Panel Decision for dispute CAC-ADREU-004829

Case number	CAC-ADREU-004829
Time of filing	2007-12-07 13:40:10
Domain names	tobias-grau.eu, tobiasgrau.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Tobias Grau GmbH, Franziska Grau

Respondent

Organization / Name	Mandarin & Pacific Services Limited, Gerald Mwanyika

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 legal proceedings which are pending or decided and which relate to the disputed domain names.

FACTUAL BACKGROUND

Complainant is holder of the Community Trade Mark 2400523 "Tobias Grau" and of several domain names under different Top-Level-Domains most of them containing the elements “tobias” and “grau”: The trademark grants the Complainant protection in the classes

11 - Lighting apparatus and systems, lamps
20 - Furniture, mirros, picture frames, goods, inlcuded in class 20, of woord, cork, horn or of plastics
42 - Design services, furnishings consultancy and planing, in particular lighting planning.

A. COMPLAINANT

The Complainant asserts that the disputed domain names are identical to the Community Trade Mark “Tobias Grau” as the spelling is the same. Furthermore the Community Trade Mark at issue is the only trademark in existence containing the elements “tobias” and “grau” which is used in a large number of European countries. In addition the Respondent is not commonly known by the domain names. The Complainant contends that the domain names have also been registered in bad faith because the Respondent offers lamps under the domain name "tobias-grau" (Annex 1 attached to the Complaint) and because the domain name “tobisgrau” is not pointing to any website what has to be considered as a passive use.

B. RESPONDENT

The Respondent has not exercised its option to submit a formal response to the complaint.

DISCUSSION AND FINDINGS

Pursuant to Article 22 (1) of Regulation (EC) No. 874/2004, alternative dispute resolution may be sought by anybody if registration of a domain name is speculative and/or abusive within the meaning of Article 21 (EC) No. 874/2004. For a registration to be speculative and/or abusive within the meaning of Article 21 (EC) No. 874/2004 requires that

• the domain names are identical or confusingly similar to another name in respect of which rights are recognised or established by national and/or Community law,

and

• the domain names have been registered by a domain holder who cannot assert any rights or legitimate interest in the domain names,

or

•the domain names are registered or used in bad faith.

1. Domain names are identical or confusingly similar

The Complainant is the proprietor of trademark rights in respect of the “Tobias Grau” name. Aside from the top-level domain “(dot)eu”, the trademark is identical to the disputed “tobiasgrau” domain name. However, only the second-level domain is of relevance, because the top-level domain “(dot)eu” must be disregarded when comparing trademarks and domain names, due to its importance, acknowledged by the market, as an essential component of a domain name (see ADR Panel Decision No. 1693 – GASTROJOBS, ADR-Panel Decision No. 283 – LASTMINUTE). The trademark is also identical to the disputed “tobis-grau” domain name because it is set forth in Article 11 of Regulation (EC) No. 874/2004, that spaces contained in prior rights can either be eliminated or replaced with a hyphen in a domain name. Thus, the Complainant’s underlying trademark registration “Tobias Grau” can serve as a prior right for the domain name "tobias-grau".

For these reasons, the “tobis-grau” and the “tobisgrau” domain name and the trademark are identical within the meaning of Article 21 (1) of Regulation (EC) No. 874/2004.

2. Right to or legitimate interest in the domain names

Another requirement for a speculative and/or abusive registration within the meaning of Article 21 of Regulation (EC) No. 874/2004 is that the holder of the domain names can refer to having rights or legitimate interests of its own in the domain names.

2.1
The Complainant contents that the Respondent used the domain name “tobiasgrau” to offer lamps. But as the screenshot of the website shows (Annex 1 attached to the Complaint) the Respondent does not personally offers lamps. However the Respondent uses the domain name for a "direct navigation" business. “Direct navigation” is characterised in Wikipedia as

“a marketing term that describes the method individuals use to navigate the Internet in order to arrive at specific websites. Direct navigation is a new, loosely defined term which is generally understood to include type-in traffic and bookmarked traffic. This involves an internet user navigating to a website directly through the website address bar, bypassing any online search engines and navigating directly to the domain.

A 2005 study of internet traffic revealed that direct navigation traffic such as browser type-in traffic, bookmarks of existing sites and visits to existing, known website domain names converts into sales for advertisers at 4.23% of total visits compared to 2.3% for product and service related searches performed via the search box at search engines such as Google and Yahoo.”

Beyond doubt "direct navigation" with generic terms constitutes a legitimate service for the benefit of both the Internet user and those wishing to be listed on the resulting web pages associated with the generic terms, i.e. domain name. But the use of a trademark as a domain name for a "direct navigation" business can not establish a legitimate interest according to Article 21. 2 (c) of Regulation (EC) No. 874/2004, as it is commonly known that a "direct navigation" business offers the Respondent the opportunity to earn pay-per-click-revenues for redirecting Internet users not to the website of the holder of the trademark but to third parties’ websites. In effect the redirecting is an unacceptable infringement of the trademark of the Complainant and generates no right to or legitimate interest in the domain name “tobiasgrau”.

2.2
The Complainant contends that the Respondent has used neither the domain name “tobias-grau”, nor any name corresponding to this domain name in connection with the selling of goods or services, nor provably made any preparations to that effect, and that the domain holder is not a natural person that is generally known under the domain name.

As the panel discussed en detail in Decision No. 3444 – OCUNET (sub 2) generally Complainants bear the burden of proof regarding Respondent’s rights or legitimate interest (or rather the lack thereof). But since the domain name “tobias-grau” has not been used for a website by the Respondent, the Complainant is unable to state, never mind prove the “negative fact” of any unlawful and commercial or

unfair use of the domain name, for example. For the Complainant, it is therefore sufficient to state and prove important, clear and congruent facts that are not invalidated by counter-indices, and which render it predominantly likely that the domain holder und Respondent cannot refer to its having rights or legitimate interests of its own in the domain name, whereby it is not necessary to establish this beyond a doubt. In considering the Complainant's assertion that the domain holder has used neither the domain name nor any other name corresponding to the domain name, and that the Respondent does not operate a website under the domain name that has been checked by the Panel, and in consideration of the reduction in the standard of proof, the Complainant has therefore provided sufficient indices in the present procedure, in the view of the Panel, of its own rights, or that the Respondent does not have any legitimate interest of its own to the domain name.

3. In thorough consideration of the findings on the rights and legitimate interests explicitly set out above hereto the Panel decides that in the case at hand it is not necessary to proceed with any consideration upon the Complainant's claims in relation to bad faith in registration and/or use of the domain names.

DECISION

For all the foregoing reasons the Panel orders that

the domain name TOBIAS-GRAU, TOBIASGRAU be transferred to the Complainant.

PANELISTS

Name	**Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2008-02-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

"Direct navigation" with generic terms constitutes a legitimate service for the benefit of both the Internet user and those wishing to be listed on the resulting web pages associated with the generic terms, i.e. domain name. But the use of a trademark as a domain name for a "direct navigation" business can not establish a legitimate interest according to Article 21. 2 (c) of Regulation (EC) No. 874/2004, as it is commonly known that a "direct navigation" business offers the Respondent the opportunity to earn pay-per-click-revenues for redirecting Internet users not to the website of the holder of the trademark but to third parties' websites. In effect the redirecting is an unacceptable infringement of the trademark and generates no right to or legitimate interest in a domain name.