Panel Decision for dispute CAC-ADREU-003125

Case number	**CAC-ADREU-003125**
Time of filing	**2006-09-22 10:27:52**
Domain names	**basler-haarkosmetik.eu, baslerhaarkosmetik.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Basler Haar-Kosmetik GmbH & Co. KG**

Respondent

Organization / Name	**Iwebment Media Limited, James Jackson**

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

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain names

FACTUAL BACKGROUND

1.
The Complainant is a company with seat of business in Germany and was established in 1992. The Complainant is the owner of the German trademark No. 2024361 “Basler HAAR-KOSMETIK” (word/device) for various goods with relation to hair care. Although the trademark was applied for in 1991 and registered 1992, it was only assigned to the Complainant with effect of 12 April 2006.

The Complainant also owns the domain names “basler-haarkosmetik.de”; “baslerhaarkosmetik.com”; and “basler-haarkosmetik.com” and is doing business under these domain names.

2.
The Complainant applied for a preferred registration of the domain names “baslerhaarkosmetik.eu” and “basler-haarkosmetik.eu” (the Domains) during the Sunrise Period I but both applications were rejected by EURid. The Complainant did not challenge EURid’s decisions and the Domains were released for registration. On 7 June 2006, the date of the release announced by EURid, the Respondent registered the Domains. The Domains are not in use.

3.
On 22 September 2006 the Complainant filed the Complaint with the Czech Court of Arbitration (CAC). On 3 October 2006 the Respondent was notified by CAC that the Complaint was filed, that the Time of Commencement of ADR Proceeding was 3 October 2006 and that a Response would have to be filed within 30 working days. With non-standard communication of 27 November 2006 the Respondent was notified by CAC that the Response would have to be filed within a deadline of 6 December 2006. On 7 December 2006 the Respondent was notified by CAC that he was in default with the submission of the Response. On 12 December 2006 the Respondent submitted a Challenge of Notification of Respondent Default.

A. COMPLAINANT

4.1
The Complainant asserts that he is the owner of a trademark and a trade name “Basler Haar-Kosmetik” and that both rights are confusingly similar with the Domains.

4.2
The Complainant argues that the Respondent does not have a right or legitimate interests in the Domains. The Complainant contends

that he is not aware of any rights of the Respondent in the Domains nor that the Respondent or his products are known under the name “basler(-)haarkosmetik”.

4.3
Furthermore, the Complainant is of the opinion that the Respondent registered the Domains in bad faith in order to either exclude the Complainant from the registration or use of the Domains or to sell the Domains to third parties.

4.4
The Complainant claims the assignment of the Domains.

B. RESPONDENT

5.1
With his Challenge of Notification of Respondent Default, the Respondent failed to submit arguments with regard to the substantive issues of the dispute. Instead, the Respondent asserts that the Complainant never approached the Respondent with a request for the assignment of the Domains prior to the filing of the Complaint. The Respondent declares that he is willing to transfer the Domains for “the standard retail rate of 30 Euros each” and submits two ANNEXES with the title “Sales Agreement”, which are in truth invoices issued by the Respondent but showing a company called “Domain Brokerage Ltd.” as account holder / beneficiary.

5.2
The Respondent requests that the Cancellation of Notification of Respondent Default be accepted by the Panel and offers to transfer the Domains for 30 Euros each to the Complainant.

DISCUSSION AND FINDINGS

6. Procedural Issues

6.1
With submission of 12 December 2006 the Respondent has challenged the Notification of Respondent Default. According to section B(3)(g) ADR-Rules this challenge shall be considered by the Panel in its sole discretion as part of its decision making.

The Respondent was in default and, hence, the Challenge is without cause. The day of the commencement of the ADR-Proceedings is, according to the case file, 3 October 2006. The case file does not reveal in which way and on which day the Respondent was notified from the filing of the Complaint. However, the Panel assumes that this was done via email on 3 October 2006. In the view of the Panel, the 30 working day deadline ended on 14 November 2006. The deadline might have been extended by a few days according to public holidays in the relevant countries. Why CAC notified the Respondent with non-standard communication that the Respondent could file his Response until 6 December 2006 is irreproducible for the Panel. In the view of the Panel the Respondent was already in default when CAC issued the non-standard communication of 27 November 2006. However, as the Panel held in ADR.eu case No. 00119 – nagel.eu, even if CAC was not competent to extend the deadline, a party can rely on such favourable communication. Since the Respondent missed even the deadline of 6 December 2006 without giving another excuse but stating that he missed the deadline only by one day, there cannot be any doubts about the Respondent being in default.

Since the Respondent did in the Challenge of Notification of Respondent Default not submit arguments relevant for the contentious issues the default is, however, without consequences.

6.2
The Panel would like to point out to the fact that the Respondent’s offer to sell the Domains to the Complainant does not build an obstacle for a decision by the Panel, cf. section B(4)(b) ADR-Rules.

6.3
As far as the Respondent criticizes that he was not contacted by the Complainant before filing the Complaint, it has to be stated that there does not exist an obligation of a complainant to do so. A complainant can even have a genuine interest in not doing so in order to have the domain name in question put on hold in order to prevent a transfer of the domain to a third party.

