Panel Decision for dispute CAC-ADREU-005087

Case number	CAC-ADREU-005087
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Domain names	petrom.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	PETROM SA, Claudiu Petre

Respondent

Organization / Name	Kurt Janusch, Kurt Janusch

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 in relation to the disputed domain name <petrom.eu>.

FACTUAL BACKGROUND

The Complainant has requested transfer of the domain name <petrom.eu> to the Complainant by initiating ADR proceedings.

The Complainant, Petrom SA, a company incorporated in Romania, is the proprietor of registrations and applications for trademarks consisting of or containing the element PETROM. The said trademark registrations cover a relatively wide range of goods and services and are protected inter alia in Romania, Kazakhstan, Moldavia, Serbia and the European Union.

The Respondent, Kurt Janusch from Germany (according to the Whois data recorded for the domain name <petrom.eu>), is the proprietor of the Benelux trademark registration No. 795985 pet & rom, applied on 20 March 2006 and registered on 22 March 2006 for the services “Telecommunications” in Class 38 of the Nice Agreement.

The Respondent applied for the domain name <petrom.eu> on 22 March 2006 based on its aforesaid registered Benelux trademark pet & rom.

The Complaint was filed on 26 June 2006 and the Respondent failed to file a Response to the Complaint.

A. COMPLAINANT

The Complainant seeks a transfer of the disputed domain name <petrom.eu> (hereinafter referred to as the “Disputed Domain Name”) from the Respondent to the Complainant in accordance with Paragraph B 11 (b) the .eu Alternative Dispute Resolution Rules (hereinafter “the ADR Rules”).

The Complainant has made the following contentions:

The Complainant satisfies the general eligibility criteria for registration according to Paragraph 4 (2) (b) of Regulation (EC) No 733/2002.

The Complainant is the largest Romanian integrated oil and gas group, with activities in the business segments of Exploration and Production, Refining, Marketing, Natural Gas, Energy and Chemical Products. In 2007 the turnover of The Complainant was EUR 3.683 millions. Approximately 51% of The Complainant's shares are owned by OMV Austria, Austria's largest listed industrial company and the leading integrated oil and gas group in Central and Eastern Europe. The Complainant is the largest listed company at the Bucharest Stock Exchange.

The Complainant is the largest producer of oil and gas in South Eastern Europe and has estimated oil and gas reserves of 1 billion BOE. The Complainant is the only oil producer in Romania and supplies around half of the internal gas production. Domestic and international oil and gas production amounted to 72 million BOE in 2007. The total reserves were 894 million BOE (at the end of 2007). The company operates approximately 15.000 onshore oil & gas wells and 7 offshore production platforms in the Black Sea. The Complainant together with its affiliates is running Exploration & Production operations in 3 areas in Kazakhstan. The Complainant also acquired its first exploration and production licenses in Russia in 2006.

Furthermore, according to the Complainant, it is the leader of the Romanian retail market for petroleum products, with a network of about 550 filling stations in Romania. The Complainant also operates an international network of around 257 filling stations in Bulgaria, Serbia and the Republic of Moldova. On the wholesale market, The Complainant is a major business partner for companies and institutions acting in economy sectors such as Transportation, Industry, Construction and Mining, Agriculture or Public and Civil Authorities. Through its network of regional storage facilities or directly from the two refineries, the Complainant delivers petroleum products to more than 5.500 business customers. With its two refineries the Complainant is the largest refining operator in Romania.

According to the Complainant it has duly shown that through its strong presence in everyday life the Complainant and its trademark PETROM are well known to the public at large in many countries, inter alia in Romania.

In order to evidence the contentions it has made, the Complainant submits an Affidavit signed by Marina Gheorghe, Chief Executive Officer of the Complainant, and Dan Costinescu, Legal Department of The Complainant together with copies of several newspaper articles and website news article print-outs as Annexes attached to the Complaint. The Complainant further refers to the information on the Complainant which can be found on the Complainant's main website www.petrom.com.

