Decision for dispute CAC-UDRP-100900

Case number	CAC-UDRP-100900
Time of filing	2014-12-23 10:19:40
Domain names	hohmann.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Hohmann Fine Art, Inc.

Complainant representative

Name	Steve Rinehart

Respondent

Name	Hans Hohmann

Respondent representative

Organization	BPM legal

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on US registration No. 4582082 for the trademark HOHMANN claiming protection for "art gallery services" in class 35 and on common law rights over the trademark for HOHMANN.

FACTUAL BACKGROUND

About the Complainant

The Complainant was founded on April 1, 1976 in Germany by Werner and Ursula Hohmann for vending fine art. Christian Hohmann, the founders' son, joined the family business in 1993. Mr. Hohmann later assumed residence in California and opened other fine art galleries there, including one in Palm Desert, California. For nearly forty years, the Complainant has shown and sold fine art across Europe and North America. The Complainant maintains websites at <christianhohmann.com> (for US traffic) and <galeriehohmann.de>, which is destined to German traffic. The Complainant also maintains numerous storefront galleries. Over the years, the Complainant's clients and influence in the fine art industry have steadily grown. The Complainant has sold tens of millions of dollars worth of fine art across America, Europe and throughout the western world.

Given the nature and extent of its sales, advertising as well as client and media recognition, the Complainant maintains that the name and trademark HOHMANN has become well-known throughout the world and individuals and other entities have come to recognize the Complainant's mark as the distinctive identifier which it is.

About the Respondent

The Respondent is a graduate engineer for electrical engineering and operates his own business in Stuttgart, Germany, since 1991. The Respondent's family name is Hohmann.

The disputed domain name was offered for sale at www.afternic.com back in 2004. In October 2004, the Respondent acquired the disputed domain name at sedo.com for the amount of € 2.200,00. The Respondent has provided evidence of the purchase of the disputed domain name in 2004 from Sedo.

According to the Respondent, it took some time to manage the transfer of the disputed domain name from the seller's registrar in Malaysia to the Respondent's registrar in Germany. The Respondent maintains that he is using the disputed domain name in connection with his business, mainly for e-mail communication purposes since 2005, and that the content of the website has not changed throughout the years.

PARTIES CONTENTIONS

The Complainant's contentions are the following.

The disputed domain name should be transferred to the Complainant because it violates the rights of the Complainant on its HOHMANN US registered trademark and its common law trademark rights, for the following reasons.

The disputed domain name is identical to the Complainant's HOHMANN registered and common law trademark. The addition of the generic top-level domain ".com." is irrelevant for the purpose of assessing similarity under the Policy.

The Respondent's registration of the disputed domain occurred after the Complainant began using its mark in commerce. The Respondent created the disputed domain name on November 21, 2000 and renewed it many times over a period of years, including in 2006, 2007, 2008, 2010, 2011, 2012, 2013 and 2014. During these fourteen years, the Respondent has never made use of the disputed domain name. The disputed domain name only resolves to a generic landing page containing advertisements to competitors of the Complainant unaffiliated with the Complainant. The Respondent derives cost-per-click revenue from the landing page, including some having pornographic advertisements. The websites resolved by the disputed domain name have always been in English.

Given the passive use of the disputed domain name, its effective registration date for the purposes of this proceeding is November 21, 2014, which is the last date the disputed domain name was renewed. The Complainant cited a number of case precedents, in WIPO and NAF UDRP proceedings, where the Panelist held that the renewal date is the effective registration date in cases of long time passive holding of the disputed domain names.

The Respondent has no rights or legitimate interest in the disputed domain name. The Respondent's registration of the disputed domain name occurred after the Complainant began using its mark in commerce.

Once a complainant establishes a prima facie case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests. The Complainant has never authorized, licensed, or otherwise permitted the Respondent to use its mark. The Respondent's unauthorized and unapproved mis-direction of consumers searching for the HOHMANN mark damages the Complainant. As such, the Respondent's registration and use of the disputed domain name is not legitimate. Therefore, the Respondent use of the disputed domain name to intentionally divert Internet users seeking the Complainant's products and services to a direct competitor for its own commercial gain does not constitute a bona fide offering of goods or services, or a legitimate noncommercial or fair use of the domain name pursuant to the Policy.

