# Panel Decision for dispute CAC-ADREU-004309

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| Case number | CAC-ADREU-004309 |
| Time of filing | 2007-02-26 10:33:21 |
| Domain names | osram-os.eu |

## Case administrator

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| Name | Tereza Bartošková |

## Complainant

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| Organization / Name | OSRAM GmbH, CEO Martin Goetzeler |

## Respondent

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| Organization / Name | Zheng Qingying |

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 that are pending or decided and that relate to the disputed domain name. The Panel is aware, however, of several previous ADR proceedings to which the Respondent was a party and which are mentioned in the decision below.

FACTUAL BACKGROUND

1. The Complainant OSRAM GmbH is a limited liability company incorporated under German law, having its principal place of business in Munich, Germany. It is one of the world's two leading lighting manufacturers and sells its products to 150 countries. The Complainant has 40,000 employees. In its fiscal year 2006 the worldwide sales of OSARAM products amounted to 4,600 million Euro. The Complainant's historical roots go back to the year 1906 when the trademark "OSRAM" was first registered by one of its predecessor companies. Meanwhile Complainant owns 135 registered German trademarks and 18 registered European Community trademarks containing the word "OSRAM".

2. One of the business areas in which Complainant is active are opto-semiconductors. In 2006 opto-semiconductors accounted for 12% of Complainant's global sales. The company "OSRAM Opto Semiconductor GmbH" is a fully owned subsidiary of Complainant.

3. The abbreviation for opto-semiconductors that is frequently used by Complainant and its competitors is "OS". Furthermore, Complainant is registered owner of the European Community trademark no. 1349463 "OS". Complainant also owns the domain name "osram-os.com" and uses it for a website dealing with opto-semiconductor products.

A. COMPLAINANT

4. Complainant contends that its name "OSRAM" is a protected company name pursuant to S. 5 German Trademark Act. Furthermore, Complainant specifically relies on the rights conferred by its European Community trademarks no. 1680461 "OSRAM" (with design) and no. 27490 "OSRAM" (word), which are registered for numerous goods and services in classes 1, 4, 6, 7, 9, 10, 11, 12, 14, 17, 21, 25, 28, 35, 37 and 42. Complainant contends that the disputed domain name is confusingly similar to these protected rights.

5. Complainant contends that Respondent has no rights or legitimate interest in respect of the disputed domain name. Specifically, Complainant contends that

(1) Respondent does not use and has never used the disputed domain name or a similar name in connection with the offering of any goods or services; Respondent has not made any demonstrable demonstrations to do so;

(2) Respondent is not holder of a trademark "OSRAM", "Osram-os" or any similar trademark and is not commonly known by the domain

name; and

(3) Respondent is not an authorized dealer, distributor or licensor of the Complainant, and is not (and will not) be able to make a legitimate or non-commercial or fair use of the domain name without misleading consumers or harming the reputation of Complainant's company name and trademarks.

6. Complainant further contends that Respondent has already been involved in numerous ADR proceedings under Article 21 of Commission Regulation (EC) No 874/2004 (the "Public Policy Rules"), namely the proceedings with CAC case numbers 3444 OCUNET, 3588 XIRONA and LEVOTHYROX, 2325 GLENDIMPLEX, 2429 ERICPOL, and 2986 TERXON. Complainant contends that in all these proceedings Respondent had registered domain names that were identical to trademarks of the respective Complainants. According to Complainant this demonstrates that Respondent is "specialized" in trademark infringing domain name registrations, and that Respondent has acted in bad faith and with speculative intent in the present case as well.

7. Based on these arguments Complainant requests transfer of the disputed domain name.

B. RESPONDENT

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

DISCUSSION AND FINDINGS

9. Respondent has failed to submit any Response to the Complaint. In Accordance with Paragraph 10(a) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") the Panel nevertheless proceeds to a decision as follows.

10. According to Article 21(1) Public Policy Rules and Paragraph B11(d)(1) ADR Rules Respondent's registration of the disputed domain name is considered abusive and speculative if
(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.

11. The domain name "OSRAM-OS" is confusingly similar to Complainant's trademarks and company name "Osram". The additional element "-OS" is either a descriptive abbreviation for "opto-semiconductors" or, if not descriptive, an element that is almost identical to Complainant's additional trademark "OS". In either case the domain name "OSRAM-OS" is dominated by the element "OSRAM", which is identical to the name in which Complainant has rights.

