Panel Decision for dispute CAC-ADREU-005969

Case number	**CAC-ADREU-005969**
Time of filing	**2011-03-29 10:52:39**
Domain names	**ngm.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**NGM ITALIA srl, Stefano Nesi**

Respondent

Organization / Name	**David Fishman**

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 Panelist is not aware of any other legal proceedings, pending or decided, which would be related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, NGM Italia srl, is an Italian company selling mobile phones under the brand "NGM". The Complainant's existing internet site is www.ngm-mobile.com. The Complainant is the holder of: (1) "NGM", Italian registered trademark No. 0001245829, with application date 28 December 2007, and registration date 12 February 2010; and (2) "NGM", Community Trademark No. 006987895, with application date 13 June 2008, priority date 28 December 2007 and registration date 3 March 2009.

The Respondent, Mr. David Fishman, registered the domain name NGM.EU on 10 January 2008.

The Complainant filed the Complaint seeking the transfer of the domain name to itself by arguing that (1) the Complainant has earlier rights (the company name and trademarks), (2) the respondent has no rights or legitimate interest in the domain name NGM.EU, and (3) the respondent registered the domain name in bad faith.

In his response, the Respondent denied all Complainant's assertions and explained that although his internet site www.ngm.eu has not been working properly, he intended to use this domain name in a legitimate way.

A. COMPLAINANT

The Complainant's name is NGM Italia srl and its business is selling mobile phones. The Complainant asserts that a company name is protected under Italian laws, namely, a company name, if already known, may be an obstacle to registration of a subsequent trademark.

The Complainant also maintains to be a holder of several trademarks protecting its brand "NGM", which stands for "New Generation Mobile", namely:
(1) "NGM", Italian registered trademark No. 0001245829, with application date of 28 December 2007, and registration date of 12 February 2010;
(2) "new generation mobile", Italian registered trademark No. 0001245830, with application date of 28 December 2007, and registration date of 12 February 2010;
(3) "NGM il cellulare che gestisce due sim contemporaneamente" (meaning "NGM the cellular phone that operates two sims at the same time"), Italian trademark No. 0001373588, with application date of 5 June 2009, and registration date of 17 November 2010;
(4) "NGM", Community trademark No. 006987895, with application date of 13 June 2008, and registration date of 3 March 2009.

To prove the existence of the cited Italian trademarks, the Complainant submits printouts from internet trademark database of the Italian

Patent and Trademark Office, and for the cited Community trademark, a printout from the internet database of Community trademarks.

The Complainant states that its brand "NGM" is very famous in Italy and, to prove that, provides the following evidence: (1) a printout of Italian Google search result for "ngm", (2) a printout of the internet site www.ngm-mobile.com, belonging to the Complainant, and (3) survey results featuring sales figures for mobile phones in Italy in 2009 and 2010.The evidence shows that if a word ngm is searched through Italian Google, the first three non-sponsored hits are links to the internet site www.ngm-mobile.com, which belong to the Complainant. The printout of the Complainant's internet site shows various types of mobile phones sold by the Complainant. The survey results show that the Complainant's market share in Italy of dual-sim phones was 51.8% in 2009, and 67.7% in 2010. The Complainant's exact market share in the open Italian market in 2009 cannot be determined from the results, because there is no figure in the presentation, but it could be seen that it is about 1% or 2%; whereas in 2010 the Complainant share of that market was 3.7%.

The Complainant claims that the Respondent has no rights or legitimate interest in the name "NGM", because no demonstrable use of that name by the Respondent could be found. The Complainant maintains that when searching in Google for westhoffen@gmail.com, which is the only available contact information of the holder, no internet site having any connection with NGM could be found. The Complainant submits a printout of a list of the Google search results for westhoffen@gmail.com, and no reference to NGM could be found on the list.

The Complainant further claims that the Respondent has registered and used the domain name NGM.EU in bad faith, because (1) the domain name has not been used in any relevant way for at least two years, (2) the domain name was used to attract internet users to another commercial web site www.emrconsult.com, and (3) if searching in Google for www.ngm.eu, the search being limited to pages in Italian language, the search engine suggests that you are perhaps looking for www.ngm.com, and the first hit in the proposed search is www.ngm-mobile.com, which is the internet site belonging to the Complainant.

