

Decision for dispute CAC-UDRP-100535

Case number CAC-UDRP-100535

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Domain names wnp.com

Case administrator

Name Lada Válková (Case admin)

Complainant

Organization Williams & Partner CEE s.r.o.

Complainant representative

Organization Švehlík & Mikuláš advokáti s.r.o.

Respondent

Organization The Runa Group B.V.

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of Czech registered trade mark no 294600 applied for on 29 January 2007 and registered on 19 December 2007 in classes 9, 35 and 41 for the word mark "WILLIAMS & PARTNER". However, the ownership of this mark is in dispute.

FACTUAL BACKGROUND

The Complainant is a company established pursuant to Slovak law.

There are a number of domain names in issue in these proceedings. They are as follows:

<wnp.com> first registered on 9 June 1997
<williams-partner.com> first registered on 18 June 2003
<williamspartner.com> first registered on 18 June 2003; and
<williamsandpartner.com> first registered on 18 June 2003.

Hereinafter these domain names are collectively referred to as the Domain Names.

The Respondent is a company based in the Seychelles.

According to publicly available Whois data the Domain Names are all currently registered in the name of the Respondent.

Prior to the filing of the Complaint the <wnp.com> Domain Name would re-direct internet users to a website operating from the domain name <espartners.cz> with the headings "Executive Search Partners" and "The Total Deception Detection Blueprint". At the bottom of that page was to be found the text:

"Executive Search Partners is a division of The Runa Group B.V. a Venture Capital & Business Incubator specialist with activities in Europe, Russia & CIS, Japan and the United States"

As at the date of this decision all of the Domain Names divert to the same website operating from the <espartners.cz> domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINT:

The Complainant's contentions in the Complaint are hard to follow. It contains various assertions but provides virtually no dates when certain events are said to have occurred. Also although it appends certain documents, these are not cross referenced to the body of the Complaint and the Panel is left to determine their relevance. Matters are not helped by the fact that some of these documents appear to be in Czech; i.e. a language which is not the language of these proceeding, and no translation of the parts of these documents relied upon (if any) is provided.

Nevertheless, it is tolerably apparent that the Complainant claims to be engaged in the business of recruitment and management consultancy in Central and Eastern Europe. It claims to be the successor in business to a business that from marketing materials annexed to the Complaint would appear to have been established in 2003.

The Complainant possesses the Czech trade mark already described above for "WILLIAMS & PARTNER". The material appended to the Complaint in this respect is in Czech and accordingly unintelligible to the Panel. Nevertheless, the Czech trade mark office provides online an English language version of the material appended to the Complaint. This shows (a) that prior to February 24, 2012, the trade mark was registered in the name of "Williams & Partner sro"; and (b) that on February 24, 2012 the trade mark was transferred into the name of the Complainant; i.e. "Williams & Partner CEE s.r.o".

The Complainant also claims to possess a Slovak trade mark. However, no documentation in relation to that trade mark appears to have been provided. Publicly accessible online databases record there to be Slovakian trade mark no 219783 for "Williams & Partner" but the mark to be in the name of "Williams & Partner, s.r.o" and not the name of the Complainant; i.e. "Williams & Partner CEE s.r.o".

The Complainant asserts that the Domain Name <wnp.com> is confusingly similar to its trade marks being "an abbreviation of [the] [C]omplainant's trade[]marks Williams & Partner, that is w np derived from the words Williams 'n' Partner".

The Complainant contends that it has in the past used the <wnp.com> Domain Name as the "main domain name for its business". It claims to have "made significant effort including investments to promote the [D]omain [N]ame", using it in various promotional materials. However, no evidence is offered in support of those contentions.

The Complainant maintains that the Respondent has no rights or interests in the Domain Name having no licence or consent from the Complainant to use its marks.

So far as bad faith is concerned, it claims that Mr Sassen, who is the Managing Director of the Respondent, was previously a

party to a franchise agreement with the Complainant that was subsequently terminated. Annexed to the Complaint is an unsigned franchise agreement. The front page of that agreement identifies the Franchisee as "Gerard Sassen ... using Williams & Partner s.r.o., as a legal entity for his franchise operations".

The Complainant provides a separate signed signature page for this agreement dated October 2011, but the formatting and positioning of the text on this page is somewhat different from that in the unsigned agreement.

The Complainant contends that subsequent to termination of the franchise agreement Mr Sassen registered the domain name "to endorse the Respondent's business for commercial gain". Further, it contends that the wording of the franchise agreement required Mr Sassen on termination of that agreement to "rename the business ... which he never did".

