Decision for dispute CAC-UDRP-101587

Case number	CAC-UDRP-101587
Time of filing	2017-07-18 10:56:39
Domain names	FITNESSPEOPLE.CLUB

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Fitness People B.V.

Complainant representative

Organization	Bird & Bird Advokatpartnerselskab

Respondent

Name	Jes Hvid Mikkelsen

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings of which the Panel is aware.

IDENTIFICATION OF RIGHTS

There is no evidence that the Complainant is the owner of a registered trademark on which it can rely in this proceeding.

However, the Complainant contends that it has an unregistered or common law trademark with which the disputed domain name is alleged to be identical or confusingly similar. If the Complainant were able to establish to the satisfaction of the Panel that it has such an unregistered or common law trademark it will have established trademark rights that are sufficient to found a proceeding under the UDRP.

For reasons set out in detail hereunder, the Panel finds that the Complainant has not established that it has such a trademark and the proceeding will therefore fail.

FACTUAL BACKGROUND

The Complainant and the Respondent are in disagreement on what appear to be all of the essential factual matters in this proceeding and the wider dispute between the parties. The Panel therefore notes that all of the factual matters that are necessary for an understanding of the Panel's decision are set out in the parties' contentions and referred to in the Principal Reasons for the Decision.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant made the following contentions:

1. The Respondent is the former CEO of the Complainant

2. The Respondent purchased the disputed domain name for himself while he was still the CEO of the Complainant.

3. The Respondent purchased the disputed domain name in bad faith, fraudulently stole the content of the Complainant's domain, FITNESSPEOPLE.COM, and is now using the disputed domain name to mislead costumers of the Complainant to believe that the Complainant's business has been moved to the disputed domain.

4. In August and September 2016 while the Respondent was the CEO of the Complainant, a representative of the Complainant negotiated the purchase of another domain confusingly similar/identical to the disputed domain; FITNESSPEOPLE.COM. The purchase from the former owner, Raymond T. Furlong, was negotiated by the current CEO Patrick Drew on behalf of the Complainant.

5. The purchase of FITNESSPEOPLE.COM was finalized by the Respondent as CEO of the Complainant. The Respondent paid for the transfer of the domain by using his company credit card, and thereby by using funds belonging to the Complainant. The payment was made using escrow.com in September 2016.

6. Payment was made with a credit card belonging to the Complainant. The payment was made by "J.H.P MIKKELSENFITNESS PEOPLE B.V.", meaning that the payment ID consists of both the name of the Respondent and company name of the Complainant. The Respondent used his company credit card to finalise the purchase which is why the legal proprietor of FITNESSPEOPLE.COM is the Complainant.

7. The Respondent is no longer employed by the Complainant.

8. The latest update registered regarding FITNESSPEOPLE.COM in the Whois-register was made on 1 May 2017. On this date the Respondent transferred the FITNESSPEOPLE.COM domain to his alias Mickey Jezzard, but kept his own contact information on the Whois record, i.e. his telephone number and his e-mail address.

9. The Respondent was the person who on behalf of the Complainant purchased the FTNESSPEOPLE.COM domain.

10. After the Respondent was dismissed of the position as CEO of the Complainant, the Respondent started another company offering the exact same goods and services as the Complainant. The Respondent registered the disputed domain name which is identical/confusingly similar to the FITNESSPEOPLE.COM domain on 30 July 2016 using GoDaddy.com as the Registrar.

11. The Respondent copied the original website of the Complainant (as it looked on FITNESSPEOPLE.COM before the dismissal of the Respondent) to the disputed domain name. One of the appendixes attached to the Complaint shows different print screens that show the former content of FITNESSPEOPLE.COM, including:
- Purchase of a "Quest bar"
- Overview of people that had a membership with FITNESSPEOPLE.COM
- A customers print screen of a default on FITNESSPEOPLE.COM
- Link on Instagram
- Content on the Instagram profile

Another appendix shows following information on the disputed domain that does not refer to the Respondent, but to the Complainant, thus underlining that the Respondent has copied the whole content from FITNESSPEOPLE.COM on to the disputed domain name:
- the contact information of the Complainant,
- referring to "All rights are reserved by Fitness People B.V." ie. the Complainant, and
- stating "Welcome to FitnessPeople.com" in the "Terms and conditions" of the website.

