Panel Decision for dispute CAC-ADREU-004339

Case number	**CAC-ADREU-004339**
Time of filing	**2007-10-03 12:08:39**
Domain names	**merci-pur.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**August Storck KG, Dr. Wolf-Christian Dickertmann**

Respondent

Organization / Name	**World Online Endeavours, Ltd.**

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.

FACTUAL BACKGROUND

The Complainant in this proceeding is August Storck KG. The submitted evidence shows that the Complainant is the owner of the following registered trademarks:

MERCI - German trademark with registration number 802273 with priority from May 16, 1964.;

MERCI - European Community trademark with registration number 003858231 with priority from May 27, 2004;

MERCI-PUR MANDEL SAHNE – German trademark with registration number 39531298.1 with priority from July 29, 1995;

MERCI PUR HERBE SAHNE - German trademark with registration number 39531275.2 with priority from July 29, 1995;

MERCI PUR KAFFEE SAHNE - German trademark with registration number 39531274.4 with priority from July 29, 1995;

MERCI PUR HELLE SAHNE - German trademark with registration number 39531266.3 with priority from July 29, 1995.

The Respondent in this proceeding is World Online Endeavours, Ltd. On April 7, 2006, the Respondent registered the disputed domain name <merci-pur.eu>.

The Czech Arbitration Court (“CAC”) acknowledged receipt of the Complainant’s Complaint regarding the disputed domain name on October 3, 2007.

On October 22, 2007, CAC acknowledged receipt of the Respondent’s Response.

A. COMPLAINANT

The Complainant contends as follows:

The Complainant is the parent company of the Storck-group, one of the leading companies for production and distribution of sweets and candies in Germany. Some of the Complainant’s famous products are “Toffifee”, “Werther’s Original”, “nimm 2” and “merci”. The

Complainant has built a family of trademarks around the trademark MERCI and a few of them are combinations of the words “MERCI” and “PUR”.

The Complainant maintains that it is the proprietor of various registered trademarks containing the name MERCI. In addition to the trademark registrations, the Complainant claims that the brand names MERCI and MERCI PUR are protected under paragraph 4, 14 Markengesetz (German Trademark Act). In 2006, the sales of merci-products in the EU amounted to more than 160 million Euro and the Complainant spent more than 22 million Euro on media.

The Respondent is a British private limited company, incorporated on March 21, 2006 with addresses in Sweden and the UK. The Respondent is known as a “domain grabber” and has been involved in several ADR cases. See for example ADR Case 04008, 04037 and 04336. Of particular relevance is the previous ADR Case 04336 between the Respondent and the Complainant regarding the domain name <nimm2-lachgummi.eu> in which the panel ruled against the Respondent.

The disputed domain name <merci-pur.eu> is identical and/or confusingly similar to the marks MERCI and MERCI PUR recognized by German and Community law. In addition to this, the disputed domain name is partly identical and confusingly similar to the Complainant’s registered trademarks MERCI, MERCI-PUR MANDEL SAHNE, MERCI PUR HERBE SAHNE, MERCI PUR KAFFEE SAHNE and MERCI PUR HELLE SAHNE.

Although there is no connection between the Complainant and the Respondent, the registration of the disputed domain name by the Respondent causes a substantial danger of confusion between the enterprises. The Respondent has no legitimate interest to the domain name and has not been commonly known by the domain name. The Respondent does not even use the domain name. The disputed domain name has been registered by the Respondent in bad faith only 18 days after the company was incorporated. According to previous ADR cases, the Respondent has engaged in a pattern of registering domain names in order to prevent legitimate right holders from registering corresponding domain names.

It is obvious that the Respondent’s intention is to attract Internet users to the Respondent’s websites to achieve commercial gain by creating a likelihood of confusion with the Complainant’s trademarks.

B. RESPONDENT

The Respondent contends as follows:

The Respondent did not intend to infringe prior rights and is prepared to release the disputed domain name if the Complainant is prepared to drop the ADR.

DISCUSSION AND FINDINGS

The Complainant must, in accordance with Article 21.1 of Commission regulation (EC) No. 874/2004 and Paragraph B 11 (d)(1) of the ADR Rules, demonstrate that the domain name <merci-pur.eu> is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognized or established by the national law of a member state and/or Community law and either (a) the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name; or (b) the domain name has been registered or is being used in bad faith.

The Complainant is, according to the submitted evidence, the owner of the following registered trademarks: MERCI, MERCI-PUR MANDEL SAHNE, MERCI PUR HERBE SAHNE, MERCI PUR KAFFEE SAHNE and MERCI PUR HELLE SAHNE. Furthermore, the Complainant relies upon protection of the brand name MERCI PUR in accordance with Paragraph 4, 14 of the German Trademark Act. The definition of ‘prior rights’ as referred to in Article 21 of Commission regulation (EC) No. 874/2004 is defined in Article 10(1) and includes unregistered trademarks, trade names and business identifiers in as far as they are protected under national law in the member-state where they are held.

The disputed domain name <merci-pur.eu> contains the Complainant’s registered trademark MERCI in its entirety. In addition to this, the disputed domain name contains the phrase “merci pur” which is an integrated part of the following registered trademarks: MERCI-PUR MANDEL SAHNE, MERCI PUR HERBE SAHNE, MERCI PUR KAFFEE SAHNE and MERCI PUR HELLE SAHNE.

Having the above in mind, it is the opinion of the Panel that the disputed domain name <merci-pur.eu > is confusingly similar to the trademarks of the Complainant which are recognized within the meaning of Paragraph B.11(d)(1) of the ADR Rules.

It has been argued by the Complainant that the disputed domain name has been registered by the Respondent without rights or

legitimate interest in the name. In its Response, the Respondent has not submitted any evidence indicating that the Respondent is the owner of any rights similar to the disputed domain name or that the Respondent is or has been commonly known by the disputed domain name. On the contrary, the Respondent has indicated that it is prepared to cancel the domain name registration if the Complainant would terminate the ADR proceeding.

Thus, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in respect of the disputed domain name in accordance with the requirements of Article 21.1 of Commission regulation (EC) No. 874/2004 and Paragraph B11(d)(1)(ii) of the ADR Rules and the Panel finds that the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name.

In the light of these findings, the Panel does not need to consider whether the disputed domain name has been registered or is being used in bad faith as the conditions set in Paragraphs B11(d)(1)(i) and (ii) of the ADR Rules are satisfied.

DECISION

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

PANELISTS

Name	**Johan Carl Sjöbeck**

DATE OF PANEL DECISION 2007-11-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant, August Storck KG, is, according to the submitted evidence, the owner of the following registered trademarks: MERCI, MERCI-PUR MANDEL SAHNE, MERCI PUR HERBE SAHNE, MERCI PUR KAFFEE SAHNE and MERCI PUR HELLE SAHNE.

The Respondent is World Online Endeavours, Ltd. registered the domain name <merci-pur.eu> on April 7, 2006.

The Panel held that the domain name was confusingly similar to the Complainant's registered trademarks and that the domain name was registered by the Respondent without rights or legitimate interest in the name.

Since the conditions set in Paragraphs B11(d)(1)(i) and (ii) of the ADR Rules were satisfied, the Panel did not have to consider whether the disputed domain name was registered or used in bad faith.

Accordingly, the Panel ordered the transfer of the domain name <merci-pur.eu> to the Complainant.