Decision for dispute CAC-UDRP-102597

Case number	CAC-UDRP-102597
Time of filing	2019-09-10 09:42:42
Domain names	aero-vodochody.net

Case administrator

Name	Lenka Náhlovská (Case admin)

Complainant

Organization	AERO Vodochody AEROSPACE a.s.

Complainant representative

Organization	Law office Cech Hromek Pleskac, LLC

Respondent

Name	Jiří Dvořák

OTHER LEGAL PROCEEDINGS

The Panel has been informed by the Respondent that a civil law suit has been filed by the Complainant seeking judgment ordering Respondent to shut down web site www.aero-vodochody.net. The court issued preliminary court order, forcing the Respondent to shut down this web site. The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of registered EU trademarks no. 11418027 “AERO VODOCHODY” and no. 11347457 “AERO VODOCHODY AEROSPACE”, both registered since 2012. The Complainant is further the owner of the several Czech trademarks that contains the term “AERO” – trademark O-16779 registered since 1930, trademark O-35901 registered since 1965 and trademark O-154437 registered since 2000. The full business name of the complainant further contains term “AERO VODOCHODY” whereas the term “VODOCHODY” is the name of the place where the factory of the Complainant is located. The disputed domain name was registered on August 10, 2017.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is based in the Czech Republic and it is historically the largest producer of military jet trainers in the world with more than 11,000 aircrafts produced totally and over 13,000,000 flight hours' total log of the fleet. The Complainant cooperates with major global aircraft manufacturers on commercial and military programs. In 2019 the Complainant celebrates the 100th anniversary of its existence.

The Complainant uses and operates the official website "www.aero.cz". The Respondent uses and operates the false website "www.aero-vodochody.net". The Complainant asserts that the Respondent holds no connection to the Complainant, either as a dealer, agent, distributor, wholesaler or retailer of the Complainant.

The disputed domain name, according to the Complainant, is identical to its EU trademark no. 11418027 "AERO VODOCHODY" dating as early as 2012. Furthermore, the disputed domain name is confusingly similar to other Complainant ´s trademarks. All these other Complainant´s trademarks listed above contain the term "AERO" and/or "VODOCHODY" and they are clearly recognizable in the disputed domain name.

The most distinctive part of the disputed domain name is "AERO", which is identical to the Complainant´s trademarks listed above. The most distinctive element of the Complainant's trademarks is the term "AERO", which is exactly replicated in the disputed domain name.

The addition of the dash and of the term "VODOCHODY" does not avoid the confusing similarity between the disputed domain name and Complainant's trademarks: in fact, AERO is recognizable in the disputed domain name.

Additionally, the other distinctive part of the disputed domain name is "VODOCHODY", which is again identical to or confusingly similar term to the Complainant´s trademarks which contains the same term "VODOCHODY" and the company/trade name of the Complainant, which contains the same term "VODOCHODY" as well as the term "AERO". It is worthwhile to mention that the term "VODOCHODY" refers originally to the location of the main factory and production plant of the Complainant which is still in full operation.

Finally, it should be noted that the disputed domain name would likely mislead and direct customers or businesses away from the Complainant's legitimate websites www.aero.cz.

The Complainant asserts that the Respondent is the former employee of the Complainant and he is an author of the articles published on the disputed domain name web site, however he tried to conceal his identity as a disputed domain holder from the public using the proxy services, whereas the use of a privacy protection service when registering the disputed domain name is evidence of the Respondent's bad faith.

The Complainant asserts that the Respondent has in previous cases been found to be in violation of the UDRP Policy, similar to the present Complaint, in support of their bad faith assertion against the Respondent.

The web site operated under the disputed domain name apparently looks like and pretends to be an official web site of the Complainant and it is full of malicious content. It is the view of the Complainant that the Respondent has intentionally registered the disputed domain name which replicates the most distinctive elements of the Complainant's trademarks: "AERO" and "VODOCHODY".

