

Panel Decision for dispute CAC-ADREU-008677

Case number CAC-ADREU-008677

Time of filing 2024-12-03 13:36:54

Domain names outbackmotortek.eu

Case administrator

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

Complainant

Organization Outback Motortek

Respondent

Name Samuel Oliveira de Carvalho Matos

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 unaware of any other pending or decided legal proceedings in respect of the domain name <outbackmotortek.eu> ('the disputed domain name').

FACTUAL BACKGROUND

A. Complainant

A.1 Complainant's standing

The Complainant relies on the following registered trade mark:

- Benelux trade mark registration no. 1504881, filed on 21 May 2024, for the word mark OUTBACK MOTORTEK, in class 12 of the Nice Classification.

(Referred to as 'the Complainant's trade mark').

The Complainant further asserts rights by virtue of its business name 'Outback Motortek Europe B.V.', duly registered in the Netherlands in 2018.

The disputed domain name <outbackmotortek.eu> was registered on 1 April 2024 and currently directs to a parking page hosted by Sedo, a trade platform for internet addresses, showcasing the message 'This domain is for sale!' (referred to as 'the Respondent's website').

A.2 Complainant's Factual Allegations

The Complainant, established and headquartered in Canada, operated solely within Canada from 2014 to 2018 before expanding into Europe. As a manufacturer of motorcycle accessories, the Complainant seeks to use the disputed domain name for its European operations.

With a decade of industry presence, the Complainant manages international activities through the website at <outbackmotortek.com>, registered in 2013, alongside a temporary website for EU customers at <outback-motortek.eu>.

B. Respondent

B.1 Respondent's Factual Allegations

The Respondent served a Response in this Alternative Dispute Resolution proceeding ('the ADR proceeding') on 1 November 2024, summarised in the section 'Parties' Contentions'.

Since 2020, the Respondent has worked as a professional domain name investor based in Portugal.

A. COMPLAINANT

The Complainant submits that the disputed domain name has been taken and is not in use; further, it appears that the sole purpose of the

disputed domain name is to be sold at a speculative price.

B. RESPONDENT

The Respondent served a Response in this ADR proceeding on 1 November 2024.

The Respondent's contentions can be summarised as follows:

B.1 Complainant's lack of trade mark rights

The Complainant registered the trade mark OUTBACK MOTORTEK after the registration of the disputed domain name, rendering its claim of bad faith registration weaker. At the time of registration, no protected trade mark existed that the Respondent could have infringed.

B.2 Respondent's legitimate interest in the disputed domain name

The Respondent asserts that, as a domain name investor, the acquisition and resale of domain names represent a legitimate business model. Listing the disputed domain name for sale aligns with standard practices in the industry and does not imply bad faith. The Respondent contends that terms like 'outback' have generic associations in industries like automotive and adventure gear, justifying the acquisition of the disputed domain name on that basis.

B.3 Lack of bad faith evidence

The Respondent argues that reselling domain names is an accepted practice and has not engaged in any attempts to deceive the Complainant.

B.4 Complainant's responsibility for proactive brand protection

The Respondent contends that the Complainant should have proactively secured the domain name or sought equivalent protection within the EU.

DISCUSSION AND FINDINGS

1. Procedural Factors

A. Panel's directions

On 26 November, the Panel transmitted to the Parties the Procedural Order No. 1 ('the PO1'), directing as follows:

I. Complainant's Obligation: To submit documentary evidence of business incorporation and activities over the past ten years, including proof of presence of transactions in Portugal and/or with Portuguese counterparts; and

II. Respondent's Obligation: To submit documentary evidence of professional activities as a domain investor.

III. Response Deadline: The Parties shall submit their responses to PO1 by 29 November 2024 (CET time)."

B. Complainant's Response to PO1

The Complainant submitted a response to PO1 on 28 November, the details of which are set forth below:

"Please find attached the establishment of our European (NL) business, back in 2018. For the first few years (2014-2018), the business was in Canada only, where the company was founded and is 'headquartered'. We're in contact with our dealer in Portugal (In-Parts) to hopefully still get today the proof of our business presence/sales in Portugal since 2019."

