Panel Decision for dispute CAC-ADREU-005235

Case number	CAC-ADREU-005235
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Domain names	jackwolfskin.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	JACK WOLFSKIN Ausrüstung für Draussen GmbH & Co. KGaA, Manfred Hell

Respondent

Organization / Name	THD Concept, Thomas Hermsdorf

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 Complainant - one of the major producers of outdoor equipment and outdoor apparel - obtained on 26 May 2006 an injunction against the Respondent which was confirmed by judgement of the District Court of Hamburg on 11 July 2006.

In order to avoid an administrative fine to be specified by the District Court of Hamburg in each event of violation and in the event that it should not be possible to collect such fine ar-rest for contempt of court the Respondent is prohibited from using the description “jackwolf-skin” and/or arrange to have the description “jackwolfskin” used in business dealings in connection with outdoor clothing and equipment, in particular if this should be carried out through registration and/or use of the domain “jackwolfskin.eu.

Furthermore the District Court of Hamburg ordered that the Respondent is prohibited from selling or transferring the domain name “jackwolfskin.eu” if the sale or transfer is not effected in favour of the Complainant.

FACTUAL BACKGROUND

The Complainant is the proprietor of various word and figurative “Jack Wolfskin” trademarks registered at the German Patent and Trademark Office. The Complainant is also using the designation “JACK WOLFSKIN” as company name.

The Respondent registered the “jackwolfskin” domain name on 7th April 2006 after the Complainant had not been assigned the domain name during the Sunrise Period.

On 19th April 2006 the Respondent offered the domain name “jackwolfskin” to the Complainant and announced to offer the domain name to competitors of the Complainant in case the Complainant was not prepared to acquire the domain and further web services from the Respondent.

A. COMPLAINANT

The Complainant contends that the Respondent registered the domain in bad faith after it was released by the Registry by the end of the Sunrise Period with the purpose of preventing the Complainant from using the domain name and to sale the domain name to the Complainant or to competitors of the Complainant.

The Complainant further contends that the Respondent was at first not prepared to transfer the domain name to the Complainant without a payment of a lump sum even not after the judgement of the District Court of Hamburg.

The Complainant also asserts that the Respondent was still not prepared to transfer the domain name to the Complainant in return to waive half of the Respondents debts caused by the legal proceedings before the District Court of Hamburg.

B. RESPONDENT

The Respondent contends the registration of the domain name during the Landrush Period was rightfully after the Complainant “had let pass the Sunrise Period without exercising its prior claim of registration”.

The Respondent also asserts that he offered to transfer the domain name to the Complainant at no charge, which has been rejected by the Complainant during the hearing before the District Court of Hamburg.

On 29th April 2009 the Respondent stated in a Nonstandard Communication that he “will be no longer holder of the domain "jackwolfskin.eu"” and that he has no “access for this domain actually”.

DISCUSSION AND FINDINGS

1. Confession

In considering that the Registry suspended the domain name involved from cancellation or transfer the statement of the Respondent on 29th April 2009 is either obscure or an inappro-priately worded confession. The first part of the statement may mean the Respondent admits the claim of the Complainant without restrictions. But whereas the English language is not the mother tongue of the Respondent the statement could also mean the Respondent wants to point out that he has transferred or rather has tried to transfer the domain name to a third party. This interpretation is supported by the second part of the statement. The second part retracts the statement that the Respondent will be no longer holder of the domain name wherefore the domain name can not be transferred to the Complainant on basis of a unques-tionable confession of the Respondent. Although the Panellist has considered theo request of the Respondent stating stated within a stipulated period if he admits the claim of the Complainant with-out restrictions the Panellist desists from doing so due to the fact of long-winded out of court settlement negotiations of the parties. Furthermore the Complainant has every right to insist on a fast decision whether the Complainant has the right to claim the transfer of the domain name or not.

2. Judgement of the District Court of Hamburg

The judgement of the District Court of Hamburg ordered that the Respondent is prohibited from using the description “jackwolfskin” in particular if this is be carried out through registration and/or use of the domain “jackwolfskin.eu”. But the District Court of Hamburg ordered restrictively that the Respondent is only prohibited from using the domain name in connection with outdoor clothing and equipment. Hence the Complainant is still entitled to claim the transfer of the domain name in this proceeding even when the Panellist can´t approve that the Complainant has not at first filed an ADR-proceeding but a lawsuit before the District Court of Hamburg knowing that the District Court of Hamburg is not entitled by German Law to transfer the domain name to the Complainant.

