Panel Decision for dispute CAC-ADREU-004398

Case number	**CAC-ADREU-004398**
Time of filing	**2007-04-19 10:37:41**
Domain names	**suzuki.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Suzuki International Europe GmbH, Meike Weber**

Respondent

Organization / Name	**Bint Praha, Jiri Chmelar**

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 any other legal proceedings pending or decided which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a subsidiary company of the Suzuki Motor Corporation and was registered in the German commercial register as a German limited liability company in 1976, under the name of Suzuki Motor GmbH Deutschland, later changing names to Suzuki International Europe GmbH.

In 1976, the Complainant began selling motorcycles and marine products in Germany. In 1980 the Complainant commenced the sale of Suzuki automobiles in Germany.

The Complainant and its parent organisation, the Suzuki Motor Corporation are the owners of a number of trademark registrations for the SUZUKI mark.

The Complainant is owner of German trademarks DE 10 067 30 SUZUKI (figurative) and DE 10 390 37 SUZUKI (figurative). The Complainant's parent company Suzuki Motor Corporation is the owner of, inter alia, Community trademarks CTM 201 566 SUZUKI; Community Trademark CTM 3 455 714 SUZUKI (figurative mark) and German trademarks DE 10 100 80 SUZUKI; DE 862795 SUZUKI (figurative). The Complainant has furnished excerpts from the online registers of the German Patent and Trademark Office and the Community Trademark Office (OHIM) as evidence of its rights in said registrations. The Complainant's parent corporation, Suzuki Motor Corporation is also owner of a number of Czech registered trademarks for the SUZUKI mark and marks incorporating the SUZUKI mark namely, Czech trademark registration no. 158539 SUZUKI (figurative mark), registered with priority of 27 September 1968, TEAM SUZUKI (figurative mark) registration nos. 223184 and TEAM SUZUKI (figurative mark)211072, registered with priority of 9 July 1998 and 3 February 1997.

The Complainant is authorised by power of attorney to represent its parent organisation, Suzuki Motor Corporation to protect and defend Suzuki Motor Corporation's trade names, trade marks and other intellectual property rights and has furnished this Panel with a copy of said Power of Attorney. The Power of Attorney includes the right to commence, prosecute and defend any proceedings whether judicial or extra-judicial that may arise in connection with the protection and enforcement of the trademarks as well as the right to register such intellectual property rights.

The Complainant is the owner of the domain name <suzuki.de> and has established a website at the <www.suzuki.de > address.

The Complainant applied for registration of the domain name <suzuki.eu> on 7 December 2005 during the Sunrise period. Due to

unfortunate misunderstandings in regard to the formalities requested for registration in the Sunrise period, the Complainant's application was denied.

According to the Complaint, the Respondent is part of a company named Bint Praha. The corresponding website www.bint.cz shows that the Respondent sells kitchens under the name of Bint Praha s.r.o. This was not denied by the Respondent.

The domain name <suzuki.eu> was registered by the Respondent at EURid on 5 December 2006. Since then the Respondent has not made any active use of the domain <suzuki.eu> to support any offer of goods or services, but has merely parked the domain name.

By letter dated 19 February 2007, the Complainant requested the Respondent to cease and desist from using the domain and to transfer it to Complainant. As of the date of filing the Amended Complaint herein, the Respondent had not responded to that letter.

A. COMPLAINANT

The Complainant submits that the Complainant and its parent organisation Suzuki Motor Corporation have rights in the above listed German and CTM registrations of the SUZUKI trademarks pursuant to Sec. 4 No. 1, 14 para. 1 German Trademark Act and the Community Trademark Regulation (CTMR).

The Complainant furthermore claims that the name SUZUKI is protected as a commercial designation in Germany, pursuant to Sec. 5 para. 1 and 2, 15 para. 1 German Trademark Act, which respectively state in translation:

Section 5: "(1) Company symbols … shall be protected as commercial designations.
(2) Company symbols are signs used in the course of trade as names, firm names or special designations of business establishments or enterprises."

Section. 15: "(1) The acquisition of protection for a commercial designation shall confer on its proprietor an exclusive right."

To qualify for such protection the German Trademark Act requires that the commercial designation has been used "in the course of trade" in Germany. As shown above, the Complainant has been active in the German market since the end of the 1970s and has been a registered German company since 1976, thus clearly fulfilling this condition.

