

Decision for dispute CAC-UDRP-100182

Case number **CAC-UDRP-100182**

Time of filing **2010-07-07 09:14:24**

Domain names **bugattidoo.com**

Case administrator

Name **Tereza Bartošková (Case admin)**

Complainant

Organization **F. W. Brinkmann GmbH**

Complainant representative

Organization **PETOSEVIC DOO**

Respondent

Organization **Bugatti d.o.o.**

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The Complainant is the Registered Proprietor of various Registered Trade Marks:

Community Trade Mark 4290201 for the word BUGATTI

International Registrations 483232, 972141, 448607A, all for the word BUGATTI

Other registered marks including various national marks.

The Complainant has used the word mark in Germany since the late 1970s and in international trade since 1990 and on its website at bugatti.de.

The Complainant has a reputation in the word mark BUGATTI which is well known.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

A. Complainant's Trademark/Service marks

1. The Complainant is a renowned producer of clothing, footwear, headgear, leather products and related accessories. Production of the BUGATTI products (initially coats) started once the brand (BUGATTI) was initially registered at the (German) patent office on 26.05.1978. The Bugatti brand went international during the 1990s, in the Benelux countries in 1990, followed by the UK and Finland and Prague in 1998. The VW Group acquired rights to the Bugatti car brand which lead to export sales to France, Italy and other countries in 1999.
2. The Complainant has a commercial presence on the Internet through the domain name <bugatti.de>. The website is used to provide information on the Complainant's products.
3. The Complainant owns numerous registrations for its BUGATTI marks around the world, such as IR 483232 BUGATTI word mark (valid in Serbia), IR 972141, BUGATTI word mark (valid in Serbia), IR 448607A, BUGATTI (word mark), IR 952732, B Device (valid in Serbia), CTM 4290201, BUGATTI (word mark). Each of the registrations is valid, subsisting and owned by Complainant.
4. The subject trademarks are registered for the following goods:
IR 483232 – “Outer clothing” in IC 25.
IR 972141 – “Goods made of leather” in IC 18; “Textile fabrics” in IC 24 and “Clothing” in IC 25.
IR 952732 – “Goods made of leather” in IC 18; “Home textiles” in IC 24 and “Clothing” in IC 25.
CTM 4290201 – “Outer clothing” in IC 25.
5. Long prior to Respondent's registration of the Infringing Domain Name in 2006, the Complainant adopted, and has thereafter continuously used, the inherently distinctive BUGATTI Mark for goods and services that include, but are not limited to, clothing production in many countries, including in Serbia.
6. The Complainant has invested substantial resources in advertising and promoting the BUGATTI brand.

B. Respondent's Registration and Use of the Infringing Domain Name.

1. The Respondent is not affiliated with or related to Complainant in any way, nor is Respondent licensed by the Complainant or otherwise authorized to use any of the BUGATTI Marks.
2. On or about October 4, 2006, long after Complainant's adoption and use of the BUGATTI Marks, including substantial use of the BUGATTI Marks on the Internet, Respondent registered the Infringing Domain Name.
3. The Infringing Domain Name hosts the Respondent's website advertising and offering identical/confusingly similar products under the name B Underwear.

C. The Infringing Domain Name is Confusingly Similar to the BUGATTI Marks.

1. The Infringing Domain Name is confusingly similar to the BUGATTI Marks because the Infringing Domain Name incorporates the entirety of the BUGATTI mark.

D. Respondent Has No Rights or Legitimate Interests in the Infringing Domain Name.

1. The Respondent is not known by the BUGATTI Marks and has not acquired any trademark or service mark rights in the BUGATTI Marks.

2. The Complainant has not licensed or otherwise permitted the Respondent to use the BUGATTI Marks or to apply for or use any domain name incorporating any of the BUGATTI Marks.

3. Moreover, the Respondent's use of the BUGATTI mark in the Infringing Domain Name is not "nominative" in that it is not an unavoidable use of the trademark to identify the goods or services that Respondent offers on its website.

4. Furthermore, none of the products/services offered on the Respondent's website (hosted on the infringing domain name) bear the mark BUGATTI.

