Panel Decision for dispute CAC-ADREU-000131

Case number	**CAC-ADREU-000131**
Time of filing	**2006-03-02 09:58:18**
Domain names	**minitec.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Bernhard Bauer**

Respondent

Organization / Name	**Dirk Pauwels**

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

None

FACTUAL BACKGROUND

The Complainant, Mr. Bernhard Bauer, claims to be (but, as concluded below, he actually is not) the registered owner of a word community trademark ("CTM") "MINITEC", Reg. No. 692681, registered for goods in International Classes 6, 7 and 9, with a priority right as of 2 December 1997.

The Respondent, Mr. Dirk Pauwels, is an owner of a registered word BeNeLux trademark "minitec,", Reg. No. 710304, registered for goods in International Classes 7, 8 and 28, with a priority right as of 20 June 2002.

The Respondent applied for the disputed domain name <minitec.eu> during the Phased Registration (Sunrise Period I). The Claimant was the next applicant in the queue for the domain name concerned. The disputed domain name was registered for the Respondent since he demonstrated a prior right as defined in Article 10, para 1 of Commission Regulation (EC) 874/2004 ("Regulation"). Claimant's application was not therefore considered.

The Complainant claims that the disputed domain name has been registered and is being used by the Respondent without legitimate interest and in bad faith and requests the Panel to order transfer of the disputed domain name to the Complainant.

A. COMPLAINANT

The Complainant contends as follows:

- The Complainant's CTM is identical and more senior to the Respondent's trademark and both these trademarks are registered for identical or at least confusingly similar goods. Given the foregoing, the Respondent's trademark is an evident violation of the Complainant's prior CTM rights and, hence, subject to cancellation and injunctive relief. Consequently, the disputed domain name has been registered by Respondent without any definite rights in the name "minitec."

- Thus, the Respondent has registered and is using the disputed domain name without legitimate interest and in bad faith.

- The Complainant's CTM is well-known and widely recognized throughout the European Community and enjoys a good reputation. In addition, the Complainant holds several other international registered trademarks, such as US Trademark No. 2295102, Canadian Trademark No. 520121, and Australian Trademark No. 752826.

- Due to the well-known character of the more senior Complainant's CTM and the Complainant's business, the disputed domain name creates an impression among Internet users that they are visiting the legitimate and official website of the Complainant and that any of the information contained therein will be the accepted as official statements, views and/or comments of the Complainant. Thus, average Internet users are likely to be confused and mislead.

- The Respondent intentionally attempts to attract Internet users to his site by creating a likelihood of confusion with the Complainant's name and CTM.

- Thus, the Respondent has registered and is using the disputed domain name in bad faith.

B. RESPONDENT

The Respondent contends as follows:

- The Respondent is a registered owner of a valid BeNeLux trademark. Therefore, the Respondent has exclusive rights to his trademark.

- The Respondent used to perform his business activities under a name "minitec" from 1997 to 2003 and, since 12 September 2003, such activities have been performed by the newly established company "Minitec bvba." However, the Respondent still remains an owner of the abovementioned BeNeLux trademark.

- The scope of business of the Claimant is heavy machinery, whereas the Respondent (or a company MINITEC bvba) is active in the fields of so-called "mini technology" for modelers, hobby workers and engineers in precision machinery. Given the foregoing, business activities of the Claimant and that of the Respondent are different and there can be no confusion among Internet users regarding origin of the goods offered and promoted through the domain name website.

- Complainant's trademark registrations in non-EU countries are irrelevant.

DISCUSSION AND FINDINGS

Complainant filed the Complaint against the Respondent, a holder of the disputed domain name <minitec.eu> on 1 March 2006 (ADR fees were paid on 2 March 2006), whereas the disputed domain name was activated by the Registry on 2 March 2006. According to the last sentence of Article B 1 (a) of the ADR Rules ("Rules"), before activation of the domain name, it is only possible to file a complaint against the Registry (EURID), not against a holder of a domain name.

Given the foregoing, the Panel finds that the Complaint was filed prematurely. For such reasons, the Complaint must be dismissed.

However, notwithstanding the above, the Panel decided to also provide the Parties with its opinion on the merits of the case.

