Decision for dispute CAC-UDRP-102474

Case number	CAC-UDRP-102474
Time of filing	2019-06-07 12:59:18
Domain names	nungessergmbh.com

Case administrator

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

Complainant

Organization	KM Commodities AG

Complainant representative

Organization	Rechtsanwälte Kolb, Blickhan & Partner

Respondent

Organization	See PrivacyGuardian.org/Domain Administrator

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of European trademark No. 013219795 “Nungesser”, registered on March 3, 2015 for goods and services in classes 6, 21, 29 30, 31, 35, 42.

FACTUAL BACKGROUND

The Complaint is based on the following grounds:

A. The disputed domain name <NUNGESSERGMBH.COM> is identical or confusingly similar to a trademark in which the Complainant has rights.

• The Complainant is the registered owner of the european trademark no. 013219795 “Nungesser” registered on March 3, 2015 for goods and services in classes 6, 21, 29 30, 31, 35, 42.

• The Complainant is a commodity trader for baked seeds, nuts and other specialties. The Complainant registered class 6 for “preserving boxes of metal, class 21 for “preserve glasses”, class 29 for “marmalade; oils and fats; processed fruits, Fungi and vegetables (including nuts and pulses)”, class 30 for “natural starches for food; processed grains, starches and goods

made thereof, baking preparations and yeasts; Spices; Salts, seasonings, flavourings and condiments", class 35 for "wholesale services in relation to fodder for animals; Wholesale services in relation to lubricants; Wholesale services in relation to foodstuffs" and class 42 for "constructing an internet platform for electronic commerce".

• The disputed domain name registered in January 2018 is confusingly similar to the Complainants trademark where it incorporates the Complainant´s trademark in its entirety. In case at hand, the Complainant´s registered trademark "NUNGESSER" is fully included in the disputed domain name. It is true that the disputed domain name <NUNGESSERGMBH.COM> contains an additional generic term "gmbh" and the gTLD.com none of which distinguish the disputed domain name from the Complainant´s trademark.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name.

• The Complainant believes that the Respondent has no rights or legitimate interests in respect of the disputed domain name since, to the best of the Complainant´s knowledge, the Respondent is not commercially linked to the Complainant. Furthermore, the Complainant informs that it never granted the Respondent any authorization, consent, right or license to use the trademark "NUNGESSER" within the disputed domain name or in any other way. Additionally, the Complainant has made research and found no trademarks or any other rights owned by the Respondent on the "NUNGESSERGMBH" or "NUNGESSER" term.

• It is not clear why the Respondent must use the trademark of the Complainant. The Respondent could use any other name for his domain.

• Before any notice to the Respondent of the dispute, there is no evidence of the Respondent´s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

• The Respondent is not commonly known by the disputed domain name.

• The Respondent is not making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service at issue.

C. The disputed domain name was registered and is being used in bad faith.

• The Complainant contends that the disputed domain name was registered and is being used in bad faith. In particular, the Complainant states that "NUNGESSER" trademark has enjoyed wide-spread extensive use and is widely well-known and that, accordingly, it seems inconceivable that the Respondent was not aware of the Complainants prior rights when the disputed domain name was registered. This is especially true, considering the fact that the Respondent is using the old address of the Complainant´s company "NUNGESSER" – "Am Steimel 12; GER-64397 Modautal". In the first known mail from the Respondent, he offered the goods mentioned on the domain name <NUNGESSERGMBH.COM> for a certain price without sending an invoice. On May 22, 2018 the Complainant tried to order goods offered on the domain name <NUNGESSERGMBH.COM>. The Respondent then sent an invoice. Recently the Complainant received an e-mail from the police Südhessen (Germany) that the operator of the domain <NUNGESSERGMBH.com> is still active. They continue to send e-mails including invoices to requesting customers. All e-mails name different contact persons, addresses, e-mails, bank account contacts or phone numbers. It is therefore clear, in the Complainant´s view, that the Respondent had the Complainant or its trademarks in mind when registering the disputed domain name.

• The Complainant sees no possible way whatsoever that the Respondent would use the disputed domain name in connection with a bona fide offer of products or services. Indeed, any use of the "NUNGESSER" trademark without authorization would amount to trademark infringement and damage to the repute of the trademark. In the Complainants view, the sole detention of the disputed domain name by the Respondent in an attempt to prevent the Complainant from

reflecting its trademark in a domain name, is a strong evidence of bad faith. According to the Complainant, any actual use of the disputed domain name by the Respondent would amount to bad faith active use.

• In order to hide the identity of the domain holder, the Respondent registered the disputed domain name via privacyguardian.org. PrivacyGuardian is an organization to hide the information of a domain registrant when buying a domain name.

• By using the disputed domain name the Respondent has intentionally attempted to attract, for gaining, Internet users, to create a likelihood of confusion with the Complainant´s mark "NUNGESSER" as to the source and affiliation of the Respondent´s website or location.

• The Respondent registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant.

PARTIES CONTENTIONS

No administratively compliant response has been submitted.

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, 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 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

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The disputed domain name is confusingly similar to the Complainant's trademark. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain name (i.e. ".com"), and

b) not finding that the addition of a generic element (such as "GMBH") would be sufficient to distinguish a domain name from a trademark. The abbreviation GMBH is the German abbreviation for a limited liability company which is a "Gesellschaft mit beschränkter Haftung". It is commonly placed behind the distinctive name as is the case in the disputed domain name <NUNGESSERGMBH.COM>. Such an indication of the legal character of an entity is no more a distinctive element in the comparison of names, trademarks or domains than the top-level suffix in a domain name.

The element NUNGESSER is identically contained in the disputed domain name and in the earlier trademark.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name other than for the purpose of registering the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

The Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations for use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name.

On the contrary, The Complainant has further shown that the Respondent was seeking to create a false impression of association with the Complainant, which does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

The use made by the Respondent illustrates awareness of the earlier rights of the Complainant by using the very address of the Complainant´s company “NUNGESSER” – “Am Steimel 12; GER-64397 Modautal”, even if this is no longer the current address.

In e-mail correspondence, the Respondent offered the goods listed on the disputed domain name for a particular specified price and upon the Complainant’s attempt to order the goods, the Respondent sent an invoice. In May of 2019, the German police notified the Complainant of the continuing activity of the domain <NUNGESSERGMBH.com>. According to the police, the operator continued sending e-mails including invoices to potential customers. In doing so, all e-mails name different contact persons, addresses, e-mails, bank account contacts or phone numbers.

Such use of the “NUNGESSER” trademark without authorization in the disputed domain would amount to trademark infringement and damage the reputation of the trademark. Use of the disputed domain name by the Respondent in the manner described above is strong evidence of bad faith.

Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NUNGESSERGMBH.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2019-07-25

Publish the Decision