Decision for dispute CAC-UDRP-101109

Case number	CAC-UDRP-101109
Time of filing	2015-11-16 11:22:34
Domain names	nanotemper.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	NanoTemper Technologies GmbH

Complainant representative

Organization	AC Tischendorf Rechtsanwälte mbB

Respondent

Name	Robert Eibl

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings that would relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant, incorporated on 27 May 2008, is the holder of the (1) EU trademark "NANOTEMPER" with register no. 008696767, filled on 18 November 2009 in the classes 1, 5, 9, 10, 38, and 42, as well as of the (2) US trademark "NANOTEMPER" with register no. 4223921, registered on 16 October 2012 in the classes 1, 5, 9, 10, and 42.

Mr. Philipp Baaske and Mr. Stefan Duhr are the managing directors of the Complainant and at the same time holders of the German trademark "NanoTemper", which has been registered under register no. 30745750 in the classes 16, 1, and 9 on 12 July 2007.

FACTUAL BACKGROUND

The Complainant contends that:

(1) the name "Nanotemper" was mentioned for the first time in a press release of the Ludwig Maximilians University Munich dating from 7 February 2007 on the Munich Businessplan Competition 2007 (Münchener Businessplan Wettbewerb), as "Team Nanotemper", consisting of Baaske and Duhr who later became the managing directors of the Complainant as well as the Business Economics student Marko Hierling, was the winner in the category "Student Ideas" (Idee von Studierenden). It is

argued that immediately after the press release was issued, the Respondent registered the disputed domain name on 18 June 2007.

(2) their managing directors had granted the Complainant an exclusive right of use for the German trademark "NanoTemper" (DE 30745750).

(3) the Respondent had offered the disputed domain name for sale to the Complainant in October 2010 for a price of 20,000 Euros and again to an employee of the Complainant on 14 July 2015 for a price of 50,000 Euros.

(4) the Respondent prevents the Complainant from exercising their rights to their US and EU trademarks as well as to their (sic!) German trademark.

(5) the Respondent is not using the domain name, but the Complainant has presented an email from the Respondent, in which a handling fee is demanded by the Respondent for forwarding emails sent using the disputed domain name to the Respondent which were, however, meant for the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has established that it owns an EU and a US trademark in respect of the term “Nanotemper”. The Panel holds that the disputed domain name is identical to the “Nanotemper” trademarks as it is well established that the specific Top-Level of a domain name - in this case (dot) com - does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. Registration of the disputed domain name before the Complainant acquires its trademark rights in the name “Nanotemper” does not prevent a finding of identity or confusing similarity under the UDRP. Accordingly the Complainant has established the first element of paragraph 4(a) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s case is that there is no valid use of the disputed domain name although it is obviously used for the purpose of sending and receiving emails as the Complainant presents relevant evidence. The Complainant does not provided the Panel with other clear evidence showing how the disputed domain name has resolved at various points in time. The Panel therefore reviewed the Way Back machine at www.archive.org which shows one screen shot on Februar 11, 2011 that resolved to a private homepage of the Respondant. Later the screen shots resolve to a note by the registrar that the disputed domain name is already registered. These evidence indicate that the disputed domain name was used in its original and ordinary meaning as a legitimate noncommercial site and is still used for the purpose of sending and receiving emails. This use may be permissible and indeed consistent with recognized sources of rights or legitimate interests under the UDRP as there is no capitalization of a trademark value. At least, there is nothing on the current website that suggests any commercial activity, either by way of advertising competing products or providing sponsored links to competitors of the Complainant. In light of the above, the Panel is confirmed in its view that the Complainant has not shown that circumstances specified in the second element of paragraph 4(a) of the Policy exist why the Complainant has failed to establish that the Respondent had no rights or legitimate interest in the registration and use of the disputed domain name as required by the Policy particularly as there can also be no doubt that the Respondent could not be aware of a Complainant’s trademark at the time of registration of the dispute domain name as the disputed domain name has been registered on 18 June 2007, i.e. before the incorporation of the Complainant on 27 May 2008 and before the registration of the Complainant’s EU and US trademarks on 18 November 2009 and 16 October 2012.

BAD FAITH

In view of its finding the under the preceding paragraph, it would be unnecessary for the Panel to consider this part of paragraph 4(a) of the Policy. However, as the disputed domain name has been registered on 18 June 2007 before,

(1) the incorporation of the Complainant on 27 May 2008 the Complainant cannot assert any pre-existing rights to a

company or to a special trade name against the Respondent and

(2) the registration of the EU and US trademarks on 18 November 2009 and 16 October 2012 respectively the Complainant can also not assert any pre-existing trademark rights;

(3) the registration of the German trademark on 12 July 2007 by the managing directors of the Complainant Philipp Baaske and Stefan Duhr regardless the Complainant cannot assert any rights to the German trademark as the Complainant only claims to have been granted an exclusive licence by the holders of the trademark rights, but the existence of any such licence has not been established by presenting a contract;

it is noted that the Complainant in fact knew or clearly should have known at the time that it filed the Complaint that it could not prove the essential elements required by the UDRP especially as it is also far-fetched to assume, that the name "Nanotemper" could become a common law trademark of whomever just by issuing a press release.