The Complainant seeks the transfer of the domain name NGM.EU to the Complainant.

B. RESPONDENT

The Respondent, Mr. David Fishman, asks the Complaint to be dismissed by arguing that he has acquired the domain name NGM.EU in relation to the CDD.eu hobby webpage project. He and his three family members were excited about the new .EU space and the potential audience they might get with their websites, and they created websites with original content.

The Respondent asserts that the domain name NGM.EU was acquired about three years before February 2010 when the Complainant trademarks NGM were registered. The Respondent set up an automatic script for www.ngm.eu, such as the one used for the site www.alcool.eu (meaning alcohol in French), but it did not work properly, because the Respondent and his family members own and have published content on numerous .eu domains, and this particular one slipped their attention. However, the Respondent explains, he intended to use the domain name within two year period (as he used the domain name ALCOOL.EU). After the Complaint was filed, the Respondent explains, he has partially updated the internet site www.ngm.eu, namely the script was set to run, but the internet site still does not working properly. The Respondent continues that he is not well experienced in web creation; he works more with ideas. He and his family members enjoyed the learning process of how to build internet sites (manually, and later with scripts) about various topics of personal interest, like traveling and medicine. The Respondent submits printouts of the internet sites (Amiens, Diabetes-Center, Lviv, MSM, NQ, OSC, Padua, Roots, SCD, Svoboda, and THC) showing examples of use of his other .EU domain names, all used in a non-commercial way, and asserts that these are not any 'parking sites'.

Regarding Complainant’s assertion that the domain NGM.EU may cause confusion with Complainant's rights or use of the brand NGM, the Respondent replies that anyone simple enough to experience confusion in this particular case, would probably not be able to understand how to use a mobile phone. The Respondent continues that the Complainant is a new entity, present on the Internet under a different domain name (NGM-MOBILE.COM), and if "NGM" is known for any brand, it would have to be for the National Geographic Magazine, and not for the Complainant or its brand. The Respondent is wondering why did the Complainant choose such name in the first place, thereby risking the confusion with the National Geographic Magazine. In the Respondent's view, the domain name NGM.IT, used by a third party, is confusingly similar to the Complainant’s site www.ngm-mobile.com. The Respondent believes that the Complainant would like to have a better domain name than the relatively lengthy NGM-MOBILE.COM, and is using this ADR proceeding in an abusive way to acquire the domain name NGM.EU.

Regarding the Complainant's assertion that when searching for NGM.EU in Google, the search engine suggests to search for NGM.COM, the Respondents points out that (1) he has no influence on search engine algorithms, (2) www.ngm.com is the internet site of the National Geographic Magazine, and not of the Complainant, and (3) the Complainant's site www.ngm-mobile.com is listed as the first result in the Italian version of Google search engine (www.google.it), but not in the French version (www.google.fr).

The Respondent addressed the Complainant's assertions regarding the internet site www.emrconsultant.com by explaining that the internet site www.ngm.eu does not "redirect" the user to www.emrconsultant.com, but at bottom of the site www.ngm.eu it was merely stated "COPYRIGHT by emrconsultant.com". The internet site www.emrconsultant.com is a family business that helped the Respondent to set up the scripts (which did not work) on some of the automated pages. The Respondent further explains that no registration or payment is necessary to access www.emrconsultant.com; merely submitting a completed form is required.

The Respondent concludes that the Complaint was filed in bad faith, because it comprises factual errors which are likely to have been made with the intent to deceive. The Respondent believes that he has sufficiently showed his intent to use the domain name NGM.EU in a legitimate way.

DISCUSSION AND FINDINGS

Paragraph B11 (d) (1) of the .eu Alternative Dispute Resolution Rules (hereinafter "ADR Rules"), implementing Article 21(1) of Regulation 874/2004 states the following:

The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves:
(1) 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.