The disputed domain name is being used for publishing untrue, false, defamatory and libelous articles about the Complainant, its business, products, board members, employees etc., which is illegal and could be detrimental to the good reputation of the Complainant.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that (i) only the Complainant is allowed to use its trademarks and company/trade name; (ii) the Respondent allows and enables use of the disputed domain name to publish illegal content and this could tarnish the Complainant's trademarks, company/trade name and image. This situation is also capable to damage the Complainant's good reputation.

Furthermore, the Complainant asserts that the Respondent chose the disputed domain name to create a likelihood of confusion with the Complainant's trademarks and with the Complainant's official web site www.aero.cz and ultimately to confuse the Complainant's clientele and customers into believing that there would be some sort of affiliation between the disputed domain name and the Complainant, solely for the Respondent's commercial gain and other unfair purposes.

As to the use of the disputed domain name in bad faith it is worthwhile to note that the Respondent created and operates the web site in such a manner which is identical and similar to the Complainant's official web site www.aero.cz including, but not limited to, its graphic design, which is illegal. Such use cannot be considered a bona fide use and is detrimental to the Complainant's trademarks, image and good reputation.

Finally, the Complainant submitted enforceable judgment rendered by the Czech criminal court according to which the Respondent was convicted as an offender of various criminal attacks against the Complainant´s employees with respect to their working activities for the Complainant. It should be emphasized that the penal attacks conducted by Respondent were aimed at the Complainant and a good reputation of its employees and included criminal defamation and blackmailing. It should be also stressed in this regard that the criminal attacks conducted by the Respondent have been continuing up to now (in spite of the criminal judgment rendered by Czech penal court) and from the Complainant´s perspective they mean unwelcome events of serious misconduct.

It is duly established that the disputed domain name is misused to the detriment of the Complainant and webpages which are operated under the disputed domain name obviously serve as a vehicle and place to commit criminal activities and the Respondent is fully liable for such wrongful activities.

The Complainant therefore suggests that the Panel should take into consideration that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. Webpages are clearly operated with dishonest intent – to tarnish the Complainant´s trademarks and services and to damage its good reputation.

Such use can neither be considered as bona fide offering of goods or services nor 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 mark at issue.

The Complainant is convinced that it has sufficiently proven in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it, according to paragraph 4(a) of the Policy.

When a domain name wholly incorporates a complainant's registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. The top-level suffix .NET is also generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for functionality of a website.

Furthermore, the Respondent has obviously no rights or legitimate interests in respect of the disputed domain name. One of the key factors that corroborate a finding of bad faith is that the disputed domain name was registered in 2017, which is long after the Complainant filed for its first registered trademark in 1930.

The Respondent is not affiliated with nor authorized by the Complainant in any way, and it is not related in any way to the Complainant's business.

The Respondent has registered the domain name with no intention to use it for its legitimate entrepreneurial activity, but only for illegal purposes - unjustified criminal attacks towards the Complainant, its managers and employees.

The disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademarks in the classes of goods or services in which they are registered.

The Complainant believes that it has made out a strong prima facie case that the Respondent could have no rights or legitimate interests in respect of the disputed domain name.

The Respondent has used the disputed domain name not in connection with a bona fide offering of goods or services.

The Complainant further contends that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name and is not commonly known under the disputed domain name.

RESPONDENT:

The Respondent responded that a civil lawsuit has been launched by the Complainant, seeking judgment ordering Respondent to shut down web site www.aero-vodochody.net. The court issued preliminary court order, forcing the Respondent to shut down this site. Web site hosting has been terminated by the Respondent and the webhosting company has been asked to terminate the disputed domain name, but the Respondent has not received an answer.

The Respondent further contested that Complainant does not and never will possess exclusive rights to the name “aero”, since “aero” is a word, not a name such as Boeing, Ford etc. Various subjects around the world are using the word “aero” within their domain names. To list just a few, aero.net, aero.com, aero.org,, aero.pl, aero.de, aero.fr, aero.co.uk. Additionally, there is .aero top level domain (TLD) available. In Czechia alone, there are several companies using the word “aero” within their internet domains: www.kinoaero.cz, www.aeroprague.com, www.aerofilms.cz, www.herbstaero.cz, www.aeroteam.cz, www.aero-cluster.cz.