On 29 November, the Complainant submitted its supplementary response to PO1, as follows:

"We've tried to [sic] gather the contract but unfortunately not able to do so (on time). Alternatively, which we believe to fulfil the same request, we have a screenshot of some of the few initial orders from our Portuguese dealer on our wholesale website. Along with it, the pdf of the first order on record.

In-Parts (<https://in-parts.com/en/brand/65-outback-motortek>), our Portuguese [sic] exclusive dealer, has kindly offered their services and contact, for any further clarification by the panel, if needed. The contact is [A***], at ***@in-parts.com."

C. Respondent's Response to PO1

On 28 November, the Respondent submitted a response to PO1, the details of which are set forth below:

"Please find attached the evidence of my professional activity as a domain investor. I have prepared a .rar file to consolidate all the information. If you would prefer me to send the .pdf files individually, please let me know.

Within the .rar file, you will find the Portuguese document confirming the start of my activity in 2020. Additionally, I am including a few examples of domain sales from 2020 to the present. I have included two sales per year, but if you require more examples, please let me know.

I hope this information is sufficient to meet your request. Please don't hesitate to contact me if you need anything further."

At the request of the Panel, the Respondent furnished the documentary evidence in PDF format.

D. Panel's further directions

On 28 November, the Panel directed the Respondent to submit a list of all domain names in his possession by 29 November.

The Respondent submitted his list of domain names on 29 November.

E. Procedural Order No. 2

On 29 November, The Panel transmitted to the Parties the Procedural Order No. 2 ('the PO2'), ordering as follows:

"1. Following the submission of supplementary evidence as directed by Procedural Order No. 1, the Panel is prepared to render a decision on the merits of this ADR proceeding.

2. The Panel therefore **ORDERS** as follows:

I. This ADR proceeding is now closed for deliberation.

II. Pursuant to paragraph B7 of the ADR Rules, the deadline for the Panel's decision is extended by one week, with the new due date set for **6 December 2024.**"

2. Principal Reasons for the Decision

A. Legal Framework

This ADR proceeding is conducted in accordance with the applicable Regulation (EU) 2019/517 ('the EU Regulation') and the Commission Implementing Regulation (EC) 2020/857 (collectively referred to as 'the EU Regulations'); the .eu Alternative Dispute Resolution Rules ('the ADR Rules'); and the Center of the Czech Arbitration Court Supplemental ADR Rules ('the ADR Supplemental Rules').

In line with paragraph B11 (a) the ADR Rules, the Panel is tasked with determining the Complaint based on submitted statements and documentation, guided by the legal framework set forth in the ADR Rules, the ADR Supplemental Rules, and the EU Regulations.

B. ADR proceeding – Threshold

Pursuant to article 4(4) of the EU Regulation and paragraph B11(d)(1) of the ADR Rules, the Complainant bears the burden of establishing the following grounds for a successful claim:

- i. The domain name is identical or confusingly similar to a name in respect of which a right is recognised 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.

(emphasis added)

The responsibility to fulfil these criteria rests with the Complainant. The evidentiary standard guiding the ADR proceeding is one of balance of probabilities. The Panel will now analyse these grounds in turn.

C. Identical or Confusingly Similar

This criterion requires a comparative analysis, whereby the disputed domain name is juxtaposed with the Complainant's established rights. To succeed in this regard, the Complainant must furnish evidence demonstrating rights in a name recognised by the applicable national or Community law.

The Panel is satisfied that the Complainant possesses established rights through both its trade mark registration of OUTBACK MOTORTEK and business name registration of 'Outback Motortek Europe B.V.' (collectively referred to as 'the Complainant's IP rights'). A straightforward comparison reveals that the disputed domain name is at least confusingly similar to the Complainant's IP rights.

Consequently, the Panel finds that the Complainant has met the first requirement under Article 4(4) of the EU Regulation and paragraph B11(d)(1) of the ADR Rules.