The Complainant argues that the Disputed Domain Name is identical with or confusingly similar to trademarks in which the complainant has rights, and supports its aforesaid argument as follows:

- The Complainant is the proprietor of multiple registrations and applications of trademarks consisting of or containing the sign PETROM. These various trademark registrations cover a relatively wide range of goods and services and are protected inter alia in Romania, Kazakhstan, Moldavia, Serbia and the European Union. As examples, The Complainant submits copies of the registration database extracts for the following registrations: Romanian national trademark registration No. 050438 PETROM & device with the priority date 21 April 1998, International Registration No. 735763 PETROM & device with the priority date 6 March 2000 with protection in Kazakhstan, Moldavia and Serbia and Community Trademark reg. No. 4697835 PETROM MEMBER OF OMV GROUP & device with the priority date 21 October 2005.

- According to the Complainant, it has traded under the name PETROM in Romania since 1991 and internationally since 1998. The Complainant operates its principal website at www.petrom.com. The site contains information on The Complainant's activities and background. The Complainant and its subsidiaries are also the registrants of several ccTLD domain names, for example for Romania under the domain name <petrom.ro>.

- The Complainant contents that the distinctive part of the Disputed Domain Name PETROM is identical to the Complainant's well known trademark PETROM. Numerous Panel decisions have stated that a top-level domain, in this case the element ".eu", is to be ignored when assessing identity or confusing similarity of a mark and a domain name. Furthermore, likelihood of confusion is evident. Consumers worldwide will think that there is an economic relationship with, sponsorship or endorsement of Respondent with the Complainant, since they would see the Disputed Domain Name as a variation of the Complainant's mark PETROM. The consumers will think that the offers at Respondent's website are provided and/or authorized by the Complainant.

The Complainant further argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and supports its aforesaid argument as follows:

- The Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or any variations thereof, or to register or use any domain name incorporating any of those marks or any variations thereof.

- The mark PETROM is purely fanciful and has no descriptive meaning. Therefore, no-one would legitimately choose this word or any variation thereof, unless seeking to create an association to The Complainant. In this respect, it is according to the Complainant obvious that Respondent seeks to create the false and misleading impression that he acts in affiliation with The Complainant.

- The Respondent has registered the Disputed Domain Name to create the misleading impression of being in some way associated with

The Complainant. The Respondent is trying to exploit the fame and reputation of The Complainant's trademarks and intended to gain profits by offering the Disputed Domain Name for sale.

- Given the fame and reputation of the Complainant's trademark PETROM and also the activities of the Complainant in many countries of the world, it is inconceivable that the Respondent had been unaware of the Complainant before registering the disputed domain name. It therefore can be excluded that the Respondent created a fantasy name, which corresponds to the Complainant's famous trademark PETROM.

- Furthermore, none of the circumstances listed under Paragraph B 11 (e) of the ADR Rules, possibly demonstrating rights or legitimate interests, are present according to the Complainant. The Respondent has not used the Disputed Domain Name with a bona fide offering of goods or services, and the Respondent has not been commonly known by the Disputed Domain Name or made any legitimate and non-commercial or fair use of the Disputed Domain Name. The website under the Disputed Domain Name pretends to be an online pet shop. Pictures of different pets and accessories are shown. However, no contact information is available, and it is not possible to place an order so that it can be assumed that the Respondent does not actually intend to operate an online pet shop. The website appears to be just set up to pretend in fact non-existing legitimate interests. Such "mock up" website is not adequate evidence to show that the Respondent has used or made demonstrable preparations to use the domain name in connection with a bona fide offering of goods and services.

- The Respondent has not been commonly known by the Disputed Domain Name but rather intends to have a free ride on the fame and good will of The Complainant's trademarks and profit from sale or consumer confusion as to an economic relationship of Respondent with The Complainant.