12. The Complainant did not give its consent to transfer the content.

Rights and/or legitimate interests

12. The Respondent has no rights or legitimate interests in the disputed domain name in accordance to paragraph 4(a)(ii) of the Policy.

13. The fraudulent overtaking of the content of FITNESSPEOPLE.COM by the Respondent cannot establish a right or legitimate interests in the disputed domain name. The objective for the Respondent has been and is still to steal as many customers as possible from the Complainant.

14. In regards to paragraph 4(a)(i) of the Policy, the Complainant has rights due to the unregistered trademark and company name FITNESSPEOPLE that has been used consistently and continuously by the Complainant to market its goods and services since the founding of the company. The Complainant has used a significant amount of money in the marketing of FITNESS PEOPLE in the industry and some transactions have been completed through FITNESSPEOPLE.COM.

15. Unregistered trademark rights have previously been regarded as sufficient to satisfy the requirement in paragraph 4(a)(i) of the Policy.

16. The use of a term in connection with specific products have also previously been recognized as unregistered trademark rights, see accordingly WIPO case no. D2000-0575 (finding that complainant demonstrated unregistered trademark rights in a term based on evidence that complainant had been using the mark in association with its business for years prior to the registration of the disputed domain name) and WIPO case no. D2001-0770 (finding that complainant’s use of a term as a trade name in connection with its product on its website was sufficient evidence that complainant had tied its business name to its product in advertising and promotion and, consequently, was sufficient evidence of complainant’s rights in the trade name as an unregistered trademark).

17. Based on the above submitted evidence the Complainant has a common law trademark right to the FITNESSPEOPLE trade name. Since the Respondent has no rights or legitimate interests in FITNESSPEOPLE.COM the Complainant has proved that the requirements of paragraph 4(a)(i) and (ii) are met.

Bad faith

18. The disputed domain contains a direct copy of the content that belongs to the Complainant. The Respondent purchased the disputed domain name while he was still the CEO of the Complainant and while he was finalizing the purchase of an identical/confusingly similar domain name on behalf of the Complainant, in accordance to paragraph 4(a)(i). The disputed domain name contains the name and business identifier of the Complainant of which the Respondent used to be the CEO. The Complainant registered the disputed domain name in bad faith in accordance to paragraph 4(a) (iii) of the Policy and in violation of his Shareholders Agreement.

19. The disputed domain name contains the above stated information regarding the Complainant, underlining that the Respondent is using the disputed domain name to mislead customers of the Complainant to believe that the Complainant has moved its online business to the disputed domain name.

20. In accordance to Rules for Uniform Domain Name Dispute Resolution Policy section 3 (b) (ix) (2), the Respondent has

registered and uses the disputed domain name in bad faith and the Complainant therefore requested a transfer of the disputed domain name to the Complainant.

RESPONDENT:

The Respondent made the following contentions:

1. It rejects any transfer of any its domain names, including <fitnesspeople.club>.

2. In July 2016 the Respondent personally purchased the disputed domain name and registered it in his personal name Jes Hvid Mikkelsen, Galionsvej 15, 1437 Copenhagen, Denmark.

3. The disputed domain name <fitnesspeople.club> has been registered in the Respondent's personal name only, and has at no point been registered by any other person or company. It has purchased the disputed domain name <fitnesspeople.club> before the Complainant FitnessPeople BV was even founded as a company.

4. The Respondent has been running the company FitnessPeople ApS in Denmark since 2013, as documented by appendix attached to the Response. He stated he will not accept any violation of his personal or company rights.

5. The Respondent stated that the Complainant FitnessPeople BV has no right to claim any domain, since the Respondent and his company FitnessPeople Aps have the historic rights to the name FitnessPeople.

6. The Respondent has over the years purchased and registered several fitnesspeople domain names, namely: <fitnesspeople.dk>, <fitnesspeople.eu>, <fitnesspeople.be>, <fitnesspeople.se>, <fitnesspeople.club>, <fitnesspeople.cz>, <fitnesspeople.com>, <fitnesspeople.pl>.

7. The Respondent has been the owner of several of the above-mentioned domain names for more than 10 years, and several of the domains are in use.

8. The Respondent stated he will under no circumstances accept claims from FitnessPeople BV in the Netherlands, or any transfer of any of my personally owned and correct-registered domains to any other person or company.

