Panel Decision for dispute CAC-ADREU-008157

Case number	CAC-ADREU-008157
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Domain names	pccmail.eu

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	PCC SE

Respondent

Organization	Petro Carbon Chem

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

This Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name <pccmail.eu> (the "Domain Name").

FACTUAL BACKGROUND

PCC SE, the Complainant in the present proceedings, is an international chemicals and transport company established within the European Union (the "EU") in Germany.

The Complainant owns several PCC trademark registrations, including:

- the German registration PCC No. 30576754 (word/figurative) registered on February 23, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40;
- the International Trademark registration PCC No. 895466 registered on May 24, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40.

PCC mark is used by the Complainant as a part of the name of companies from the Claimant's group.

The Complainant's official domain name is <pcc.eu>.

The Domain Name was registered on March 11, 2021.

The Domain Name resolves currently to an inactive website displaying the notification that it is "under maintenance/reconstruction" and "will be up and running soon".

A. COMPLAINANT

The Complainant requests that the Domain Name be transferred to the Complainant.

First, the Complainant submits that the Domain Name is identical or confusingly similar to the PCC trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Third, the Complainant contends that the Domain Name was registered and is being used in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions.

DISCUSSION AND FINDINGS

In order to succeed in its Complaint, the Complainant is required under Paragraph B(11)(d)(1) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules"), in connection with Article 21(1) of the Commission Regulation (EC) No 874/2004 (the "Regulation 874/2004"), to demonstrate the following:

(i) the Domain Name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or EU 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.

At the outset, considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), this Panel also refers to WIPO Overview 3.0. and UDRP cases, where appropriate.

A. The Domain Name is confusingly similar to the protected rights of the Complainant

The first element that the Complainant must establish is that the Domain Name is identical or confusingly similar to the Complainant's trademark rights recognized or established by national law of a Member State and/or EU law.

In the present dispute the Complainant has sought to protect its rights to the PCC trademark.

The Complainant owns PCC trademark registered in a Member State of the EU, namely the word/figurative PCC trademark No. 30576754 registered in Germany on February 23, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40. In addition, the Complainant owns the International Trademark PCC No. 895466 registered on May 24, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40.

The Complainant's PCC trademark registrations predate the registration of the Domain Name.

The Domain Name incorporates the Complainant's PCC trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS), WIPO Case No. D2003-0696).

The addition of the term "mail" does not serve to distinguish the Domain Name from the Complainant's trademark. UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, would not prevent a finding of confusing similarity under the first element. See WIPO Overview 3.0, section 1.8.

The the country-code Top-Level Domain ("ccTLD") ".eu" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See WIPO Overview 3.0, section 1.11.1.

Given the above, the Panel finds that the Domain Name is confusingly similar to the trademark in which the Complainant has rights recognised or established by the national law of a Member State and/or EU law. Thus, the requirements under Article 21(1) of the Regulation 874/2004 and Paragraph B(11)(d)(1)(i) of the ADR Rules have been satisfied.

B. The Domain Name has been registered by the Respondent without rights or legitimate interest

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name.

Pursuant to Paragraph B(11)(e) of the ADR Rules, in connection with Article 21(1)(a) of the Regulation 874/2004, any of the following circumstances, in particular but without limitation, shall demonstrate the Respondent's rights or legitimate interests to the Domain Name for purposes of Paragraph B11(d)(1)(ii) of the ADR Rules:

(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, 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 EU 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 recognised or established by national law and/or EU law.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in Paragraph B(11)(e) of the ADR Rules are present in this case. On the contrary, it has been proven by the Complainant to the Panel satisfaction that the Domain Name has been registered by the Respondent without rights or legitimate interest.

As mentioned above, there are the Complainant's PCC trademark registrations, which predate the Respondent's registration of the Domain Name. There is no evidence in the record indicating that the Complainant has licensed or otherwise permitted the Respondent to use its trademark or to register the Domain Name incorporating this trademark.

The Panel accepts that the Domain Name suggests an affiliation with the Complainant and its PCC trademark, as the Domain Name wholly reproduces this PCC trademark. Fundamentally, the Respondent's use of the Domain Name will not be considered "fair" if it falsely suggests affiliation with the Complainant as a trademark owner. See WIPO Overview 3.0, section 2.5.

