Panel Decision for dispute CAC-ADREU-004052

Case number	CAC-ADREU-004052
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Domain names	tarkett-commercial.eu

Case administrator

Name	Tomáš Paulík

Complainant

Organization / Name	TARKETT SAS

Respondent

Organization / Name	REZEPT LTD, Janusch KURT

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

The Panel is not aware of other pending or decided legal proceedings which relate to the disputed domain name

FACTUAL BACKGROUND

All capitalized terms not defined herein are used by reference to the various regulations and rules identified in this decision.

This complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation”), European Parliament and Council Regulation (EC) No 733/2002 of April 22, 2002 (“EU Regulation”) and the .eu Domain Name ADR Rules and the Terms and Conditions (the “Rules” and “Conditions”).

1. The parties

TARKETT SAS, (the “Complainant") and its corporate headquarters are based in Nanterre (France). Dominique Mallo is the Complainant’s Authorized Representative.

The Complainant requests the transfer of the domain name Tarkett-commercial.eu, “the Domain Name” from the current Registrant to TARKETT SAS.

The current Registrant of the Domain Name registered on 7 April 2006 is REZEPT LTD, Janusch KURT, (the “Respondent”).

2. The ADR proceeding

On 29 December 2006, the Complainant submitted a Complaint to the ADR Center filed in the English language requesting the transfer to it of the Domain Name “tarkett-commercial.eu”.

On 10 January 2007, the ADR Center confirmed the receipt of the Complaint and requested verification information from EUrid about the Respondent.

On 12 January 2007, EUrid answered in a non-standard communication providing the information as requested and confirming that the Domain Name will remain locked during the pending ADR Proceeding.

On 12 January 2007, the ADR Center notified to the Complainant in a non standard communication that the Registrar was partly incorrectly identified in the Complaint.

On 16 January 2007, the Complainant provided in a non standard communication the appropriate identification of the Registrar.

On 23 January 2007, the ADR Center checked the Complaint and notified to the Respondent that an ADR Proceeding had been commenced against it pursuant to Regulations (EC) No. 733/2002 and No. 874/2004.

On 13 February 2007, the ADR Center indicated to the Respondent in a non standard communication that the term for submitting a Response would expire on 23.2.2007.

On 21 February 2007, the ADR Center indicated in a non standard communication that the date stated in the previous non standard communication was incorrect and that the Response had to be submitted by 23.3.2007.

On 22 February 2007, the ADR Center indicated in a non standard communication that the letter announcing Commencement of the ADR Proceeding to the Respondent and containing the Complaint and login information was returned undelivered due to unknown address. The ADR Center added that the envelope was opened and provided a photograph showing this.

On 26 March 2007, the ADR Center notified the Respondent's default.

On 6 April 2007, the ADR Center notified the appointment of the ADR Panel and the projected decision date.

On 11 April 2007, the case 4052 was transmitted by the ADR Center to the ADR Panel.

A. COMPLAINANT

The Complaint is below.

I - Foreword: Presentation of the complainant.

TARKETT has been founded in 1886 and its corporate headquaters are based in Nanterre (France). TARKETT has more than 100 years of experience in the manufacture of floorings focuses on resilient floorings (plastic floorings, linoleum), hardwood floorings (prefinished hardwood floor) and laminate floorings.

It is one of the world's leader and most experienced manufacture of floor coverings. Thus, TARKETT is today one of the largest worldwide producer and distributor of resilient floorings. With a global workforce of approximately 7500 employees, TARKETT provided, in 2005, 270 million square metres of floor and wall coverings.

Today, the TARKETT Group is an innovative and global company, present in more than 50 countries and operating 25 production units in 10 countries, 16 in Europe alone. Thus, TARKETT provides its products all over the world.

TARKETT'S products are used in different fields and in particular in healthcare, education, stores and shops, housing and sports (Annex 1: Brochure of TARKETT "Intelligent flooring solutions").

The complainant is composed of several business divisions, i.e. TARKETT RESIDENTIAL, FIELDTURF TARKETT and TARKETT COMMERCIAL.

TARKETT COMMERCIAL, which is especially concerned by the present case, is an innovative and global business division within the TARKETT GROUP. It provides designing, manufacturing and distributing floorcovering solutions for professionals, architects, specifiers and distributors all over the world.

Regarding the above elements, it is established that the complainant is a well known company in the field of floor coverings.