I have examined the statements and evidence submitted by the Complainant and the Respondent; as provided for in Paragraph B7 (a) of the ADR Rules, I have also done my own on line investigation, as will be explained in detail below, and have reached the following conclusions.

COMPLAINANT'S EARLIER TRADEMARK RIGHTS

I have established that the dominant and distinctive part of the Complainant's company name (NGM Italia srl) indeed is NGM and that the Complainant is using "NGM" as a brand name for selling mobile phones at least in Italy. To promote its business the Complainant is using the existing internet site www.ngm-mobile.com.

From the submitted evidence, it is evident that the Complainant is the holder of various Italian and Community trademarks. However, given the respective domain name NGM.EU, the most relevant trademarks in this particular case are:
(1) "NGM", Italian registered trademark No. 0001245829, with application date of 28 December 2007, and registration date of 12 February 2010, which covers, among others, apparatus for transmission sound and images in class 9 of the Nice Classification system, and telecommunications in class 42; and
(2) "NGM", Community Trademark No. 006987895, with application date of 13 June 2008, priority date of 28 December 2007 and registration date of 3 March 2009, which covers, among others, telephones, mobile telephones in class 9, and telecommunications, in particular rental of communications apparatus, instruments and infrastructure, including mobile radio devices and mobile telephones; mobile and fixed telecommunications services; telephone services, mobile telephone services in class 42.

The above mentioned relevant trademarks "NGM" are valid and registered, they belong to the Complainant, both consist merely of the word "NGM", so I have reached an obvious conclusion that the respective domain name NGM.EU is identical to the Complainant's earlier registered trademarks, except for extension .EU, which is not relevant for this analysis. In the light of that, I found it unnecessary to take into consideration possible legal protection of the Complainant's company name (NGM Italia srl) or other two trademarks, cited by the Complainant, namely (1) "new generation mobile", Italian registered trademark No. 0001245830 and (2) "NGM il cellulare che gestisce due sim contemporaneamente" (meaning "NGM the cellular phone that operates two sims at the same time"), Italian trademark No. 0001373588.

Regarding the Respondent's argument that the Complainant's trademarks were registered after the respective domain name was registered, I must stress that once a trademark is registered, it is valid and enjoys protection from the application date, or, if applicable, from the priority date. The respective domain name was registered on 10 January 2008, whereas the above mentioned Italian trademark NGM No. 0001245829 has the application date of 28 December 2007, and the Community trademark has the priority date of 28 December 2007. Therefore, both trademarks must be regarded as earlier rights in relation to the respective domain name.

Although the Respondent explained that NGM stands for "New Generation Mobile", the word NGM itself is not a generic or descriptive term, so it enjoys full trademark protection.

COMPLAINANT'S RIGHTS OR LEGITIMATE INTEREST

The next question I addressed was whether the Respondent has any rights or legitimate interest in the name "NGM" or domain name NGM.EU.

The Respondent submitted no evidence, nor did he claim, that he had any rights in the name NGM.

Article 21 (2) of the Regulation 874/2004 defines that a legitimate interest may be demonstrated where:
(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;
(c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

The Respondent asserted that he had a legitimate interest in the name NGM.EU, because he had an intention to use this domain name in relation to the CDD.eu hobby webpage project. However, by stating that the internet site www.ngm.eu did not work properly, the Respondent actually acknowledged the Complainant's statement that, since its registration, this domain name has not been used in any meaningful way. The Respondent's explanation, that he did not notice the failure of the internet site www.ngm.eu to work properly, because he had numerous other internet sites to take care of, only reaffirms the Complainant's assertion about the lack of any serious use. Namely, if the Respondent himself failed to notice that his own internet site does not work properly, it is obvious that the Respondent made no serious efforts to actually use this domain name by creating a functioning internet site.

It is also important that the Respondent failed to submit any evidence or even to explain in his response why he sought the registration of the domain name with this particular string of characters NGM(.EU), in other words, what does this word mean to him, what is his interest in it, or why he chose this particular domain name.