Further, it is claimed that by the use of the <wnp.com> Domain Name, the Respondent has intentionally and deliberately attempted to attract, for commercial gain, Internet users to the Respondent's website.

RESPONSE:

The Respondent claims that in late 2011 it signed a contract for the purchase of "Williams & Partner s.r.o IC 271 78 111" with legal effect from 1 January 2012. In this respect it attaches an agreement that appears to be Czech. It claims that the property that formed part of this purchase was the Domain Names.

It further claims that the <wnp.com> Domain Name was registered in the name of its "daughter company Williams & Partner s.r.o. IC 271 78 111, until it was transferred to the Respondent".

It denies that the Complainant has invested in the <wnp.com> Domain Name attaching copies of various brochures issued by the Complaint, none of which use that Domain Name. This material has email and website addresses that use the domain name <wnp.cz>.

It claims that its daughter company is also the owner of various registered trade mark for "WILLIAMS & PARTNER". It refers in this respect to Romanian Registered trade mark no 086916. It also claims to be the owner of Slovak trade mark no. 219783. It also claims to be the true owner of the Czech registered trade mark relied upon by the Complainant, alleging that the Complainant using an "predated contract and an undated Power of Attorney" wrongfully obtained a transfer of that trade mark from Williams & Partner to the Complainant. That alleged wrongful transfer is claimed to subject of a dispute at the relevant trade mark registry and to have been reported to the Czech police.

No documentation is provided to support those assertions and instead the Respondent states that they can be verified if the Panel contacts the Police and/or the Czech trade mark registry. The Respondent also asserts that so far as the Czech trade mark registry is concerned this can be verified on line, but no further explanation is provided as to how this might be done and as far as the Panel can tell this is not recorded on the online public register.

The Response then recounts makes various allegations as to the conduct of an individual associated with the Complainant that it is not necessary to record in this decision.

The Respondent denies that the franchise agreement attached to the Complaint is the version of the document that was signed.

The Respondent appears to suggest that Williams & Partners s.r.o. is no longer trading and the Respondent is currently considering its position in relation to the use of the brand but intends to provide services under that brand in future. It also claims that, contrary to what the Complainant suggests, the Complainant is no longer engaged in any commercial activity.

The Respondent asserts that all the Domain Names were transferred into the name of the Respondent on 3 July 2012.

At one point in the Response there appears to be a reference to a summons directed to the Complainant requiring it to

change its name, but this is neither explained nor evidenced.

COMPLAINANT'S "REPLY" TO THE RESPONSE:

The Complainant filed a "Reply" to the Response on 14 February 2013. It requested that in addition to the <wpn.com> Domain Name, the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names also be dealt with in these proceedings.

The document in part repeats contentions made in the Complaint. However, it is relevant to note that the Complainant contends that the suggestion that there is any dispute in relation to Czech trade mark is "false in its entirety" and that there is no mention of any such dispute in the online record for that trade mark at the Czech trade mark registry. Further, it claims that the marks of Williams & Partner were transferred to the Complainant "before the transfer of the acquisition of Williams & Partner s.r.o. by the Respondent from the Complainant became effective".

In support of that claim it attaches what it claims to be an "Agreement on Transfer of Trademarks". However, this is a one page document in Czech which appears to form part of a larger document and is unintelligible to the Panel.

It also maintains that the assertion that the Respondent intends to develop the "Williams & Partner" brand is neither evidenced nor credible and does not sufficiently explain why the Domain Names have been used to redirect internet users to a business of the Respondent under another brand.

It further claims that the Respondent's assertions about the Complainant's business are "untrue or unproven", but provides no independent evidence in this respect.

RESPONDENT'S "REPLY" TO THE COMPLAINANT'S "REPLY" TO THE RESPONSE:

On 14 February 2012 the Respondent filed a document in response to the Complainant's reply. For reasons that are explained in greater detail under the heading Procedural Factors below, it is not necessary to describe the contents of this document. However, it is noteworthy that the Respondent did not raise any objection to the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names forming part of these proceedings.

RIGHTS

There clearly is a dispute in this case between the parties as to who owns the various trade marks that the Complainant relies upon in these proceedings and that this forms part of a far larger dispute between the parties.

It is tempting for the Panel simply to assert that this larger dispute involving allegations of breach of contract and possibly even fraud is simply inappropriate for determination under the UDRP. Nevertheless, in the opinion of the Panel the approach here should be somewhat more systematic than simply to assert that the case involves issues that are too difficult for it to determine. Its task is to consider each aspect of the requirements of the Policy. In doing so it must bear in mind that it is the complainant that bears the burden of proof of satisfying the requirements of each aspect of the Policy in order to succeed in the proceedings.