The Complainant further submits that pursuant to the German Trademark Act, in particular the key words in a firm's "official" name are protected as a commercial designation. The Complainant is definitely known in the market under its name "Suzuki". The Complainant therefore has exclusive rights to the term "Suzuki" as its company name.

The Complainant states that it applied for registration of the domain name <suzuki.eu> on 7 December 2005 during the Sunrise period, however due to an unfortunate misunderstandings in regard to the formalities requested for registration in the Sunrise period, the Complainant's application was denied.

Addressing the grounds on which the Complaint is made the Complainant refers to Regulation (EC) 874/2004, Art. 21 and submits that the domain name <suzuki.eu> is identical to the Complainant's protected trademarks and company name SUZUKI..

The Respondent submits that the Respondent has no rights or legitimate interests in the domain name <suzuki.eu>. In particular the Complainant submits that the Respondent does not hold any rights on the disputed domain name according to paragraph B 11 (e) of the ADR Rules. The Complainant submits that the Respondent does not own any SUZUKI trademarks, services marks or trade names and is not commonly known by the name "suzuki".

The Complainant further submits that the Respondent does not own trademarks that are identical with the term "suzuki" nor does the Respondent hold any right on the disputed domain name. The Respondent has no connection whatsoever to the name "Suzuki".

The Respondent is engaged in the kitchen industry. There is also no indication why a Czech business man should have an interest in registering a Japanese name. The Complainant submits that it follows that the Respondent has no right or legitimate interest in the disputed domain name.

The Complainant submits that due to the extremely high profile of the Complainant and its parent company and the fact that the Respondent is not actively using the domain name, it must be assumed that the Respondent registered the domain name in bad faith.

Therefore, the Complainant submits, the domain name <suzuki.eu> is subject to revocation according to Art. 21.1 of Commission

Regulation (EC) No. 874/2004 and Sec. B 11 (d) (1) of the ADR Rules.

Addressing its application for transfer of the domain name and its entitlement to be registered as the owner of the domain name in dispute, the Complainant, submits that it is eligible for registration as set out in Paragraph 4 (2) (b) of Regulation 733/2002. The Complainant has its registered office and central administration in Bensheim, Germany.

In further submissions filed in accordance with Paragraph A2 (k) of the ADR Rules the Complainant submits that, contrary to the Respondent's remarks, the Complainant and its parent corporation, have exclusive prior rights to the mark SUZUKI as detailed above and for the first time provided information relating to the Complainant's parent corporation's ownership of the Czech trademarks listed above and asserts that the Complainant is fully authorized by its parent company to protect its Czech trademarks.

The Respondent's argument (below) that "Suzuki" is a common Japanese word and the Complainant therefore cannot assert its trademark rights, is implausible. This argument is beside the point and is strongly disputed by the Complainant. This strain of argument shows that the Respondent has neither understood the concept of prior trademark rights and protection thereof nor of this dispute resolution procedure.

Contrary to the Respondent's allegation (below), the Complainant was denied registration of the domain name during the Sunrise period solely due to unfortunate misunderstandings of the formalities required. By no means was this due to the reasons that the Respondent alleges.

The Respondent has no rights to the domain name and in particular, the Respondent has not gained any such rights on behalf of its registration on 5 December 2006 with the EURid, as it argues.

There is absolutely no legitimate reason why the Respondent, whose business is based in the Czech Republic, should need to use a Japanese term, which is identical to the Complainant's registered trademarks, for its products. In view of the fact that the trademark SUZUKI is very well-known worldwide, it is further strongly disputed that the Respondent had no knowledge of this fact and was planning a product line referring to a Japanese meaning as "ringing wood". This argument is obviously a mere defensive tactic of the Respondent. This is also underlined by the fact that the Respondent is not even using the domain, but has merely parked it. It is significant that the Respondent has not submitted any evidence at all of its allegedly planned use.

Even if the statement of the Respondent were to be true, before settling on the name SUZUKI, the Respondent could easily have researched and verified that it was infringing trademark rights of others by the use of this name. This especially applies due to the fact that the Complainant's parent corporation, Suzuki Motor Corporation, as shown above, is also owner of several Czech trademarks.