- The Complainant submits that it is aware of that the Respondent filed an application for the Benelux trademark reg. no. 1107088 pet & rom on 20 March 2006. The trademark was registered on 22 March 2006 and on the same day the Respondent applied for the Disputed Domain Name based on his Benelux trademark rights. According to several ADR Panel decisions, the registration of Benelux trademarks via the expedite procedure for the mere registration of a .eu domain does not grant the registrant a legitimate interest in the corresponding domain name. Furthermore, the Respondent's trademark registration covers completely different goods than the ones the Respondent now pretends to use the domain name for. As regards the trademark pet & rom of the Respondent, it has been a common practice to apply for trademark registrations including the special character "&" to obtain trademark rights in otherwise non-registrable signs as basis for a privileged registration of a .eu-domain, as such characters can be omitted according to Article 11 of Commission Regulation (EC) No 874/2004. This has caused multiple trademark registrations, especially for famous trademarks and generic terms, which allowed the owner to unlawfully register the respective .eu-domain name.

The Complainant further argues that the Respondent has registered the Disputed Domain Name in bad faith, and supports its aforesaid argument as follows:

- The trademark PETROM is a famous trademark not only in Romania but in many other countries and it is inconceivable that the Respondent would not have been aware of this fact. It is apparent that the intent of the Respondent is to exploit the reputation of The Complainant's mark and his activities.

- According to the Complainant, the Respondent's obvious intent is to misleadingly divert the consumers looking for the Complainant as a famous EU company on the internet to the Respondent's website, causing confusion among consumers in the way of creating the impression of economic relation with or sponsorship or endorsement of the Respondent by the Complainant for commercial gain. Respondent seeks to create the impression of being affiliated with the Complainant, which is not the case.

- Considering that the disputed domain name has been offered for sale under the Disputed Domain Name at www.petrom.eu, it can be assumed that the Respondent intended to gain profits for transferring the domain name to the Complainant at some point or provide an obstacle to the Complainant to use the domain name.

- Furthermore, several .eu ADR proceedings against the Respondent Mr Kurt Janusch have been conducted so far, which have similar factual circumstances. The Respondent has been responsible for registering a large number of .eu domain names. Links to several of these domain names could be found on parking websites of the Respondent, which underlines that the Respondent only registered the domain names in order to attract internet users and to profit from their visits on his websites, which constitutes evidence of bad faith.

- The Respondent has registered several Benelux trademarks, all including famous brands or generic terms, especially in connection with the special character "&". In another ADR decision the Panel stated that the Respondent offered almost 3000 domains for sale via afternic.com. Furthermore, Respondent has already been involved in several ADR proceedings. According to the Complainant this

supports the first impression that it is a common practice of the Respondent to register domain names incorporating famous trademarks.

- Furthermore, the Respondent's website under the Disputed Domain Name is just set up to pretend in fact non-existing legitimate interests. According to the Complainant such "mock up" website is not adequate evidence to show that the Respondent has used or made demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods and services and underlines the dishonest motives of the Respondent.

The Complainant has supported its arguments with a relatively extensive evidence material, including Affidavits, website prints, copies of newspaper articles, copies of registration database print-outs evidencing trademark registrations owned by the Complainant as well as the Benelux registration owned by the Respondent, several print-outs from the Respondent's website under the Disputed Domain Name, as well as copies of several previous ADR decisions.

B. RESPONDENT

The Respondent has been notified on the ADR proceedings, but has failed to file a Response to the Complaint.

DISCUSSION AND FINDINGS

First of all, the Panel notes that the Respondent is in default in the meaning of Paragraph B 10 (a) and (b) of the ADR Rules, which state that the Panel may consider the failure by the Respondent to comply with the time limits for filing a Response as grounds to accept the claims of the Complainant, and that the Panel shall draw such inferences from the default as it considers appropriate.

According to Articles 21 (1) and 22 (11) of the Commission Regulation (EC) No 874/2004 and Paragraph B 11 (d) (1) of the ADR Rules the Complainant bears the burden of proof in proving the following:
(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.