The Respondent's registration and use of the disputed domain name is in bad faith, and illegitimate. The Respondent had knowledge when it registered the disputed domain name that the Complainant had rights in the disputed domain name. Use of the disputed domain name to only resolve to a generic landing page containing advertisements to competitors of the Complainant unaffiliated to the Complainant interferes with the Complainant's business affairs, creates initial interest confusion, and otherwise harms the Complainant by using the Complainant's mark to generate traffic and search engine rankings, as well as to deprive the Complainant of a gTLD in which to reflect its mark. The Respondent is therefore intentionally attempting to divert Internet users to its website via the disputed domain name and is therefore not making legitimate noncommercial, or fair use of the disputed domain name pursuant to Policy.

The Respondent's bad faith registration and use of the disputed domain name has, will, and continues to damage the Complainant through the loss of customers, profits, business, lower search engine rankings, and goodwill, as well as by damage to the Complainant's reputation and marks.

The Respondent's contentions are the following:

From a procedural point of view, the Respondent points out that the correct language of the proceeding is German, as the language of the registration agreement is German. The Complainant requested to change the language of the proceeding based on screenshots from the website available at the disputed domain name at a time, where the Respondent was not the registered owner of the disputed domain name. The screenshot as of February 5, 2005 simply states that the website cannot be crawled by the Wayback Machine in English, which is the language of the Wayback Machine. Therefore, there is no evidence whatsoever which would justify a language other than the language of the registration agreement.

However, as the Respondent is able to understand English, the Respondent accepts English to be the language of the proceeding, provided that he is not obliged to translate the German annexes to the Response into English.

The Respondent affirms that the Complaint has abused these proceedings. There can be no doubt that the Complainant has absolutely no right to the disputed domain name. The Respondent registered the disputed domain name in good faith solely because it corresponds to his family name.

The Respondent acquired the disputed domain name in 2004 because it corresponds to his family name. The disputed domain name was offered for sale at www.afternic.com back in 2004. In October 2004, the Respondent acquired the disputed domain name at sedo.com for the amount of € 2.200,00. It took some time to manage the transfer of the disputed domain name from the seller's registrar in Malaysia to the Respondent's registrar in Germany. Since 2005, the Respondent uses the disputed domain name in connection with his business, mainly for email communication purposes. The content of the website remained unchanged throughout all the years. The Respondent made available screenshots of his website at the disputed domain name of February 2, 2015, December 17, 2014, May 17, 2014, December 31, 2013, June 11, 2013, February 7, 2011, September 23, 2009 and October 14, 2005. The Respondent has not provided any kind of adult or infringing content at any time. The printouts attached to the Complaint refer to the domain name <hohman.com> and not to the disputed domain name <hohmann.com>.

With respect to the "identity or confusing similarity" requirement under paragraph 4(a)(i) of the Policy, the Respondent accepts that the disputed domain name is not only identical to his own family name but also to the family name of the

Complainant's owner and the trademark "Hohmann". However, the Complainant cannot rely on rights on the name "Hohmann" in this proceeding.

With regard to the trademark for "Hohmann" registered with the USPTO, the Complainant has failed to provide evidence that it is the rightful owner of such trademark. The trademark is registered in the name of a certain Hohmann Fine Art, PO Box 3407, 92261 Palm Desert CA, US, while the Complaint is filed in the name of Hohmann Fine Art, Inc., 73-660 El Paseo, 92260 Palm Desert, CA, US. Therefore, the Complainant does not correspond to the trademark owner and the Complainant has not provided any evidence that it can rely on the rights in the registered Hohmann mark. Moreover, the Respondent acquired the disputed domain name 10 years before the trademark "Hohmann" was registered with the USPTO.