Moreover, there is no evidence in the record indicating that prior to 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. Equally, the Respondent is not making a legitimate and non-commercial or fair use of the Domain Name.

On the contrary, the Respondent's use of the Domain Name is evidence of bad faith. The Panel notes that the Respondent uses the email address connected to the Domain Name in order to offer false work opportunities on behalf of PCC Prodex GmbH – a company from the Complainant's group of companies (the "PCC Prodex") without any authorization. Such use of the Domain Name perpetuates false impression that the Domain Name resolves to the Complainant's official website or at least that there is an official relationship between the Respondent and the Complainant.

Moreover, the website to which the Domain Name resolves is inactive displaying only the notification that it is "under maintenance/reconstruction" and "will be up and running soon". The Panel notes that there is no reasonable explanation under the ADR Rules for passive holding the Domain Name, and using it as an email address, and that in the circumstances of the case such use cannot give rise to rights or legitimate interest under the ADR Rules.

Finally, there is no evidence in the record showing that the Respondent has been commonly known by the Domain Name.

Given the above, the Panel concludes the requirement under Article 21(1)(a) of the Regulation 874/2004 and Paragraph B(11)(d)(1)(ii) of the ADR Rules has been satisfied.

C. The Domain Name has been registered or is being used in bad faith.

Under Article 21(1) of the Regulation 874/2004 and Paragraph B(11)(d)(1) of the ADR Rules, lack of rights or legitimate interests and registration or use in bad faith are considered alternative requirements for a successful complaint. As the Panel has found that the Respondent lacks rights or legitimate interests in the Domain Name no further discussion on bad faith registration or use is necessary.

Nevertheless, noting the composition of the Domain Name, the Panel finds it likely that the Respondent was aware of the Complainant at the time of registration of the Domain Name. The Complainant have submitted evidence showing that the Respondent registered the Domain Name well after the Complainant registered its PCC trademark.

Moreover, as noted above, the Respondent uses the Domain Name to send emails to third parties on behalf of the PCC Prodex without any authorization to do so. This circumstance constitutes clear evidence of bad faith.

Given the above, the Panel finds that the condition set out in Article 21(1)(a) of the Regulation 874/2004 and Paragraph B(11)(d)(1)(iii) of the ADR Rules has also been satisfied.

To sum up, the all the requirements established in Paragraph B(11)(d)(1) of the ADR Rules, in connection with Article 21(1) of Regulation 874/2004 have been met in the present case. In addition, according to Paragraph B(11)(b) of the ADR Rules, the Complainant satisfies the general eligibility
criteria set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002 as amended by Articles 20 and 22 of the Regulation (EU) 2019/517.

DECISION

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

PANELISTS

Name	**NOWACZYK, Piotr Nowaczyk, Esq, FCIArb**

DATE OF PANEL DECISION 2021-07-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: PCCMAIL.EU

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

III. Date of registration of the domain name: 11 March 2021

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. the German registration PCC No. 30576754 (word/figurative) registered on February 23, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40;
2. the International Trademark registration PCC No. 895466 registered on May 24, 2006 in respect of goods and services in classes 1, 3, 4, 17, 36, 39, 40.

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: There are the Complainant's PCC trademark registrations, which predate the Respondent's registration of the Domain Name. The Complainant has not permitted the Respondent to use its trademark or to register the Domain Name incorporating this trademark.

The Respondent has been not commonly known by the Domain Name. Also, the Respondent has not 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. Equally, the Respondent is not making a legitimate and non-commercial or fair use of the Domain Name. On the contrary, the Respondent's use of the Domain Name is evidence of bad faith, as the Domain Name resolves to an inactive website and is being used to send emails offering false work opportunities on behalf of the Complainant without any authorization.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. No
2. Why: Noting the composition of the Domain Name, the Panel finds it likely that the Respondent was aware of the Complainant at the time of registration of the Domain Name. The Complainant have submitted evidence showing that the Respondent registered the Domain Name well after the Complainant registered its PCC trademark.

Moreover, the Respondent uses the Domain Name to send emails impersonating the Complainant to third parties offering false work opportunities.

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name to the Complainant.

XI. Procedural factors the Panel considers relevant:

XII. Is Complainant eligible? Yes