Decision for dispute CAC-UDRP-102532

Case number	CAC-UDRP-102532
Time of filing	2019-06-14 09:45:55
Domain names	oknoplast-finestre.com, oknoplastfinestre.com, oknoplastitalia.com, oknoplast-store.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Oknoplast IP Management Sp. z.o.o. Sp. K.

Complainant representative

Organization	Avvocati Associati Franzosi Dal Negro Setti

Respondent

Organization	SKEMA LIBERO S.r.l.s unipersonale

OTHER LEGAL PROCEEDINGS

The same domain names have been subject of the proceeding no. 102351 before the Czech Arbitration Court which has been rejected.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of several trademarks for "OKNOPLAST". The Complainant submitted evidence of the following trademark registrations:

(i) International trademark registration no. 903237 for "OKNOPLAST" word, registered on 20 June 2006 in class 19, designating numerous countries;

(ii) EU trademark registration no. 007490345 for "OKNOPLAST" word, registered on 17 May 2010 in classes 6, 19 and 37; and

(iii) EU trademark registration no. 010291061 for the caption of "OKNOPLAST" in navy blue, capital straight letters and placed above it a blue schematic picture of a window with open folding shutters, registered on 28 March 2012 in classes 6, 19, 35, 37, 40, 41, 42 and 45.

FACTUAL BACKGROUND

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

The Complainant, Oknoplast IP Management Sp. z.o.o. Sp.K., is a Polish company that owns the above-identified trademarks and that is well known in Europe, including in particular Italy (where it has a high market share), as one of the leader companies in the PVC window industry. The Complainant has been one of the leader companies in its field for more than 20 years. It counts almost 3,000 sales outlets in 13 countries and sells around 1,500,000 windows units per year. The Complainant has been several times awarded for its activities. It has grown fast during the last few years, hitting the peak of the sales for more than EUR 100 million per year. It is the second-largest windows joinery supplier in Italy. The Complainant has also been the sponsor of important European football clubs, such as the French Olympique Lyon and Italian F.C. Internazionale (Inter).

The Respondent's activity appears to be, among others, the sale of windows.

The disputed domain names were registered on 10 October 2016 (oknoplast-finestre.com), 11 October 2016 (oknoplastitalia.com and oknoplast-store.com), and 14 February 2017 (oknoplastfinestre.com).

The Complainant sent a cease and desist letter dated 23 October 2018 to the Respondent and to the company NOSKEMA VS S.r.l.s., requesting inter alia the transfer of all the domain names with the word "OKNOPLAST" to the Complainant.

On 8 October 2018, the Complainant requested the Italian Arbitration Court (PSDR) to transfer the similar national domain names “oknoplast-store.it” and “oknoplast-italia.it”, both also registered by the Respondent. The Italian Arbitration Court (PSDR) granted such request on 24 January 2019 and the respective domain names were transferred to the Complainant.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain names and that the language of the registration agreement is Italian.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

With respect to identical or similar domain requirement, the Complainant asserts that the disputed domain names are practically identical to the Complainant's trademarks as well as its domain names that are composed of the word "OKNOPLAST".

Firstly, the Complainant argues that the disputed domain names contain entirely the word "OKNOPLAST" which is the only word of which the Complainant's trademarks are composed. The Complainant refers to the CJEU decision No. T-346/04 of 24 November 2005 and argues that where a prior trademark is contained in a later filed more complex sign, both signs are usually considered identical.

Secondly, according to the Complainant, the disputed domain names differ from its trademarks and domain names just for the addition of descriptive and generic words "finestre" (meaning "windows" in Italian), "store" and "Italia" (meaning "Italy" in Italian). The Complainant contends that using words meaning "windows", "store" and "Italy" to indicate the activity of selling windows in Italy is clearly descriptive. Therefore, those three words added to "OKNOPLAST" in the disputed domain names are not able to confer those domains any distinctive character and are not able to exclude the risk of confusion between those domain names and the Complainant's trademarks. The Complainant points to Section 1.8. of the WIPO Overview 3.0 which provides that "where the trademark in question is recognizable within the disputed domain name, adding other terms (which are descriptive, geographical, pejorative, meaningless or otherwise) does not prevent the risk of confusion".

The Complainant further mentions that the risk of confusion has been assessed by the Italian Arbitration Court, which after having recalled the WIPO guidelines, held that the addition of the terms "store" and "Italy" does not exclude the risk of

confusion between the distinctive signs in conflict, given that these are words that can be easily associated to the applicant's business area.

