Decision for dispute CAC-UDRP-101897

Case number	CAC-UDRP-101897
Time of filing	2018-03-06 10:04:26
Domain names	vtusp.org

Case administrator

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

Complainant

Organization	Vojenský technický ústav, s.p.

Complainant representative

Name	JUDr. Libor Vašíček

Respondent

Name	Wang Zhi Yi

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of multiple trademark registrations with the Czech Industrial Property Office, among them:
Registration No. 228846 in classes 8, 9, 13, 37, 39, 40 and 42, registered on November 20, 2000.
Registration No. 240768 in classes 12 and 42, registered on January 25, 2002.
Registration No. 296968 in classes 6, 7, 8, 9, 12, 35, 37, 39, 40, 41, 42 and 43, registered on March 18, 2008.
Registration No. 338007 in classes 6, 7, 8, 9, 12, 13, 35, 37, 39, 40, 41, 42 and 43, registered on May 14, 2014.
The Complainant is a holder of the <vtusp.cz> domain registered on 30 July 2012.

FACTUAL BACKGROUND

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

I.

The Complainant is a Czech company (state enterprise) established by the Czech Ministry of Defence. Its business consists mainly of meeting strategic and other significant interests of the state in the field of defence and security, development of

capabilities of Czech Republic Army and other law enforcement authorities and integrated rescue system, development of the Czech Republic’s strategic know-how in the field of defence and security research and development. Its history dates back to 1922.

The Complainant is the owner of a number of combined trademarks, which consist in the wording or depiction of the word “VTÚ”, which is also abbreviated form of the Complainant's business name (Vojenský technický ústav s.p.). This concerns especially trademarks registered with the Czech Industrial Property Office with its registered office in Prague, maintained under numbers (a) 228846, (b) 240768 a (c) 296968, (d) 338007.

The trademark registration number 228846 is used in connection with a wide variety of services and goods including munition, weapons, removal of munition and transport services. The trademark registration number 240768 is especially used in connection with unmanned air vehicles and industrial research. The trademark registration number 296968 is used in connection with a wide variety of services and goods including armours, various kinds of weapons, weapons repairs and special military equipment research and development. The trademark registration number 338007 is used in connection with a wide variety of services and goods including armours, various kinds of weapons, weapons repair and special military equipment research and development.

The Complainant is a holder of the <vtusp.cz> domain, registered on 30 July 2012 ("Complainant's Domain").

As at the date of filing this complaint, the Respondent is the holder of the disputed domain name <vtusp.org> (“Domain Name”), and this Domain Name was registered on 8 February 2015. The Respondent operates the exact copy of the Complainant's website located under the Complainant's Domain. The only differences between the original website and its copy rests in altered contact details (especially in the site's footer) and limitation of website language only to English version.

The Respondent (the registrant name "" is translated by automatic means as "Wang Zhiyi") is also the holder of the <vtusp.cn> domain name, registered on 20 November 2014, which is not subject of these proceedings (because it does not fall within the scope of UDRP), but it is otherwise alike in all respects to the Domain Name.

II.
On 7 February 2018, the Complainant sent an notice by e-mail to the Respondent, requesting that the Respondent voluntarily transferred the Domain Name to the Complainant within 10 days from the date of receipt of that e-mail. The Respondent has not responded to this request as at the date of the filing.

III.
Due to the inability to resolve the transfer of the Domain Name from the Respondent to the Complainant in any other manner, the Complainant hereby files this complaint, stating, in accordance with paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy of 26 August 1999 (“UDRP Policy”) and paragraph 3(b)(ix) of the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), the following grounds for filing this complaint:

1. The Domain Name is identical or confusingly similar

i. The Domain Name contains a word element “VTÚ” (or "VTU" as the character "Ú" couldn't be standardly contained in a domain name), which is protected by the above trademarks of the Complainant, and the Complainant is the sole owner of such trademarks. The Domain Name creates the impression that it is an official website of the Complainant since the Domain Name is identical with the abbreviated form of the Complainant's business name and its trademarks.