SUPPLEMENTARY SUBMISSIONS

The Panel decided to accept supplementary submissions (i.e. supplemental filings). Supplementary submissions were filed by both parties twice in form of so called “Nonstandard Communication“.

COMPLAINANT

By a Nonstandard Communication, the Complainant made the following further contentions:

1. The Response is "fraudulent as factually incorrect ." The Respondent is i.e. not running the company FitnessPeople ApS, company registration number 33867212, in Denmark. The company was declared bankrupt by court decree on 5 January 2017 based on a petition filed on 25 August 2016, cf. enclosed copy of transcript from the Companies Registry (Erhvervsstyrelsen). The handling of the bankruptcy was finalized by the court on 21 June 2017, so this fact was clearly known to the Respondent when filing the response in this matter.

2. The Complainant maintains its position that the disputed domain name is used in bad faith by the Respondent as it was legally registered on behalf of the Complainant and paid for by the Complainant.

RESPONDENT

By a Nonstandard Communication, the Respondent made the following further contentions:

1. The Complainant's contention in the Complaint No 101587 " The Respondent is Jes Mikkelsen who registered the disputed domain name on 4 October 2016, see Appendix" is false according to the Respondent. He then stated he purchased the disputed domain name <fitnesspeople.club> in his private name on July 30, 2016, and attached invoice from the registrar.

2. The Complainant's claims in the Complaint No. 101587:
"The Complainant is an online retailer of sport and fitness supplements, and offers consumers the opportunity to purchase products at the actual cost prices if the consumers become members of FitnessPeople Club."
and
"In regards to paragraph 4(a)(i) of the Policy, the Complainant has rights due to the unregistered trademark and company name FITNESSPEOPLE that has been used consistently and continuously by the Complainant to market its goods and services since the founding of the company."

are false according to the Respondent. The company Fitness People BV does not run any online business (nor offline) and is not operating as an online retailer. Fitness People BV does not offer nor sell anything to anyone. No products and no services. It is an inactive registration in the Netherlands. There is no trace whatsoever, to be found on the Internet of Fitness People BV business activities. The statements from the Complainant are false and written in bad faith according to the Respondent.

3. The authorised representative of the Complainant is in his submission of August 11, 2017, "accusing me of being fraudulent. That is a strong word to use by a person that clearly build the entire complaint on false information - as mentioned above - and it is of course not true. My aim is strictly to document my historic and continual use/business of the name FitnessPeople, and the complainant is even fully aware that the activities of FitnessPeople Aps was partly split and continued in Fitness People Aps, Hesselager 16, Brondby, in 2014. On top of that I, in person and under my name, started;

- The Facebook-page 'Fitness-People.net' in February 2011 accompanying an online training platform I marketed,
- the Facebook-page 'FitnessPeople' in October 2014,
- the Instagram-page 'FitnessPeople.beone' in November 2014,
- and had the FitnessPeople logo designed in November 2014 (see attached file, originating from Nov 26, 2014). I personally own the copyright to the FitnessPeople logo."

4. My personal purchase and ownership of several FitnessPeople-domains - some for 10 years - and my historic and continued use of FitnessPeople and various business activities for more than 7 years in the name of FitnessPeople is documented and can not be questioned.

5. Lars Karnø, Bird & Bird, further explains in his 'Non Standard Communication' of Aug 11, 2017, that he failed to meet his simple obligations and duties on the complaint he filed in a wish to prolong this fabricated dispute. The usual period of vacation in Denmark ended two weeks ago. I do not know if Lars Karnø simply neglected his responsibilities or he didn't bother to pass on the task to one of the more than 30 lawyers employed at Bird & Bird in Denmark. This negligence is sadly in line with the full text from the complainant in 'complaint, No. 101587'. The complainant didn't even care to write in the correct domain-name, fitnesspeople.club. This is unheard of. This complaint is pure harassment and solely an attempt to obstruct my legitimate business. This Bird & Bird-nonsense must end now for me to carry on with my FitnessPeople business activities selling fitness apparel in USA.