The Complainant, therefore, sums up that the disputed domain names are identical to its trademarks or, at least, are confusingly similar, being the only differences secondary and descriptive expressions added to the highly distinctive word "Oknoplast" registered by the Complainant as trademarks and which is also the Complainant's company name.

Regarding Respondent's rights or legitimate interests, the Complainant argues that according to the Respondent's company registration certificate, the Respondent has nothing in common with the "OKNOPLAST" fantasy name (no owner's name, no company name, no business name, etc.). The Respondent allegedly never had any commercial relationship with the Complainant and has never been authorized by the Complainant to use the relevant trademarks in its commercial activity.

All the disputed domain names are connected to the same active webpage in which the Complainant's trademarks are also used, without any authorization from the Complainant. Moreover, the Complainant claims that undue use of the word "OKNOPLAST" made on the website connected to the disputed domain names is clearly of commercial nature, and specifically points to the following statements on the website: "GRANDI PROMOZIONI OKNOPLAST. Questo Anno Regalati le Nuovissime Finestre PROLUX. Clicca QUI per Scoprire le Offerte", "Contattateci per Avere un Preventivo Gratuito per le Vostre Nuove Finestre in PVC Oknoplast Prolux", "Contattaci per un Preventivo Gratuito" (in English: "OKNOPLAST BIG PROMOTION. This Year Give yourself the Brand New Prolux windows. Click HERE to discover the offers", "Contact us for a Free Estimate for Your New Oknoplast Prolux PVC windows" "Contact us for a Free Estimate"). The Complainant states it is clear that the goal of the Respondent is to disrupt the business of the Complainant and to attract, for commercial gain, Internet users to its website unduly suggesting some sort of partnership with the Complainant and creating confusion, that being clearly illegitimate pursuant to Par. 4 (b) (iii) (iv) of the Policy.

Furthermore, the Complainant asserts that there is not only the risk of confusion between the disputed domain names and the Complainant's trademarks but there is also an effective and ongoing damage to the Complainant's market share due to the Respondent attracting and misleading clients who search for the Complainant's products, and to the Complainant's good name resulting from the Respondent's disservices to clients, and existence of the disputed domain names and related website creates prejudice to the Complainant's reputation.

Turning to the bad faith argument, the Complainant makes the following assertions.

It cannot be argued that the Respondent did not know the existence of the Complainant's right to the trademark "OKNOPLAST" and related domain names because, firstly, the Complainant sent a cease and desist letter on 23 October 2018 to the Respondent informing it of its rights. The Complainant argues that there is no doubt the Respondent was made well aware of the existence of the Complainant's trademarks.

Secondly, the Complainant is a very well-known company in the European market of PVC windows and therefore the Respondent who is active on the same market, at least should have known about the Complainant and its prior rights before registering the disputed domain names. The Complainant emphasizes that it has gained high visibility in Italy due to its important sponsorships (eg. Internazionale Football Club).

Thirdly, the Complainant argues that the webpage connected to the disputed domain names mentions also another company (NOSKEMA VS S.r.l.s.) that once was the Complainant's distributor in Italy, who had no right to register domain names or trademarks containing the word "OKNOPLAST". While the Complainant considers it uncertain how that company is connected to the Respondent, it concludes that there must be at least some collaboration between them. Therefore, the Complainant considers it undeniable that Noskema knew about the Complainant and reasonably informed the Respondent about "OKNOPLAST" trademarks.

Fourthly, the Complainant claims that the Respondent must have known about the Complainant because the Complainant had already proceeded against the Respondent before the Italian Arbitration Court and had the domain names "oknoplast-store.it" and "oknoplast-italia.it" registered by the Respondent reassigned. The Complainant then summarizes the

conclusions of the Italian Arbitration Court regarding the bad faith element.

Lastly, the Complainant asserts that the Respondent unlawfully uses its trademarks on the webpage related to the disputed domain names, showing it is aware of the Complainant's existence (and its appeal to the public). The Respondent's website connected with the disputed domain names indicates the Complainant's trademarks both in their verbal and graphic form (which according to the Complainant cannot be a coincidence but a conscientious choice to use competitor's prior trademarks as domain names).

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Complainant requested that the proceedings be held in the English language despite the language of the Registration Agreement is Italian. The Complainant substantiated its request by stating that there is no doubt the Respondent speaks or at least understands English. The Complainant submitted a printout from the archiproduct.com website where it appears that that the Respondent offers and sells its products through an on-line platform which expressly addresses English speakers or the UK public in general and allows consumers to contact directly (and therefore communicate with) the Respondent through an English on-line platform. The Complainant also argues that according to Italian case law (for example in trademark matters) it is now widely stated that English language and words are mostly understood in Italy.