ii. The element “VTU” is identical with word element included in Complainant’s combined trademarks that are registered with the Czech Industrial Property Office under numbers (a) 228846, (b) 240768 a (c) 296968, (d) 338007.

iii. For the sake of completeness, it should be pointed out that registration of trademarks only in the Czech Republic does not preclude the satisfaction of the first element. This results from WIPO decision in Case No. D2016-1425 - Assurances

Premium SARL v. Whois Privacy Shield Services / Daisuke Yamaguchi, that states the following: „[T]he ownership of a trademark is generally considered to be a threshold standing issue. The location of the trademark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. However, such factors may bear on a panel's determination whether the respondent has registered and used the domain name in bad faith under the third element of the UDRP.“

iv. The Domain Name contains (i) a dominant element “VTU”, followed by letters "SP" denoting abbreviated form of the legal form of the Complainant; and (ii) the generic domain designation, “.org”, which is a technical prerequisite for the registration of this domain and thus does not have a distinctive capability.

v. The element “VTU” as a dominant element has a distinctive function in the Domain Name. Its identity and, by extension, interchangeability is then mainly due to the fact that this designation is identical with the Complainant’s designation “VTU”, which is, among specialised circles and professionals in defence industry, known and perceived by them, due to the Complainant’s long tradition, as designation associated with the products and activities of the Complainant.

vi. Based on the above, it is beyond doubt that an Internet user will link the Domain Name with the designation of the Complainant’s products and with abbreviated form of the business name, in this case specifically with the Complainant’s website. When pronounced, the Domain Name is thus aurally perceived as identical with the Complainant’s trademarks. It is also perceived identically when read visually, and it is perceived identically also in terms of semantics. The element “VTU” included in the Domain Name is thus interchangeable for the average Internet user in all aspects, both in the phonetic as well as visual and semantic aspects. The presence of the element “VTU” leads the average Internet user to a reasonable conclusion that the Domain Name is in some way connected with the Complainant, its products or services and, by extension, with its business as such.

vii. Since in some of the aforementioned trademarks of the Complainant the visual elements prevail, the Complainant refers to, for example, the WIPO decision in Case No. D2001-0031 - Sweeps Vacuum & Repair Center, Inc. v. Nett Corp., which states that “In addition, graphic elements, such as the Sweeps design, not being reproducible in a domain name, need not be considered when assessing identity or confusing similarity.”

viii. The interchangeability of the Domain Name and the Complainant’s designation is absolutely clear and undisputed as the designation “VTU” is protected by both Czech and foreign legal regulations in relation to the Complainant, not the Respondent, and the Domain Name is thus interchangeable with the Complainant’s designation.

ix. With regard to the above, the Complainant believes that the condition referred to in paragraph 4(a)(i) of the Policy should be considered satisfied.

2. Lack of the Respondent’s right or legitimate interests to the Domain Name or the Complainant’s designation

i. There is no legal protection related to the element “VTU” in favour of the Respondent. Neither the Complainant nor any of the beneficiaries or persons exclusively entitled to use the aforementioned trademarks have provided the Respondent with consent with the use of the “VTU” designation in the Domain Name or otherwise.

ii. The Respondent has been using this designation in the Domain Name without any right to use the designation.

iii. The Respondent uses the Domain name for commercial gain, when under the Domain Name the altered copy of the Complainant’s website is being shown, where especially the contacts are altered thus misleading consumers.

iv. Since (i) the Respondent does not have any right to the Complainant’s designation identical with the Domain Name; (ii) before the dispute initiation, the Respondent had not been using the Domain Name for bona fide purposes in connection with offerings of goods or services, and had not demonstrably made preparations for such use; (iii) the Respondent is not commonly known under the Domain Name; (iv) the Respondent is not using the Domain Name for honest purposes, free from intentions to mislead a third party or tarnish the Complainant’s reputation or designation (see above); (v) solely the

Complainant and entities authorised by it are entitled to use the aforementioned trademarks; (vi) the Respondent has not been granted any consent to use the VTU designation in the Domain Name; and (vii) the Domain Name is an artificial creation not similar to any common word, which the Respondent must have been aware of while making a copy of Complainant's website.

v. Based on the above, the Complainant believes that the condition referred to in paragraph 4(a)(ii) of the Policy has been satisfied. It can therefore be concluded that the Respondent does not have any right to the Domain Name or the Complainant's designation.

