Panel Decision for dispute CAC-ADREU-008570

Case number	CAC-ADREU-008570
Time of filing	2023-12-22 15:27:42
Domain names	baywa-baumarkt.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BayWa Bau- & Gartenmärkte GmbH & Co. KG

Complainant representative

Organization	Kümmerlein, Simon & Partner Rechtsanwälte mbB

Respondent

Organization	BayWa Bau und Gartenmarkte GmbH und Co. KG

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 pending or decided proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is BayWa Bau- & Gartenmärkte GmbH & Co. KG.

According to public WHOIS information, the registered holder of the disputed domain name and Respondent has pretended to be “BayWa Bau und Gartenmarkte GmbH und Co. KG”.

The Respondent registered the domain name on 03 September 2023 under the name:

The Respondent registered the domain name on 3 September 2023 under the name:

Organisation: BayWa Bau und Gartenmarkte GmbH und Co. KG

Name: Martin Jung

Address: Zeche Oespel 15, Dortmund, 44149, nordrhein westfalen, DE

Phone: +49.1680043520

Email: pasubander@outlook.de

The Complainant filed a complaint on 18 October 2023 and filed a Complaint amendment on 23 October 2023.

The Respondent has not confirmed receiving the notice of the ADR Proceeding of 23 October 2023 by accessing the online platform and was notified of his failure to comply with the deadline indicated in the notification of deficiencies in response on 5 December 2023.

A. COMPLAINANT

I. The Complainant claims that the disputed domain name is identical or confusingly similar to a trademark or service mark in which he has rights. He states that the disputed domain name is confusingly similar to the name “BayWa Bau- & Gartenmärkte”, which is recognized as a commercial designation of its company name “BayWa Bau- & Gartenmärkte GmbH & Co. KG” according to Sec. 1 No. 2, Sec. 5 of the German Trademark Act (herein: “MarkenG”). The addition “GmbH & Co. KG” is solely the denomination of the Complainant's legal form.

Further, the Complainant is also holder of the name “baywa-baumarkt”, which is also recognized as a commercial designation according to Section 1 No. 2, Section 5 MarkenG with regard to Complainant’s country code top-level domain <baywa-baumarkt.de>.

The Complainant claims, that panels in earlier decisions found that rights to commercial designations according to Section 1 No. 2, Section 5 MarkenG are relevant with regard to Sec. B11(d)(1)(i) of the ADR Rules. See, for example, TSE Systems GmbH v. Fienna Ltd, CAC 1328, <tse-systems.eu>.

According to Sec. 1 No. 2 MarkenG, commercial designations are protected under German trademark law. According to Sec. 5 (1) MarkenG, company symbols and titles of work shall be protected as commercial designations. Company symbols are signs used in the course of trade as names, firm names or special designations of business establishments or enterprises, Sec. 5 (2) MarkenG. According to Sec. 5 (2) MarkenG, firm names are protected when the firm name is suited to designate the merchant and distinctive.

These requirements are fulfilled. Both names, “BayWa Bau- & Gartenmärkte” and „baywa-baumarkt“, are suited to designate the Complainant as a merchant and are not devoid of any distinctive character because of their distinctive element “BayWa”/”baywa”.

The Respondent’s domain name <baywa-baumarkt.eu> is identical or, at least, confusingly similar to Complainant’s names “BayWa Bau- & Gartenmärkte” and „baywa-baumarkt“. Respondent’s domain name contains Respondent’s entire name “baywa-baumarkt” and the distinctive word element “BayWa”/”baywa”.

II. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

III. The disputed domain name was registered and is being used in bad faith. The Registrant used the name of Complainant‘s subsidiary "BayWa Bau und Gartenmarkte GmbH und Co. KG" and its post address in order to create a likelihood of confusion. Probably due to a language issue, the Respondent misspelled the name (“Gartenmarkte” instead of “Gartenmärkte”; “und” instead of “&”) in the post address.

B. RESPONDENT

The Respondent did not submit a response.

DISCUSSION AND FINDINGS

In accordance with Article 21(1) of Regulation 874/2004 a registered domain name is speculative or abusive where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:

a) has been registered by its holder without rights or legitimate interest in the name;
or
b) has been registered or is being used in bad faith.

The Complainant has provided sufficient evidence that he is the owner of the unregistered trademark "BayWa Bau- & Gartenmärkte" and the company name "BayWa Bau- & Gartenmärkte GmbH & Co. KG".

A. The disputed domain name incorporates the word "baywa-baumarkt" only differs from the Complainant's name by the addition of the suffix .eu.

It is the consensus view among the panelists that for assessing identity or confusing similarity the .eu suffix has to be disregarded.

Therefore, the Panel finds that the disputed domain name <BAYWA-BAUMARKT.EU> is highly similar to the domain name registered on behalf of the Complainant well before its registration.

B. The Complainant claims that the Respondent is not affiliated with nor authorized by the Complainant in any way. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s name, nor to apply for registration of the disputed domain name by the Complainant. He therefore contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. According to Art. 21 (1) of the Regulation the registration of a domain name is speculative or abusive where that name is identical or confusingly similar to a recognized trademark and where it has been registered or is being used in bad faith.

Bad faith may be demonstrated where circumstances indicate that the domain name was intentionally used to attract Internet users for commercial gain to the holder of a domain name website, by creating a likelihood of confusion with a name on which a right is recognized or established by national and/or Community law.

The registration of a domain name in the name and on the postal address of a third party not only constitutes a breach of contract per Art. 3 of the Regulation, it is also the illegal impersonation of a corporation and hence identity fraud.

The Panel finds that the domain name has been registered in bad faith.

The Complainant, being a company registered under German law, satisfies the eligibility requirement for .eu domain name registrations pursuant to Article 4(2)(b)(ii) of Regulation (EC) No. 733/2002.

Therefore, the disputed domain name has to be transferred as claimed.

DECISION

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

PANELISTS

Name	**Friedrich Kurz**

DATE OF PANEL DECISION 2023-12-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: baywa-baumarkt.eu

II. Country of the Complainant: Germany, country of the Respondent: Germany.

III. Date of registration of the domain name: 3 September 2023

IV. Rights relied on by the Complainant (B(11)(f) ADR Rules) on which the Panel based its decision:

unregistered trademark according Art. 5 German Trademark Act and company name.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (B(11)(f) ADR Rules):
1. No
2. Why: Complainant has established prime facie case, no response submitted by Respondent.

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules):
1. Yes
2. Why: circumstances indicate that the domain name was intentionally used to attract Internet users, for commercial gain and has been registered impersonating the Complainant.

IX. Other substantial facts the Panel considers relevant: No

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: the Respondent’s failure to supply a response.

XII. Is Complainant eligible? Yes