Panel Decision for dispute CAC-ADREU-003896

Case number	**CAC-ADREU-003896**
Time of filing	**2006-11-29 13:19:47**
Domain names	**vinos.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**VINOS LTD, Johann Sebastian Guevara Kamm**

Respondent

Organization / Name	**Ovidio Limited, Ovidio Limited**

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 is a privat limited company incorporated on January 11, 2006 under the UK Companies Act 1985 with the company name „VINOS LTD“ (Annex 2).
The Respondent has registered the domain name at issue during the public landrush period on November 21, 2006.

A. COMPLAINANT

The Complainent relegates the panel to the almost identical ADR case ADR 2381 (HAJI). The Complainant is a limited liability company corporation named "VINOS" incorporated under the law of the Federal Republic of Germany and under the law of the United Kingdom. During Sunrise Period II the Complainant failed to register the domain name due to formal errors while entering the documentary evidence to the Registry. The Complainant distributes and imports wine from southamerica. The company has been founded in January 2006 by Johann Sebastian Guevara Kamm, who is appointed as the sole managing director of the Complainant (see ANNEX 12). The Complainant posseses prior rights for the domain name for several reasons. The Complainant is firstly registered its company in both national trade registers of Germany and the United Kingdom. Enclosed you will find proving certificates of Trade Register of the City of Pohlheim , Germany (ANNEX 1) and also of Companies House, Cardiff, U.K. (ANNEX 2). The Complainant is also Member of the Chamber of Commerce under the Name "VINOS". Enclosed you will find an Invoice of the chamber of commerce in Germany for the year of 2006 (ANNEX 3). Therefore the Complainant´s prior rights sufficiently complies with Article 12 (3) and Article 21.1 of EC Regulation 874/2004 and Article 11(d)(1) of the ADR Rules. The prior right for the name "VINOS" is also identical to the domain name including the suffix .EU. The “.eu” suffix must be disregarded for determining whether the domain name is identical or confusingly similar to the prior right. See: ADR 2381 (HAJI), ADR 596 (RESTAURANTS), ADR 475 (HELSINKI), ADR 387 (GNC) ADR 1676 (BAUMAX). Secondly the Complainant also used its companies name “VINOS” in trade businesses and in many other circumstances, which also states a prior right itself. Pursuant to Section 16 Nr. 5 (ii) of the sunrise rules the use of the companies name in the beforesaid manner implements a prior right and validates the Complainant interest to register the domain name. Enclosed you will find an invoice to a customer of February (ANNEX 4) and a copy of a business card and a trade card of METROGROUP International Store for Companies (ANNEX 5).On the business cards, on the invoices and on the bussiness letters, the Complainant informed about the future use of the Domain name www.vinos.eu. In many letters to its customers, the Complainant informed its Customers of the propper use of the Domain name as soon as the domain once www.vinos.eu is beeing registered (ANNEX 6 a + 6 b). The phrase "Luego que este activado vas a recibir un login para nuestra plataforma" does mean translated: "As soon as its activated, you will receive a login to our platform". The Complainant is waiting with its prepared software to launch it on the disputed website once the domain name "vinos.eu" is available to him. The Complainant has also informed about the future connection in its email footer (ANNEX 7 and 7b, Email to german Chamber of Commerce IHK). The Complainant has further also informed on its provisory german website "www.chilevinos.de" about the future use