With regard to the unregistered rights in "Hohmann", the Complainant has not provided sufficient evidence to establish such rights. It is well-established that common law trademark rights may be sufficient for the purposes of establishing rights under paragraph 4(a)(i) of the Policy. However, it is noteworthy that the requirements to establish common law trademark rights under the UDRP may differ from those necessary under national law. To establish common law trademark rights under the Policy, a complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. A conclusive allegation of common law or unregistered rights (even if undisputed) would not normally suffice. In fact, specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. The Complainant has not provided sufficient evidence in this regard, neither with regard to the date of the Respondent's acquisition of the disputed domain name in 2004 nor with regard to any later point of time:

- The screenshots of the Complainant's website postdate the Respondent's domain name acquisition by years.
- The Complainant's Articles of Incorporation for its Palm Desert location postdate the Respondent's domain name acquisition by years.
- The photograph of the grand opening of Complainant's gallery in Palm Desert in 2009 to the Complaint postdate the Respondent's domain name acquisition by years.
- The Photographs of the Complainant's catalog in German and the print ads, allegedly run by the Complainant to the Complaint are undated.

As the Complainant has not provided any evidence with regard to the length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys or media recognition, the Complainant failed to establish unregistered trademark rights under the Policy, at least with regard to the time of the acquisition of the disputed domain name in 2004. Furthermore, the Respondent denies that the Complainant is "well-known and favorably known throughout the world". Finally, according to the Respondent, it is noteworthy that, according to the printout of the trademark register provided by the Complainant, the trademark "Hohmann" was first used in commerce on January 1, 2013, which clearly contradicts the Complainant's assertions with regard to its use of the Hohmann mark.

With respect to the "rights or legitimate interests" requirement under paragraphs 4(a)(ii) and 4(c) of the Policy, the Respondent has rights or legitimate interests in the disputed domain name based on his family name and the fact, that the Respondent is using the disputed domain name in connection with his business ever since the acquisition of the disputed domain name in 2004.

The disputed domain name corresponds to the Respondent's family name, which gives the Respondent a right in the disputed domain name. Even if the Respondent was aware of the Complainant's mark when he registered the disputed domain name, the record does not support a conclusion that the Respondent registered the domain name with the intent of appropriating the Complainant's mark for his own use. According to the website available at www.deunamen.com, the name "Hohmann" is one of the 400 most common family names in Germany and therefore does not have a highly distinctive character. As the Complainant observes, the Respondent clearly has the right to use his own name. Without proof that the Respondent registered the disputed domain name in order to capitalize on the Complainant's goodwill in its mark, the Complainant cannot successfully invoke the Policy's narrow exception to the primary "first come, first served" rule in relation to domain name registrations.

The Respondent has at no time used the disputed domain name in connection with services in competition to the Complainant. In fact, the Respondent is using the disputed domain name in connection with its legitimate German business ever since its acquisition. Therefore, the Respondent can rely on rights or legitimate interests in the disputed domain name under paragraph 4(c)(i) of the Policy as well, in that the Respondent used the disputed domain name in connection with a bona fide offering of services before any notice of the dispute.

The fact that the Complainant waited about 10 years before complaining about the Respondent's activities, which are not similar to the Complainant's services and which was continuously conducted under the disputed domain name, adds successive years of legitimacy to the use the Respondent was making of the disputed domain name and legitimacy acquiesced in by Complainant. Despite having the opportunity to do so, the Complainant has offered no explanation for the 10-year delay in bringing this Complaint. Furthermore, given that the Complainant has not complained about the Respondent's business for over 10 years, it appears that any business disruption or confusion suffered by the Complainant as a result of the Respondent's domain name registration was either non-existent or de minimis, else the Complainant would have taken action in a more timely fashion.

With respect to the "bad faith registration and use requirement" under paragraphs 4(a)(ii) and 4(c) of the Policy, the Respondent has not registered and used the disputed domain name in bad faith for the following reasons.

Although a trademark can form a basis for a UDRP action under the first element irrespective of its date, when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right. In the present case, the Complainant had no registered trademark rights and has not provided sufficient evidence with regard to unregistered trademark rights in "Hohmann" at the time of the acquisition of the disputed domain name by the Respondent. In addition, the Respondent affirms that he had no knowledge of the Complainant or its German store or its trademark before receiving the Complaint in the present UDRP proceeding.