The Panel would like to point out that the objective of provisions of Article 21 of the Regulation (Speculative and Abusive Registrations) is not to automatically secure .eu domain names for those who have "better," "stronger" or "more senior" rights to the name corresponding to the domain name in question. Given the foregoing, it is always necessary for the Panel to carefully ascertain whether all necessary prerequisites (as stipulated in Article 21, para 1 of the Regulation) of a speculative and/or abusive registration are present.

1. Alleged Registration of Domain Name without Rights and Legitimate Interest

With respect to the alleged registration of the Domain Name without rights or legitimate interest the Panel holds as follows:

The Panel is satisfied by the evidence submitted by the Respondent that he is an owner of a registered BeNeLux word trademark "minitec," Reg. No. 710304, registered for goods in International Classes 7, 8 and 28, with a priority right as of 20 June 2002. As a result, the Panel holds that the Respondent has, under the applicable national law of Belgium, a trademark right to a name that corresponds to the disputed domain name.

The Complainant claims that due to the existence of the Complainant's more senior CTM, such Respondent's right is indefinite and not legitimately acquired. Such statement is irrelevant. The Panel has no power or intention to dispute the Respondent's trademark registration as it is not the purpose of ADR proceedings to asses whether the Respondent's national trademark is subject to potential revocation or invalidation. Nevertheless, the Panel would like to point out that even identical trademarks might coexist for various reasons (for example, due to dissimilarity of goods for which such trademarks are registered which, in this case, might especially apply to goods in Classes 8 and 28 for which the Respondent's trademark is registered). Thus, the Claimant's statement that the Respondent's

trademark rights are “indefinite and subject to injunctive relief” is speculative and tentative.

The Panel also finds that the disputed domain name has been registered by the Respondent with legitimate interest. The Respondent has used the name “minitec” (i.e. the name corresponding to the disputed domain name) within the scope of his business activities prior to any notice of the ADR. The Respondent’s enterprise had been, before formation of the company MINITEC bvba, known by the name “minitec,” and the Respondent had used a domain name “minitec.be” under a national Belgian TLD for promotion of his business. Currently, the disputed domain name (as well as national domain name “minitec.be”) is used for promotion of goods of the company MINITEC bvba, a private company with limited responsibility incorporated under Belgian law. It is apparent from the deed of incorporation of MINITEC bvba that the sole participant in (shareholder of) MINITEC bvba is Mrs. Lefevere, who is the Respondent’s wife.

Therefore, the Panel finds that it is acceptable and within fair business practices that (i) the Respondent registered the disputed domain name for promotion of business activities of a company in which his family member is solely participating, having in mind that (ii) such company’s company name consists of the name identical to the disputed domain name. Given the foregoing, the Panel concludes that the Respondent has registered the domain name with legitimate interest.

Given the foregoing, the Panel ascertains that (i) the Respondent has rights in the name for which the disputed domain name is registered, as well as that (ii) the Respondent registered the domain name with a legitimate business interest. Hence, the Panel concludes that conditions under Article 21, para 1, letter (a) of the Regulation for revocation of the disputed domain name are not fulfilled.

2. Alleged Registration and Use of Domain Name in Bad Faith

The Complainant also argues that the Respondent has registered the disputed domain name in bad faith, namely in order to mislead consumers about the origin of goods promoted and offered through the disputed domain name website.

The Complainant asserts that he is a registered owner of a community trademark (“CTM”) “MINITEC,” Reg. No. 692681, registered for goods in International Classes 6, 7 and 9 with a priority right as of 2 December 1997, which is more senior than the Respondent’s trademark.

However, based upon an extract from the applicable trademark register, the Panel has observed that the aforesaid CTM is registered for a company MiniTec Maschinenbau GmbH & Co. KG, not for a Complainant (who is Mr. Bernhard Bauer). Given the foregoing, claims of the Complainant based upon alleged more senior rights to the “minitec” denomination are unjustified. Thus, since the claim was based upon CTM rights, the Complainant should have been the company MiniTec Maschinenbau GmbH & Co. KG, not Mr. Bauer.

