

ADMINISTRATIVE PANEL DECISION

Vitalen Otomotiv A.Ş and Vitalen Technology GmbH v. Faith Ünsal
Case No. DEU2022-0001

1. The Parties

The Complainants are Vitalen Otomotiv A.Ş, Turkey, and Vitalen Technology GmbH, Germany, represented by Juris Attorney Partnership, Turkey.

The Respondent is Faith Ünsal, Sweden.

2. The Domain Name, Registry and Registrar

The disputed domain name is <pedalcommander.eu>.

The Registry of the disputed domain name <pedalcommander.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is team.blue Denmark A/S.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2022. On January 13, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On January 21, 2022, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 3, 2022. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was March 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 17, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on March 23, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the ADR Rules, Paragraph B(5).

4. Factual Background

The Complainants are the Turkish company Vitalen Otomotiv A.Ş (the first Complainant), and the German company Vitalen Technology GmbH (the second Complainant). The shareholders of the first Complainant established the company Vitalen Holding A.Ş, which is the sole shareholder of the second Complainant, incorporated in August 2021.

The Complainants produce and sell a throttle response controller under the trademark PEDAL COMMANDER. Specifically, the first Complainant operates as a center for manufacturing and sales operations whilst the second Complainant runs the operations in the European Union.

The first Complainant is the owner, amongst others, of the following trademark registrations for PEDAL COMMANDER:

- International trademark registration No. 1408975 for PEDAL COMMANDER (figurative mark), registered on April 13, 2018, in international Class 12, and designating the European Union;
- Turkish trademark registration No. 2012/89181 for PEDAL COMMANDER (figurative mark), filed on October 22, 2012 and registered on January 20, 2014, in international class 12.

The Complainants operate the websites at the domain names <pedalcommander.com> registered on July 7, 2012; <pedalcommander.com.tr> and <pedalcommander.de>, used to promote and offer for sale PEDAL COMMANDER products.

The disputed domain name <pedalcommander.eu> was registered on May 19, 2020, and currently does not resolve to an active website. According to the screenshots available on the Internet Archive at <archive.org>, to which the Complainants refer in the Complaint, the disputed domain name previously redirected to a website featuring the PEDAL COMMANDER trademark and displaying the indication "Pedal Commander Europe Official Vendor".

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name <pedalcommander.eu> is identical to the trademark PEDAL COMMANDER in which the Complainants have rights as they reproduce the trademark in its entirety with the mere addition of the country code Top-Level Domain ("ccTLD") ".eu".

The Complainants also contend that, besides the use of the trademark in the domain name, also the contents of the correspondent website including the interface, the figurative trademark displayed therein and the website design were identical to that of the original website displayed at the domain name <pedalcommander.com>.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainants state that, on September 15, 2020, the first Complainant had signed a Distributorship Agreement with the company FTSM Holding Ivs, of which the Respondent is founder and manager, which was cancelled on July 5, 2021, due to unauthorized registration of the disputed domain name by the Respondent.

The Complainants underline that Clause 14 of such Distributorship Agreement specified that the rights on domain names incorporating PEDAL COMMANDER belonged to the first Complainant.

With reference to the circumstances evidencing bad faith, the Complainants indicate that, considering the Respondent's company was once a distributor of the first Complainant, and that it did not abide to the rules

since it breached the Distributorship Agreement, the Respondent was well aware of the Complainants' rights and deliberately acted in bad faith at the time of registering the disputed domain name.

The Complainants emphasize that the Respondent registered the disputed domain name to benefit from the Complainants' reputation and, as shown by the screenshots available in the Internet Archive at "Archive.org", also copied the content, interface and design of the website at <pedalcommander.com>, attempting to pass off as the original PEDAL COMMANDER website whilst intentionally attempting to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainants and their trademark as to the source, sponsorship, affiliation or enforcement of the Respondent's website.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Preliminary Procedural Issues

A. Consolidation of Complainants

The Commission Regulation (EC) No. 874/2004 (the "Regulation"), the Regulation (EU) 2019/517 of the European Parliament and of the Council, and the ADR Rules do not expressly contemplate the possibility of an ADR complaint filed jointly by multiple complainants.

However, prior panels who rendered decisions in cases decided pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") accepted under certain circumstances a single complaint filed by more than one complainant against a single respondent¹.

According to section 4.11.1 of the [WIPO Overview 3.0](#), "[when] assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation".

In the case at hand, the Complainants are sister companies, as the shareholders of the first Complainant established the company Vitalen Holding A.Ş, which is the sole shareholder of the second Complainant.