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

The Respondent has used the disputed domain name in connection with his bona fide business as an engineer in Germany ever since the acquisition. The Respondent has not tried to sell the disputed domain name to the Complainant at any time and has not acquired the disputed domain name primarily for the purpose of selling it to the Complainant. The Respondent has also not engaged in a pattern of registering third parties' trademarks as domain names.

Given that the Respondent is not a competitor of the Complainant and that the Respondent has at no time provided any kind of links to the Complainant's competitors and any other kind of advertising at the website available of the disputed domain name, the requirements of paragraphs 4(b)(iii) and 4(b)(iv) of the Policy are not existent as well.

Finally, the Respondent has invested a significant amount of money in the disputed domain name. Such circumstances are evidence that the acquisition and subsequent use of the disputed domain name was not in bad faith, as cyber-squatters generally do not invest such amount of money in a domain name registration.

Therefore, the Respondent has not used the disputed domain name in bad faith.

Lastly, the Respondent requests the Administrative Panel appointed in this administrative proceeding to issue a decision that the Complainant and its attorney engaged in Reverse Domain Name Hijacking in that it used the Policy in bad faith to attempt to deprive the Respondent of the disputed domain name.

Reverse domain name hijacking is defined in the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.". Moreover, paragraph 15(e) of the Rules provides as follows: "If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain

Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.". Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent's use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy".

The Respondent's registration of the disputed domain name predates the Complainant's claim of rights in the term "Hohmann" by far, and the Complainant knew this because it produced the WhoIs record for the disputed domain name as evidence attached to its Complaint. Thus, the Complainant, represented by an IP attorney, should have known that it was unable to prove that the Respondent registered the disputed domain name in bad faith. This suffices to establish Reverse Domain Name Hijacking.

The finding for Reverse Domain Name Hijacking is supported by the fact that the Complainant made false assertions with regard to the Respondent's use of the disputed domain name and provided screenshots from an unrelated domain name to the Panel in bad faith in order to get a decision in its favor.

The Complainant's attorney, in accordance with the Rules, paragraph 3(b)(xiv), wrote in the Complaint at paragraph 21 that "[t]he Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate […] and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.". It is irreproducible how that certification properly could have been made. Before filing this proceeding, there was apparently no attempt to confirm whether the Respondent possessed a legitimate interest in using his given name. Nonetheless, the Policy is clear that being commonly known by the disputed domain name is a clear ground establishing a respondent's right or legitimate interest. Complainant has therefore disregarded the mandatory rules governing this dispute, in particular, paragraphs 4(c)(i) and 4(c)(ii) of the Policy.

RIGHTS

The Complainant has, to the satisfaction of the Panel, 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 Complainant has failed to prove that the Respondent lacks rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

In view of the fact that the Respondent failed to prove that the Respondent lacks rights or legitimate interests in respect of the Domain Name, and that in order to succeed in a UDRP proceeding, all requirements under the Policy must be met, the Panel did not examine whether the Respondent registered and used the Domain Name in bad faith

PROCEDURAL FACTORS

The ADR Center issued a Notification of Deficiencies in Complaint pointing out that:

1) the Complaint lacked sufficient identification of the Respondent, since the Respondent's fax was missing; and

2) the Complaint was not filed in the language of the registration Agreement, which is German.

Therefore, the ADR Center invited the Complainant to submit an amended Complaint within five days of the date of the notification of deficiency.

Within the given term the Complainant submitted an amended Complaint indicating the Respondent's fax number. The

Complainant requested to change the language of the proceedings to English because the disputed domain name was used in English. To support this claim, the Complainant filed evidence that, according to him, showed use of the disputed domain name in English, in particular screenshots of the Respondent's website.

In its Response, the Respondent points out that the Complainant requested to change the language of the proceeding based on screenshots from the website available at the disputed domain name at a time, where the Respondent was not the registered owner of the disputed domain name. With respect to the other screenshots, the Respondent underlines that that dated February 5, 2005 simply states that the website cannot be crawled by the Wayback Machine in English, which is the language of the Wayback Machine. Therefore, there is no evidence whatsoever which would justify a language other than the language of the registration agreement.

However, the Respondent affirms that he is able to understand English and therefore the Respondent accepts English to be the language of the proceeding, provided that he is not obliged to translate the German Annexes to the Response into English.