This UDRP proceeding brought against the Respondent is purely frivolous and malicious. The Complainant was at the time of submission aware of the fact, that the civil lawsuit launched against the Respondent shall result in shut down of the web site aero-vodochody.net. Furthermore, the Complainant achieved the shutdown of the site even before the court hearings could take place by means of the preliminary court order. The site is now defunct and the UDRP proceeding, regardless of the outcome, will not change the current status. The Respondent has no intentions to run the web site anymore, since he will employ other means to force Complainant to pay for damages.

The accusations of the Complainant, that the web site contained information, which is untrue and defamatory, is sheer and blatant lie. It is on record in court and police documents, that an organised criminal gang of employees led by Director of Manufacturing (25 years with the company) was involved in illegal manufacturing for at least a decade, where the losses Complainant had incurred exceeded 100 million CZK. Former Aero Vodochody President testified, that three employees were making parts and assemblies for other “clients” and were ordering material on behalf of Aero. They were immediately terminated. Complainant, according to documents issued by DA, filed report with local police, stating that evidence found within Aero factory suggest, that an unknown perpetrator is involved in illegal manufacturing, although they knew the identity of the suspects. Police and DA acting on orders from Aero parent (criminal organisation Penta Investments) swept the whole thing under the carpet and covered it up with bullet proof shield. The criminals are walking free and there is no way they will face criminal prosecution.

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 deadline for the response of the Respondent expired on September 30, 2019, but the Case administrator decided to grant the extra time limit to the Respondent on the basis of the Respondent's request due the technical issues preventing the Respondent to log on the platform and provide the response. The prolonged deadline for the response expired on October 9, 2019 and the response has been provided the same day.

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The 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 domain name; and
(iii) The domain name has been registered and is being used in bad faith.

I. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant has established the fact that the Complainant has valid rights for the EU trademark No 11418027 "AERO VODOCHODY" and 11347457 "AERO VODOCHODY AEROSPACE" both registered since 2012, and further Czech trademarks that contains that the term "AERO" – O-16779 registered since 1930, O-35901 registered since 1965 and O-154437 registered since 2000. The disputed domain name has been registered on 10 August 2017, i.e. 5 years after the EU trademarks registration and more than 85 years after the first Czech trademark containing term "AERO" registration.

The first element of the disputed domain name ("AERO") fully corresponds to the only one element of the Czech trademarks and the first element of the EU trademarks.

The second element of the disputed domain name ("VODOCHODY") fully corresponds to the second element of the EU trademarks.

Moreover, the geographical term "VODOCHODY" in the disputed domain name does not distinguish the disputed domain name from the Complainant's Czech trademarks. As the Complainant's main factory is operated in a place in Czech Republic called "Vodochody", the term "VODOCHODY" strengthen the likelihood of confusion between the disputed domain name and Complainant's Czech trademarks.

The addition of the geographical top level domain ".NET" does not change the overall impression of the designation as being connected to Complainant's trademarks.

The terms "AERO" and "VODOCHODY" are divided by the space within the EU trademarks and by the hyphen within the disputed domain name. The replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used within the domain names. Therefore, the use of the hyphen instead of the space between two parts of the trademark does not distinguish the disputed domain name from the Complainant's trademarks.

The Panel therefore considers the disputed domain name to be identical to Complainant's EU trademark "AERO VODOCHODY" and confusingly similar to the Complainant's Czech trademarks "AERO" and Complainant's EU trademark "AERO VODOCHODY AEROSPACE" which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. RIGHTS OR LEGITIMATE INTERESTS

The Complainants have established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainants or its business. These facts have not been challenged by the Respondent.

The Complainant further claimed that there is no indication that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. The Respondent, however, is the former Complainant's employee and it is clear from the evidence presented by the Complainant that the Respondent used the disputed domain name to present several critical articles related to the Complainant or his activities.

