Decision for dispute CAC-UDRP-101464

Case number	CAC-UDRP-101464
Time of filing	2017-03-09 09:54:25
Domain names	Franke-servisi.com

Case administrator

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

Complainant

Organization	Franke Technology and Trademark Ltd

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	hakan gUlsoy

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the registered trademark, FRANKE, protected as a word and figurative mark in several classes in numerous countries all over the world including Turkey. In particular, the Complainant points to its two international registrations for the word mark, FRANKE, IR No. 975860 in classes 6, 11, 20, 21 and 37 registered on 14 June 2007 and IR No. 872557 in classes 6, 11 and 21 registered 28 February 2005. Both registrations designate Turkey. The Complainant also has a Turkish national mark No. 135579 for the word mark in classes 6-7, 9, 11, 19, 20-21, registered on 23 September 1992.

The Complainant also has a number of domain names, for example, franke.com, registered on 18 March 1996, and franke.com.tr, registered 27 April 2000 and franke.net, registered on 1 October 1997. These resolve to the Complainant's website.

In addition to its registered rights, the Complainant relies on its rights arising from use in trade in the various jurisdictions in which it trades which recognize unregistered rights.

The Complainant says its FRANKE mark is a well-known mark or a mark with a reputation due to its extensive use and

advertising and revenue generated worldwide, including in Turkey.

The Complainant relies on findings in previously successfully UDRP cases including WIPO cases D2016-1120, DCO2016-0021, D2016-0686 and D2016-0663.

FACTUAL BACKGROUND

The Complainant is a Swiss company founded by Hermann Franke in Rorschach, Switzerland as a sheet-metal business in 1911. By 1974 the Franke Group had expanded significantly with 13 subsidiaries and various licensees Europe-wide. In 1989 the company expanded further and today is a global group with some 70 subsidiaries and around 9000 employees in 37 countries (including related companies), generating aggregate sales of CHF 2.1 billion.

The Franke Group consists of four businesses: (1) Franke Kitchen Systems being integrated systems for food preparation and cooking, including sinks, taps, worktops, hoods and cooking appliances; (2) Franke Foodservice Systems, namely kitchen equipment, supplies and a broad range of services for leading restaurant chains; (3) Franke Water Systems, various integrated systems for private bathrooms and semi-/public washrooms, including taps, showers, sinks, accessories, water management systems and (4) Franke Coffee Systems and machines including superautomatics, traditionals and brewers.

The Disputed Domain Name, franke-servisi.com, was registered on 26 November 2016 by the Respondent, located in Turkey, and operating as a repairer or otherwise unauthorized Franke Service agent --based on the website to which the Disputed Domain Name resolves.

The Complainant's trademark registrations (as above) predate the registration of the Disputed Domain Name and the Complainant has previously successfully challenged several FRANKE domain names through UDRP processes e.g. WIPO case, D2016-1120, DCO2016-0021, D2016-0686 and D2016-0663.

No Response has been filed in this case.

That does not mean the Complainant wins by default, rather it must still make out its burden of proof and the three elements required under the UDRP.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Rights
The Complainant says the Disputed Domain Name includes the entirety of the Complainant's name and word mark, FRANKE, and the addition of the generic word for 'service' in Turkish adds nothing that distinguishes but rather compounds confusion by suggesting a connection, such that the Respondent is an authorized dealer, sales agent or licensee or similar. The Complainant cites the WIPO Overview on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2. and says that the Respondent is representing it is doing authorized business in Turkey using the Complainant`s trademark. It is well established that the suffix, here .com, is ignored for the purposes of assessing similarity under the Policy, see WIPO Case No. D2014-0581(sledge). The Complainant says it has rights in a name or mark similar to the Disputed Domain Name.

Legitimate Rights and Interests
The Complainant says the Respondent is not commonly known by the Disputed domain name. The WHOIS information describes the Respondent as Hakan gUlsoy. The Respondent has not by virtue of the content of the website, nor by its use of the Disputed Domain Name shown use in connection with a bona fide offering of goods or services. The Respondent is using the Disputed Domain Name to attract internet users to its website where it states they are "Yetkili Servis Merkezi" (in