5. In addition, none of the stores in the region where the subject products can be found bare the BUGATTI mark.

6. Based on its lack of rights in the BUGATTI Marks and lack of affiliation with the Complainant, the Respondent does not have rights or a legitimate interest in the Infringing Domain Name.

E. Respondent Registered and Is Using the Infringing Domain Name in Bad Faith.

1. The Respondent company was founded on October 15, 2001 under the name Dakota d.o.o., of Lazara Kujundzica 86, 11000 Belgrade, Serbia.

2. On March 10, 2005, the Respondent (under its initial name – Dakota d.o.o.) filed a trademark application No. Z-255/2005 for the mark BUGATTI (word mark), in IC 18, 24 and 25, before Serbian Intellectual Property Office. The said trademark application was finally refused protection on July 31, 2006.

3. On July 18, 2006, Serbian Business Registers Agency issued a decision recording a change of the Respondent's company name from Dakota d.o.o. to Bugatti d.o.o.

4. On October 9, 2006, the Respondent (now under its new name - Bugatti d.o.o.) filed a trademark application No. Z-2241/2006, for the mark BUGATTI (word mark) for goods in IC 25, before Serbian Intellectual Property Office. This application was finally refused on June 16, 2008.

5. On July 10, 2008, the Respondent filed another trademark application No. Z-1749/2008, for a variation of the subject mark – BUGATTIDOO UNDERWEAR, for goods in IC 18, 24, 25, before Serbian Intellectual property office. The said application had been withdrawn on July 20, 2009. The suffix DOO (Serbian equivalent for LLC – Limited Liability Company) or the verbal element UNDERWEAR can be considered distinctive with respect to the applied goods, leaving BUGATTI, as only distinctive element of the mark.

6. Considering that Serbian IPO examines trademark applications on relative grounds (Serbian TM Law does not recognize opposition system) and that the Respondent had attempted to register the mark identical to the Complainant's prior trademark registrations before Serbian IP Office under the name Dakota d.o.o., it must have been aware of the Complainant's IP rights at the time he changed his company name (to Bugatti doo) and filed for registration of the Infringing Domain Name.

7. In addition, beside the BUGATTI marks, the Complainant's (sic) products can also be found under the B device trademark (IR 952732). Therefore, the fact that Respondent at the same time and under the Infringing Domain Name offers the products under the mark "B underwear" supports his continuous intention to create association with the Complainant's brand among the consumers.

8. Article 2 of the UDRP Policy prescribes that By applying to register a domain name, or by asking us to maintain or renew a domain name registration, the Respondent thereby represents and warrants to the registrar that (a) the statements he made in the Registration Agreement are complete and accurate; (b) to his knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) he is not registering the domain name for an unlawful purpose; and (d) he will not knowingly use the domain name in violation of any applicable laws or regulations. This provision emphasizes

that it is the Respondent's responsibility to determine whether his domain name registration infringes or violates someone else's rights.

9. The Respondent's knowledge of the Complainant's trademark rights in the BUGATTI Marks is evidence that the Respondent did not register the Infringing Domain Name with the intention of using it legitimately.

10. Furthermore, the Complainant wrote to the Respondent on several occasions 2008 in order to settle the dispute amicably, but has not received any response.

11. Moreover, as a result of the Respondent's opportunistic bad faith in registering the Infringing Domain Name, the Complainant's BUGATTI Marks and name and corresponding reputation and goodwill are placed at the Respondent's mercy. The Respondent's Infringing Domain Name will most certainly create the confusion in the commerce, mislead the consumers and/or discourage Internet users from locating Complainant's true web site, thereby diluting the value of the BUGATTI Marks and BUGATTI name.

12. The Respondent's constructive knowledge of the Complainant's prior rights is sufficient to demonstrate bad faith registration and use of the Infringing Domain Name.

PARTIES CONTENTIONS

COMPLAINANT'S CONTENTIONS:

As to Confusing Similarity, See, e.g. Kabushiki Kaisha Toshiba v Shan Computers, Case No. D3000-0325 (WIPO June 27, 2000) (the Panel found that the relevant part of this domain name was <toshiba>, which is identical to the Complainant's registered TOSHIBA trademark); Am. Int'l Grp, Inc. v. AIG-Pro c/o Alvin Givens, Claim No. FA 0730318 (NAF July 27, 2006) (finding that Respondent's domain name was confusingly similar to Prosecutor's mark "because the disputed domain name incorporated the registered mark in its entirety...."); AOL, LLC v. Butler, Claim No. FA 0733440 (NAF July 25, 2006) (finding the infringing domain names confusingly similar to Prosecutor's trademark where domain names included Prosecutor's trademark in its entirety).