3. Speculative and/or abusive registration of the domain name

Pursuant to Article 22 (1) of Regulation (EC) No. 874/2004, alternative dispute resolution may be sought by anybody if registration of a domain name is speculative and/or abusive within the meaning of Article 21 (EC) No. 874/2004. For a registration to be speculative and/or abusive within the meaning of Article 21 (EC) No. 874/2004 requires that

• the domain name is identical or confusingly similar to another name in respect of which rights are recognised or established by national and/or Community law, and

• the domain name has been registered by a domain holder who cannot assert any rights or legitimate interest in the domain name,

or

the domain name is registered or used in bad faith.

3.1 Domain name is identical to a trademark of the Complainant

The Complainant is the proprietor of trademark rights in respect of the “Jack Wolfskin” name. Aside from the top-level domain “(dot)eu”, the trademark is identical to the disputed “jack-wolfskin.eu” domain name. However, only the second-level domain is of relevance, because the top-level domain “(dot)eu” must be disregarded when comparing trademarks and domain names, due to its importance,

acknowledged by the market, as an essential component of a domain name. For this reason, the “jackwolfskin” domain name and trademark are identical within the meaning of Article 21 (1) of Regulation (EC) No. 874/2004.

3.2 No right to or legitimate interest of the Respondent in the domain name

Another requirement for a speculative and/or abusive registration within the meaning of Article 21 of Regulation (EC) No. 874/2004 is that the holder of the domain and the Respondent can or cannot refer to having rights or legitimate interests of its own in the domain name.

The registration of the domain name during the Landrush Period was only rightfully if the Respondent had rights or legitimate interests of its own in the domain name at that time. But undisputed the Respondent has used neither the domain name, nor any name corresponding to this domain name in connection with the selling of goods or services at that time, nor probably made any preparations to that effect. Furthermore the Respondent is undisputed neither an undertaking, an organisation or a natural person that is generally known under the domain name. The Respondent had at that time although no plans in using the domain name in a legitimate and non-commercial or fair manner without misleading consumers, nor without harming the reputation of a name in which a right is recognised by national and/or Community law because he offered the domain name “jackwolfskin” to the Complainant already 12 days after registration and announced to offer the domain name to competitors of the Complainant in case the Complainant was not prepared to acquire the domain and further web services from the Respondent.

For this reason, the Respondent has no rights or legitimate interests of its own in the domain name within the meaning of Article 21 of Regulation (EC) No. 874/2004.

3.3 Registration of the domain name in bad faith

Bad faith within the meaning of Article 21 (3) a) of Regulation 874/2004 may be demonstrated for instance where circumstances indicate that the domain name was registered 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 recognised or established by national and/or Community law (Article 21 (3) a of Regulation (EC) No. 874/2004).

The Respondent registered the domain name only for the purpose of selling the domain name to the Complainant or even worse for the purpose of selling the domain name to competitors of the Complainant in case the Complainant was not prepared to acquire the domain and further web services from the Respondent.

Without any doubt the Respondent has therefore registered the domain name in bad faith within the meaning of Article 21 (3) a of Regulation (EC) No. 874/2004.

DECISION

For all the foregoing reasons the Panel orders that

the domain name JACKWOLFSKIN be transferred to the Complainant.

PANELISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2009-04-28

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

1.
A judgement by confession requires a statement of a Respondent that he admits the claim of the Complainant without restrictions. If a statement of a Respondent is not clear and precisely a transfer of a domain name cannot be ordered by a judgement by confession.

2.
If a judgement of a national court only orders restrictively that a Respondent is prohibited from using a trademark if this is carried out

through registration and/or use of the domain name in connection with certain products or services a Complainant is still entitled to claim the transfer of the domain name in an ADR-proceeding even when it cannot be approved that the Complainant has not at first filed an ADR-proceeding but a lawsuit before a national court knowing that the national court is not entitled by national law to transfer the domain name to the later Complainant.

3.
A Respondent has without any doubt registered a domain name in bad faith within the meaning of Article 21 (3) a of Regulation (EC) No. 874/2004 when the Respondent registered the domain name only for the purpose of selling the domain name to the Complainant or even worse for the purpose of selling the domain name to competitors of the Complainant in case the Complainant was not prepared to acquire the domain and further web services from the Respondent.