Pursuant to Paragraph 11(a) of the Rules, "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The Panel shares the Respondent's view that the evidence submitted by the Complainant to support the request of change of language of the proceeding is inappropriate, since most of the screenshots refer to a time where the Respondent was not the owner of the disputed domain name, and the remaining evidence does not refer to the Respondent's website contents but to the the Wayback Machine website.

However, since the Respondent accepted the change of the language of these proceedings provided he was not compelled to translate the Attachments to the Response in English, the Panel agrees with the change of the language of the proceedings from German to English .

The Panel therefore determines, under paragraph 11(a) of the Rules, that English shall be the language of the proceedings.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, to succeed in a UDRP the Complainant must prove the existence of each of the following three elements:

(i) the domain name is identical or confusingly similar to a trade mark or a service mark in which the Complainant has rights; and
(ii) the Respondent has no rights or legitimate interest in respect of the domain name; and
(iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

For the purpose of these proceedings, the Complainant relies on the trademark HOHMANN, which was filed on 27 February 2014, and was granted on 5 August 2014, for "Art gallery services; On-line art galleries; Advertising and marketing services in the nature of promoting the goods of others, namely, the pieces of art of others; Sale of art, namely, retail store services and consignment store services featuring art", in class 35.

The Respondent contends that the Complainant cannot rely on above-mentioned trademark rights because the Complainant has failed to provide evidence that it is the rightful owner of such trademark. The trademark is registered in the name of Hohmann Fine Art, PO Box 3407, 92261 Palm Desert CA, US, while the Complaint is filed in the name of Hohmann Fine Art, Inc., 73-660 El Paseo, 92260 Palm Desert, CA, US. Therefore, the Complainant does not correspond to the trademark owner and the Complainant has not provided any evidence that it can rely on the rights in the registered Hohmann mark.

The Panel disagrees with the Respondent's consideration. As a matter of fact, there is no contradiction between the name of the holder of the HOHMANN US registration, and the Complainant's name. One is called Hohmann Fine Art, and the other is called Hohmann Fine Art, Inc.. The main difference lies in the addition of the initials "Inc.", which clearly refer to the type of legal entity holding the trademark registration. The US trademark registration holder does not contain this additional reference, while the Complainant's name does. The name of the two entities is however identical. Taking also into consideration the inclusion in both cases of a name referring to the Complainant's and trademark holder activity, i.e., "Fine Art", it is extremely unlikely that the two entities be different. The fact that the address indicated in the trademark application and the one indicated in this Complaint partially differ, is also not in itself a contradiction. As a matter of fact, the address referred to in the US trademark registration is a PO Box, while the address referred to in the Complaint is a street address. Nevertheless, both are located in Palm Desert, CA, US.

Therefore, the Panel concludes that the Complainant has satisfactorily demonstrated to be the owner of the US trademark registration for the name HOHMANN, cited as one of the basis of the Complaint.

With respect to the other unregistered trademark rights over the term HOHMANN cited as a basis of this Complaint, the Panel notes the following.

In order to successfully assert common law rights, "the complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the complainant's rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required" (See the 2011 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

In the case at issue the Complainant has supported its claim with the following evidence:

- Screenshots of the Complainant's websites;
- The Complainant's Articles of Incorporation;
- Photographs of the Complainant's store in the 1970,s in Germany;
- Publicly-displayed posters advertising the Complainant's gallery in 2000;
- Print ads run by the Complainant in newspapers, magazines and other media,

The Respondent has objected to the fact that this evidence is sufficient to positively conclude that the Complainant owns enforceable common law rights in the case at issue.

The Panel shares the Respondent's view. As a matter of fact, it is the Panel belief that while the evidence submitted to the Complaint may be sufficient to prove the use of the name HOHMANN in relation with art gallery services, it is insufficient to prove that the sign HOHMANN has become a distinctive identifier associated with the complainant or its goods or services, and has therefore acquired "secondary meaning". The Complainant failed to prove the amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition, etc. The statement contained in the US HOHMANN trademark registration that the trademark has been first used in commerce anywhere "since as early as 01/01/2004" and first used in commerce "since as early as 01/01/2013", and the filing of some pictures or posters, and the current screenshots from the Complainant's websites do not satisfy the requirements necessary to conclude, with sufficient certainty, that the name HOHMANN has become the Complainant's distinctive identifier. Even the Complainant's Articles of Incorporation do not attest the acquisition of such "secondary meaning". The Articles of Incorporation simply attest that a company bearing the Complainant's name was incorporated in 2009.

