

Decision for dispute CAC-UDRP-100894

Case number	CAC-UDRP-100894
-------------	------------------------

Time of filing	2015-02-26 09:49:47
----------------	----------------------------

Domain names	CARGLASS-SERVICE.COM, CARGLASS-SERVICE.NET, CAR-GLASS-SERVIS.COM, CARGLASS-SERVIS.COM
--------------	--

Case administrator

Name	Lada Válková (Case admin)
------	----------------------------------

Complainant

Organization	Belron Hungary Kft. Zug Branch
--------------	---------------------------------------

Complainant representative

Organization	Rott, Ruzicka & Guttman
--------------	------------------------------------

Respondent

Name	Jaroslav Pittner
------	-------------------------

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided proceedings which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of, inter alia, the following word trademarks:

(i) CARGLASS (word), BeNeLux trademark, application and registration date 25 May 1989, registration no. 461610, registered for goods and services in classes 12, 21 and 37;

(ii) CARGLASS (word), French national trademark, application and registration date 18 July 1989, registration no. 1620650, registered for goods and services in classes 12, 21, 37, and 39;

(iii) CARGLASS (word), Irish national trademark, application and registration date 21 November 1994, registration no. 173552, registered for goods in class 12.

In addition, the Complainant has registered various combined trademarks consisting of the dominant part “carglass” in many jurisdictions, including Community Trademarks (CTMs), international (WIPO) trademarks, national trademarks in most EU member states, US national trademarks and many others.

All such trademarks are herein collectively referred to as “Carglass Trademarks”.

FACTUAL BACKGROUND

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is a Switzerland based branch of a worldwide operating vehicle glass repair and replacement group of companies, providing its services under a common brand “carglass”.

For these purposes the Complainant has registered worldwide numerous Carglass Trademarks (for details, see Section 2 “Identification of Rights”) and country specific as well as generic domain names, as for example <carglass.com>, <carglass.cz>, <carglass.de>, <carglass.fr>, <carglass.co.uk> and others.

The disputed domain names were registered by the Respondent on 10 March 2014 (<car-glass-servis.com> and <carglass-servis.com>) and on 22 July 2014 (<carglass-service.net> and <carglass-service.com>),

The disputed domain names have not been used since their registration by the Respondent or any third party.

PARTIES CONTENTIONS

3.2 PARTIES' CONTENTIONS

(i) COMPLAINANT

The Complainant asserts that the disputed domain name is confusingly similar to its Carglass Trademarks (as listed above), since it incorporates “carglass” denomination, which is a dominant part of the Carglass Trademarks. The Complainant namely alleges that inclusion of a non-distinctive part “servis” or “service” into the disputed domain names cannot prevent confusing similarity between the disputed domain names and the Carglass Trademarks.

The Complainant further claims that the Carglass Trademarks enjoy high level of distinctiveness and enjoy well-known character as a result of extensive use thereof throughout the world.

In a rejoinder to Respondent’s response (see below) the Claimant refuses Respondent’s statement that a word “carglass” (and consequently Carglass Trademarks) is descriptive in relation to windshield and other car window repair services and thus is not capable of a trademark protection. The Complainant contends that the phrase “car glass” or “carglass” is not commonly used in the English language and therefore is of an imaginative nature and cites various sources to support his allegations in this respect. As a result, the Complainant concludes that the term “carglass” is exclusively known in relation with the Complainant and its business.

The Complainant also presents facts and evidence to show that the disputed domain names have been registered and used in bad faith and that the Respondent has no rights or legitimate interest to the disputed domain name, in particular because it does not use the disputed names in any manner and failed to respond to various requests and correspondence addressed to it in relation to the disputed domain names. Moreover, the Complainant shows that the Respondent must have been aware of the infringing nature of the disputed domain names, primarily because of his knowledge of a judgement rendered by Prague Municipality Court against a company Car Glass Perfect, s.r.o. (in which the Respondent was involved) which established, among others, that use of a “carglass” denomination infringes Complainant’s rights to Carglass Trademarks (“Court Resolution”).

In this respect, the Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

- 1) List of various Carglass Trademarks;
- 2) Cease and Desist Letter sent to the Respondent;

- 3) Various evidence about extensive use of the Carglass Trademarks worldwide;
- 4) Various information and evidence on Claimant's business;
- 5) Court Resolution on the Car Glass Perfect, s.r.o, dispute;
- 6) Extracts from various dictionaries and an affidavit from a court-sworn translator (to prove non-existence of the term "carglass" or "car glass" in the English language).

The Panel states that some of the provided documents were in other language than the language of this proceedings (English). The Panel still reviewed and accepted those documents which were in the Czech language because Respondent's native language is Czech and as a result the Respondent was able to understand them. The Panel, however, rejected and did not take into account documents which were neither in Czech nor in English – regardless whether the Panel was able to understand them or not – as it concluded that the Respondent's procedural rights would have been otherwise aggrieved.

(ii) RESPONDENT:

The Respondent in his response mainly asserts that the "carglass" denomination is descriptive and as a result the Complainant cannot claim exclusive rights to use thereof.

