Decision for dispute CAC-UDRP-103075

Case number	**CAC-UDRP-103075**
Time of filing	**2020-06-24 13:55:31**
Domain names	**goldbeckgroup.com**

Case administrator

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

Complainant

Organization	**Goldbeck GmbH**

Complainant representative

Organization	**BRANDI**

Respondent

Name	**Adam Ward**

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, inter alia, of the following trademark registrations consisting of, or comprising, GOLDBECK:

- European trademark registration No. 005604723 for GOLDBECK (word mark), filed on December 20, 2006 and registered on November 6, 2007 in classes 6, 19, 36 and 37;

- European trademark registration No. 015823917 for GOLDBECK (word mark), filed on September 9, 2016 and registered on March 10, 2017, in classes 6, 9, 17, 19, 35, 36, 37, 39, 40 and 42;

- German trademark registration n. 303075473 for GOLDBECK (word mark), filed on February 14, 2003 and registered on May 9, 2003 in classes 6, 19, 36 and 37.

FACTUAL BACKGROUND

The Complainant is a German construction company employing more than 7,000 people in 40 offices in several European countries.

The Complainant is the owner of the domain name <goldbeck.de> which is used by the Complainant to promote its services under the trademark GOLDBECK.

The disputed domain name <golbeckgroup.com> was registered on November 6, 2019 and has not been pointed to an active website. Based on the evidence submitted by the Complainant, which has not been challenged by the Respondent, has been used by the Respondent to send e-mails from an e-mail address based on the disputed domain name to business partners of the Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that disputed domain name <goldbeckgroup.com> is confusingly similar to the trademark GOLDBECK in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “group” and the generic Top Level Domain “.com”.

The Complainant highlights that the addition of the term "group" generally indicates a structure under group law and is not in itself distinctive.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is in no way affiliated with the Complainant nor has it been licensed in any way to use the trademarks or to act in the Complainant’s name, and that, by using the disputed domain name for sending e-mails, it wishes to create and strengthen a likelihood of confusion among the recipients of the e-mails.

The Complainant highlights that this is the second time the same Respondent has registered a domain name using the Complainant’s mark and that the Complainant already conducted proceedings before the CAC also in early 2020 resulting with the complaint being accepted.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith since the Respondent has obviously registered the domain for the sole purpose of exploiting the resulting confusion of allocation for fraudulent and business-damaging purposes to the detriment of the Complainant and its suppliers and customers.

The Complainant underlines that, for such purpose, e-mails were sent from an e-mail address based on the disputed domain name to business partners of the Complainant, in which the sender pretended to be the Complainant's managing director. The confusion of names was further intensified by the fact that the signature used in the e-mails included the Complainant’s company name and logo. The Respondent was thus deliberately misrepresenting itself as the Complainant and used the e-mails to trigger fraudulent orders. Only after a supplier became suspicious and informed the Complainant, it was clear that it was a case of attempted fraud.

The Complainant concludes that the Respondent is using the disputed domain name in bad faith for the purpose of preparing fraudulent acts or at least to discredit the Complainant, since the sender of such e-mails, sent under the disputed domain name, deliberately pretends to be the Complainant's managing director in order to obtain payments from the Complainant's suppliers or customers, if necessary, by exploiting the resulting confusion of allocations.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

The Panel notes that the Complainant has provided evidence of ownership of several trademark registrations consisting in or comprising GOLDBECK.

The Panel thus finds that the disputed domain name is confusingly similar to the Complainant's trademark GOLDBECK, as it includes the Complainant's trademark in its entirety, with the mere addition of the generic term "group" and the generic Top Level Domain ".com", which, as stated in a number of prior decisions rendered under the UDRP, are not sufficient to prevent a finding of confusing similarity.

In view of the above, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to the trademark in which the Complainant has established rights in accordance with paragraph 4(a)(i) of the Policy.

With reference to rights or legitimate interest in the disputed domain name, the Panel notes that the Complainant has made a prima facie case and the Respondent, by not submitting a Response, has failed to raise any convincing circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

Based on the records, the Respondent is in no way affiliated with or authorized by the Complainant and the Respondent has not been commonly known by the disputed domain name or by a name corresponding to the disputed domain name.

Moreover, in light of the evidence provided by the Complainant, which has not been challenged by the Respondent, the Respondent appears to have used the disputed domain name with the sole purpose of sending fraudulent e-mails to business partners of the Complainant in order to extort them money by impersonating a Complainant's director. Therefore, the Panel finds that, on balance of probabilities, the Respondent has been deliberately misrepresenting itself whilst generating the impression that the e-mails delivered from e-mail addresses based on the disputed domain name were sent by the Complainant. Such use of the disputed domain name clearly does not amount to a legitimate non-commercial or fair use.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

As to bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainant's trademark, the confusing similarity of the disputed domain name with such trademark and above all the fact that the disputed domain name was used to deliver e-mail communications pretending to come from the Complainant, the Respondent was well aware of the Complainant's trademark at the time of registration.

As highlighted above, the disputed domain name has not been pointed to an active website but has instead been used in connection with the sending of fraudulent e-mail communications in the name of the Complainant's Managing Director. As

found in Section V.3 of the Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition ("CAC .EU Overview 2.0"), "It is also discussed whether the use of a domain for the purpose of sending and receiving e-mails is sufficient. Most panels concluded that the use of a domain name for e-mail correspondence may constitute relevant use of the domain name, however, e-mails must be proven - the mere reference to general, abstract data like the number of e-mails sent and received is not sufficient". In view of the circumstances of the case, considering that the Respondent has failed to file a Response and to submit counter-allegations to rebut the Complainant's contentions and challenge the evidence submitted by the Complainant, the Panel finds that the Respondent's use of the disputed domain name described above amounts to bad faith.

In light of the above, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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. **GOLDBECKGROUP.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2020-09-28

Publish the Decision