D. Rights or Legitimate Interest

The second requirement demands that the Respondent demonstrate rights or legitimate interest in the disputed domain name. Once the Complainant establishes a prima facie case indicating the absence of such rights, the burden of proof shifts to the Respondent.

The Respondent claims to be a 'domain name investor', a title that may suggest valid business practices. However, this assertion requires closer examination, particularly regarding the disputed domain name which only contains the term 'outbackmotortek' in its string. This term, or even the recognisable terms within, ie 'outback' and 'motortek' together, cannot be simply dismissed as generic or descriptive. Instead, as far as the Panel can discern, the term 'outbackmotortek' and the terms 'outback' and 'motortek' together, hold particular significance in relation to the Complainant's established identity and business.

Notably, to the best of the Panel's knowledge, the above referenced terms (namely 'outbackmotortek', and 'outback' and 'motortek' together) have no commonly understood meaning beyond their connection to the Complainant. The term 'outback' is often associated with wild terrain or adventure and does not inherently relate to motorcycle accessories, while 'motortek' seems to be a coined term, likely a blend of 'motor' and 'technology'. Together, these terms form a distinct identifier in this niche industry from the available case record. This specificity highlights the uniqueness of the Complainant's IP rights and, on balance, suggests that the Respondent's choice of this particular domain name was intentional, rather than a mere act of generic investment.

Furthermore, the lack of similar domain name registrations within the Respondent's collection calls into question the legitimacy of this acquisition. Despite possessing an extensive portfolio, the distinctive nature of 'outbackmotortek' deviates from what might be considered a dictionary word. To the best of the Panel's knowledge, there is no recognised dictionary meaning for this term. The Panel also notes that the Respondent does not hold any other domain names with 'outback' in its string in combination with either 'motor', 'tech' or 'tek'.

Additionally, the fact that the Complainant has been active in Europe, and especially in Portugal since 2019 – where the Respondent also operates – further complicates the Respondent's claim of legitimate interest. A diligent domain investor would likely be aware of the direct connection between the disputed domain name and the Complainant's market presence.

In conclusion, the evidence provided does not adequately support the Respondent's assertions of legitimate interest in the disputed domain name. The Panel finds that the Complainant has therefore met the second requirement under Article 4(4) of the EU Regulation and paragraph B11(d)(1) of the ADR Rules.

E. Registered or Used in Bad Faith

The Panel reminds the Parties that, under article 4(4) of the EU Regulation and paragraph B11(d)(1) of the ADR Rules, the onus lies with the Complainant to establish whether the disputed domain name was registered by the Respondent without rights or legitimate interest; or if it has been registered or used in bad faith.

In light of the Respondent's failure to demonstrate legitimate interest in the disputed domain name, the Panel finds it unnecessary to rule on the matters of bad faith registration or use.

F. Eligibility Criteria

The Complainant seeks the transfer of the disputed domain name and satisfies the eligibility criteria imposed by article 3 of the EU Regulation, substantiated by its establishment in the Netherlands.

DECISION

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

PANELISTS

Name	Gustavo Moser
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DATE OF PANEL DECISION 2024-12-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <outbackmotortek.eu>

II. Country of the Complainant: the Netherlands, country of the Respondent: Portugal

III. Date of registration of the domain name: 1 April 2024

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

1. word trade mark registered in the Benelux, reg. No. 1504881, for the term OUTBACK MOTORTEK, filed on 21 May 2024, registered on 6 August 2024, in respect of goods and services in class 12 of the Nice Classification.

2. company name: Outback Motortek Europe B.V.

V. Response submitted: Yes

VI. Domain name is at least 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: the evidence provided does not adequately support the Respondent's assertions of legitimate interest in the disputed domain name.

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules): not applicable

IX. Other substantial facts the Panel considers relevant: Respondent is a domain name investor. Nonetheless, on balance, the Respondent's choice of the disputed domain name appears to have been intentional, rather than a mere act of generic investment.

X. Dispute Result: transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: parties requested to submit further evidence to substantiate their claims.

XII. Is Complainant eligible? Yes