II – Grounds of the complain:

A. 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 (Rules § 11 d. (1) (i))

1. Complainant's rights

a/ The Trademarks TARKETT

The complainant owns several registrations of the Trademark TARKETT and inter alia the following Trademarks:
International Registration (annex 2):
TARKETT, n° 715620, of 1999, in classes 17, 19 and 27, claiming for 19 countries.

National Trademarks of Member States (annex 3):
- TARKETT, French trademark n° 1503747, of 1988, in classes 19 and 27.
- TARKETT, Benelux Registration n° 569901, of 1971, in classes 2, 19 and 27.
- TARKETT, German Trademark n° 39515918, of 1995 in classes 19 and 27.
- TARKETT, Portuguese Trademarks n° 299993 of 1994, in class 19 and n°299994 in class 27.

All the above trademark rights are recognized by the national law of a State Member and by the Community law.

b/ The trade names TARKETT and TARKETT COMMERCIAL

The complainant owns Production Centers under the trade name TARKETT in 16 European countries and in particular in Luxembourg, France, Sweden, Italy and Germany, which it uses to identify its activities of fabrication and commercialization of floor coverings .

As said above, TARKETT COMMERCIAL is an innovative and global business division within the TARKETT GROUP. It is a designing, manufacturing and distributing floor covering solutions for professionals, architects, specifiers and distributors all over the world.

The trade name TARKETT COMMERCIAL appears on a lot of brochures and advertisings available to consumers or professionals, so that it is known by the public as identifying floor covering solutions.

Regarding the above, it's possible to conclude that the trade names TARKETT and TARKETT COMMERCIAL are used in the European Community market to identify trade activities, thus it constitutes a right recognized by Community law.

c/ The domain names

The complainant is also the owner of the following domain names:
- "tarkett.eu"
- "tarkett.com"
- "tarkett.biz"
- "tarkettcommercial.eu"
- "tarkett-commercial.com"
- "tarkett-commercial.net"
- "tarkett-commercial.org"
- "tarkett-commercial.info"

(Annex 4 – copies of the WHOIS data base concerned)

All the above rights are recognized by the national law of a State Member and by the Community law.

2. Litigious domain name

The domain name on which the present complain is based is "tarkett-commercial.eu" (Annex 5 - copies of the WHOIS data base).

As a consequence of the above, the complainant owns rights on the denominations TARKETT and TARKETT COMMERCIAL.

The denomination TARKETT COMMERCIAL is identical to the litigious domain name "tarkett-commercial".

Concerning the comparison between TARKETT and “tarkett-commercial”, it should be noted that the denomination TARKETT COMMERCIAL is composed of the elements TARKETT and COMMERCIAL. The word “commercial” is descriptive, thus the distinctive and dominant element in this denomination is TARKETT, which has no specific meaning.

The word TARKETT is identically reproduced in the sign TARKETT COMMERCIAL, so that TARKETT COMMERCIAL appears as a declination of TARKETT and the consumer will think that both sign have the same origin.

Therefore, it is possible to conclude that denominations TARKETT and TARKETT COMMERCIAL are confusingly similar.

3. Conclusion

Regarding the above elements, it appears obviously that the complainant owns rights recognized or established by the national law of a State Member and/or by the Community law on the denominations TARKETT and TARKETT COMMERCIAL, whose are identical or, at least, similar to the litigious domain name.

B. The domain name has been registered by the Respondent without rights or legitimate interest in the name and is being used in bad faith (Rules § 11 d. (1) (ii) & (iii))

1. The domain name has been registered by the Respondent without rights or legitimate interest in the name

The respondent is not commonly known by the domain name “tarkett-commercial” either as an individual or as a business. Moreover, the respondent has no rights on the signs TARKETT COMMERCIAL or TARKETT.

In addition, the complainant has no licensed or otherwise authorized the respondent to use the denominations TARKETT COMMERCIAL or TARKETT and there are no relationship between the complainant and the respondent.

With this respect, the litigious domain name has been registered while the “sunrise period”, which corroborate the fact that the respondent has no right on the name.

The absence of meaning of the signs TARKETT and TARKETT COMMERCIAL reinforces the lack of legitimate interest into the related domain name, knowing that the denominations TARKETT and TARKETT COMMERCIAL have absolutely no generic value.