English by Google Translator: “Authorized Service Center”). However, the Respondent is not an authorized repair center. The FRANKE logotype in red appears prominently on the top left of the website and strongly suggests that there is a connection with the Complainant. Moreover, the use of the word FRANKE (i) in the Disputed domain name and (ii) also on multiple occasions in the website text, further creates the impression that there is some official or authorized link with the Complainant in relation to repairs and services within Turkey, especially in the Istanbul area. In addition, the website invites visitors to contact the Respondent via the telephone number 444 0 569 or its link “Servis Talep Formu” (in English: “Service Request Form”) which was not working at the time of filing of the Complaint. See WIPO Case No. D2015-1024 Steven Madden, Ltd. v. Daniel Monroy (respondent collected personal information from internet visitors to the website such as name, phone number, email address, age etc who filled out a form, where the Panel noted that: “users presumably would not provide such data unless they believe they are dealing with Complainant or with a representative of Complainant…). This is an attempt to “phish” for users’ personal information by the Respondent is neither a bona fide offering of goods and services nor a legitimate non-commercial or fair use pursuant to the Policy. Personal data is a valuable commodity and eliciting such data as described is not a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers, pursuant to Policy paragraph 4(c)(iii).

The Complainant says Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, is not applicable here as the Oki Data conditions are not met in this case as: (1) the Respondent is not offering the Complainant’s products or services through the Disputed Domain Name, but rather appears to be offering an appliance repair and maintenance service; (2) the Respondent does not publish a disclaimer on the challenged pages. The website merely points out that the logo and brand name on the website and in the announcements are the registered trademark of the relevant company and they serve as special technical service of Franke brand. This proves that Respondent had prior knowledge of the Complainant’s trademark and tried to take advantage of it and create an association with the business of the Complainant; (3) the Respondent is depriving the Complainant of reflecting its own mark in the Disputed domain name; and (4) the Respondent presents themselves as the trademark owner by using the Complainant`s official trademark (being the logo mark comprised of the word mark in color). In short the Respondent's use of the Disputed domain name creates an overall impression that they are the Complainant.

Bad Faith
The Complainant says that its registered marks predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. In light of the website content, it is clear that the Respondent was aware of the Complainant’s trade marks at the time of registration and, therefore, the Disputed Domain Name was registered in bad faith.

The Complainant also says it tried to contact the Respondent on 31 January 2017 through a Cease and Desist letter and reminders were sent on 10 February 2017 and 16 February 2017 to the email address listed in the WHOIS record and to the email address listed on the website, however, no reply was received and no Response to this Complaint and process. It cites News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623 (failure to reply to cease and desist relevant to bad faith analysis); Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598 (same) and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460 (same).

Here the Complainant says the Respondent has never been granted permission to register the Disputed Domain Name, it takes advantage of the FRANKE trademark by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s products, services, website or location. Further, it intentionally chose the Disputed Domain Name based on registered and well-known trademark in order to generate more traffic to its business. The Respondent is using the Disputed Domain Name to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of its website. This conduct has been considered as bad faith under the Policy, and other WIPO decisions have also arrived to the same conclusion, see Philip Morris Incorporated v. Alex Tsypkin, WIPO Case No. D2002-0946 Pursuant to Policy paragraph 4(b)(iv), this constitutes evidence of both bad faith registration and bad faith use, for the purposes of paragraph 4(a)(iii)). See also WIPO case no. D2014-1010 (<ankaraaristonservisi.net) (“the Respondent's active websites associated with the disputed domain names appear to offer repair services for Ariston branded products. Therefore, the Respondent was aware of the Complainant's trademark ARISTON at the time the disputed

domain names were registered... suggests that the respondent is affiliated with the Complainant when it is actually not the case. The Panel has noted the presence of a small disclaimer on the active website but finds it insufficient ...the use made of the active websites associated with the disputed domain names does not qualify as a bona fide offering of goods or services under the Policy") and see WIPO case no. D2015-0579 AB Electrolux v. Guangzhou Nan Guang Electrical Appliances Co.Ltd. (zanussi-china.com) ("The Respondent is using the Domain Name for a website with an orange and black livery, which displays the mark ZANUSSI in a large, black font in the banner and photographs of the Complainant's group's ZANUSSI products... The Panel accepts the Complainant's evidence that the Respondent's website is liable to mislead customers into believing that it is a website of the Complainant or authorized by it... having regard to all the circumstances, the Panel considers that it was the Respondent's intention so to mislead customers"). Similarly, see WIPO case no D2014-0487 Aktiebolaget Electrolux v. electroluxmedellin.com, Domain Discreet Privacy Service / Luis Rincon ("The continuing use of the disputed domain name is clearly confusing to online users who will be attracted by the inclusion of the word ELECTROLX in the disputed domain name, and who will therefore believe that they are accessing a website that is in some way associated with or authorized by the Complainant. This is not the case, and the consumer confusion is further strengthened by the fact that there are services for Electrolux products advertised on the Respondent's website without any disclaimer of association with the Respondent").