In its Response (below) the Respondent has not named or put forth any legitimate right or interest in the name SUZUKI and the domain name was registered in bad faith. Therefore, the domain name <suzuki.eu> is subject to revocation according to Art. 21 (1) of the Commission Regulation (EC) No. 874/2004 and Sec. B 11 (d) (1) of the ADR Rules.

B. RESPONDENT

In the Response, the Respondent submits that according to the register of trademarks of the Czech Patent and Trademark Office, there are many owners of trademarks with a similar analogy SUZUKI. As of the date of filing the Response the Respondent had not received any document which would prove the Complainant's exclusive right to use the name in question for the registration of the domain.

The domain name in dispute consists of a Japanese word which has several thousand meanings in Japanese and is one of the most common Japanese names. According to the information available to the Respondent, the Complainant attempted to register the domain name <suzuki.eu> during the "Sunrise Period." The Complainant's request for registration was refused, evidently on the basis that SUZUKI is a commonly used word for which it is not possible to have precedence for a domain on the basis of a right corresponding to the trade-mark.

The Respondent registered the domain name <suzuki.eu> on December 5, 2006 with EURID and is entitled to retain ownership of it. The Respondent's rights in the domain name cannot be withdrawn nor can the registration process of EURID to be changed.

The Respondent intends to use the domain name as the label for a set of products that relate to one of its meanings, which is "ringing wood". For this purpose, the Respondent has created a business project using this name and the name has been already communicated to its customers.

SUZUKI is a word of Japanese origin. It has a certain imitative value and evokes a colour in the Japanese language. The word is also "a

generally known Japanese accuracy." The Respondent decided to apply for this domain name for use in its corresponding project. The Respondent had no intention either to obstruct the rights of the Complainant or to mislead the Complainant's customers.

The domain name in dispute was released for public registration and the Respondent properly applied for the name. The Complainant apparently applied to register the domain based on their trademark in the so-called "Sunrise period", however this request was denied.

The Respondent refutes any accusation that it registered the domain in question for speculative or otherwise forbidden reasons.

The Respondent incurred considerable expenses in registering the domain name and in relation to the planning and execution of the above mentioned business project and last but not least, in relation to these proceedings. For the above reasons, the Respondent is the authorized owner of the <suzuki.eu> domain and refuses any interference into this right of theirs.

The Respondent also requests that communication be exclusively in the Czech language.

DISCUSSION AND FINDINGS

Paragraph 11(d) (1) of the.eu Alternative Dispute Resolution Rules (the "ADR Rules") impose on this Panel an obligation to issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated 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.

Paragraph 11(b) of the ADR Rules limits the remedies available pursuant to an ADR Proceeding where the Respondent is the Domain Name Holder in respect of which domain name the Complaint was initiated to the revocation of the disputed domain name or, if the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002, the transfer of the disputed
domain name(s) to the Complainant.

1. Identical or Confusingly Similar

The domain name <suzuki.eu> is identical to the Complainant's German registered trademark, CTM registration SUZUKI. Furthermore the domain name is confusingly similar to the Complainant's business name as it consists of the most significant element of the Complainant's corporate name.

The Complainant has therefore established the first element of the test set out in Paragraph 11 of the ADR Rules.

2. Respondent's Rights or Legitimate Interest in the Domain Name

By analogy to the jurisprudence developed in respect of provisions in paragraph 4(a)(ii) of the ICANN Uniform Domain Name Dispute Resolution Policy that are identical to the provisions in paragraph 11(d)(1)(ii) of the ADR Rules once a Complainants has made out a credible prima facie case that the Respondent has no rights or legitimate interest in respect of the domain name in dispute, the onus shifts to the Respondent to establish that it has such rights or interest.

In casu, the Complainant has submitted that the Respondent has not acquired any rights by means of activities coming within those listed at paragraph B 11(e) of the ADR Rules.

In the Response the Respondent relies on the fact that it succeeded in registering the domain name and has put forward an unsubstantiated claim that it intends to use the word SUZUKI as a trademark for timber products. The Respondent has not put the domain name to any active use since registration. While it claims to have expended monies on its project to sell furniture using SUZUKI as a trademark, it has not provided any evidence of its plans and relies on a mere assertion of its plan.

In the circumstances this Panel is satisfied on the balance of probabilities that the Respondent has no rights or legitimate interest in the domain name in dispute. The Complainant has therefore established the second element of the test set out in Paragraph 11 of the ADR Rules.