It is also worth noting that, as the Respondent has mentioned and proved, HOHMANN is one of the 400 most common

family names in Germany and therefore does not have a highly distinctive character. In such a situation, it is the Panel's opinion that the Complainant's burden of proof that the sign HOHMANN has become a distinctive identifier associated with the Complainant should be greater and supported with more convincing evidence.

For all reasons mentioned above, the Panel concludes that while the Complainant has satisfactorily demonstrated that it owns valid registered rights over the trademark HOHMANN, it has failed to demonstrate that it owns valid and enforceable common law rights over this name. Therefore, for the purpose of this decision, the Panel will only take into consideration the Complainant's US registered trademark HOHMANN covering services in class 35.

It is worth lastly noting that the HOHMANN registered trademark that is to be taken into account for the purpose of these proceedings is subsequent to the registration of the disputed domain name. As a matter of fact, the Complainant's HOHMANN US registration was filed on 27 September 2014, while the Respondent has proved to have acquired the disputed domain name in 2004 (while the disputed domain name was originally registered in 2000).

The Complainant maintains that since the Respondent never used the disputed domain name, the last renewal date should be considered its effective registration date for the purposes of this proceeding. In consideration of this statement, the disputed domain name should be considered as having been registered on November 21, 2014, which coincides with its last renewal date.

The Complainant cites a number of case precedents, in WIPO and NAF UDRP proceedings, where the Panelist held that the renewal date is the effective registration date in cases of long time passive holding of the disputed domain names. The Panel realizes that in some precedent decisions panels have considered the renewal of a domain name as equivalent to a new registration. However, it is the Panel's view, that the circumstances of the subject case do not enable to reach this conclusion. In the Panel's view, the disputed domain name registration date coincides with the date the Respondent has acquired the domain name, that is in 2004.

While it is true that the disputed domain name does not lead to an active website, but only to a page (in German) containing the following indication: "Here is the website created hohmann.com . So far no content yet filed, but you can contact us using the form below . We look forward to your letter !", there are no doubts that the Respondent holds the domain name since 2004 and renewed it since then. It does not appear that the Respondent ever changed its use of the domain name (the documents filed by the Complainant is support of this statement refer to a different domain name/website, namely to <hohman.com>), or that the use of the disputed domain name amounts to textbook cybersquatting, or that the Respondent renewed the disputed domain name with the intent to benefit from its inclusion of the Complainant's trademark.

In view of the foregoing, the Panel concludes that the disputed domain name was registered before the date of application of the Complainant's US identical trademark registration. This circumstance however does not prejudice the Complainant's rights under paragraph 4(a)(i)of the Policy since "registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights." (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

Finally, with respect to the identity requirement, it is crystal clear that the domain name <hohmann.com> is identical to the Complainant’s trademark registration for HOHMANN, as the addition of the “.com” gTLD should not be taken into account when comparing the two signs, as it lacks distinctive character.

Therefore, the Panel concludes that the Complainant has satisfied the first requirement under the Policy, that is that the disputed domain name is identical or similar to a service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant affirms that it never authorized, licensed, or otherwise permitted the Respondent to use its trademark, and that the Respondent's unauthorized use and unapproved mis-direction of consumers searching for HOHMANN mark

damages the Complainant. Therefore the Respondent's registration and use of the disputed domain name is not legitimate. The Complainant further stresses that "once a complainant establishes a prima facie case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests pursuant to the Policy".