The Panel decided to grant the request and agreed to change the language of the proceedings to the English language. In addition to the arguments laid out by the Complainant, the Panel also took into account the fact that the Respondent has been inactive not only in present proceedings (including failure to respond to the cease and desist letter drafted in Italian language) but also in the proceedings before the Italian Arbitration Court (PSDR) that were conducted in Italian language. Furthermore, based on the Italian company register extract presented by the Complainant as Annex 9, the Respondent is an inactive company. Given that the CAC employed reasonably available means of communicating with the Respondent by sending the written notice of the Complaint as well as notices to all available email addresses, although unsuccessfully, and given that according to the CAC the Respondent actually accessed the online platform on 15 July 2019, the Panel believes that the Respondent was given a fair opportunity to not only present its case, but also to comment or oppose the change of language of proceedings, and have failed to do so. In absence of any hint of the Respondent's activity, the proceedings should continue with due expedition.

Therefore, 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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4 (a) of the Policy, the Complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated, and the Panel has verified, that it owns the three asserted trademark registrations for the mark "OKNOPLAST", both word and device. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The disputed domain names are all formed by a combination of the word "oknoplast" and another word ("finestre", "store" or "italia"), whether linked by a hyphen or not. The "oknoplast" part of the disputed domain names is identical to the Complainant's word trademarks "OKNOPLAST" and to the word element of the Complainant's device trademark. The Panel is of the view that the words added to the "oknoplast" name in the disputed domain names (i.e. windows, store, and Italy) are generic and descriptive, especially in the context of the relevant activity (i.e. selling windows in Italy). The "oknoplast" part of the disputed domain names has, on the other hand, a distinctive character which makes the disputed domain names confusingly similar to the respective Complainant's trademarks. The Panel concurs with the Complainant that according to established UDRP case law the addition of descriptive terms to a trademark recognizable within a domain name does not prevent a finding of confusing similarity under the first element.

The Panel, therefore, finds that the disputed domain names are confusingly similar to trademarks in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Complainant argues that the Respondent does not have any legal right to use the name "OKNOPLAST" as part of its domain name and that the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant's trademarks for its commercial activities.

The Complainant further submits that the undue use of the word "OKNOPLAST" made on the website connected to the disputed domain names is clearly of commercial nature and has the goal of disrupting the Complainant's business and attracting, for commercial gain, Internet users to the Respondent's website unduly suggesting some sort of partnership with the Complainant. According to the Complainant, such use causes damage to the Complainant's market share as well as its good name and reputation.

The Respondent has not filed a Response and there is no evidence that the Respondent has used or has been preparing to use the disputed domain name in connection with a bona fide offering of goods or services, or for a legitimate non-commercial or fair use, without intent for commercial gain, or that the Respondent has been commonly known by the domain name.

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain names.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states that the Respondent is not only using the trademark of the Complainant in its domain names, but also on the webpage related to the disputed domain names, both in its verbal and

graphic form.

The Complainant has submitted evidence that the Panel believes sufficiently demonstrates that the Respondent must have been aware of the existence of the Complainant and its trademarks because of the earlier communication, the Italian domain arbitration proceedings, as well as goodwill and notoriety of the trademarks arising from the Complainant's size of business and sponsorship of a well-known sports club.

It is well established that mere registration of a domain name that is confusingly similar to a widely-known trademark by an unaffiliated entity can lead to the presumption of bad faith. Furthermore, typical circumstances demonstrating respondent's bad faith include a situation where the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trademark or its products or services on the respondent's website.

The Panel has already found that the domain name is confusingly similar to the Complainant's trademark "OKNOPLAST". Having compared evidence submitted by the Complainant (screenshots of the Complainant's website operated on the disputed domain names), the Panel is satisfied that the Respondent's website contains trademarks of the Complainant, making the Respondent's website appear as affiliated with the Complainant. In absence of the Respondent's Response, there seems no reasonable explanation as to why the Respondent would register and use the disputed domain names other than to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

The Panel disregarded information about the earlier Complainant's Italian distributor NOSKEMA VS S.r.l.s. While it could perhaps be indicative of the Respondent's bad faith if there was some link with the previous distributor of the Complainant, the Panel is of the view that the statements and documents submitted by the Complainant are not sufficient enough to draw any particular conclusions regarding connection with the Respondent and its knowledge.

In conclusion, the Panel finds that all three elements required by Paragraph 4 (a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OKNOPLAST-FINESTRE.COM**: Transferred
2. **OKNOPLASTFINESTRE.COM**: Transferred
3. **OKNOPLASTITALIA.COM**: Transferred
4. **OKNOPLAST-STORE.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2019-08-10

Publish the Decision