The Complainant says this is also a case where there is a pattern of conduct as the Respondent using its official email address dj_fener154@hotmail.com, as indicated in WHOIS Lookup record, for some 49 domain names including well-known brands with protected trademarks such as BOSCH. Such pattern of abusive registrations does not constitute bona fide use of the Disputed domain name and it is clear that the Respondent is capitalizing on well-known trademarks.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed 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 not shown to the satisfaction of the Panel, the Respondent has no rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, not to the satisfaction of the Panel, shown the Disputed 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 record shows that the Respondent was duly served under the Policy.

The Respondent has not challenged the language of the proceeding.

There are no other procedural issues in this case.

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

There is no question that the Complainant has Rights in a name and mark similar to the Disputed Domain Name, both from its registered marks and arising from its substantial use in trade. The key issue in this case is whether the Respondent is making a bona fide offering of goods or services as a reseller/repairer/servicer and has a legitimate right or interest in doing so under the second limb of the Complainant's burden.

Firstly, no trade mark owner (in the EU) including the Complainant, has the right to monopolise the servicing or repair or

resale (of previously sold) of its products and the limits to and exhaustion of the rights of a trade mark owner reflect this -- and promote valid and honest competition. In UDRP jurisprudence this is reflected in the OKI DATA principles from WIPO Case No.D2001-0903 which provide that a reseller/distributor can make a bona fide offering of goods and services and have a legitimate interest in a domain name, provided that:

(a) The use involves the actual offering of goods and services in issue;
(b) The site sells only the trademarked goods;
(c) The site accurately and prominently discloses the registrant's relationship with the trademark holder.
(d) The Respondent must not try to "corner the market" in domain names that reflect the trademark.

The rule protects descriptive uses if necessary to indicate purpose and in accordance with honest practices—which encompasses a duty to act fairly in relation to the legitimate interests of the trade mark owner. This extends to protect third parties' use of a mark as an indication of the kind, quality, quantity, intended purpose... of goods or services and where it is necessary to indicate the intended purpose of a product or service, in particular as to repair or service or accessories or spare parts provided the use is in accordance with honest practices in industrial or commercial matters." The seminal case is Case C-63/97 BMW v Deenik, where an independent dealer in BMWs provided repair and maintenance services for BMWs and made reference to that in his marketing, holding himself out as a "BMW specialist" although he was not an authorised or licensed dealer. The use in relation to the repair services was protected and the use was "necessary" to indicate that purpose and in accordance with honest practices. That is the legal norm or rule in the EU. The proviso is unless the mark is used in a way that may create the impression that there is a commercial connection between the other undertaking and the trademark proprietor, and in particular that the reseller's business is affiliated to the trademark proprietor's distribution network or that there is a special relationship between the two undertakings—such use would not meet the honest practices test.

Turning now to the Complainant's detailed arguments on the applicability of the OKI DATA conditions in this case, it says it does not apply as: (1) the Respondent is not offering the Complainant's products or services but an appliance repair and maintenance service; (2) the Respondent does not publish a disclaimer; (3) the Respondent is depriving the Complainant of reflecting its own mark in the Disputed Domain Name; and (4) the Respondent presents themselves as the trademark owner by use of the Complainant`s logo mark. In short the Respondent's use of the Domain Name creates an overall impression that they are the Complainant and is not honest use.

As to (1) the rule extends to service and repair as well as to resales—see the discussion above. Further, it is well established that the OKI DATA rule applies to unauthorized or unofficial resellers and repairers just as it does to official agents, per WIPO Case D2001- 1292 (Volvo Trademark Holdings AB) (OKI DATA principles apply as long as he operates a business genuinely revolving around the owners' goods and services) and WIPO Case D2007 -1524 (nascartours) (OKI DATA applies to authorized and unauthorized sellers). See also Bettinger, 2nd Ed. P1387 ¶ IIIE.310. The cases cited by the Complainant are fact sensitive and represent the minority rather than the majority position under the UDRP. As to arguments (2-4), we need to look at evidence submitted of the website to which the Disputed Domain Name resolved. We note the website includes the following statements (extracted by the panel and translated by Google Translate on 1 May 2015):