In this respect, the Respondent has presented to the Panel the following evidence, which has been assessed by the Panel:

- 1) Translation of a term "car glass" and "carglass" to Czech language as "auto sklo" or "autosklo" respectively (to prove alleged generic nature of terms carglass or car glass in the English language).

RIGHTS

The Panel concluded that all disputed domain names are confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP").

For details, see "Principal Reasons for the Decision".

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 UDRP).

For details, see "Principal Reasons for the Decision".

BAD FAITH

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

For details, see "Principal Reasons for the Decision".

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

(I) CONFUSING SIMILARITY WITH COMPLAINANT'S RIGHTS

Since the domain names and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names consisting of a prima facie generic term "CARGLASS" are confusingly similar to the Complainant's Carglass Trademarks.

Having in mind the complexity of this issue, the Panel below reveals in detail its considerations and findings:

(i) Existing Case Law

In decisions by various panels constituted under the UDRP process, there has been discussion of what constitutes confusion for the purposes of paragraph 4(a)(i) of the UDRP where registered trademarks and domain names already in use had been joined together with generic prefixes or suffixes to form a new domain name (sometimes referred to as a derivative).

Although the panel is well aware that the principle of stare decisis does not apply in these proceedings and that it is not bound by decisions reached by earlier panels, it is of the opinion that a review of some of the cases provides some support for the conclusions of this decision.

Decisions dealing with an issue of descriptiveness of the trademark (or a trademark and a generic word) often resulted in rejection of the complaint (see, for example, *Hotels unis de France vs. Christopher Dent / Exclusivehotel.com*, WIPO D2005-1194, *Pinnacle Intellectual Property vs. World Wide Exports*, WIPO D2005-1211, *City Utilities of Springfield vs. Ed Davidson*, WIPO D2000-0407 and similar).

In light of the above, assessment of a level of descriptiveness (generic nature) of a term “carglass” is principal.

(ii) Legal Analysis

Ad 1) Generic vs. Distinctive Nature of the Carglass Trademarks

In the Panel's view, after careful review of provided evidence, research performed by the Panel and consultations with native English speakers, the term “carglass” is not commonly used in the English language. Therefore, a generic nature of such term as presumed by the Respondent is only putative, namely in eyes of non-native speakers. Therefore, the term “carglass” shall not be perceived as a descriptive generic term. An affidavit provided by the Respondent that the term “carglass” shall be translated to Czech as “autosklo” is not in a conflict therewith – a term “carglass”, if translated, indeed most likely corresponds to a Czech term “autosklo”, however it does not imply that such term (i.e. carglass) is used in the English language.

In addition, the Carglass Trademarks have through extensive use acquired additional level of distinctiveness due to their reputation and well-known character and as such shall enjoy higher degree of protection than “standard” trademarks.

As supporting evidence on a well-known character of Carglass Trademarks, the Panel has endorsed principles and findings already discussed and applied in the following UDRP decisions:

Belron Hungary Kft. - Zug Branch v. F. Boom, WIPO Case No. DNL2013-0037, <careglass.nl>, <care4urglass.nl> and <cglass.nl>

Belron Hungary Kft. - Zug Branch v. Hartmut Clasen, Falkenber Consultants Ltd., WIPO Case No. D2014-2248, <chris-a-carglass.com>

In light of the above, the Panel contends that the term “carglass” as well as the Carglass Trademark are distinctive and satisfy the criteria as set in the paragraph 4(a)(i) of the UDRP.

Ad 2) Confusing Similarity Between the Carglass Trademarks and Disputed Domain Names

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP customarily involves a straightforward visual or aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “carglass” element of Carglass Trademarks (which standalone enjoys distinctiveness) into the disputed domain names constitute confusing similarity between Complainant’s trademark and such domain names. Addition of a non-distinctive element “service” or “servis” to the “carglass” denomination cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant’s Carglass Trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the “.com” or the “.net”) must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case and it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

(II) NO RIGHTS OR LEGITIMATE INTEREST

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie illustration of absence of rights or legitimate interest in the disputed domain names on the part of the Respondent.

Respondent’s affiliation to a company Car Glass International Ltd., is not relevant since the domain names are registered in the name of the Respondent (natural person), not the said company.

Thus, the Panel has taken a view that the Respondent has no rights or legitimate interest in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the UDRP).

(III) BAD FAITH

Since the Respondent was aware of the Court Resolution, the Panel contends, on the balance of probabilities, that the domain names have been registered (and that the above discussed similarity between the disputed domain names and Carglass Trademarks has been established) by the Respondent on purpose and in a bad faith. Moreover, while the more senior Carglass Trademarks were well-known and in wide use on the Internet and in the industry in which the Respondent was active at the time the disputed domain names were registered, Respondent’s denial of bad faith is highly improbable.

The Respondent has not used the disputed domain names in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Conclusively, the Panel has taken a view that the disputed domain names have been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CARGLASS-SERVICE.COM**: Transferred
2. **CARGLASS-SERVICE.NET**: Transferred
3. **CAR-GLASS-SERVIS.COM**: Transferred

4. **CARGLASS-SERVIS.COM:** Transferred

PANELLISTS

Name	JUDr. Jiří Čermák
------	--------------------------

DATE OF PANEL DECISION	2015-04-29
------------------------	------------

Publish the Decision
