Decision for dispute CAC-UDRP-100152

Case number	CAC-UDRP-100152
Time of filing	2010-04-16 11:00:47
Domain names	ab-in-den-urlaub.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Unister GmbH

Respondent

Organization	GS-Internetservice

Respondent representative

Organization	HOELLER RECHTSANWAELTE

OTHER LEGAL PROCEEDINGS

The Complainant has asked the District Court of Leipzig for an injunctive relief; the court has granted the injunction with its Decision of 9 February 2010 - 5 O 346/10 (annex of the complaint). The decision forbids the use of the sign "ab-in-den-urlaub" as a part of domain especially in the travel business. The decision refers to a registered trademark of the Complainant (however, it is not clear in the decision which registered trademark is the basis of the decision).

The Complainant refers to another case decided by the District Court of Leipzig issued March 24, 2010 which contains, according to the Complainant, a preliminary injunction forbidding the Respondent to use the domain ab-in-den-urlaub.com in Germany. This decision has not been made available to the panel. Furthermore, the Complainant refers to a decision of the District Court issued at March 23, 2010 whose content is unclear and unknown.

IDENTIFICATION OF RIGHTS

The Complainant has registered a German trademark at the German Patent Ofiice (DPMA) for the figurative trademark "aidu.de. Ab in den Urlaub" (No. 305 13208 registered at the 28 April 2005). The Complainant claims to have unregistered trademarks in the terms "Ab in den Urlaub".

FACTUAL BACKGROUND

The Complainant, established in 2002, is - among other websites – running an online travel agency under the domain”ab-in-den-urlaub.de”. The website is known in Germany at least due to substantial efforts of the Complainant in television and

online advertisement.

The Complainant has a registered trademark in Germany, "aidu.de ab in den urlaub", registered in April 2005 (see above). In 2004 the Complainant tried to register the trademark “ab-in-den-urlaub” at the German Patent Office (DPMA); the application was refused due to the missing distinctiveness of the term.

In 2000, one of the shareholders of the Respondent registered the domain in question. The domain name was first used to direct Internet users to the website at www.fewo4you.com of the Respondent. On this website, the Respondent sold and is still selling primarily vacation homes.com but also hotels and packaged holidays.

On the 24th of February 2010, the Complainant sent a cease-and-desist-letter to the Respondent, among other things asking for the transfer of the domain name. In a phone call between the inhouse counsel of the Complainant, Jan Witzmann, and Mr. Hans Jürgen Stumpf, one of the two partners of the Respondent, Mr. Stumpf asked the Complainant to offer him a sum of money for purchasing the domain, what Mr. Witzmann refused to do. After the phone call, the Respondent stopped the redirection.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Complainant held:

The Complainant has rights in a registered as well as in a common law trademark.

The disputed domain is identical to the last part of the registered trademark of the Complainant. The disputed trademark is identical to the common law trademark of the Complainant. The Respondent does not have any rights or legitimate interest in the domain name. Respondent is neither an authorized partner of the Complainant nor licensed in any other way to use "ab in den urlaub" in a domain name. Redirection of the disputed domain name to a different website unrelated to the Complainant but selling apartments does not constitute a legitimate “interest” in the domain name. An offer to sell the domain is proving that the domain name has been registered and is used in bad faith.

The Respondent held:

The phrase 'ab in den urlaub' has no other meaning then "to go on leave", "taking a holiday" etc.
The Complainant has failed to show the existance of trademark rights, even in a wider sense, there is no "protected mark" that could have been offended.

RIGHTS

The Complainant has, to the satisfaction of the Panel, not shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The decision does not have to deal with the rights of the Respondent as the Complaint must already be rejected for the missing rights of the Complainant (see above) and the fact that there is no evidence for bad faith (see below).

BAD FAITH

Complainant has failed to prove that the domain name was registered in bad faith.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

First, the Complainant refers to his registered trademark "AIDU.de. Ab In Den Urlaub" (305 13208). This figurative trademark is characterized by the specific graphical feature of the logo. The wording of that logo is based upon the word "Aidu" which has a high distinctiveness compared to the generic words "Ab in den Urlaub" (let´s go to holidays). The domain name "Ab-in-den-Urlaub.com" only relates to the generic parts of the trademark and can thus not interfere with the distinctive parts of the trademark.

Apart from that, the Complainant has not demonstrated that he owns an unregistered common-law trademark "ab-in-den-Urlaub". The Complainant had to show that the name has become a distinctive identifier associated with the Complainant or its goods and services. Relevant evidence of such “secondary meaning” has to consider amount and length of the sales under the mark, the nature and extent of advertising, consumer surveys and media recognition (see the WIPO cases Uitgeverij Crux v. W. Frederic Isler D2000-0575; Skattedirektoratet v. Eivind Nag D2000-1314;, Australian Trade Commission v. Matthew Reader D2002-0786)

Given the weak character of Complainant's mark, I find that the evidence of secondary meaning is inadequate to prove any enforceable rights in the mark. The Complainant only hints at the involvement of Michael Ballack for advertisement purposes. He does not provide exact figures regarding the marketing and sales of products via the website “Ab-in-den-Urlaub.de”

Even if Complainant had established such rights, however, Complainant still has failed to prove that the domain name was registered in bad faith as it is difficult to show that the domain name was registered with a future trademark in mind (see WIPO cases AB Svenska Spel v. Andrey Zacharov D2003-0527; Iogen Corporation v. Iogen D2003-0544; Madrid 2012, S.A. v. Scott Martin-MadridMan Websites D2003-0598 among others). The domain name was registered in 2000. It is unclear when Complainant began its own online business. As the Complainant has been established in 2002, it can be estimated that he didn´t start the online agency under the domain name “ab-in-den-urlaub.de” before 2002. By its own admission the Complainant did not try to register its marks before 2004. As a result it is difficult to conceive of how the Respondent could have known of the Complainant at the time of domain name registration, and therefore to have registered the domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **AB-IN-DEN-URLAUB.COM**: Remaining with the Respondent

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2010-06-28

Publish the Decision