As this Panel stated in *Audiotech Systems Ltd. v. Videotech Systems Ltd.* WIPO Case No. D2008-0431 (a case in which both parties made legal claims against one another and there were broader disputes of fact):

"7.8 In the circumstances, the Panel believes that the correct approach is to examine each of the requisite elements of the Policy in turn. If in the context of that examination it is apparent that there is a substantive factual dispute between the parties, it may be that the dispute is incapable of determination under the Policy, and the Complaint may consequently fail. It may also be a dispute of fact that is relevant to some separate claim as a matter of law. But it is the irreconcilable dispute of fact rather than the legal claim that is relevant here."

Nevertheless, in embarking on that process in this case, the Panel notes that the way that both parties have prepared their various submissions in this case is to say the least problematic. Both are prone to assertion without bringing forward proper evidence to support the assertions that they make.

In the case of the Complainant, insofar as the claims made are intelligible at all, they seem at times to be inconsistent with publically available material. For example, the Complainant asserts that it is the owner of a Slovak trade mark, but the online record of the Slovak trade mark registry suggests otherwise. Further, there are at times issues with the evidence that is provided. For example, the Complainant relies upon a franchise agreement, but instead of simply providing the signed document, it provides an unsigned document and a separate signature page, where the format of the signature page suggests that the unsigned document may be different from that which was actually signed. The reliance of Czech language documents is also unhelpful in circumstances where the Complainant brought these proceedings in English, the panelist in this case (as the Complainant should have known might be the case) does not speak Czech and the Complainant did not ask for the proceedings to have been conducted in Czech.

There is less of an issue of inconsistency so far as the Respondent's submissions are concerned, but at times the assertions made are also problematic. For example, the Respondent frequently makes assertions to the effect that the Panel (at times referred to in error as the "court") can verify certain statements by making enquiries of certain third parties (for example, the Czech police or the Czech trade mark registry). However, these statements are misguided. Although sometimes panels will make limited enquiries of documents of public record (for example online databases of trade mark registries) it is not a panel's job to verify the evidence of a party by making enquiries of third parties. If a party considers third party material to be relevant, it should gather it itself and then present this before a panel. Further the Respondent also refers to un-translated material in Czech.

Ultimately, given this the Panel has decided that the appropriate course in this case is to proceed very cautiously when assessing the competing assertions of the parties. In particular, the Panel has considered it appropriate to give little weight to any factual assertion by either party unless it appears that the other party accepts that assertion either explicitly or implicitly or if the contention is supported by credible evidence that is intelligible to the Panel.

With this all in mind the Panel finally turns to the question of rights. If one is to take at face value the entries in the various trade mark registries, then it would appear that the Complainant is the registered owner of the registered trade mark for WILLIAMS & PARTNER in the Czech Republic and the Respondent is the owner of registered trade marks elsewhere.

Of course, the Respondent contends that the Czech trade mark was wrongfully transferred to the Complainant, but that is something on the material provided that the Panel is in no position to decide. Further, although the Respondent contends that this has been raised with the Czech trade mark registry, there is no real evidence before the panel to support this, or even if correct what legally remedy has been sought and could be obtained by the Respondent in this respect.

In the circumstances, the Panel is prepared to proceed on the assumption (with formally deciding this issue in favour of the Complainant) that the Complainant has rights in this Czech trade mark.

It is clear that in the case of the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names, that they are each "confusingly similar" as that term is understood under the Policy, to that Czech trade mark.

In the case of the <wnp.com> matters are somewhat more difficult. Many panels, including this one, view the requirement of "confusing similarity" as imposing a low threshold test the purpose of which is effectively to assess whether a complainant has sufficient rights so as to give it standing to bring a complaint (see, for example, Research in Motion Limited v. One Star Global LLC, WIPO Case No. D2009-0227). Nevertheless, the Complainant is asking the Panel to find confusing similarity in relation to the use in a domain name of only three letters to be found in a (if spaces are to be ignored) 16 character trade mark. Even though each of these letters is said to represent an individual work in the mark, that is asking too much. The Panel is not convinced that there is a sufficient degree of similarity between the two to satisfy the test of "confusing similarity" under the Policy.

Further, undertaking this assessment strikes the Panel as somewhat artificial in the particular circumstances of this case. The Complainant contends that the term “wnp” is one that has been extensively used in business. In short, the real question in this case is whether the Complainant has trade mark rights in this term alone. The Complainant has no registered trade mark rights in the term “wnp” but that is not the end of the matter. Unregistered trade mark rights are also recognised for the purposes of the Policy. Although those rights are more commonly recognised in common law countries, if a complainant can show that if use of that term would be protected by the law in any relevant country (for example under unfair competition law), that is likely to be sufficient (see the analysis in TKS, S.A. v. Huang Li Technology Corp. WIPO Case No. D2012-2367).