3. Bad Faith Registration or Use

Once the Complainant has established the first element of the test in paragraph 11 of the ADR Rules, it need only then prove either would be entitled to succeed if it can prove either the element described in paragraph 11 (d) (1)(ii) or (iii).

For completeness however this Panel will also address the issue of alleged bad faith registration and use of the domain name by the Respondent.

It is clear from the evidence that the Complainant has a significant reputation in the use of the trademark and corporate name SUZUKI in Germany and other jurisdictions. The Czech Republic is the next nearest neighbour of Germany. Furthermore the Respondent has demonstrated that it has a significant knowledge of Japan and the Japanese language. The Complainant's SUZUKI group of companies have a well established reputation in the motor-cycle and motor car industry within the EU. It is inconceivable that the Respondent was not aware of this reputation and goodwill when registering the domain name at issue.

The Respondent's reasons for registering the domain name viz. that it intends to launch a range of products using the trademark SUZUKI are not convincing and the Respondent has not provided any evidence whatsoever of its plans.

In the circumstances, on the balance of probabilities the Respondent registered the domain name in bad faith intending to use the domain name to take predatory advantage of the Complainant's well known trademark and goodwill in the knowledge that any use of the domain name would be likely to confuse and misdirect Internet users intending to access the Complainant's website to a site or online location established by the Respondent.

The Complainant has therefore established the third and final element of the test set out in Paragraph 11 of the ADR Rules.

Finally as the Complainant is a body corporate registered and having its seat in Germany it comes within the scope of paragraph 4 (2) (b) of Regulation 733/2002 and having succeeded in proving its case it is entitled to have the domain name transferred to it.

The Complainant is therefore entitled to succeed in its application.

DECISION

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

PANELISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2007-07-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is a subsidiary company of the Suzuki Motor Corporation and was registered in the German commercial register as a German limited liability company in 1976. The Complainant is owner of German trademarks DE 10 067 30 SUZUKI (figurative) and DE 10 390 37 SUZUKI (figurative). The Complainant's parent company Suzuki Motor Corporation is the owner of, inter alia, Community trademarks CTM 201 566 SUZUKI; Community Trademark CTM 3 455 714 SUZUKI (figurative mark) and German trademarks DE 10 100 80 SUZUKI; DE 862795 SUZUKI (figurative). The Complainant has furnished excerpts from the online registers of the German Patent and Trademark Office and the Community Trademark Office (OHIM) as evidence of its rights in said registrations. The Complainant's parent corporation, Suzuki Motor Corporation is also owner of a number of Czech registered trademarks for the SUZUKI mark and marks incorporating the SUZUKI mark namely, Czech trademark registration no. 158539 SUZUKI (figurative mark), registered with priority of 27 September 1968, TEAM SUZUKI (figurative mark) registration nos. 223184 and TEAM SUZUKI (figurative mark)211072, registered with priority of 9 July 1998 and 3 February 1997.

The Respondent is engaged in the business of selling kitchens under the name BINT PRAHA. The domain name <suzuki.eu> was registered by the Respondent at EURid on 5 December 2006. Since then the Respondent has not made any active use of the domain.

The Complainant requests that the domain name be transferred to the Complainant and argues that the domain name is identical to the trademark SUZUKI in which the Respondent has rights, that the Respondent has no rights or legitimate interest in the domain name and the domain name was registered and is being used in bad faith.

The Respondent challenged the Complainants rights to the trademark SUZUKI. The Respondent argues that the name SUZUKI is a popular Japanese name and has further argued that the Japanese word “suzuki” has many meanings including “ringing wood”. The Respondent chose the domain name <suzuki.eu> because of the reference to “ringing wood” and has plans to launch a product line of kitchens under that name.

The Panel decided that the domain name in dispute is identical to the Complainant’s trademark, that the Respondent’s claim to have a bona fide intent to use the trademark in relation to kitchens lacked credibility and that on the balance of the probabilities the domain name was registered by the Respondent in bad faith to take predatory advantage of the goodwill and reputation of the Complainant’s trademark in the knowledge that any use of the domain name by the Respondent would be likely to confuse and misdirect Internet users intending to access the Complainant’s website to a site or online location established by the Respondent.

In the circumstances the Panel decided that the Complainant should succeed in its application and directed that the domain name in dispute be transferred to the Complainant.