As to Rights and Legitimate Interests;

The Respondent is not known by the name/marks. See Cellular One Group v. Paul Brien, Case No. D2000-0028 (WIPO March 10, 2000) (the Panel found bad faith use of "cellularonechina.com" because the domain name included the complainant's entire trademark, and in light of Cellular One's trademark registrations and applications, the Panel determined that "it is not possible to conceive of a plausible circumstance in which Respondent could legitimately use the domain name.") See Charles Jourdan Holding AG v. AAIM, Case No. D2000-0403 (WIPO June 27, 2000) (the Panel found that the respondent had no rights or legitimate interests in the domain name at issue where (1) the Respondent was not a licensee of the prosecutor; (2) the complainant's prior rights in the domain name precedes the Respondent's registration; and (3) the Respondent was not commonly known by the domain name in question. The same is true in this case. Respondent has no prior or current rights to the BUGATTI mark that would establish a legitimate interest in the Infringing Domain Name.

The Respondent has no licence or consent to use marks, see Telestra Corporation Limited v. Nuclear Marshmallows, Case No. D2000-003 (WIPO Feb. 13, 2000) (the Panel found that the Respondent had no rights or legitimate interests to use the domain name at issue because the Respondent was not licensed or otherwise permitted to use the prosecutor's trademark, which was the relevant part of the domain name).

The Respondent's Use is not nominative. See Six Continents Hotels, Inc. v. Hotel Partners of Richmond, Case No. D2003-0222 (WIPO May 14, 2003) (finding that the use of the Prosecutor's HOLIDAY INN mark in the domain name <holidayinnhotelreservations.com> was not nominative fair use because it was not unavoidable and necessary use of a mark to identify Respondent's services).

As to Bad faith Registration and Knowledge, see Caesar World, Inc. v. Forum LLC, WIPO Case No. D2005-0517(The Panel

found that “the Complainant’s reputation, and presence on the Internet, indicates that Respondent was or should have been aware of the marks prior to registering the disputed Domain Name”).

NO RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has Rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Rights (paragraph 4(a)(i)of the Policy)

The Complainant has Rights in its registered trade marks and the word mark is a well known mark with an international reputation.

Further the International Registrations are effective in Serbia, Yugoslavia, where the Respondent is incorporated and resides.

The Complainant’s word mark is the distinctive and dominant part of the Domain Name and the remaining characters comprise the local generic abbreviation for the corporate form and therefore do not distinguish the Domain Name.

The Domain Name is confusingly similar to a mark in which the Complainant has Rights.

2. Rights or Legitimate Interest (paragraph 4(a)(ii)of the Policy).

The Respondent’s corporate name was obviously adopted as part of a plan to cloak itself in legitimacy to better misappropriate the Complainant’s reputation and goodwill.

This was no doubt only possible due to a lack of harmonization between the company name registration regime and that for intellectual property –as the Serbian IPO appear to have foiled the Respondent’s attempts to register national marks employing the Complainant’s registered work mark.

In these circumstances, the Respondent is not legitimately commonly known by the name and its offerings under that name cannot be bona fide.

3. Bad Faith (paragraph 4(a)(iii)of the Policy)

As already mentioned, I am satisfied the Respondent’s registration of the Domain Name was part of an audacious plan to misappropriate the Complainant’s reputation and goodwill while harvesting the fruits of the confusion.

There is no need to rely on any imputed or constructive knowledge where, as here, the Respondent impersonated the Complainant. I find the Respondent had actual knowledge of the Complainant.

The Respondent's execution of its plan; its use of the Domain Name is in bad faith. It disrupts the Complainant's business and attracts Internet users to benefit its own sales of competing goods.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BUGATTIDOO.COM**: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION	2010-08-11
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Publish the Decision