However, no claim of “unregistered trade marks” (or any local law equivalent) has been made by the Complainant in this case. Further, there are a number of unresolved factual complications which might be relevant to any assessment of whether such rights exist that the Panel is not in a position to determine (i.e. to what extent the Complainant is the owner of the relevant rights and to what extent there remains any real business of the Complainant that is trading in this term).

In the circumstances, at least so far as the <wnp.com> Domain Name is concerned, the Complainant has failed to satisfy the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

Whether the Respondent has rights or legitimate interest in the Domain Names is at the heart of the dispute between the parties in this case.

As the Panel has already mentioned in this decision, Williams & Partner, s.r.o. appears to be the owner of Slovak registered trade mark rights. Although the Respondent, and not Williams & Partner, s.r.o., is the registered owner of the Domain Names, it appears to be accepted that Williams & Partner, s.r.o. is a wholly owned subsidiary of the Respondent. Accordingly, it is reasonably clear that the Respondent is acting with the consent of, and/or with the benefit of an informal licence from, Williams & Partner, s.r.o., and that for the purposes of these proceedings, both can be treated as the same entity.

Accordingly, prima facie the Respondent does appear to have rights in the form of the Slovak trade mark in the term represented in the Domain Names.

This is not necessary conclusive. For example, ownership of a trade mark in a term represented in a domain name, will not provide such rights for the purposes of the Policy if it is clear that the trade mark was not been sought or obtained for a legitimate or bona fide purpose, but merely in order to bolster a domain name registration (see the analysis in BECA Inc. v. CanAm Health Source, Inc. WIPO Case No. D2004-0298). Had the Complainant been able to present a compelling case to the effect that it, and not the Respondent’s subsidiary, is the owner of the mark, then the Panel might similarly have been prepared to ignore this registration.

However, even though the Complainant has claimed to be the true owner of the Slovak mark in this case, on the material before it the Panel is not in a position to decide whether this is correct. The fact that the Domain Names are being used to direct internet users to the website of a business that is not actively using the “Williams & Partner” name at the moment is curious. Nevertheless, as far as the Panel can tell there does seem to be a real dispute between the parties over who can use this name, which the Panel is in no position to determine. In the circumstances, the Complainant has failed to prove that the Respondent has no rights or legitimate interests in these Domain Names. Accordingly, it has not made out the requirements of paragraph 4(a)(ii) of the Policy.

BAD FAITH

Given the findings of the Panel on rights and legitimate interests above, it is not necessary to consider the issue of bad faith. However, for the reasons already given it would also have been difficult to make a finding in favour of the Complainant on the issue of bad faith registration or use. In short, if the Respondent’s subsidiary legitimately owns rights in the name “Williams & Partner”, and the Respondent has acted with the consent of that subsidiary in registering these Domain Names,

then there is unlikely to have been any registration or use in bad faith. Of course the Complainant contends that the Respondent's subsidiary rights are illegitimate, but this is a dispute in respect of which the Panel is unable to reach a conclusion one way or the other. In the circumstances, the Complainant has not made out the requirements of paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

There are two procedural issues in this case. The first is that in the course of the proceedings the Complainant requested that the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names be added to these proceedings.

The circumstances in which domain names can be added to a complaint, are summarised at paragraph 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition. There has been reluctance by some panelists to allow this after the proceedings have formally commenced, but a panel can permit this. Where the panel does permit this, care needs to be taken that steps are taken to ensure that no party is unfairly disadvantaged in this respect, and a panel may give directions in this respect.

In the present case, there seems to be no material difference in the circumstances leading to the registration of these Domain Names by the Respondent and the arguments of both parties in this respect appear identical. Further, the Complainant made this request in its Reply to the Response and although the Respondent has filed a submission in response to this document, it did not appear to raise any objection to the addition of these Domain Names to the Complaint.

Accordingly, on 22 February 2012 the Panel notified ADR.eu that it agreed to the Complainant's request and ADR.eu sought formal Request for Registrar Verification in respect of the Domain Names. This was provided by the Registrar on 26 February 2012.