Nonetheless, as it seems that the Complainant (Mr. Bauer) is a representative of MiniTec Maschinenbau GmbH & Co. KG, the Panel, having in mind all aspects of the case, has decided not to follow a purely formalistic approach during these ADR proceedings, and hereby provides the parties with its opinion as if the said CTM was registered for the Complainant (i.e. as if the CTM was registered for Mr. Bauer).

The Complainant contends that the Respondent was aware or should have been aware about the seniority of the CTM over the Respondent’s trademark. Thereby, the Complainant claims that the Respondent has registered the disputed domain name in bad faith since the Respondent allegedly benefits from the distinctive character of Claimant’s CTM and, therefore, abuses its good reputation.

First at all, the Panel would like to stress that a trademark with an earlier priority right (more senior trademark) does not have priority over a more junior trademark for purposes of the .eu domain name registration, which is primarily based on a “first come, first served” principle. As a result, the mere existence of the Complainant’s more senior trademark (or other prior right, as the case may be), that is identical to the domain name, does not necessarily constitute a “bad faith” element of the Respondent’s domain name registration and therefore cannot, in itself, serve as grounds for transfer of the disputed domain name to the Complainant.

Alleged good reputation, well-known character or good name of the said CTM is not relevant for this case. The Panel is aware that well known denominations are often hijacked or they are subject to cyber-squatting (domain grabbing) or other malicious practices; however, as already described above, this is clearly not the case.

Analogically, registrations of the denomination “minitec” as Complainant’s trademarks (or trademarks of a company MiniTec Maschinenbau GmbH & Co. KG, as the case may be) in various jurisdictions worldwide (although such registrations might support the Complainant’s statement about the asserted well-known character of the CTM) are also irrelevant for this case.

Since (i) the Respondent has demonstrated legitimate interest in the disputed domain name (namely since he uses the domain name for his own legitimate business activities or business activities of his family members) and (ii) because business activities of the Respondent and the Claimant are different, the Panel ascertains that the Respondent has no intention to attract Internet users to the disputed domain name website by confusing them about the origin of products promoted through such website, or by causing an impression that such goods originate from the Complainant (or the company MiniTec Maschinenbau GmbH & Co. KG). The Panel holds that any such confusion (if any) would be purely accidental and unintentional.

Given the foregoing, the Panel holds that there are no indications and no evidence whatsoever that the disputed domain name has been registered or is being used in bad faith. Hence, the Panel concludes that conditions under Article 21, para 1, letter (b) of the Regulation for revocation of the disputed domain name are not fulfilled.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied.

PANELISTS

Name	**Jiri Cermak**

DATE OF PANEL DECISION 2006-05-16

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant claims that the disputed domain name has been registered and is being used by the Respondent without legitimate interest and in bad faith and requests the Panel to order transfer of the disputed domain name to the Complainant.

Complainant filed the Complaint against the Respondent, a holder of the disputed domain name, before activation of the domain name in question. According to the last sentence of Article B 1 (a) of the ADR Rules, it is not possible to file a complaint against a holder of a domain name before activation of the concerned domain name. Given the foregoing, the Complaint was filed prematurely. For such reasons, the Complaint must be dismissed.

With respect to the alleged registration of the disputed domain name without rights and legitimate interest the Panel holds that the Respondent has, under the applicable national law of Belgium, a trademark right to a name that corresponds to the disputed domain name. As to the Complainant's claims that (due to the existence of the Complainant's more senior community trademark identical to Respondent's national trademark) Respondent's right is indefinite and not legitimately acquired, the Panel rules that such statement is irrelevant. The Panel has no power to dispute the Respondent's trademark registration as it is not the purpose of ADR proceedings to asses whether the Respondent's national trademark is subject to potential revocation or invalidation.

With respect to the alleged registration of the disputed domain name in bad faith, the Panel concluded that a mere existence of the Complainant's more senior trademark (regardless of its potential well-known character) did not constitute a bad faith element of the Respondent's domain name registration. In addition, The Panel also concludes that the Respondent has no intention to attract Internet users to the disputed domain name website by confusing them about the origin of products promoted through such website. The Panel holds that any such confusion (if any) would be purely accidental and unintentional.

The Panel dismissed the Complaint.