7. The legal Basis for the Decision

A claim for the transfer of the Domains to the Complainant requires, according to Art. 21(1), 22(11) Regulation (EG) Nr. 874/2004 of 28 April 2004 (Regulation 874/2004), that the Panel finds that the Domain is identical or confusingly similar to a name in respect of which a

right is recognised or established by national and / or Community law, such as rights mentioned in Art. 10(1) Regulation 874/2004 and that the Respondent has registered the Domains without rights or legitimate interests in the domain or that the Respondent has registered or is using the Domains in bad faith.

8. Identical or confusingly similar Right

8.1
The Complainant can rely on a trade name and company name “Basler HAAR-KOSMETIK” in Germany. According to section 5 para 2 German Trademark Act, the use of a business name in commerce creates a right that, according to section 15 para 1 and 2 German Trademark Act, protects the name against the use of an identical or confusingly similar name by third parties. The Complainant has shown to the satisfaction of the Panel that he has been using his complete registered company names “Basler Haar-Kosmetik GmbH” and “Basler Haar-Kosmetik GmbH & Co. KG” as well as the trade name “Basler Haar-Kosmetik” in commerce in Germany prior to the registration of the Domains. These contentions of the Complainant remained undisputed by the Respondent.

8.2
The trade name “Basler Haar-Kosmetik” is confusingly similar to both Domains, basler-haarkosmetik.eu and baslerhaarkosmetik.eu. It is widely accepted that the top level domain .eu is not considered while comparing the domain with the right under Art. 10 Regulation 874/2004 since it is seen by the users of the internet as having only the function of an address and, hence being merely descriptive (cf. e. g. ADR.eu cases No. 00387 – gnc.eu and No. 02035 – warema.eu). Furthermore, the separation or non-separation of the portions “Basler” “Haar” and “Kosmetik” by hyphens or spaces in the Complainant’s trade name and company name on the one hand and the Domains on the other hand does not influence the similarity since the internet users are used to the fact that some of the companies doing business in the internet separate the elements of their company names in the respective domain names and others do not (cf. e.g. ARD.eu cases No. 00453 – web.eu and No. 02732 – hotel-adlon.eu). It is also common knowledge within internet users that many companies have registered variations of domain names with and without hyphens in order to facilitate the access to their website, such as the Complainant has done with the registration of “baslerhaarkosmetik.com” and “basler-haarkosmetik.com”.

8.3
Since the Complainant can rely on his trade name “Basler Haar-Kosmetik” as a prior right being confusingly similar to the Domains, the question whether the Complainant could rely on his German trademark as a prior right, particularly the question whether the device portion of this trademark could be seen as an obstacle to a confusing similarity, does not have to be decided.

9. No rights or legitimate Interests

The Panel finds that the Respondent has neither a right nor legitimate interests in the Domains. The Panel agrees with the ruling in previous ADR.eu cases that the Complainant carries the onus of proof with regard to the requirements of the claim for the transfer of the domain name in question. However, since the lack of a right or a legitimate interest is a negative fact that cannot be proven, the Complainant can discharge his onus of proof by establishing a prima facie evidence in asserting that there are no obvious circumstances indicating a right or legitimate interests of the Respondent in the domain name. The burden of proof then shifts to the Respondent to submit evidence of a right or legitimate interests (cf. e. g. ADR.eu cases No. 02035 – warema.eu and No. 02648 – balver-zinn.eu). Here, the Complainant asserted that there are no indications for a right of the Respondent and that the Respondent does not use the Domains. This assertion was not contested by the Respondent. Nothing in the Respondent’s name implies that he could have a right in the designation “basler(-)haarkosmetik”. Consequently, the Panel comes to the conclusion that the Respondent has neither a right nor legitimate interests in the registration or use of the Domains.

10. Bad Faith

Since it is sufficient for the Complainant to establish either a lack of right or legitimate interests or, alternatively, the registration or use in bad faith (cf. e. g. ADR.eu cases No. 02035 – warema.eu and No. 02810 – ratioparts.eu) the Panel does not have to decide whether the fact that the Respondent registered the Domains still on the day of their release by EURid and tried to sell the Domains to the Complainant during the ADR Proceedings using a form that identifies a domain trader as beneficiary can establish conclusive evidence for a registration in bad faith.

11. Claim for the Transfer of the Domains

The Complainant’s pleading to have the Domains “assigned” is interpreted by the Panel as an application for the transfer of the domain according to the second sentence of Art. 22(11) para 1 Regulation 874/2004. Since the Complainant has his seat in Germany, he fulfils the eligibility criteria set out in Art. 4(2) lit. (b) of Regulation (EC) 733/2002. Hence the Complainant is entitled to the transfer of the

Domains.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain names BASLER-HAARKOSMETIK and BASLERHAARKOSMETIK be transferred to the Complainant.

PANELISTS

Name	**Uli Foerstl**

DATE OF PANEL DECISION 2007-01-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant owns a trade name that is confusingly similar to the two domain names in question. The Complainant asserts that the Respondent does not have a right or legitimate interests in the domain names. The Respondent did not submit a Response in due time. In a Challenge of Notification of Respondent Default the Respondent offered to sell the two domain names in question to the Complainant but did not submit arguments with regard to the substantive issues of the dispute. Since the Complainant established a prima facie evidence of the lack of a right or legitimate interests of the Respondent and the Respondent failed to produce conclusive evidence of a right or legitimate interests in the domain names, the domain names were to be transferred to the Complainant.