The second procedural issue arises out of the fact that both parties in this case have sought to file submissions in addition to the Complaint and Response. As this Panel stated in the BECA case already referred to in this decision:

"5.2 Under paragraph 10(a) of the Rules, the Panel has the power to conduct these administrative proceedings in such a manner as it considers appropriate in accordance with the Policy and the Rules. Paragraph 12 of the Rules permit the Panel to request, in its sole discretion, further statements or documents from either of the Parties in addition to the Complaint and the Response. Paragraph 10(d) states that the Panel shall determine the admissibility, relevance, materiality and weight of the evidence submitted to it. In determining whether it should admit evidence and if so the relevance, materiality and weight of such evidence the Panel shall, in accordance with paragraph 10(b) of the Rules, in all cases ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

5.3 However, it is now well-established that a supplemental filing will rarely be considered. In *DK Bellevue, Inc. d/b/a Digital Kitchen v. Sam Landers*, WIPO Case No. D2003-0780 the panel stated as follows:

'As is by now well established the Rules do not provide any right of reply. *Parfums Christian Dior S.A. v Jadore*, WIPO Case No. D2000-0938. Although supplemental submissions may be accepted to address new legal developments, see e.g., *Pet Warehouse v. Pets.Com, Inc.*, WIPO Case No. D2000-0105, or to rebut unexpected factual assertions, see e.g., *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, WIPO Case No. D2001-0237, they should be allowed sparingly.'

In the present case the Panel has considered the Complainant's Reply to the Response. The reason is that it seeks to rebut factual assertions in relation to the ownership of the Williams and Partner name. Frankly, it is questionable whether the Panel should have done so. The reason is that the Panel is far from convinced that the assertions contained in the Response would have come as a surprise to the Complainant. There clearly has been an on-going dispute for some time between the Complainant and Mr Sassen as to who has the effective right to use the "Williams & Partner" name that could have been dealt with in a more detailed manner in the original complaint. Nevertheless the Panel decided to give the Complainant the benefit of the doubt in this respect and the consideration of the Complainant's Reply to the Response has not affected the outcome of this case.

Also this is the document in which the Complainant made the request that the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names be added to these proceedings

So far as the Respondent's Reply to the Complainant's Reply to the Response is concerned, it for the most part re-iterated or amplified points that had been made in the Response. The Panel was unconvinced that there was any compelling factual or legal reason to consider this document further save to record that in this document no objection appeared to be raised in response to the Complainant's request that the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names be added to these proceedings.

PRINCIPAL REASONS FOR THE DECISION

There is a clear factual dispute in this case as to which of the parties is entitled to use, and who is the ultimately the rightful owner, of the mark WILLIAMS & PARTNER. That dispute appears to arise out of previous business dealings between the individuals who are behind each of the parties.

The WILLIAMS & PARTNER mark has been registered in a number of countries and the Complainant is the current registered owner of a Czech trade mark registration and the Respondent is the registered owner of that mark elsewhere. The position of each party appears to be that is true owner of the other party's marks.

The Panel proceeded (without deciding the issue) on the assumption that the Complainant was the owner of the Czech trade mark. That trade mark was confusingly similar to the <williams-partner.com>, <williamspartner.com> and <williamsandpartner.com> Domain Names.

However, the Complainant failed to convince the Panel that the <wnp.com> Domain Name was confusingly similar to that trade mark. The Panel took into account that the test of confusing similarity provides a low threshold test the purpose of which is effectively to assess whether a complainant has sufficient rights so as to give it standing to bring a complaint. Nevertheless in this particular case the Panel was not convinced that the fact that three letters in the Domain Name appeared in a (if spaces are to be ignored) 16 character trade mark relied upon, was sufficient.

The Complainant had not claimed unregistered rights (as that term is understood under the Policy) in the term "wnp" alone. Even if it had done so, in the unusual circumstances of this case where there is an on-going dispute as to who is entitled to use the name "Williams & Partners", it was unlikely that the Complainant could have established to the Panel's satisfaction that it was the owner of such rights.

Further the dispute between the parties, the fact that the Panel was not in a position to decide who was the true owner of the rights in the WILLIAMS & PARTNER name and marks and the fact that the Respondent was the recorded on the relevant registers as the owner of at least one registered trade mark in that name, meant that the Complainant had failed to establish that the Respondent had no right or legitimate interest in the Domain Names. Similar reasoning led the Panel to conclude that the Complainant had not satisfactorily shown bad faith registration and use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **WNP.COM**: Remaining with the Respondent
2. **WILLIAMS-PARTNER.COM**: Remaining with the Respondent
3. **WILLIAMSPARTNER.COM**: Remaining with the Respondent
4. **WILLIAMSANDPARTNER.COM**: Remaining with the Respondent

PANELLISTS

Name	Matthew Harris
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DATE OF PANEL DECISION 2013-02-27

Publish the Decision