The first requirement is that 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. The Panel finds as follows:

- The Disputed Domain Name is <petrom.eu>. The Complainant is the holder of several trademark registrations for marks, which comprise the element PETROM. The Complainant has submitted proof of the following registrations: (1) Romanian national trademark registration No. 050438 PETROM & device with the priority date 21 April 1998, (2) International registration No. 735763 PETROM & device with the priority date 6 March 2000 accepted for registration in Kazakhstan, Moldavia and Serbia and (3) Community Trademark registration No. 4697835 PETROM MEMBER OF OMV GROUP & device with the priority date 21 October 2005. The most dominant and distinctive elements in the marks are the figurative element (with stylized letter "P" and a wolf figure inside it) together with the word element "PETROM".

- Since it is impossible to include figurative elements to the domain names, the Panel finds that the Disputed Domain Name is identical to such most distinctive and dominant elements included in the trademarks, to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law, which can be included in a domain name. Further, the Panel finds that the Disputed Domain Name is at least confusingly similar to the trademarks to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law, considering the trademarks owned by the Complainant and the elements included in the said trademarks in their entirety.

- Based on the foregoing, the Panel concludes that it finds that the requirements under Paragraph B 11 (d) (1) (i) of the ADR Rules are met.

The second (alternative) requirement is that the domain name has been registered by the Respondent without rights or legitimate interest in the name. The Panel finds as follows:

- The Respondent is the owner of the Benelux Trademark registration No. 795985 pet & rom. It is set forth in Article 11 of Commission Regulation (EC) 874/2003, that special characters such as "&" can be eliminated entirely or replaced with hyphens or, if possible, rewritten. Thus, the Panel finds that the Respondent's underlying trademark registration pet & rom can serve as a prior right for the Disputed Domain Name and the Respondent has not registered the domain name entirely without any right or legitimate interest in the

name.

- Notwithstanding the above, the Panel notes that although the Respondent's underlying trademark registration has been applied for and has been registered for "Telecommunications" under class 38 of the Nice Agreement, and the said registration confers exclusive rights for telecommunications services, the Respondent is not using the corresponding trademark pet & rom or the Disputed Domain Name in connection with bona fide offering of telecommunications services.

- Since all domain names are used in relation to internet, the fact that the Respondent has used and/or is using the Disputed Domain Name within its internet related business cannot alone and result in a finding that the domain name is or was used for telecommunications services. Further, the Panel notes that the mark in the form it is registered in the Benelux register, "pet & rom", is not in use on the websites under the Disputed Domain Name, and according to the evidence provided by the Complainant has not been in use in its registered form on the said websites. The Panel considers that the aforesaid facts give a clear indication on that the Respondent may well have registered its Benelux trademark pet & rom solely in order to obtain a basis for the corresponding .eu domain name registration, and not because the Respondent had a genuine right or legitimate interest in the name.

- The Complainant has argued that the Respondent has not used the Disputed Domain Name with a bona fide offering of goods and services, and the Respondent has not been commonly known by the domain name or made any legitimate and non-commercial or fair use. Further, the Complainant states that it has not licensed or otherwise permitted Respondent to use any of its trademarks or any variations thereof, or to register or use any domain name incorporating any of those marks or any variations thereof.

- According to the Complainant the mark PETROM is purely fanciful and has no descriptive meaning. Therefore, the Complainant has argued that no one would legitimately choose this word or any variation thereof, unless seeking to create an association to The Complainant.

- The Complainant has further argued that website under the Disputed Domain Name is only made to look like an online pet shop, but the site does not function in a way that it would be possible to purchase or order goods from the shop. The Complainant argues that the website now shown under the Disputed Domain Name is not adequate evidence to show that the Respondent has used or made demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods and services.

- The Respondent did not submit any, timely or late, Response to the Complaint. The Respondent has been duly given a proper chance to provide argumentation and evidence on having rights or legitimate interest in the Disputed Domain Name, but the Respondent has not made any submissions in this respect. The Respondent has thus failed to present any evidence of rights or legitimate interest in the Disputed Domain Name, although it was duly given a chance to do so.