The evidence, allegedly showing the Respondent's use of other domain names .EU, is irrelevant for establishing whether the Respondent has a legitimate interest in the domain name NGM.EU.

To verify the credibility of the Respondent's assertions regarding his motives for registration of the domain name NGM.EU, I have made, on my own initiative, an investigation of other possible ADR procedures against the Respondent. I have discovered that the Respondent had also registered the domain name STAEDLER.EU, which was eventually transferred to J.S. Staedtler GmbH & Co. KG, the holder of a well known trademark STAEDLER, as a result of the ADR procedure. In that case, the Respondent also failed to use the domain name and alleged that he registered it because his hobbies include genealogy and for the internet site dedicated to genealogy he was seeking to register a distinguished sounding Germanic name, i.e. STEADLER. It appears to me that there is a pattern in the Respondent's activities related to registration of the domain names, namely registering domain names that could be potentially interesting for other companies, not using them in any meaningful way, and in ADR procedure explaining his motives for registering the domain names by stating some vague hobbies which do not have any clear relation to the domain name in question. Therefore, the respondent's assertions about his honest intent to use the domain name NGM.EU without any evidence did not convince me.

Given the above, I have come to a conclusion that (1) the Respondent has not used the domain name or a name corresponding to the domain name in connection with the offering of goods or services nor has made demonstrable preparation to do so, (2) the Respondent has not been commonly known by the domain name, and (3) the Respondent has not been making any legitimate and non-commercial or fair use of the domain name. Therefore, I found that the Respondent did not have any legitimate interest in the name NGM(.EU).

BAD FAITH

The minimal set of the required conditions defined in Paragraph B11 (d) (1) of the ADR Rules and Article 21(1) of Regulation 874/2004 for granting the remedy requested by the Complainant are met, namely (1) the existence of the identical earlier trademarks registered in the name of the Complainant, and (2) the Complainant's lack of rights or legitimate interest. Therefore, I found it unnecessary to establish whether the Respondent had acquired the registration of the domain name NGM.EU, or had used it, in bad faith.

TRANSFER OF THE DOMAIN NAME

The Complainant has asked that the disputed domain be transferred to the Complainant. The Complainant is an Italian company having its principal place in Italy, so the Complainant satisfies the general eligibility requirements under Article 4(2) of Regulation 733/2002 for the transfer of the domain name .EU.

For these reasons I have decided that all conditions are met for the transfer of the domain name NGM.EU to the Complainant.

DECISION

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

PANELISTS

Name	**Gregor Macek**

DATE OF PANEL DECISION 2011-07-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is an Italian company, NGM Italia srl, and has used "NGM" as a brand name for selling mobile phones at least in Italy. To promote its business the Complainant has used the internet site www.ngm-mobile.com. The Complainant is the holder of the following earlier trademarks:
(1) "NGM", Italian registered trademark No. 0001245829, with application date of 28 December 2007, and registration date of 12 February 2010; and
(2) "NGM", Community Trademark No. 006987895, with application date of 13 June 2008, priority date of 28 December 2007 and registration date of 3 March 2009.

The Respondent submitted no evidence, nor did he claim, that he had any rights in the name NGM. From the statements by the Complainant and the Respondent, and submitted evidence it was concluded the Respondent did not have any legitimate interest in the name NGM(.EU) because (1) the Respondent has not used the domain name or a name corresponding to the domain name in connection with the offering of goods or services nor has made demonstrable preparation to do so, (2) the Respondent has not been commonly known by the domain name, and (3) the Respondent has not been making any legitimate and non-commercial or fair use of the domain name. The Respondent also failed to submit any evidence or even to explain in his response why he sought the registration of the domain name with this particular string of characters NGM(.EU), in other words, what does this word mean to him, what is his interest in it, or why he chose this particular domain name.

The Complainant is an Italian company having its principal place in Italy, so the Complainant satisfies the general eligibility requirements under Article 4(2) of Regulation 733/2002 for the transfer of the domain name .EU.

For these reasons it was decided that all conditions are met for the transfer of the domain name NGM.EU to the Complainant.