Decision for dispute CAC-UDRP-106746

Case number	CAC-UDRP-106746
Time of filing	2024-08-14 13:29:50
Domain names	milei-gmbh.shop, milei.shop

Case administrator

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

Complainant

Organization	MILEI GmbH

Complainant representative

Organization	Heuking Kühn Lüer Wojtek PartGmbB

Respondents

Name	Robert Lang
Organization	Buggyland

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the EU trademark registration No. 000046979 “MILEI", registered on December 9, 1998, for goods and services in classes 5, 29 and 31.

The disputed domain names were registered on July 15, 2024 and on November 24, 2023.

FACTUAL BACKGROUND

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

The Complainant is a German company founded in 1940. The Complainant is specialized in the production, distribution, export and import of products derived from whey or milk. In addition, the Complainant produces, imports, exports and distributes refined chemical products, in particular pharmaceuticals, made from whey, milk or other substances.

The Complainant points out that it is the owner of the EU trademark "MILEI", registered before the registration of the disputed

domain names.

The Complainant underlines that it is the registrant of the domain name <milei.de>, used for its corporate website.

The Complainant states that the disputed domain names are used as web shops selling household appliances such as air dryers and cutlery sets, and contain the Complainant's company name and contact information.

The Complainant observes that the disputed domain names include the Complainant's trade mark in its entirety, and notes that the word “GmbH” is generic, as it describes the legal form of the Complainant as a limited liability company.

The Complainant argues that the word "shop" can be disregarded because it is the top-level domain of the disputed domain names.

The Complainant considers that the disputed domain names are identical, or at least confusingly similar, to the Complainant's trade mark.

The Complainant notes that:

- the Complainant's trademark registration predates the creation date of the disputed domain names;

- the Complainant has neither granted the Respondent a licence nor authorised him to register or use the disputed domain names;

- the Respondent is not connected to the Complainant in any way;

- there is no evidence that the Respondent is known by the disputed domain names or owns a corresponding registered mark;

- there is no evidence that the Respondent has used the disputed domain names in connection with a bona fide offering of goods and services, or has made a legitimate non-commercial or fair use of the disputed domain names;

- the disputed domain names lead to websites impersonating the Complainant.

The Complainant considers that, in the light of the above, the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant points out that the websites associated with the disputed domain names prominently and repeatedly use the Complainant's trade mark. The Complainant adds that the websites do not provide any information about the person operating them, and their relationship with the Complainant, but contain the Complainant's contact information.

The Complainant submits that the Respondent's use of the "MILEI" trade mark in combination with the company information clearly proves that the Respondent was aware of the Complainant's trade mark.

The Complainant argues that the Respondent could sell goods or services by capitalising on the reputation of the Complainant and its trade mark.

The Complainant considers that the Respondent has registered and is using the disputed domain names primarily with the intention of attracting Internet users to its websites for commercial purposes by creating a likelihood of confusion with the Complainant's trade mark as to the origin, sponsorship, affiliation or endorsement of those websites.

The Complainant, in the light of the above, considers that the disputed domain names were registered and are being used in bad faith.

PARTIES CONTENTIONS

The Complainant, relying on the arguments summarised above, contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.
No administratively compliant Response has been filed.

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

CONSOLIDATION OF THE COMPLAINT FOR THE DISPUTED DOMAIN NAMES

It is well established that where the particular circumstances of a given case indicate that common control is being exercised over the disputed domain names, consolidation may be granted, provided that it would be fair and equitable to all parties.

The Complainant considers that the Respondent is the same for the two domain names in dispute.

The Complainant submits that the same pattern of conduct is used and that the websites related to the disputed domain names are very similar. In particular, the Complainant notes that both domain names have clear similarities in their design, structure and content, contain the same imprint and use the same logo.

The Complainant asserts that, in the light of the above, the disputed domain names are under the effective control of a single person or organisation.
The Panel agrees with the Complainant's arguments and, in line with decisions of other panels in similar cases (see, for example, WIPO Case No. D2023-1121), considers that, on the balance of probabilities, the disputed domain names are under the control of a single person or organisation.

Therefore, the Panel decides to grant the requested consolidation.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of a domain name, the complainant has to demonstrate 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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant’s trademark.

There are two elements of this test: for each domain name, the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "MILEI", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain names.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain names to the Complainant’s trademark.

The disputed domain names differ from the Complainant’s trademark "MILEI" by the top-level domain ".SHOP" and, in <milei-gmbh.shop>, by the addition of the word "GMBH" preceded by a hyphen.

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the generic term "GMBH" (related to the type of company) after the hyphen in <milei-gmbh.shop> has no impact on the distinctive part “MILEI”. It is well established that, where the relevant trademark is recognizable within the domain name, the addition of other terms would not be sufficient to prevent a finding of confusing similarity (see, for example, CAC case No. 104755).

The Panel observes that it is well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain names are confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in each of the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] 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 mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names.

In particular, the Complainant states that:

- the Complainant's trademark registration predates the creation date of the disputed domain names;

- the Complainant has neither granted the Respondent a licence nor authorised him to register or use the disputed domain names;

- the Respondent is not connected to the Complainant in any way;

- there is no evidence that the Respondent is known by the disputed domain names or owns a corresponding registered mark;

- there is no evidence that the Respondent has used the disputed domain names in connection with a bona fide offering of goods and services, or has made a legitimate non-commercial or fair use of the disputed domain names;

- the disputed domain names lead to websites impersonating the Complainant.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain names.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain names.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain names resolve to websites impersonating the Complainant.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain names with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain names. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain names.

Taking into account that the Complainant has neither granted the Respondent a licence nor authorised him to register or use the disputed domain names, that the Respondent is not connected to the Complainant in any way, that the Respondent is not known as the disputed domain names and that the disputed domain names lead to websites impersonating the Complainant, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain names were registered in bad faith and that they have been used in bad faith.

Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see WIPO Case No. D2017-0100). The Panel shares this view.

The Panel agrees also that, on the balance of probabilities, the Respondent has registered and is using the disputed domain names primarily with the intention of attracting Internet users to its websites for commercial purposes by creating a likelihood of confusion with the Complainant's trade mark as to the origin, sponsorship, affiliation or endorsement of those websites.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain names it would have filed a Response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademarks at the time of the disputed domain names’ registration and the use of the disputed domain names in websites impersonating the Complainant, which contain various products on sale and the Complainant's contact details, considers that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **milei-gmbh.shop**: Transferred
2. **milei.shop**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2024-09-16

Publish the Decision