of the companies website www.vinos.eu. Thereof the Complainant is commonly known under this domain and company name which is essential to legitimate registrations pursuant to Paragraph B 11 (e) (2) of ADR Rules and Article 21 Nr. 2 (b) of Commission Regulation (EC) No 874/2004 of 28 April 2004. The Complainant also complies with Paragraph 4(2)(b) of Regulation (EC) No. 733/2002. For all the above mentioned, the Complainant has an legitemate interest in registering the domain name. On November 21irst the Respondent registered the domain name so the Complainant failed to register. Misusing EURids domainname ability server (DAS) with com zonefiles in order to spyout all failed registrations during the Sunrise Period, the Respondent is known as biggest "Grabbing- Registrar" registering domain names in bad faith, commonly known under the name "Greek Connection". (Also see http://www.heise.de/newsticker/meldung/print/74062) The Respondents Mother Company "Advantix Computix LLC" has implemented an Postbox Office in Greek in order to be able to register domain names within the territory of the European Community and in cosequence to be enabled to register the new .EU domain names. All Phone calls and faxes sent to the greek phone numbers: +357.25870331 +357.25870347 are directly forewarded to the same answering machine located in the U.S., reachable under the following numbers: +1.7187322482 +1.7187322214 The Complaintant understands that there is a slight chance that there might exist certain registrants residing within the European Community who might have similar prior rights to register the domain name www.vinos.eu, since it means the generic word "wines" in spanish lenguage although the Complainant has not heard about any of them yet. Nevertheless the Respondent DOES NOT have such a prior right and registered the domain name for fraudery purposes. Therfore the Respondent fails Article 21 Nr. 1 of Commission Regulation (EC) No 874/2004 of 28 April 2004 and Paragraph B 11 (d) (1) (ii) of ADR Rules. The Respondent was informed immediately after registration about the threat of an ADR procedure (please see ANNEX 8 and ANNEX 9). Until to the date of filing this ADR complaint the webiste remains unconnected (please see ANNEX 10). Therof the Respondent also failed Article 21 Nr. 2 (a) and (c) of Commission Regulation (EC) No 874/2004 of 28 April 2004 and Paragraph B 11 (e) (1) and (3) of ADR Rules. The Respondent ist not commonly known under the webiste adress www.vinos.eu with its undertaking "ovidiolimited". He is known under its website www.ovidiolimited.com under the name "OVIDIO" (see ANNEX 11). The Respondent is also not Owner of Prior Rights recognised or established by national and / or Community law regarding the name "VINOS". Therof the Respondent also fails Paragraph B 11 (e) (2) of ADR Rules and Article 21 Nr. 2 (b) of Commission Regulation (EC) No 874/2004 of 28 April 2004. All the contrary, the Respondent is well known to be a domain grabber and so called "domainsquatter" who registers domain names in bad faith in order to sell them on "sedo" or misuse them for linking and tracking purposes and to mislead internet users. The statements on the Respondents Homepage (ANNEX 11) does sustain this behaviour. The Respondent publicly expresses in its first section its purposes of "growing of web properties" and "maintainment on websites of a broad array of topics" which are used for "direct navigation". The user shall "Check back often" to review the "web propperties". In the following subsection the Respondent annouces to implement a "website supplying information and links related to the phrase". It is further defined that: "This means that a user visiting legalservices.eu from Spain would see a site in Spanish that includes information and advertisements about legal services in Spain. A visitor to the same website from Germany would see a site in German including information and advertisements about German legal services." Firstly: The listing of a domain name on "sedo" (as happened in ADR panels case 2381 HAJI.EU) in order to sell the domain name to the Complainent infrings with Article 21 Nr. 3 (a) of Commission Regulation (EC) No 874/2004 of 28 April 2004. The Respondent is in full awareness of its trademark violations, it indicates the following disclaimer on its website (ANNEX 11): "Trademark Policy Due to the importance of ensuring accuracy and a consistent interpretation, the following notice is provided in English only. We maintain a policy of avoiding unnecessary disputes relative to trademark claims. As such, we diligently review communications from third parties asserting that one of our domains conflicts with their prior rights. If the documentary evidence provided establishes the prior right and that an actual conflict exists with our actual use of the domain name, we voluntarily transfer the domain name subject to appropriate documentation. If you believe you hold such a prior right, please contact us at the email address shown below with copies of evidence of your right. " The Complainent informed the Respondent of its prior rights which refused the transfer of the domain name. Secondly: The purpose of attracking and misleading users using a domain name which the Complainant reserves prior rights on in order to achieve commercial gains directly infrings with Article 21 Nr. 3 (d) of Commission Regulation (EC) No 874/2004 of 28 April 2004 and Paragraph B 11 (f) (4) and fails B 11 (e) (3) of ADR Rules. The panel considered in an similar case 2381 (www.haji.eu) that "....the Respondent has no legitimate interest in the domain name since it is not used to support any offer of goods or services, but merely parked. ....." and "....the domain name is not under non commercial or fair use insofar as the sole purpose of the Respondent's business (so called "direct navigation business") is to generate revenues with parking pages, and not to provide the internet users with relevant information." Te Respondent has known about that decision for long. All the above mentioned clearly indicates that the Respondent registered the domain name in bad faith and thereof infrings with Paragraph B 11 (d) (1) (iii) of ADR Rules and Article 21 Nr. 1 (b) of Commission Regulation (EC) No 874/2004 of 28 April 2004. The Respondent does not hold any legitemate interest in the domain name www.vinos.eu what so ever and the domain name is identical with the Complainants prior rights recognised and established by the national law of the Federal Republic of Germany and the United Kingdom. This directly infrings with Paragraph B 11 (d) (1) (i) of ADR Rules.

B. RESPONDENT

Complainant has failed to prove that Respondent’s registration of the domain name <vinos.eu> (the “Domain Name”) is speculative or abusive within the meaning of Article 21 of the EC Regulation No. 874/2004 (“Article 21”).
The Domain Name is a generic and descriptive term for “wines”. Respondent registered the Domain Name during the public Landrush

period because it was in fact a generic and descriptive term for “wines”. The Complainant did not establish the necessary prior right. Respondent’s use is entirely consistent with the generic and descriptive nature of the term and is expressly protected under European Community, UK, and German laws.

The Requirements imposed upon Complainant to prevail in an ADR are set forth in Article 21. As a foundational element, Complainant must affirmatively prove that (1) it holds a “prior right” which is protected under Community and/or National Law, AND (2) that the he domain name is identical or confusingly similar to a name in which the Complainant holds such legal rights. The burden of proof in this matter rests entirely upon the Complainant and absent proof, the Complaint must fail.
As to legitimate interest and bad faith, the panels have held that the Complainant has the burden of proof on these issues as well.