The Complainants also state that they both sell the same products under the trademark PEDAL COMMANDER. Specifically, the first Complainant acts as the center of the manufacture and selling operations, whereas the second Complainant runs the operations in the European Union.

The Complainants further points out that they both operate via the website at <pedalcommander.com> and alternative websites, namely "www.pedalcommander.com.tr" and "www.pedalcommander.de" and, therefore, the use of the disputed domain name is affecting both Complainants negatively.

Under these circumstances, the Panel finds that there is sufficient evidence to support a consolidation of the Complainants as they have a common grievance against the Respondent. The Panel also finds that the consolidation would be equitable and procedurally efficient. Therefore, the Panel accepts the single consolidated Complaint against the Respondent.

¹ Considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), where appropriate.

B. Language of proceeding

Pursuant to the panel's decision of November 29, 2021, in *Vitalen Otomotiv A.S v. Faith Ünsal*, WIPO Case No. [DEUL2021-0006](#), while the language of the registration agreement is Danish, the request for the language of this ADR proceeding to be English was granted and, accordingly, the language of the ADR proceeding shall be English.

6.2. Substantive Issues

According to Article 22(1)(a) of the Regulation, an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21. Article 21(1) of the Regulation, provides that a registered domain name shall be subject to revocation where it is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law and where it:

(a) has been registered by its holder without rights or legitimate interests in the name; or

(b) has been registered or is being used in bad faith.

Article 22(11) of the Regulation states that “the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.”

This provision is reflected in paragraph B(11)(b) of the ADR Rules, stating that the sole remedies available pursuant to an ADR proceeding where the respondent is the domain name holder in respect of which domain name the complaint was initiated shall be limited to revocation or to the transfer of the domain name to the complainant provided that it satisfies the eligibility criteria established for the registration of “.eu” domain names.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

Article 10(1) of the Regulation contains a list of rights which may fulfill the definition of “name in respect of which a right is recognized or established” provided in Article 21(1) of the Regulation. Said list includes, *inter alia*: “registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.”

Paragraph B(11)(d)(1)(i) of the ADR Rules determines that the Panel shall issue a decision granting the remedies requested in the event that the Complainant proves “The domain name is identical or confusingly similar to a name in respect of which a right is recognized by the national law of a Member State and/or European Union law”.

In the case at hand, the Complainants have provided evidence of a valid trademark registration for PEDAL COMMANDER (figurative mark), designating the European Union, registered in the name of the first Complainant (International trademark registration No. 1408975 for PEDAL COMMANDER).

The Panel notes that the core of the trademark PEDAL COMMANDER (figurative mark), consisting of the denominative element “pedal commander”, is entirely reproduced in the disputed domain name, with the mere addition of the “.eu” ccTLD which, as stated in several prior cases, is disregarded, being a mere technical requirement for registration. Therefore, the Panel finds that the disputed domain name is identical to the Complainant's trademark.

Accordingly, the Panel finds that the Complainants have proven that the disputed domain name is identical to a name in respect of which they have rights, according to the first requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

According to Article 21(2) of the Regulation and Paragraph B(11)(e) of the ADR Rules, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests in a domain name:

(1) prior to any notice of the dispute, the respondent has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparations to do so.

(2) the respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or European Union law;

(3) the respondent is making a legitimate and noncommercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national and/or European Union law.

A complainant is required to make a *prima facie* case that the respondent lacks rights or legitimate interests and, once such *prima facie* case is made, the burden of production shifts to the respondent to submit appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Panel finds that the Complainants have made out a *prima facie* case and that the Respondent, by not submitting a Response, has failed to provide any elements to establish rights or legitimate interests in the disputed domain name.

The Complainants stated that the Respondent was not authorized to register or use the disputed domain name. Moreover, according to Clause 14 of the Distributorship Agreement (submitted as Annex 7 to the Complaint), signed between the first Complainant and the Respondent's company few months after the registration of the disputed domain name, it was clear that the rights on domain names encompassing the trademark PEDAL COMMANDER were held by the first Complainant, whilst the Respondent's company could have been granted only a right of use of such domain names. Based on the evidence submitted by the Complainants and in the absence of a Response, the Panel finds that, on balance of probabilities, the Respondent maintained the disputed domain name in its name without having received any authorization from the Complainants, while being aware of such Clause 14.

In addition, there is no indication before the Panel, also on the basis of the Whois records, that the Respondent might be commonly known by the disputed domain name.