Consequently, there is an absence of legitimate right or even interest from the respondent in the signs TARKETT and TARKETT COMMERCIAL. With this respect, an Administrative Panel considered that the respondent has no right or legitimate interest because he “has not conducted any prior business under the name Carrefour in connection with the bona fide offering of goods and services (…) and it is not authorized by the complainants to use it”. The Administrative Panel considers these facts “support a clear inference that the Respondent does not have a legitimate interest in the subject domain name” (annex 5: Carrefour SA vs Damian Macafee WIPO case D 2002-1060).

Regarding the above elements, it’s possible to conclude that the respondent registered the litigious domain name without rights or legitimate interests.

2. The domain name has been registered in bad faith

The bad faith of the respondent results from the combination and succession of the following points:

a/ The litigious domain name has been registered to mislead consumers

Presently the litigious domain name reroutes to a search engine dedicated to flooring solutions (annex 6: web page: http://www.tarkett-commercial.eu/). Moreover, the litigious web site refers to complainant products and services by proposing links rerouting to websites of TARKETT.

In those circumstances, the consumers would legitimately associate the website “tarkett-commercial.eu” to the complainant.

It is therefore established that the respondent registered the domain name “tarkett-commercial.eu” in order to mislead the consumers.

b/ The respondent wanted to take advantage of the reputation of the complainant

TARKETT is a very well known company in the field of floor coverings and makes important investments in publicity to promote its products and services. Thus, further journals dedicated articles or publicities to complainant products and services (annex 7: BUILDING FOR EDUCATION – February 2005; FURTHER EDUCATION TODAY – February 2005; CARPETT AND FLOORING REVIEW – February 2005; PRACTICAL FACILITIES MANAGEMENT – February 2005; FACILITIES UK – February 2005; KEYSTONE IRELAND – February 2005; CFJ – February 2005), so that it is known by a large part of the public.

Moreover, TARKETT often organizes seminars in order to exhibit its products to architects, designers, buyers and contractors (annex 8: “GOOD MORNING – International Fair Ronneby”, 19/20 June 2006).

TARKETT is therefore a famous name, known by a large category of European Union consumers. In those circumstances, the respondent could not ignore the rights of the complainant on the denominations TARKETT and TARKETT COMMERCIAL and their reputation beside consumers.

Therefore, the respondent’s registration and use of the domain name, reproducing the complainant famous trademarks, indicate the deliberate attempt to capture persons believing that those sites are in connection with the complainant. With this respect, an Administrative panel considered that “by using the domain name to direct Internet users to a commercial website which is unrelated to the complainant (…), respondent has further illustrated its bad faith intentions (annex 9: SYSTEME U CENTRALE vs Sacha Rebk, Case n° D2001-0416).

c/ The respondent registered the litigious domain name for the purpose of selling, renting or otherwise transferring the domain name to the complainant.

As said above, the litigious domain name has been registered without any rights or legitimate interest. Moreover, it has been demonstrated that the denomination TARKETT is well known.

Therefore, these observations lead to think that the respondent registered “tarkett-commercial.eu” in order to be remunerated by the complainant for the transfer of the domain name.

For all the above reasons, it is established that the domain name “tarkett-commercial.eu” has been registered and used in bad faith.

C.Conclusion

It results of the above elements that the domain name “tarkett-commercial.eu” has been registered by the Respondent without rights or legitimate interest in the name and is being used in bad faith.

B. RESPONDENT

No response or other communication has been received from the Respondent in respect of the Complaint.

DISCUSSION AND FINDINGS

1/ It should be noted that the Respondent did not file any Response to the Complaint. This entitles the Panel to proceed to a decision based on the Complaint alone and to consider this failure to respond as grounds to accept the claims of the Complainant. This is stated under paragraph B. 10 (a) of the Rules. Consequently, the Panel accepts the claims of the Complainant, provided however, that these claims are valid, coherent and, in respect to the transfer, that the Complainant fulfils the eligibility criteria for registering a .eu domain name as established by Article 4 (2) (b) of the EU Regulation.

2/ According to Article 22(11) of the Regulation, an ADR proceeding may be initiated by any party where the registration is speculative or

abusive within the meaning of Article 21 or where a decision taken by the Registry conflicts with the Regulation or with the EU Regulation.

In the present case, the Complaint is against the registrant of the Domain Name, not the Registry. Therefore, the issue at hand is whether the registration is speculative or abusive within the meaning of Article 21.

Article 21 (1) states that:
“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.”