Respondent objects finally the Complainant’s use of Exhibits and references to materials that have not been translated into English. Respondent specifically notes that Section A(3)(c) of the .eu Alternative Dispute Resolution Rules (“ADR Rules”) requires that: “All documents including communications made as part of the ADR Proceeding shall be made in the language of the ADR Proceeding.” In this case the language of the ADR Proceeding is English.

For the reasons stated above the Complaint should be denied.

DISCUSSION AND FINDINGS

1. Following paragraph B.11(d)(1) ADR Rules it is necessary for the Complainant for making out a successful case to prove 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.

Following these requirements as basis for a decision in favour of the Complainant, he has to prove requirement (i) and additionally either recital (ii) or (iii). It is the Panels conviction, that the Complainant has already failed to meet the first requirement of paragraph B.11(d)(1) (i)-(iii), because he could not show a right in the sign “vinos”, recognized or established by a national law of a member state and/or Community law:

2. "Vinos" is a generic and with regard to the "wine-business" a descriptive word which could never be registered as a trademark for goods or services relating to wines unless it is general accepted in the trade through usage. If the Complainant were able to get such rights via business-name, it would be easy to circumvent the general principle of trademark-law not to register generic, descriptive or non-distinctive signs!

2.1 Although the Complainant was able to register the company name „Vinos Ltd“ under the UK Companies Act 1985 in the companies register, it is not possible to deduce from such a registration an exclusive right which exclude other persons from using such generic and descriptive signs.
Also the UK-law of passing off gives the Complainant no remedy which excludes others from using the word "vinos", because the basic requirements for passing off actions, especially set out in the leading cases Perry v Truefitt, Erven Warnink Besloten Vennootschap v J Twonend & Sons, Reckitt & Colman Products Ltd v Borden Inc and Consorzio de Proscuitto die Parma v Marks and Spencer plc are not met.

2.2 The Complainant could not establish a right in the name “vinos” under German law either:
A right in a business name cannot be reached by the mere registration in the company register but only by the use of the designation in Germany in commerce.
A Protection for a business name under sec. 5 para 2 German Trademark Act requires that
The name has been used in Germany in commerce;
The use must suggest a certain duration and consitency;
The name must be distinctive.

The mere application to register the seat of the company in Germany cannot be considered as proof for a use in commerce in Germany.

This Panel assumes moreover that the vast majority of German consumers are aware of the fact that the Spanish word "VINOS" means wines in German. This is true especially with regard to the internet society and to “wine-consumers”. The word “vinos” therefore is not distinctive but merely descriptive and generic with regard to goods and services relating to wine. In this respect the designation “VINOS" must be available also for other companies dealing with the import and distribution of wines.

2.3 Although the Complainants trading license (Annex 1) not only shows wholesale of wines and import of delicatessen and wine but also development and distribution of software, sales in general, internet services, medical consultancy and solutions, it is the Panels conviction that the mere fact of showing invoices, business cards and a trading license does not give special rights in the name “Vinos” with regard to goods or services relating to wines. Sec 5 German Trademark Act requires for business names to be protected either distinctiveness or general acceptance in trade of the business name. Both requirements are not proven by the Complainant with regard to the wholesale of wines and import of delicatessen and wine.

2.4 With regard to the development and distribution of software, sales in general, internet services, medical consultancy and solutions the name “Vinos” might be distinctive, however, the scope of non-registered rights, such as the right in a business name under sec. 5 para 2 German Trademark Act, are often contentious between the parties and are therefore subject to taking evidence. Therefore, in the opinion of this Panel, a Complainant must build a strong case in order to successfully rely on a non-registered right. This requires at least that the material the complainant relies on is presented in the language of the proceeding in order to guarantee that the respondent is treated fairly and can respond properly with regard to the alleged non-registered right. These minimum requirements are not met by the Complaint since none of the documents the Complainant relies on in order to prove a right in a business name in Germany has been presented with an English translation. Paragraph A.3(c) ADR Rules states moreover that all documents shall be made in the language of the ADR Proceeding. The Panel may disregard documents submitted in other languages than the language of the ADR Proceeding without requesting their translation.

3. Following the above said, the Panel held, that the Complainant did not show a right in the sign “Vinos”. In the case at issue the first-come-first-served-principle already set out in the EC Regulation 874/2004 is therefore applicable and decisive; thus the Panel decides not to grant the remedy requested by the Complainant.

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	**Tuukka Ilkka Airaksinen**

DATE OF PANEL DECISION 2007-02-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

For making out a successful case the Complainant has to prove 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.

In the case at issue the Complainant failed to show a right in the domain name <vinos> which is recognized or established by national law of a Member State and/or Comunity law.
Therefore the first-come-first-served principle is applicable and the Complaint must be denied because the Respondent registered the domain name at issue first.