The disputed domain name is currently not pointed to an active website. However, based on the screenshots available on the Internet Archive at "Archive.org", it appears that the disputed domain name was used in the past to promote the sale of PEDAL COMMANDER products in Europe. However, since the Respondent maintained the disputed domain name in its own name notwithstanding the provision in Clause 14 of the Distributorship Agreement signed by its company with the first Complainant, from which it could be easily inferred that the Respondent was not entitled to do so, and in light of the fact that the Respondent's website prominently displayed the Complainant's trademark imitating the layout of the Complainants' prior website at <pedalcommander.com>, the Panel finds that the Respondent's use of the disputed domain name did not amount to an offering of goods or services in good faith. Indeed, the Complainants stated that the Distributorship Agreement with the Respondent's company was terminated in view of the registration and use of the disputed domain name by the Respondent.

In view of the fact that the Respondent's use of the disputed domain name was apparently commercial, the Panel also finds that the Respondent has not made a legitimate and noncommercial or fair use of the disputed domain name, without intent to mislead consumers or harm the reputation of the Complainants' distinctive sign.

In addition, the Panel notes that the nature of the disputed domain name, being identical to the Complainant's PEDAL COMMANDER trademark, carries a high risk of implied affiliation. Section 2.5.1 of the [WIPO Overview 3.0](#).

In light of the foregoing and in absence of a Response, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the disputed domain name according to the second requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

According to Article 21(1)(b) of the Regulation, a complainant is required to demonstrate that a domain name has been registered or used in bad faith.

Article 21(3) of the Regulation and Paragraph B(11)(f) of the ADR Rules provide a non-exhaustive list of circumstances which, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith:

(1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognized or established by national and/or European Union law, or to a public body; or

(2) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or European Union law, or a public body, from reflecting this name in a corresponding domain name, provided that:

(i) the Respondent has engaged in a pattern of such conduct; or

(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or

(iii) there are circumstances where, at the time the ADR Proceeding was initiated, the Respondent has declared its intention to use the domain name, in respect of which a right is recognized or established by national and/or European Union law or which corresponds to the name of a public body, in a relevant way but failed to do so within six months of the day on which the ADR Proceeding was initiated;

(3) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

(4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or European Union law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent; or

(5) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.

The Panel notes that, in light of the prior registration and use of the trademark PEDAL COMMANDER in connection with the Complainants' products, the Respondent was more likely than not aware of the Complainants and its trademark when it registered the disputed domain name, which it is identical to the Complainant's trademark. While a question may arise as to whether the Respondent (as a reseller, or potential reseller) would have been entitled to register a domain name with the Complainant's trademark noting that the Distributorship Agreement was not signed until September 15, 2020, the Panel notes that the Respondent's intention was probably to take unfair advantage of the Complainant's goodwill attaching to that trademark due to its identity with the disputed domain name.

The Panel also finds that, considering the nature of the disputed domain name along its use the disputed domain name was intentionally used to attract Internet users, for commercial gain, to the Respondent's website, by creating a likelihood of confusion with the Complainants' trademark due to its identity with the disputed domain name.

Moreover, the circumstance that the Respondent maintained the disputed domain name in its name although the Distributorship Agreement signed between the Respondent's company and the first Complainant clearly established that all domain name registrations using PEDAL COMMANDER belonged to the first Complainant, and that the Respondent's company agreed to "transfer the rights and ownership of the pedal commander brand's domain [...] to the manufacturer [i.e. the First Complainant]" supports a finding of bad faith.

Furthermore, the Complainants stated that the cited Distributorship Agreement was terminated due to the Respondent's registration of the disputed domain name and the Respondent, failed to submit a Response, did not rebut such allegation. Although the Complainant has not submitted evidence of the termination of the said agreement (such as a termination letter), the Panel finds that the fact that the Respondent retained the disputed domain name even after the termination would further demonstrate the Respondent's bad faith.

In view of the circumstances of the case, the Panel also finds that the current passive holding of the disputed domain name does not prevent a finding of bad faith.

In view of the above, the Panel finds that the Complainants have also met the requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(ii) of the ADR Rules.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <pedalcommander.eu> be transferred to the second Complainant, Vitalen Technology GmbH ².

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: April 22, 2022

² The remedy sought is transfer of the disputed domain name to the Complainant Vitalen Technology GmbH. As the Complainant Vitalen Technology GmbH is established in Germany, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 4(2)(b) of the Commission Regulation (EC) No. 733/2002 as amended by Regulation (EU) 2019/517 of the European Parliament and of the Council.