According to this article, a domain name shall be subject to revocation and/or transfer, (1) where that 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, such as the rights mentioned in Article 10(1) of the Regulation, (2) and where it has been registered without rights or a legitimate interest in the name or (3) has been registered or is being used in bad faith.

3/ First, the Panel must determine whether the Domain Name is identical or confusingly similar to Complainant’s name in respect of which a right is recognized or established by the national law of a Member State and/or Community law.

The Complainant has evidenced being the owner of numerous registered trademarks consisting of the word “TARKETT”.

The Complainant owns the International Registration for the trademark TARKETT registered on May 29, 1999 claiming for 19 countries and several National Trademarks of Member States (France, Benelux, Germany and Portugal) respectively registered on June 29, 1988, December 10, 1971, January 8, 1996, December 12, 1995 and August 20, 1997.

Complainant is thus the holder of a right recognised by national and/or Community law, such as the rights mentioned in Article 10(1). There is no indication that Respondent is the holder of such a right.

The Domain Name is not identical with Complainant’s protected rights but is it confusingly similar to these?

The trademarks and the Domain Name in question differ in the additional element “commercial”, the hyphen and the extension “.eu”.

It should be noted that, the element “commercial” is a descriptive word that is also used for the innovative and global business division within the Complainant group.

The addition of such a descriptive element to the very distinctive word “tarkettis not capable of excluding confusing similarity between the Domain Name and the trademarks. First, the protected word “tarkett” is a very distinctive name which distinctiveness is not diluted by the addition of the word “commercial”. Second, the Complainant shows that it uses the expression “TARKETT COMMERCIAL” in brochures and advertisings available to consumers or professionals and is thus known also under this business name.

In respect to the extension .eu added to the protected rights, it is widely accepted that the top level domain .eu is not considered under Article 10 of the Regulation as internet users see it as having only the function of an address and, hence being merely descriptive (cf. e. g. ADR.eu cases No. 00387 – gnc.eu and No. 02035 – warema.eu).

Furthermore, the separation or non-separation of the portions “Tarkett” and “Commercial” by hyphens or spaces in the Complainant’s trade name on the one hand and the Domain Name on the other hand does not influence the similarity since the internet users are used to the fact that companies doing business on the internet separate the elements of their company names in the respective domain names and others do not (cf. e.g. ARD.eu cases No. 00453 – web.eu and No. 02732 – hotel-adlon.eu). It is also common knowledge within internet users that many companies register as domain names variations of their names with and without hyphens in order to increase the visibility of their internet presence.

Finally, even if analysed in their totality rather than separately, the descriptive additions to the name “tarkett” used in the Domain Name do not dilute the very distinctive character of the protected right.
As a result the Panel considers that the Domain Name is identical or confusingly similar to Complainant’s name as protected by intellectual property rights.

4/ Does the Respondent have a legitimate interest in the Domain Name?

Article 21 (2) of the Regulation states that:
“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.”

Article 21 (2) of the Regulation implies a demonstration by Respondent rather than by Complainant. In the present case Respondent’s failure to respond to the Complaint means a failure to demonstrate the existence of a legitimate interest in the Domain Name.

However, before concluding on this the Panel cannot disregard the existence of a website that is linked to the Domain Name. The Domain Name is linked to a web directory. Nothing precludes the Panel from considering that a domain name that is used as a web directory may be evidence of a legitimate interest. The Panel will consider this in relation to Complainant’s arguments as the website is part of Complainant’s argument.

Article (B)(1)(b)(10)(i) of the Rules states that Complainant must describe “why the domain name has been registered by its holder without rights or legitimate interests in respect of the domain name that is the subject of the Complaint”.

The Complaint complies with this requirement and outlines the reasons for the lack of a legitimate interest as follows.

a) Complainant states that Respondent has not been licensed by it to use its protected intellectual property right and that Respondent is not commonly known by the name tarkett-commercial.

b) It results from the Complaint that, prior to any notice of the dispute, the Respondent used the disputed Domain Name to redirect to a web directory dedicated to flooring solutions.

Nothing precludes the Panel from considering that a domain name that is used as a web directory is evidence of a legitimate interest.

However, a legitimate interest is generally defined as either (i) a use or planned use of a domain name in connection with a bona fide offering of goods and services (ii) being commonly known by the domain name or (iii) using the name through a legitimate non-commercial or fair use, without tarnishing, misleading or diverting consumers.

The existence of the website cannot be considered alone as evidence of a legitimate interest. Its content is paramount to such determination. The website’s content must enable the Panel to conclude that the holder of the Domain Name has a legitimate interest in the Domain Name.