- As the Complainant has made a fair effort to establish a prima facie lack of rights or legitimate interest in the disputed domain name on the part of the Respondent, and the Respondent has failed to rebut the Complainant's claims as well as failed to present any evidence of its rights or legitimate interest in the Disputed Domain Name, the Panel must come into conclusion that the Respondent has registered the disputed domain name without rights or legitimate interest in the name.

- Based on the foregoing, the Panel concludes that it finds that the requirements under Paragraph B 11 (d) (1) (ii) of the ADR Rules are met.

The third (alternative) requirement is that the domain name has been registered or is being used in bad faith. The Panel finds as follows:

- The intention beneath the Commission Regulations (EC) 733/2002 and (EC) 874/2004, as is apparent from the recitals of the said regulations, has been to allow holders of legitimate and genuine prior rights to register domain names, which correspond to their proprietary rights. The intention has not been to allow for speculative and abusive domain name registrations based on such trademark rights, which are not based on genuine and bona fide need for an exclusive right, but instead to prevent any such speculative and abusive registrations.

- The Respondent has registered the trademark pet & rom for telecommunication services but, according to the information that has been brought to the Panel's attention by the Complainant, is not using the corresponding trademark pet & rom or the Disputed Domain Name in any genuine bona fide offering of such services, and there is no evidence of the Respondent's intention to do so. Further, the Respondent having not submitted a Response to the Complaint, has failed to bring evidence in favor of its bona fide use to the Panel's knowledge.

- The Complainant further claims that the Respondent is trying to exploit the fame and reputation of the Complainant's trademarks, and

intended to gain profits by offering the Disputed Domain Name for sale. The Complainant has provided evidence on that the disputed domain name has been offered for sale under the Disputed Domain Name on the website www.petrom.eu by submitting a print-out dated 7 February 2008 from the website under the Disputed Domain Name. The print-out shows that the website under the Disputed Domain Name was at that time a parking site with sponsored links on it.

- The Panel finds that the fact that the Respondent has used the website under the Disputed Domain Name as a parking site with sponsored links which most likely are pay per click links, as well as the fact that that website under the Disputed Domain Name contained a clear sales offer on the Disputed Domain Name, are clear indications on that the Disputed Domain Name has been registered by the Respondent in order to gain profits and possibly also in order to sell the Disputed Domain Name.

- The Complainant has provided evidence on the fame and reputation of the Complainant's trademark PETROM. Although the Panel considers that the evidence provided is not sufficient for the Panel to decide whether the mark is in fact reputable or well known in any jurisdiction, the Panel finds that based on the evidence the use of the mark is rather extensive and visible, especially as the mark corresponds to the firm dominant of its holder company, it is not very likely that the Respondent had been unaware of the Complainant and its rights before registering the Disputed Domain Name.

- Furthermore, according to the evidence the Complainant has submitted and in accordance with the Panel's own investigations, there are several .eu ADR proceedings conducted against the Respondent so far, and most of them have very similar factual circumstances as regards the ownership of genuine rights to the trademarks which correspond with the domain names registered by the Respondent.

- The Panel finds that the aforesaid conduct by the Respondent indicates that it has also previously been engaged in the conduct of registering domain names which correspond to lawfully recognized rights owned by third parties.

- Based on the foregoing, the Panel considers that the Complainant has established a prima facie evidence of the Respondent's bad faith and the Respondent has failed to deny or contest the Complainant's claims as well as failed to present any evidence to the contrary.

- The Panel therefore concludes that the Respondent has registered the domain name in bad faith and that the requirements under Paragraph B 11 (d) (1) (iii) of the ADR Rules are met.

DECISION

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

PANELISTS

Name	Sanna af Ursin

DATE OF PANEL DECISION 2008-10-09

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant has requested transfer of the Disputed Domain Name to the Complainant by initiating ADR proceedings.