The submissions made by the Complainant were simply assertions that the actions of the Respondent in offering the disputed domain name for sale and in using the disputed domain name actively only for the purpose of sending and receiving emails, somehow resulted in the Respondent registering and using the Disputed Domain Name in bad faith. Given the nature of the Policy this are arguments that have no reasonable prospects of success in the circumstances of this case.

Complainant and its counsel are sophisticated and certainly understand the importance of knowing the law and facts before the proceedings wherefore the Complainant should have knew when it filed the Complaint that it could not prove at least 2 of the elements of the Policy to prevail. The fact that the Complaint shows no evidence of wrongdoing of the Respondent itself proofs bad faith of the Complainant in filing this action.

In light of the above, the Panel is confirmed in its view that the Complainant attempts to secure the disputed domain name by making a false claim against the Respondent as a rightful owner of the disputed domain name (reverse domain name hijacking). Paragraph 15(e) of the Policy defines reverse domain name hijacking as the filing of a complaint in bad faith, resulting in the abuse of the UDRP administrative process, i.e. when the registration of the domain name predates any trademark rights of the Complainant.

As a result, the Panel finds that reverse domain name hijacking is made out in this case.

PROCEDURAL FACTORS

The dispute resolution procedure requires necessarily a language regime, in order to ensure the principle of the right to a fair trial and to prevent a potential unequal treatment of the parties involved. Preferentially, the parties of the dispute resolution procedure should determine the language of the proceeding as they know best how to communicate with each other. But they have to expressly agree on a language, because the wording of § 11(a) UDRP rules does not allow for a parallel use of different languages at the proceeding. If the parties do not agree on a language, which tends to be the rule, the UDRP adopts the language of the registration for the disputed domain name, since the holder of the domain name subjects itself via this registration to the UDRP. The common specification can be deviated from if the dispute resolution procedure provides grounds for it.

According to the registrar of the disputed domain name the registration took place in German. The ADR provider has, however, formally accepted the complaint, which has been written in English, even though it has not been composed in the language of the domain name registration, after the Complainant applied for change of language of the proceeding.

The Complainant is of the opinion that there is no ADR provider which also operates in German, therefore the Complainant felt compelled to submit the complaint in English. It is true that the ADR Provider appealed to by the Complainant, just like any other ADR provider, does not maintain a website in German for UDRP procedures. However, this certainly unfortunate neglect by ADR providers cannot be used against the Respondent, especially since the ADR Provider appealed to also conducts dispute resolution proceedings in other languages (Russian: CAC case no. 100903 - ARCELORMITTAL-HQ.COM; French: CAC no. 100325 - RUEDUCOMMERCE.BIZ)

The Complainant further believes that the proceeding should be conducted in English since the Respondent has command of the English language which could be deduced from his English website under the domain name ROBERT-EIBL with the top level domain (dot)de. Neither the ability to speak a foreign language nor the existence of a website, which has no connection with the dispute resolution procedure at hand, are however adequate for complying with the request of the Complainant. The Respondent has (1) indicated his intention to negotiate with the Complainant, who also resides in Germany, in their native language by conducting correspondence in German, which has been translated by the Complainant for the purpose of the proceedings, and (2) according to the Panel, command of the English language of a Respondent alone is not sufficient grounds for deviating from the general provisions of § 11(a) UDRP rules. However, other Panels have agreed to a change of language of proceedings to the supposedly lingua franca of the Internet, if

(a) the website maintained under the disputed domain name has been written in English (see CAC case no. 100934 - ENTERPRISECARSHRE.COM). However, this is not applicable in this case as upon opening the website under the disputed domain name only a German note by the registrar is shown, according to which the disputed domain name has already been reserved. Even if the registrar would use geolocation information for the linguistic adaptation of the text to the respective position of the user opening the website, the Complainant cannot refer to the language of the text shown since the Respondent has no influence on the language version of the text shown and incidentally it cannot be determined which language is to be authoritative for the website.

(b) the address of the Respondent specified in the Whois of the disputed domain name is in a country in which the official language is English (see e.g. CAC case no. 100817 - PROTECT-HAPAGLLOYED.COM). However, this is not applicable in this case, because the Respondent has specified a German address at the time of registration. Additionally, in the opinion of the Panel, an address cannot govern the language of proceedings, as e.g. even in the United States where there is no official language specified on a federal level, 16.3% of the population speak Spanish as a native language, making the USA the country with the second largest number of Spanish native speakers in the world (see Ennis/Ríos-Vargas/Albert, The Hispanic Population: 2010, 2010 Census Briefs. (2011)), and as there are a number of countries where another language besides English is the official language such as Hong Kong (Chinese), India (Hindi), Canada (French), Malta (Maltese), New Zealand (Maori).

