Panel Decision for dispute CAC-ADREU-008172

Case number	CAC-ADREU-008172
Time of filing	2021-07-05 23:56:05
Domain names	kaufmann.eu

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	

Respondent

Organization	Domaine du Frigoulet

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a German citizen having the family name “Kaufmann” (evidenced by a copy of his ID card provided as annex).

The Respondent is the French company “Domaine du Frigoulet”, a Société à responsabilité limitée (SARL) under French law.

According to EURid’s verification in the present ADR case, the disputed domain name was registered with the registrar “NETIM”. The domain name is being used for a standard default web page of this registrar, containing statements such as “KAUFMANN.EU – This domain name is registered with Netim” and various advertisements of this service provider (e.g., “Find the perfect domain name”, “Discover all of our special offers”, “Discover our web hosting plans”, etc.).

A. COMPLAINANT

The Complainant contends that, according to his investigation, there is no connection between the Respondent and the word “Kaufmann”.

The Complainant further contends that disputed domain name was not used (except for the registrar’s standard page described above) in the past two years and regards this as bad faith registration or use pursuant to Art. 11(f)(2)(ii) of the ADR Rules.

The Complainant further contends that “Domaine du Frigoulet” is merely the name of a hotel but not of a legal entity in France that would be able to register a domain name. The Complainant rather believes that the “true owner” of the domain name is a Swiss (i.e., Non-EU) corporation (“Aktiengesellschaft”) which the Complainant believes is the company behind the “Domaine du Frigoulet”.

B. RESPONDENT

The Respondent argues that the Complainant’s original complaint provided incorrect information about the Respondent, pointing to the Swiss company which the Complainant describes as the “true owner” of the domain name instead of merely referring to the Respondent contact data which are publicly available in EURid’s WHOIS database. The Respondent therefore assumes “fraudulent misrepresentation” and therefore requests to discontinue the dispute.

The Respondent further argues that there is no need for the Complainant to use the exact “KAUFMANN.EU” domain name because there are an infinite number of other domain names available which the Complainant could use.

According to the Respondent, the term “Kaufmann” with its German meaning as “merchant”, “trader”, “businessman”, “dealer”, etc. is purely descriptive, therefore “common property” and unable to be protected as a surname. At the same time, however, the Respondent points out that it was (past tense!) owner of a Benelux trademark “Kaufmann” with registration number 0781447, registered on 5 December 2005 for “Services de restauration (alimentation); hébergement temporaire” in class 28. According to the trademark certificate submitted by the Respondent, the “Date d’échéance) (=expiration date) of this mark was 23 November 2015. There is no indication that Respondent may have renewed its (former) trademark beyond this expiration date.

The Respondent claims that the disputed domain name is in active use for a website advertising the sale and trade (which is what a German “Kaufmann” or “trader” does) of IT services. The Respondent emphasises that as long as no legal requirements are violated, the domain holder is free to publish any content related to the domain name. The Respondent further states that a domain name can also be used exclusively for email traffic without showing an active website (but a statement that the Respondent has actually used the disputed domain name for such email purposes is not made).

DISCUSSION AND FINDINGS

1.
The Panel agrees with the Respondent that the original Complaint did not state the Respondent’s full contact details in accordance with EURid’s WHOIS database. In his complaint, however, the Complainant had explained why he believes that the Swiss company mentioned in his complaint should be regarded as the “true owner” of the disputed domain name. Furthermore, after the CAC pointed out the mismatch between the complaint and the WHOIS database, the Complainant has corrected his complaint. The Panel does not regard this behaviour as “fraudulent” and therefore denies the Respondent’s request to discontinue the dispute.

2.
Pursuant to Article 11(d)(1) of the ADR Rules, the Complainant must prove that:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; EITHER
(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; OR
(iii) The domain name has been registered or is being used in bad faith.

3.
The Complainant has proven that he has the family name “Kaufmann”, which is (i) identical to the disputed domain name and (ii) a name in respect of which a right is recognised or established by German law, namely § 12 of the German Civil Code. The Respondent’s argument that “Kaufmann” is a descriptive German word for “merchant” or “trader” and therefore unable for protection could have had some value if the Complainant had tried to protect (and thereby monopolize) the word “Kaufmann” for the business activities of a “merchant” or “trader”, but this is not the case here. The Respondent’s own (former) Benelux trademark for the word “Kaufmann” shows that this word is very well suitable for protection as a right. The first requirement of Article 11(d)(1) of the ADR Rules is therefore met.

4.
Pursuant to Article 11(f)(5) of the ADR Rules, it may evidence the registration or use of a domain name in bad faith if the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered. As discussed above, the disputed domain name corresponds to the Complainant’s personal name “Kaufmann”. The Panel also finds that – at least at the time of this decision – no demonstrable link exists between the Respondent and the disputed domain name. Such “link” may have existed at the time of the Respondent’s original registration of the disputed domain name, when Respondent owned the registered Benelux trademark “Kaufmann”. But Article 11(f)(5) of the ADR Rules uses the word “exists” in present tense, so that it is not possible to rely potential former “links” that are long bygone and have become irrelevant by now. The Respondent allowed his trademark registration to lapse, and at least now does not use the disputed domain name in any relevant way that is related to the word “Kaufmann”. The Respondent’s explanation that the registrar’s standard advertising webpage is a “merchant’s use” of the disputed domain name and therefore related to the German word “Kaufmann” meaning “merchant” is a weak and unconvincing excuse – it fails to explain, for example, why the registrar’s standard advertising webpage for which the domain name is used does not contain a single German word, but is purely held in English language.

The Complainant had contended that the current kind of website use has been maintained for at least the last two years. The Respondent has not denied this long-time (non-)use for the registrar’s standard advertising webpage, but has rather tried to defend it as a “relevant” use of the disputed domain name (with which the Panel disagrees, see the previous paragraph). Given the lack of a “demonstrable link” pursuant to Article 11(f)(5) of the ADR Rules, and considering the principles of Article 11(f)(2)(ii) and (iii) of the ADR Rules which imply some form of “use it or lose it” rule for domain names under the .eu top level domain, the Panel finds that the disputed

domain name has been registered or is being used in bad faith pursuant to Article 11(d)(1)(iii) of the ADR Rules.

5.
Given the alternative character of Article 11(d)(1)(ii) and (iii) of the ADR Rules it is not necessary to assess whether the disputed domain name has also been registered by the Respondent without rights or legitimate interest in the name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name KAUFMANN.EU be transferred to the Complainant.

This decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction (see Paragraphs B12(a) and B14 of the ADR Rules).

PANELISTS

Name	SSH Rechtsanwälte PartGmbB, Dr. Thomas Schafft

DATE OF PANEL DECISION 2021-07-05

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: KAUFMANN.EU

II. Country of the Complainant: Germany, country of the Respondent: France

III. Date of registration of the domain name: 21 March 2006

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: Family name "Kaufmann"

V. Response submitted: Yes

VI. Domain name is identical to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Not discussed
2. Why: Alternative character of Article 11(d)(1)(ii) and (iii) of the ADR Rules

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The domain name is a personal name for which no demonstrable link exists between the Respondent and the disputed domain name (Article 11(f)(5) of the ADR Rules)

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: Incorrect Respondent contact details in the original complaint not considered a fraudulent abuse of the procedure

XII. Is Complainant eligible? Yes