

DISPUTE RESOLUTION SERVICE

D00015007

Decision of Independent Expert

Clasoft GmbH

And

Mr Peter Paul

1. The Parties:

Lead Complainant: Clasoft GmbH
Kalker Hauptstr . 296
Cologne
51103
Germany

Respondent: Mr Peter Paul
341 3rd Street
Cambridge
02142
United States

2. The Domain Name(s)

wilmersburger.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

06 November 2014 10:45 Dispute received
06 November 2014 11:37 Complaint validated

06 November 2014 11:44 Notification of complaint sent to parties
06 November 2014 12:54 Response received
06 November 2014 12:55 Notification of response sent to parties
10 November 2014 10:32 Reply received
11 November 2014 10:44 Notification of reply sent to parties
11 November 2014 10:44 Mediator appointed
14 November 2014 11:17 Mediation started
21 November 2014 12:17 Mediation failed
21 November 2014 12:30 Close of mediation documents sent
25 November 2014 13:13 Expert decision payment received

4. Factual Background

The Domain Name was registered on 5 March 2013, by ' Peter Paul ', a UK individual according to Nominet's whois records.

The Complainant has used the trade mark 'WILMERSBURGER' in respect of vegan foods since 2011. It is the registrant of the Community Trade Mark 'WILMERSBURGER' which it applied to register in July 2013 and which was registered in November 2013. It is also the proprietor of the same mark in Germany and the proprietor of a number of domain names which include the above mark . It sells products in several thousand stores, supermarkets and online shops around Europe. International distribution of products commenced in earnest in early 2013 (although some UK exports were made as early as November 2012) on or about the same time that the Domain Name was registered.

The Complainant created the 'WILMERSBURGER' mark by joining the end and beginning of the names of urban districts in Berlin where it was founded, namely "CharlottenBURG" and "WILMERSdorf".

The Respondent asserts that it is developing a media platform to be used in conjunction with the Domain Name.

On 6 Nov 2014 (after the Complaint had been filed), the Complainant received an email from "Thorsten Oliver" as follows:

" we just got an email that you filed a complaint regarding our registration of wilmersburger.co.uk. I order to help you out you could send us an offer for the domain if its reasonable we may consider a sales otherwise we will proceed with our project . Please let me know your next steps."

The Complainant asserts that Thorsten Oliver is in fact the former CEO of one of its competitors, Veganic.

5. Parties' Contentions

a. Complaint

The Complainant relies upon its registrations and use of the mark "WILMERSBURGER" in support of its claim to have Rights. It asserts that there has not been any active use of the Domain Name

by the Respondent and as such the registration is abusive because it is blocking the legitimate use of the Complainant ' s Rights (see Paragraph 3.a.i.B of the DRS Policy) . The timing of the registration of the Domain Name and the commencement of the Complainant ' s international distribution confirms the deliberate attempt by the Respondent to block the Complainant' s use.

b. Response

The Respondent asserts that the Domain Name was registered for the purposes of it developing a media platform and does not understand why the Complaint was filed.

c. Reply

The Complainant relies upon the email referred to above and believes that it evidences an intention on the part of the Respondent to register the Domain Name to subsequently sell it (see Paragraph 3.a.i.A of t he DRS Policy) or to disrupt the Complainant's business (see Paragraph 3.a.i.C of the DRS Policy) and further that the Respondent gave false contact details (see Paragraph 3.a.iv of the DRS Policy) .

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainants must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Disputed Domain Name ; and
- (ii) the Disputed Domain in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy)

b. Complainant's Rights

The DRS Policy defines Rights as follows –

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;"

There would appear to be no argument between the parties that the Complainants do qualify as having the necessary Rights or that they are in respect of a name or mark identical/similar to the Domain Name. I agree. It is clear that the Complainant has extensive rights in the ' WILMERSBURGER' mark both by virtue of its trade mark registrations and by its use of the mark. For the purpose of analysing whether the Domain Names are identical or similar to the name or mark in which rights are claimed, one should ignore the .co.uk suffix.

The comparison is therefore between ' WILMERSBURGER ' on the one hand, and ' WILMERSBURGER ' on the other. The Domain Name is therefore identical to the complainant's mark and as such I conclude that the Complainant has established that it has Rights in a mark identical to the disputed Domain Name .

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainants assert that the registration of the Domain Name is an Abusive Registration for the reasons identified above.

The Policy defines an Abusive Registration as –

"a Domain Name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

(ii) has been used in a manner unfair advantage of or has detrimental to the Complainant's which has taken been unfairly Rights "

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration .

The Complainant has identified that it uses a mark that is highly distinctive, being a made up word, and one that it has used extensively. This calls for an explanation from the Respondent as to why it selected the name 'WILMERSBURGER' for its proposed media platform, but instead it has chosen not to do so. Indeed it provides no evidence to corroborate the assertion that it intends to operate a media platform.

In my opinion, this factor, together with the timing of the registration of the Domain Name (which coincides with the Complainant' s international expansion) and the email from Mr Oliver (the veracity of which I have no reason to doubt) who was previously the CEO of a competitor to the Complainant , combine to create a powerful argument that the Domain Name was registered by the Respondent to block the Complainant ' s use of an identical domain name, and/or to disrupt the Complainant's business . The Respondent has simply failed to provide any evidence or submissions which I consider come anywhere near explaining why the Registration of the Domain Name was not an Abusive Registration and I therefore conclude that on the balance of probabilities, the Domain Name was registered of selling it to the Complainant and/or disrupting its business .

In respect of the complaint that false contact details were provided, I am not satisfied that I have been provided with sufficient information to reach such a conclusion.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name and mark which is identical to the Domain Name <wilmersburger.co.uk> and the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

Signed Simon Chapman

Dated 16 December 2014