(c) correspondence about the rights on the disputed domain name has been conducted in English (see CAC case no. 100799 - TAXOFON.COM). However, that has not been the case in this instance. The fact that the correspondence between both parties has been conducted in English can however, in the Panel's view, generally not be used to determine the language of proceedings because it is no indicator for their command of the language, as all parties could have employed the services of a translator for their correspondence. Panels therefore exceed their authority if they burden respondents with possible additional translation costs because a complainant does not submit the complaint in the language of registration.

(d) a complainant in dispute resolution procedures, in which the complaint has not been written in the language of the registration for the disputed domain name, has not defended themselves (see CAC case no. 100863 - NOVONORDISK.XYZ), which also is the case here. In the opinion of the Panel, a default on part of a respondent can however in general not be perceived as the consent to changing the language of the proceeding, in particular since the UDRP does not perceive the silence of a respondent as consent to the transfer of rights on the disputed domain name, but rightly requests a dispute resolution.

(e) the disputed domain name has been registered in ASCII which is based on the Latin alphabet and is used in English (see e.g. CAC case no. 100707 - MOUNTGAI.COM), but as the Latin alphabet is a common type system, that refers to many languages and not primarily to English.

(f) the registrar only offers their services in English (see CAC case no. 100684 - MYVANILLACARD.COM), which however has not been presented nor has it been evident in this dispute procedure and can therefore not be authoritative if a different language has been expressly agreed upon in the registration.

(g) the disputed domain name is composed of English words (see e.g. CAC case no. 100734 - SAFEDEAL-

HAPAGLLOYD.COM), which does not apply in this case, since the prefix "nano" is of Greek origin and because it incidentally would not be plausible, in light of wide spread Anglicism in technical languages, everyday language and slang as well as in particular in marketing jargon, to derive the language of proceedings from a domain name.

(h) sales are also made in currencies of English-speaking countries (CAC case no. 100331 - ECCOSHOESOUTLET.ORG), which however does not apply in this case and which is also otherwise unsuitable to override the language defined in the registration for a disputed domain name in light of the pre-eminence of certain currencies in the international currency system.

(i) complainants do not know the language defined in the registration conditions for a disputed domain name and will therefore be burdened with additional translation costs if the proceeding is not to be conducted in English but rather in Slovenian (CAC case no. 100967 - TRIANGLERENTAL.COM), Chinese (WIPO case no. D2008-1191 - SHOP-ZAPPOS.COM), Korean (WIPO case no. D2008-1002 - FISSLER.COM) or German (NAF case no. FA1006001330274 - INORGREN.COM). However, the Complainant in this case is a resident of Germany, which is why even this reasoning that has been adduced by other panels, which also overlook the fact that the UDRP treats all languages as equal, meaning English is not the preferred language for dispute procedures, does not apply. The panels also overlook the fact, that non-Latin languages by now prevail in the Internet, which is why their reasoning is flawed and they would need to give Asian languages precedence. Ultimately, the convenience for a complainant or for a panel cannot be the decisive factor for choosing a language.

(j) a respondent is familiar with the UDRP procedure, because the respondent has already been involved in several proceedings (CAC case no. 100967 - TRIANGLERENTAL.COM), which however has not been presented or evident in this dispute procedure nor can it be authoritative for choosing the language of the proceeding, in particular if a respondent has not submitted a statement of defence in other proceedings.

As has become evident from the aforementioned there is no justification for conducting the dispute resolution procedure in English, for which reason the Complaint has to be dismissed also on procedural grounds, as it has not been composed in the language of the domain name registration.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name has been registered before the incorporation of the Complainant. Therefore the Complainant cannot assert any pre-existing rights to a company or to a special trade name against the Respondent. The Complainant can also not assert any preexisting trademark rights since the EU and US trademarks of the Complainant have also been registered after the registration of the disputed domain name. Regardless of the registration of the German trademark by the managing directors of the Complainant Philipp Baaske and Stefan Duhr after the registration of the disputed domain name, the Complainant cannot assert any rights to the German trademark as the Complainant only claims to have been granted an exclusive licence by the holders of the trademark rights, but the existence of any such licence has not been established by presenting a contract.

Considering that after their own pleading the Complainant should have recognised on his own, that the Complainant did not own any pre-existing rights in regards to the registration of the disputed domain name, the Complainant has tried to use the complaint procedure in bad faith in order to deprive the Respondent of the domain name (para. 15 (e) UDRP rules).

Also, there is no justification for conducting the dispute resolution procedure in English, for which reason the Complaint has to be dismissed also on procedural grounds, as it has not been composed in the German language of the domain name registration.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

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

DATE OF PANEL DECISION 2016-01-24

Publish the Decision