The website to which the Domain Name is linked is a web directory. This web directory specifically identifies floorings solutions and competitors of Complainant providing links to these competitors’ websites. It is thus clear to the Panel that the holder of the Domain Name is no using the Domain Name in connection to a bona fide offering of goods and services since the trademark of the Complainant is used for purposes of diverting Complainant’s customers. Respondent does not appear to be offering any specific goods or services related to the Domain Name as such. It is also clear to the Panel that Respondent is not commonly known by the Domain Name because it itself acknowledges through its website that it is Complainant that is known through that name as Complainant’s name is also provided in secondary links. Finally, there is no doubt to the Panel that the only known use of the Domain Name by Respondent which is the website cannot be considered legitimate non-commercial or fair use, without tarnishing, misleading or diverting consumers. It is in fact exactly the opposite.

As a result the Panel finds that the Respondent has not met this requirement and therefore there is no obligation under Article 21(1) to consider the issue of bad faith. However, given the issue has been raised by the Complainant, the Panel will now take this opportunity to consider the issue of bad faith.

5/ The Domain Name was registered or is being used in bad faith

Unlike the legitimate interest issue, the criterion of bad faith goes to the circumstances surrounding the registration or use of the Domain Name by the Respondent, and focuses on the Respondent's intentions, either as they are stated explicitly or as can be inferred from the Respondent's actions and the facts of the matter.

Article 21(3) of the Regulation defines "bad faith" for the purposes of the Regulation, which includes situations where:

"(a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or

(b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:

(i) a pattern of such conduct by the registrant can be demonstrated; or

(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or

(iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;

(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

(d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name; or(e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered."

In support of its allegation of bad faith the Complainant submits that by registering and using the Domain Name Respondent intentionally and for financial gain has attracted internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

It is clear from the website that Respondent knew of Complainant as a search on Respndent's website for the word "tarkett"lists Complainant as a provider of flooring.

The Panel believes that the Domain Name is being used to attract internet users to a website that is essentially a directory of websites related mainly with flooring services. Respondent is receiving pay-per-click fees when consumers follow the links proposed on on the website. As a result, the Panel considers that the Respondent uses the Domain Name to attract internet users, for commercial gain to its website, by creating a likelihood of confusion with Complainant's trademark. Respondent intentionally violates Complainant's intellectual property rights for financial gain.

The Panel concludes that the present case reflects the situation targeted by Article 21(3) (d) of the Regulation.

In addition to this Respondent used a false address to register the Domain Name. The Panel finds that the Respondent's erroneous address is also indicia of bad faith.

According to Article 3(a) of the Regulation the request for a domain name registration shall include the name and address of the requesting party.

The Article 20 c) states that the Registry may revoke a domain name at its own initiative and without submitting the dispute to any extrajudicial settlement of conflicts if holder's breach of the terms of registration under Article 3.

The ADR Center sent the letter announcing the Commencement of the ADR Proceeding to the Respondent and containing the Complaint and login information on 23 January 2007. This letter was returned undelivered due to the fact that the addressee was unknown at the stated address on 22 February 2007.

The Panel concludes that the condition of registration imposed by the Regulation to provide the name and the address of the party who requests the domain name is not fulfilled. This conclusion evidences further the bad faith of the Respondent when it registered the Domain Name.

On the basis of the above, the Panel finds that the disputed Domain Name is used by the Respondent in bad faith.

Finally, the Complainant has demonstrated fulfilling the eligibility criteria of Article 4 (2) (b) of Regulation and orders the transfer of the Domain Name to Complainant.

DECISION

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

the domain name TARKETT-COMMERCIAL be transferred to the Complainant

PANELISTS

Name	Jean Albert

DATE OF PANEL DECISION 2007-05-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

A domain name shall be subject to revocation and/or transfer, (1) where that 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, such as the rights mentioned in Article 10(1) of the Regulation, (2) and where it has been registered without rights or a legitimate interest in the name or (3) has been registered or is being used in bad faith.

TARKETT is a protected trademark that belongs to Complainant. It refers to flooring solutions. The Domain Name is not identical to the trademark but it is confusingly similar to it.

Using the Domain Name by linking it to a website that disparages Complainant's trademark cannot result in a legitimate interest in the Domain Name. To the contrary it attests to Respondent's bad faith and blatant violation of Complainant's intellectual property rights.