3. Lack of the Respondent's good faith

i. The Respondent believes that the Respondent has registered and been using the Domain Name not in good faith.

ii. The Complainant infers the Respondent's bad faith in particular from the following: (i) the Respondent must have been aware of the existence of the element "VTU", which is abbreviated form of Complainant's business name and with which the Complainant has registered the trademarks; (ii) the Respondent intentionally operates the altered copy of the Complainant's website located under the Complainant's Domain; (iii) the Respondent registered the domain name of the same wording under different top-level domain; and finally, (iv) the Domain Name creates the impression that it is the Complainant's website. The Respondent must have known the "VTU" designation with respect to above-mentioned, it cannot have registered it accidentally, and it is therefore probable it registered the Domain Name with the intent to attract Complainant's customers.

iii. The Complainant concludes that with regard to the above, the Respondent's conduct can be seen as registration and use of the Domain Name in bad faith, and therefore believes that the condition referred to in paragraph 4(a)(iii) of the Policy should be considered satisfied.

iv. The Complainant requested that the language of the proceeding should be English. The reasons behind this are as follows: (i) English is lingua franca used for international communication and therefore known to the Respondent; (ii) It is a fair compromise to use English for both parties, as English is not the first language of either party; (iii) The Respondent has also registered another domain in Latin script, the <certificationconsortium.cn>, that contains two English words – certification and consortium – thus showing the Respondent's ability to understand English (see Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; Orlane S.A. v. Yu Zhou He / He Yu Zhou, WIPO Case No. D2016-1763); (iv) The content displayed under the Domain Name is only in English, not in Chinese, and although the content is a copy of the Complainant's website located under the Complainant's Domain, it is altered by the Respondent; upon that the Respondent's knowledge of English could be inferred (see Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; Valvoline Licensing and Intellectual Property LLC v. Andrei Arhipov, WIPO Case No. D2017-2453); (v) The Respondent targets English speaking Internet users with the website displayed under the Domain Name, in particular by the contained altered contacts (the dialling code +0044 is being used for UK) therefore showing his preparedness to communicate in English.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to be 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 disputed 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 that 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 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

A. Language of the Proceeding:

Paragraph 11 of the Rules provides that:

"(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."
The language of the Registration Agreement for the disputed domain name is Chinese.
The Complainant requested that the language of the proceeding be English.
The Respondent did not respond.
The Panel cites the following with approval:
" Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (Groupe Auchan v. xmxzl, WIPO Case No. DCC2006 0004).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:
(i) The disputed domain name consists of Latin letters, rather than Chinese characters;
(ii) The content of the website under the disputed domain name is in the English language;
(iii) The content of the website under the disputed domain name is a copy of the Complainant's website and Respondent altered the content such that it can be reasonably assumed that he has some working knowledge of the English language;
(iv) The Respondent is targeting English speaking Internet users and provides a UK phone number as his contact number and it is reasonable to assume that he will receive and process phone calls and e-mails in the English language;
(v) The Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language;
(vi) The Respondent did not object to the Complainant's request that English be the language of the proceeding.

Upon considering the above, the Panel determines that English be the language of the proceeding.

B. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant is the owner of the following trademark registrations with the Czech Industrial Property Office:

Registration No. 228846, VTUVM (figurative mark) in classes 8, 9, 13, 37, 39, 40 and 42, registered on November 20, 2000.
Registration No. 240768, VTULaPVo PRAHA (figurative mark) in classes 12 and 42, registered on January 25, 2002.
Registration No. 296968, VTUPV (figurative mark) in classes 6, 7, 8, 9, 12, 35, 37, 39, 40, 41, 42 and 43, registered on March 18, 2008.
Registration No. 338007, VTU (figurative mark) in classes 6, 7, 8, 9, 12, 13, 35, 37, 39, 40, 41, 42 and 43, registered on May 14, 2014. ("the VTU trademarks")
The Panel notes that the VTU trademarks are all figurative marks. Panel assessment of the identity or confusing similarity must involve the comparison between the disputed domain name and the textual component of the complainant's trademarks. As such the design elements are to be disregarded and the textual part of the mark used, so long as the design elements do not comprise the dominant part of the relevant marks or the textual part of the relevant marks were not disclaimed.
In the present case, the fact that the disputed domain name is used by the Respondent to operate an exact copy of the Complainant's website having altered contact details is of importance since the Respondent is using the Complainant's registered trademark VTU with their figurative element in their entirety on the Website under the disputed domain name. Under such circumstances, the examination of the disputed domain name with the Complainant's trademarks must give credence to the identity of use of the Complainant's trademarks by the Respondent.
Accordingly, the disputed domain name <vtusp.org> incorporates the Complainant's trademark (Registration No. 338007) with the dominant VTU component. The disputed domain name defer in the component "sp" and the gTLD suffix ".org" . The addition of the component "sp" refers to a bygone Czechoslovakian state designation for a business entity which appears at the end of the complainant's full name - Vojenský technický ústav s.p. The Complainant is the holder of the <vtusp.cz> domain name, registered on 30 July, 2012, with the component "sp". Therefore, the "sp" addition is not sufficient to avoid confusing similarity between the disputed domain name and the Complainant's trademark. Also, the generic domain designation, ".org", which is a technical prerequisite for the registration of this domain and thus does not have a distinctive capability (see F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451, and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).
Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's VTU trademarks.

C. Rights or Legitimate Interests

Once the Complainant establishes a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 3.0"), paragraph 2.1).
In the present case, the Complainant has demonstrated to the Panel that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent had failed to assert any such rights or legitimate interests. This is so, even though some of the VTU Trademarks consists of the word VTU trademark plus an additional term and a graphical element, because the Complainant evidence shows that the Website under the disputed domain name is an unauthorised copy of the Complainant's Website with altered contact details, which effectively impersonates or suggests sponsorship or endorsement by the trademark owner.
The Respondent is not commonly known by the disputed domain names nor is he known as VTU or VTUSP. There is no legal protection related to the element "VTU" in favor of the Respondent. The Respondent has not submitted a response to explain why he had copied the Complainant's website in its entirety while changing the contact details and did not provide any evidence to show any rights or legitimate interests in the disputed domain name that is sufficient to rebut the Complainant's prima facie case.
In the circumstances of this case and in light of the Respondent's lack of use of the disputed domain name, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

D. Registered and Used in Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith ([paragraph 4(a)(iii) of the Policy)]. Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The burden placed on the Complainant is to bring evidence showing circumstances that indicate that the Respondent registered and used the disputed domain name in bad faith. A Panel will look into the totality of the circumstances in each case, and these can include evidence of the degree of distinctiveness or reputation of the mark, the failure of the Respondent to file a response and the implausibility of any good faith use to which the domain name may be put.

To show that the Respondent registered the disputed domain name in bad faith, the Complainant argued that the disputed domain name and the Complainant´s mark are similar, that the Respondent knew of the Respondent's trademark due to the Complainant's trademark reputation and intended to take advantage of the Complainant's trademark and goodwill of the Complainant. Based on this evidence the Complainant argued that the Respondent was attempting to pass off as the Complainant.

The Complainant submitted evidence showing that without authorization, the Respondent copied the entire Website of the Complainant and is using the unauthorized copy of the Complainant's Website with altered contact details under the disputed domain name. There can be no better example of bad faith registration and use than this. Clearly, the Respondent was aware of the Complainant's trademarks when he registered the disputed domain name. There can be no imaginable good faith use when the Respondent places under the disputed domain name a copycat Website of the Complainant with altered contact details. Such behavior clearly amounts to an intentional attempt to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the website.

The Complainant sent a cease and desist letter to the Respondent, requesting that the Respondent voluntarily transferred the disputed domain name. However, the Respondent has not responded to this request as at the date of the filing. Under the circumstances of this case, the failure by the Respondent to respond to the cease and desist letter sent by the Complainant is suggestive of the Respondent's bad faith.

Considering these facts, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VTUSP.ORG**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2018-04-17

Publish the Decision