12. On the evidence made available to the Panel and in the absence of any Response from Respondent the Panel is convinced that Respondent does not have any rights or legitimate interest in the disputed domain name. Respondent is in particular not commonly known by the name "OSRAM-OS", and there is no evidence of any domain name use (whether non-commercial or in connection with the offering of goods or services) by the respondent.

While it is generally Complainant who bears the burden of proof regarding Respondent's rights or legitimate interest (or rather the lack thereof), Complainant's contention that the obvious facts do not demonstrate a right or legitimate interest of Respondent in the disputed domain name are sufficient in this regard. Based on these contentions the onus shifts to Respondent to produce factual evidence for a right or legitimate interest (see CAC case no. 2035 WAREMA, sub 8.1; CAC case no. 2888 GERMANWINGS; and the detailed discussion in CAC case no. 3444 OCUNET, sub 2). Respondent has not even claimed any right or legitimate interest in this regard.

13. On the evidence made available to the Panel and in the absence of any Response from the Respondent the Panel is further convinced that Respondent has registered the domain name in bad faith. Given the distinctive character of Complainant's "Osram" trademark, Complainant's significant business activities in the field of opto-semiconductors, and its use of the domain name "osram-os.com", it is practically impossible that Respondent coincidentally chose the domain name "OSRAM-OS" without reference to Complainant's mark.

The Panel is specifically convinced that Respondent has registered the domain name in order to prevent Complainant from reflecting its "Osram" and "OS" trademarks in the corresponding domain name "OSRAM-OS". This case may not fall exactly into the category of Article 21(3)(b) Public Policy Rules and Paragraph B11(f)(2) ADR Rules, because Respondent's registration of "OSRAM-OS" does not prevent Complainant from registering domain names that are identical to its two relevant trademarks (i.e. "osram.eu" and "os.eu"). The wording of Article 21(3)(b) Public Policy Rules and Paragraph B11(f)(2) ADR Rules seems to primarily target those cases where the disputed domain name is strictly identical to Complainant's protected name, and not a combination of two separate protected names. Article

21(3) Public Policy Rules, however, merely lists the most important examples of bad faith, and other circumstances may also suffice to satisfy the general bad faith requirement of Article 21(1)(b) (see CAC case no. 1584 KSB, sub 33; CAC case no. 283 LASTMINUTE; CAC case no. 2955 F1, sub 16, and Paragraph B11(f) ADR Rules which explicitly states that the examples are "in particular but without limitation"). Given Complainant's individual "Osram" and "OS" trademarks and Complainant's prior use of the domain name "osram-os.com" the present case is sufficiently similar to the standard cases of Article 21(3)(b) Public Policy Rules and Paragraph B11(f)(2) ADR Rules, and it is therefore justified to apply these provisions – with the necessary changes – here as well in considering Respondent's bad faith. Based on the similar ADR cases in which Respondent has previously been involved (see paragraph 6 of this decision above) it is evident that Respondent has engaged in a pattern of such conduct (see Article 21(3)(b)(i) Public Policy Rules, Paragraph B11(f)(2)(i) ADR Rules), and the Panel therefore accepts that Respondent has registered the domain name in bad faith.

DECISION

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

This decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction (see Paragraphs B12(a) and B14 of the ADR Rules).

## PANELISTS

| Name | Thomas Schafft |
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DATE OF PANEL DECISION 2007-05-22

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Panel held that the domain name "OSRAM-OS" is confusingly similar to Complainant's company name and trademark "Osram".

Complainant contended that Respondent did not have any rights or legitimate interest in the disputed domain name, and specifically contended that the examples for a legitimate interest provided in Article 21(2) Public Policy Rules are not given in the present case. On the basis of these contentions and in the absence of any Response from the Respondent the Panel accepted that Respondent did not have any rights or legitimate interest in the disputed domain name.

The Panel also held that Respondent registered the domain name in bad faith. Although the domain name "OSRAM-OS" is not strictly identical to a name in which Complainant has rights, the Panel nevertheless applied – with the necessary changes – Article 21(3)(b) Public Policy Rules and Paragraph B11(f)(2) ADR Rules in reaching this decision. Respondent had previously been involved in similar ADR cases which demonstrated Respondent's pattern of such conduct.

The Panel therefore ordered that the domain name OSRAM-OS be transferred to the Complainant.