The Complainant, a Romanian integrated oil and gas group company, is the holder of several trademark registrations for marks, which comprise the element PETROM. The Complainant has submitted proof of the following registrations: (1) Romanian national trademark registration No. 050438 PETROM & device with the priority date 21 April 1998, (2) International registration No. 735763 PETROM & device with the priority date 6 March 2000 accepted for registration in Kazakhstan, Moldavia and Serbia and (3) Community Trademark reg. No. 4697835 PETROM MEMBER OF OMV GROUP & device with the priority date 21 October 2005. The most dominant and distinctive elements in the marks are the figurative element (with stylized letter "P" and a wolf figure inside it) together with the word element "PETROM".

The Respondent, Kurt Janusch from Germany (according to the Whois data recorded for the domain name <petrom.eu>), is the proprietor of the Benelux trademark registration No. 795985 pet & rom, registered for the services "Telecommunications".

The Panel made, inter alia, the following discussions and findings:

Since it is impossible to include figurative elements to the domain names, the Panel finds that the Disputed Domain Name is identical to

such most distinctive and dominant elements included in the trademarks to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law, which elements can be included in a domain name. Further, the Panel finds that the Disputed Domain Name is at least confusingly similar to the trademarks to which the Complainant holds rights to and which right is recognized by the national law of a Member State and Community law, considering the trademarks owned by the Complainant and the elements included in the said trademarks in their entirety. Based on the foregoing, the Panel concludes that it finds that the requirements under Paragraph B 11 (d) (1) (i) of the ADR Rules are met.

The Respondent has registered the trademark pet & rom for telecommunication services but, according to the information that has been brought to the Panel's attention by the Complainant, is not using the corresponding trademark pet & rom or the Disputed Domain Name in any bona fide offering of such services, and there is no evidence of the Respondent's intention to do so. Further, the Respondent having failed to submit a Response to the Complaint, has not brought any evidence in favor of its bona fide use, genuine right or legitimate interest to the Disputed Domain Name to the Panel's knowledge.

The Complainant has made a fair effort to establish a prima facie lack of rights or legitimate interest in the disputed domain name on the part of the Respondent, and the Respondent has failed to rebut the Complainant's claims as well as failed to present any evidence of its rights or legitimate interest in the disputed domain name, the Panel must come into conclusion that the Respondent has registered the disputed domain name without rights or legitimate interest in the name. Based on the foregoing, the Panel concludes that it finds that the requirements under Paragraph B 11 (d) (1) (ii) of the ADR Rules are met.

The Panel finds that the fact that the Respondent has used the website under the Disputed Domain Name as a parking site with sponsored links, most likely pay per click links, as well as the fact that that website under the Disputed Domain Name contained a clear sales offer on the Disputed Domain Name, are clear indications on that the Disputed Domain Name has been registered by the Respondent in order to gain profits and possibly also in order to sell the Disputed Domain Name.

Although the Panel considers that the evidence provided by the Complainant on the reputation and well known nature of its trademark PETROM is not sufficient for the Panel to decide whether the mark is reputable or well known in any jurisdiction, the Panel finds that based on the evidence the use of the mark is rather extensive and visible, especially as the mark corresponds to the firm dominant of its holder company, it is not very likely that the Respondent had been unaware of the Complainant and its rights before registering the Disputed Domain Name.

Several .eu ADR proceedings against the Respondent have been conducted so far and the Panel finds that the Respondent has been engaged in the conduct of registering domain names which correspond to lawfully recognized rights owned by third parties.

Based on the foregoing, the Panel considers that the Complainant has established a prima facie evidence of the Respondent's bad faith and the Respondent has failed to deny or contest the Complainant's claims as well as failed to present any evidence to the contrary. The Panel therefore concludes that the Respondent has registered the domain name in bad faith and that the requirements under Paragraph B 11 (d) (1) (iii) of the ADR Rules are met.

For all the foregoing reasons, the Panel orders the Disputed Domain Name <petrom.eu> to be transferred to the Complainant.