The Respondent proved that the name HOHMANN coincides with his family name and maintains that for this reason the Respondent has rights and legitimate interests in the disputed domain name. "Even if the Respondent was aware of the Complainant's mark when he registered the disputed domain name, the record does not support a conclusion that the Respondent registered the domain name with the intent of appropriating the Complainant's mark for his own use. As the Complainant observes, the Respondent clearly has the right to use his own name. Without proof that the Respondent registered the disputed domain name in order to capitalize on the Complainant's goodwill in its mark, the Complainant cannot successfully invoke the Policy's narrow exception to the primary "first come, first served" rule in relation to domain name registrations".

The Panel shares the Respondent's arguments. Under Paragraph 4(c)(ii) of the Policy, one of the criteria to demonstrate rights or legitimate interests in a disputed domain name is that the respondent has been commonly known by the domain name. Of course, in the instant case no one can deny that the Respondent, whose family name is HOHMANN, has been commonly known by the disputed domain name.

Furthermore, it is worth adding that nothing in the Complaint suggests that the Respondent is using the disputed domain name inappropriately, i.e., for commercial gain, or with an intention to divert the consumers of reference, or to take advantage from the reputation and goodwill of the Complainant's trademark. As said, the disputed domain name does not lead to an active website, or - at most - is used to receive e-mails addressed to the Respondent. Moreover, the name HOHMANN is not unique nor particularly distinctive, considering that, as mentioned before, it is one of the 400 most used family names in Germany.

It follows from the above that the Complainant has failed to demonstrate that the Respondent lacks rights or legitimate interests in the disputed domain name.

C. BAD FAITH

In order to succeed in a UDRP Complaint, it is necessary to satisfy all three requirements under the Policy. These requirements are therefore cumulative, not alternative. Since the Complainant failed to prove the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii)of the Policy, it is worthless examining the existence of the bad faith requirement.

D. REVERSE DOMAIN NAME HIJACKING

Reverse domain name hijacking is defined in the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.". Moreover, paragraph 15(e) of the Rules provides that: "If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

As the Respondent previously pointed out "[a]llegations of reverse domain name hijacking have been upheld in circumstances where a respondent's use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy" (see among Others International, Inc v. Gold Line, WIPO Case No. D2000-1151 (<goldline.com>)).

The Panel does not believe that the reverse domain name hijacking claim is well-grounded for the following reasons. Preliminarily, the Complainant has satisfactorily demonstrated that it owns a valid US trademark registration for the identical sign HOHMANN. Furthermore the Complainant has demonstrated that this name is used in connection with art gallery services since at least 2000 (this is the date of the Juan Mirò posters promoting an exhibition held in the Hohmann gallery in

2000). Therefore, despite the Respondent failed to prove that it owns enforceable unregistered trademarks against the disputed domain name because the evidence submitted lacked of sufficient strength, it nevertheless proved that the name and sign HOHMANN has been circulating of a long time in respect of art gallery services.

Furthermore, as mentioned above, it is worth noting that the disputed domain name does not appear to have been used for a long time (probably ever since its registration). Although the website displays a tool that could probably be used to send e-mails to the Respondent, and despite the Respondent attests in its declaration that the disputed domain name is used for e-mail communications, the Panel finds that the Respondent did not file supporting evidence to this declaration, and that a mere statement from the Respondent, has a limited probative value, without any additional corroborating evidence. The Respondent could have easily demonstrated that the disputed domain name is effectively used for e-mail communications by submitting copies of on-going correspondence, but he failed to do so.

Accordingly, even if the Complainant failed to demonstrate that the Respondent lacks rights or legitimate interests in the disputed domain name, and the mere passive holding of a domain name even if for a prolonged period of time, without any other conclusive element does not amount to a bad faith registration and use of the disputed domain name, the Panel believes that in the instant case the Complainant and its representative could have had, under a fair interpretation of the facts, legitimate expectations to succeed in the UDRP dispute.

In reaching this conclusion the Panel has also evaluated the Respondent's argument that the Complainant submitted evidence of use referring to another domain name. While the Panel agrees with the Respondent that this circumstance should have been avoided, it is more inclined to believe that the submission of the wrong screenshots is more due to a Complainant's inattention, than to the Complainant's bad faith.

Therefore, for all the reasons mentioned above, the Panel dismisses the Respondent's reverse domain hijacking claim.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **HOHMANN.COM**: Remaining with the Respondent

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2015-03-04

Publish the Decision