"Tüm Franke ürünleriniz Servisimiz Garantisinde... Servisimiz İstanbul' un Her Semtine Franke ürünleriniz için Yerinde Servis Hizmeti, Kapıda Ödeme Seçeneği, Orjinal Parça ve 1 Yıl Parça Garantisi sunmaktadır. Detaylı bilgi için tıklayın." Per Google translate: "All our Franke products are under our Service Guarantee ...On-site service for your Franke products, door-to-door payment, original parts and 1 year parts Guarantee. Click for detailed information" and "Franke Ankastre Ürünlerinize Bakım, Onarım ve Servis Hizmetini tüm İstanbul genelinde sunmaktayız." Per Google Translates: "Franke Built-In Products We provide maintenance, repair and service throughout Istanbul."And "Franke Davlumbaz, firin, ocak teknik servisi cagri merkezi [telephone no]." Per Google Translate: "Franke Hood, oven, oven technical service call center." At the end of the site: "Tüm Franke ürünleriniz için Servis Çağrı = 444 0 569. Franke Beyaz Eşya - Franke Klima - Franke Şarap Dolabı Teknik Servisi © 2017. Sitemizde ve duyurularımızda ismi geçen logo ve marka ilgili firmanın tescilli markasıdır. Franke markasının özel teknik servisi olarak hizmet vermekteyiz." Per Google Translate: "Call for all your Franke products = 444 0 569Franke White Goods - Franke Air Conditioner - Franke Wine Cabinet Technical Service © 2017 The logo and brand name on our website and in our announcements are the registered trademark of the relevant company. As a special technical service of the Franke brand We

are serving." That last sentence also on another attempt translates as "We serve as a special technical service of Franke brand."

In the view of the panel, that the last sentence is a disclaimer of sorts. It is not possible to understand the precise meaning when dealing with translations however. We also must consider the words "Yetkili Servis Merkezi" which the Complainant relies on. This does translate as "Authorized Service Center." However the panel cannot see those words on the webpages submitted by the Complainant or on the wayback machine copy at the www.web.archive.org which has a copy of the website main landing page as at 20 April 2017. This was visited by the Panel on 2 May 2017. Further "Authorized" could mean 'regulated' in general terms or duly constituted and/or compliant with local law.

The overall impression is not that the Respondent is the Complainant or connected to it or necessarily authorized by it --and is equally consistent with an honest business that resells and services/repairs genuine Franke products without any official status. The Complainant says the telephone number on the website does not work, but it is not clear whether it worked prior to the Cease and Desist letter. The webpages do not use the Complainant's logo. While Franke, the word, is in red font in two places, the international and other registered marks submitted by the Complainant, and viewed by the panel, are not in red but black and white. The Complainant on its own .com site uses a red surround but the word itself is in white letters. The word Franke is coloured in red on the website at the Disputed Domain Name but only barely so and not in the same way as the use on the Franke.com site and does not take the use over the line to logo use in the panel's view. Competitors' goods are not also sold at the website.

There is good authority that the market for the domain name is not cornered when the marks is qualified by words such as "parts," "dealer," "resale" and "outlet" –and in the view of this panel, "service." Indeed, the addition of the term "service" in the Disputed Domain Name holds out that it is a provider of servicing services -- not the brand itself—and this must be considered together with the disclaimer. Internet users are savvy enough to know the difference and that there are authorized and unauthorized service agents and repairers and resellers. The fact that there are similar sites, such as Bosch, also makes sense where the Respondent also services other similar branded goods and is consistent with OKI DATA principles and good --and not bad --faith.

The view of the panel is that the OKI DATA principles are broadly met and the Respondent has a legitimate interest in the use of the Disputed Domain Name in light of its status as a reseller/repairer/servicer of the genuine goods.

Bad Faith

A finding of legitimate interests will often dictate the bad faith limb also. We note here that it is possible that the Respondent does not actually provide the services it holds out –but there is no satisfactory or reliable evidence on that issue and we are not prepared to assume or infer it. The wayback machine at the www.web.archive.org visited by the Panel on 2 May 2017 was the same as the evidence submitted. It was clear however that between registration in 2009 and until and including 2015, the Disputed Domain Name had unrelated non commercial content but it may have been parked pending business start-up. It is not, of itself, determinative and does not significantly impact the analysis. There is no satisfactory evidence that the purpose of the website is to gather personal data by phishing as opposed to a genuine form for service requests by the public and nor does this appear likely on the face of things to the panel. Nor is the failure to reply to a Cease and Desist letter sufficient --or the failure to participate here and defend. There are many reasons why a respondent may not come forward. The Complainant must still prove its case and the three limbs required by the UDRP. The panel finds insufficient evidence of bad faith use as at the date of this decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **FRANKE-SERVISI.COM**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2017-05-03

Publish the Decision