The UDRP jurisprudence recognizes that the use of a domain name for fair use such as noncommercial free speech, would in principle support a respondent's claim to a legitimate interest under the Policy (Section 2.6 of WIPO Overview 3.0). To support fair use under UDRP paragraph 4(c)(iii), the respondent's criticism must be genuine and noncommercial. However, the Panel finds that even a general right to legitimate criticism does not necessarily extend to registering or using a domain name identical to a trademark. Therefore, the registration of the disputed domain name which is identical to one of the Complainant's trademark, could not be accepted, even if the disputed domain names would be fairly used for the purposes of the criticism.

Moreover, the Panel is of the opinion, that the disputed domain name has not been used by the Respondent for the purposes of genuine and noncommercial criticism. It is evidenced by the judgements issued by the Czech criminal courts against the Respondent, that the Respondent was convicted as an offender of various criminal attacks against the Complainant´s employees with respect to their working activities for the Complainant and that the Respondent's activities were aimed at the Complainant and a good reputation of the Complainant and its employees. The disputed domain name obviously serves as a vehicle and place to commit such criminal activities by the Respondent.

The Panel therefore considers that 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.

III. REGISTERED AND USED IN BAD FAITH

The Respondent has registered the disputed domain name which is identical to one of the Complainant's trademarks and confusingly similar to other Complainant's trademarks. In addition, the trademarks are highly distinctive, contain the place of the Complainant's plant and correspond to the main part of the business name of Complainant. Moreover, the Respondent used the disputed domain name to publish articles related to the Complainant, its employees and activities, and therefore had been aware that the disputed domain name corresponds to the Complainant's trademarks and business name. It could be therefore concluded that the Respondent had or should have the Complainant and Complainant's trademarks in mind when registering the disputed domain name.

The Respondent's arguments, that the term "aero" is a word and not a name and that there are other examples of use of this term, are not appropriate. The term "AERO" is a single part of several Complainant's trademarks and one of the terms used in other Complainant's trademarks. This term is not used solely within the disputed domain name as it contains the term "VODOCHODY" as well. The combination of these two terms (even if the Panel would omit the Complainant's trademarks containing both terms) therefore leads directly to the Complainant and it is therefore clear, that the disputed domain name was registered having the Complainant in mind.

Moreover, the disputed domain name has been used to publish information related to the Complainant and the graphical layout of the Respondent's website was similar to the layout of the Complainant's official website. The use of the term "AERA" instead of "AERO" written by the handwritten font similar to the font of the Complainant's Czech trademarks could not distinguish the disputed domain name from the Complainant's Czech trademarks. The same applies to the use of the term "VODOHODY" instead of "VODOCHODY" where the letter "C" was skipped only.

The overall impression of the Respondent’s use of the disputed domain name is that the disputed domain name was registered primarily for the purpose of disrupting the business of the Complainant within the meaning of paragraph 4(b)(iii) of the Policy and to attract Internet users to the Respondent’s web site by creating a likelihood of confusion with the Complainant's mark within the meaning of paragraph 4(b)(iv) of the Policy.

The fact that the disputed domain name is not used at the time of the UDRP proceedings is not relevant as the suspension of the domain name and corresponding website is solely the outcome of the preliminary court order as confirmed by the Respondent.

Finally, the Panel ascertains that the identity of the Respondent was hidden through an identity protection service Proxy Protection LLC before the commencement of this proceedings. Such attempt to hide the identity may be the evidence of bad faith registration and use as well.

Considering the (i) similarity between the Complainant’s trademarks and the disputed domain name, (ii) use of the local name connected to the Complainant’s place of business within the domain name, (iii) methods of use of the disputed domain name by the Respondent and (iv) attempt to hide the Respondent’s identity, the Panel finds 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.

CONCLUSION:

The Panel finally considers that the Complainant has shown that the disputed domain name is identical to one and confusingly similar to four trademarks in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainants has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AERO-VODOCHODY.NET**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2019-10-17

Publish the Decision