed domain name is the name BOBCAT.

2) The Respondent has registered the disputed domain name <bobcatrent.eu> without rights or legitimate interests in respect of the disputed domain name as public registries do not contain any rights on name or trademark BOBCAT or BOBCATRENT belonging to the Respondent and the Complainant has not given its consent to the Respondent for registration or use of the domain names containing the trademark BOBCAT.

3) The Respondent has registered and uses the disputed domain name in bad faith as at the time of registering of the disputed domain name <bobcatrent.eu>, the Respondent must have been aware of the trademark BOBCAT and the disputed domain name <bobcatrent.eu> misleads the consumers as the goods and services offered under the trademark BOBCAT are not the goods and services offered by the BOBCAT authorized distributor.

B. RESPONDENT

The Respondent gave the following response to the statements and allegations made in the complaint:

1) Patent attorney Almar Sehver in not entitled to represent the Complainant Doosan Bobcat EMEA s.r.o..

2) Respondent did not register the disputed domain name in bad faith as it has been renting Bobcat equipment since 2003 and the corresponding activity of Respondent can also be seen in the disputed domain name <bobcatrent.eu>. By using the disputed domain name <bobcatrent.eu> Respondent advertises its own economic activities, which are undoubtedly permissible.

3) 2.2 Doosan Bobcat EMEA s.r.o argument is in bad faith as the disputed domain name <bobcatrent.eu> was registered on 19 May 2011, i.e. ten years ago. So far this has in no way bothered Doosan Bobcat EMEA s.r.o.. Doosan Bobcat EMEA s.r.o, registered in the Czech Republic, can have no reasonable reason to want a domain name for itself. Doosan Bobcat EMEA s.r.o is not operating the rental service of Bobcat equipment in Estonia or the Czech Republic, nor anywhere else in the world.

DISCUSSION AND FINDINGS

1) Right to represent the Complainant

The Panel has reviewed Power of Attorney issued to Almar Sehver on 6 January 2021 by Doosan Bobcat EMEA s.r.o, represented by its General Counsel Damien Joos de ter Beerst; Delegation of Powers issued to Damien Joos de ter Beerst on 3 January 2021 by Doosan Bobcat EMEA s.r.o, represented by Miguel Mallo as well as the Extract from Commercial Register regarding Doosan Bobcat EMEA s.r.o.

Based on these documents the Panel concludes that:
a) Miguel Mallo as board member of Doosan Bobcat EMEA s.r.o was entitled to solely represent Doosan Bobcat EMEA s.r.o.;
b) Miguel Mallo was entitled to authorise Damien Joos de ter Beerst to nominate and appoint external legal advisors of Doosan Bobcat EMEA s.r.o.;
c) Damien Joos de ter Beerst was entitled to authorise Almar Sehver to represent Doosan Bobcat EMEA s.r.o. in BOBCAT related trademark infringement enforcement actions against Klindex OÜ;
d) Almar Sehver was on 15 January 2021 duly authorised to file the Complaint against Klindex OÜ regarding the disputed domain name <bobcatrent.eu>.

2) Right to the disputed domain name

According to Article 21 of the Regulation (EC) No 874/2004 (the “Regulation 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, such as the rights mentioned in Article 10(1), 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.

Therefore firstly it should be established whether the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law. There is no dispute between the parties that trademarks BOBCAT are duly registered European Union trademarks and Complainant is the holder of exclusive license to these trademark. Trademark BOBCAT is filed among other classes in class 37- repair services for mobile, industrial, construction and excavating machinery, rental services for machinery, rental of skid steer loaders, articulated front end loaders, back hoes, trenchers and excavators.

According to the consensus view of earlier ADR.eu panels: "domain names which include a name for which a right is recognized or established by national and/or Community law combined with descriptive or generic terms are confusingly similar to that name, especially in situation where the descriptive or generic terms describe the goods and/or services or the right holder". Therefore the Panel is on the opinion that disputed domain name <bobcatrent.eu> that includes name BOBCAT combined with term "rent" is confusingly

similar to name BOBCAT.

Secondly it should be established whether the disputed domain name <bobcatrent.eu> has been registered by its holder without rights or legitimate interest in the name or whether it has been registered or is being used in bad faith.

Complainant claims that the Respondent does not have any rights or legitimate interests in respect of the disputed domain name. Respondent has explained that it has been renting BOBCAT products since year 2003 but the Respondent has not provided any evidence that it would have any rights or legitimate interest in the name. The Panel is on the opinion that therefore at the time of registering the disputed domain name the Respondent had to be aware of the fact that trademark BOBCAT was a registered trademark and that Respondent did not have the license to use the trademark BOBCAT nor the consent of the trademark owner or licensee to register the disputed domain name <bobcatrent.eu>. The Panel is on the opinion that registering a domain name that is confusingly similar to registered trademark without any rights to such registered trademark indicates bad faith as the disputed domain name is intentionally used to attract internet users, for commercial gain, to the holder of a domain name website by creating a likelihood of confusion with a registered trademark.

Panel is on the opinion that the fact that the Respondent has used the disputed domain name <bobcatrent.eu> for several years does not give the Respondent rights to the disputed domain name <bobcatrent.eu> as the disputed domain name was registered in bad faith. The fact that Complainant has until now not contested the disputed domain name <bobcatrent.eu> or that Complainant has not contested other domain names that include the name BOBCAT does not indicate that the Complaint has been filed in bad faith.

3) Transfer of the disputed domain name

The Complainant has requested the transfer of the disputed domain name <bobcatrent.eu>. According to Article 22.11 of the Regulation 874/2004, the Panel shall, in the case of a procedure against a domain name holder, decide that the disputed domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the disputed domain name shall be transferred to the Complainant if the Complainant applies for this disputed domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of the Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community; or
2. an organisation established within the European Community without prejudice to the application of national law; or
3. a natural person resident within the European Community.

In this case, the Complainant is an undertaking with registered offices within the European Community. As a result the Complainant satisfies the eligibility criteria. The Panel may order to transfer the disputed domain name to the Complainant.

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 <BOBCATRENT.EU> be transferred to the Complainant

PANELISTS

Name	**Viive Naslund**

DATE OF PANEL DECISION 2021-03-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: bobcatrent.eu

II. Country of the Complainant: Czech Republic, country of the Respondent: Republic of Estonia

III. Date of registration of the domain name: 19 May 2011

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1. Word CTM, reg. No.000029371, for the term 01/04/2026, filed on 01/04/1996, registered on 25/02/1998 in respect of goods and services in classes 7, 8, 12.
2. Word CTM, reg. No.009888298, for the term 12/04/2031, filed on 12/04/2011, registered on 15/09/2011 in respect of goods and services in classes 4, 28, 37.

V. Response submitted: Yes

VI. Domain name/s is/are confusingly similar 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 Respondent did not have the right to use registered trademark BOBCAT as distinctive part of it's domain name <bobcatrent.eu>, there was no license or consent of the trademark owner or licensee.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: At the time of registering the disputed domain name the Respondent had to be aware of the fact that trademark BOBCAT was a registered trademark

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: Representative of the Complainant has presented sufficient evidence regarding its right to represent the Complainant.

XII. Is Complainant eligible? Yes