COMPLAINANT

By a Nonstandard Communication, the Complainant made the following further contentions:

As documented with Appendix 12 - the Shareholders Agreement of Fitness People B.V. - the Agreement was entered into

and signed also by the Respondent already on 11 July 2016. Appendix 12 contains among other articles a Non-competition clause in article 14 and a Non-solicitation clause in article 15. According to clause 14 and 15 it is impossible for the Respondent to have any legitimate interest in competing activities after 11 July 2016 and until 36 months after selling his shares. Registering the disputed domain name FITNESSPEOPLE.CLUB after 11 July 2016 and using the domain for competing activities is a clear violation of article 14 and 15 of the Shareholders Agreement and clearly a registration and use of the domain in bad faith.

RESPONDENT

By a Nonstandard Communication, the Respondent made the following further contentions:

The Respondent stated he is not using any domain in competitive business, he does not run any kind of competitive business, does not violate any agreement, and does not violate the shareholders agreement either.

RIGHTS

The Complainant has not, to the satisfaction of the Panel, shown the disputed 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 not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met..

PRINCIPAL REASONS FOR THE DECISION

The first issue that arises for consideration is whether the Complainant has a trade or service mark on which it can rely.

The Complainant does not have a registered trademark and therefore seeks to rely on an unregistered or common law trademark. It is possible to do so as it is now well established that a complainant may rely on an unregistered trademark in UDRP proceedings and that view, which in any event is within the clear words of the Policy, has been followed in many prior decisions.

See, for example, the following observations of the panelist in Record Connect, Inc. v. Chung Kit Lam / La-Fame Corporation

Claim Number: FA1609001693876 (November 3, 2016):

"Complainant does not claim to own a registration of the RECORD CONNECT mark with any trademark registration agency. However, prior panels have agreed that when a complainant can demonstrate common law rights, Policy 4(a)(i) is satisfied. See Oculus VR, LLC v. Ivan Smirnov, FA 1625898 (Forum July 27, 2015) (holding, ´A Complainant does not need to hold registered trademark rights in order to have rights in a mark under Policy 4(a)(i) and it is well established that a Complainant may rely on common law or unregistered trademarks that it can make out.´)."

However, it is equally clear that the allegation that a complainant has a common law trademark must be proved, as must all essential elements of the Policy

It is therefore quite insufficient and not in compliance with the UDRP for a complainant merely to assert that it has a common law or unregistered trademark without proving it. The Complainant in the present case has not proved or even attempted to prove in any understandable or persuasive way that it has such a trademark in FITNESS PEOPLE.

So far as the Panel can tell, the Complainant's entire case on this issue (apart from its assertions that it has a common law trademark) is to be found in the words :"see Appendix 10 (statement of account from marketing company, Magnetix, and overview of transactions from Woocommerce regarding FITNESSPEOPLE.COM)." But there is not a word of explanation as to what these documents mean, how they were brought into existence or what they mean. The purpose of requiring evidence on this vital and pivotal issue is to show that the name that is claimed to be a trademark is recognized in the market as the mark of the trader and that the mark is identified with the person who is relying on it. There are numerous well-established methods of proving this and they have been set out on many occasions in decided cases and elsewhere. The proof required is to show the following:

(1) for how long the mark that is claimed has been used and if it has been used continuously;

(2) sales that have been effected under the name;

(3) advertising, and promotional activities that have been undertaken to promote the name and make it recognized in the market;

(4) what expenditure has been committed for promotion and marketing of the mark,

(5) unsolicited coverage in the media showing that the name has been recognised; and

(5) generally, how the name has come to be identified in the public understanding as the mark of the person claiming that it is such a mark.

There is simply no evidence to this effect brought forward by the Complainant.

At best, the material adduced by the Complainant, shows that there is a company named Fitness People BV, but it seems to be in dispute as to whether that company is engaging in trade at all, quite apart from whether the name that has been claimed has been recognised as the trademark of the Complainant.

Moreover, the obligation on the Complainant to comply with this requirement is higher than in some other cases, as the mark that is claimed consists of two generic words that could be seen by the public to have very wide meanings, as they do. There was therefore, as is also well-established, an onus on the Complainant to show a clear secondary meaning of the words, i.e. another meaning in addition to the primary meaning of the words which links them to the complainant and its goods and services. Again, there is no evidence to establish that important element.

The Panel will therefore reject the Complaint for that reason.

There is another matter to which the Panel should draw attention. Many of the questions that arise in this dispute are in dispute themselves. Naturally the Panel cannot pass judgement on them as that is not the function of the UDRP. Nor does the Panel have the powers to do so. But it is clear to the Panel that the dispute is not entirely a domain name dispute but a much wider commercial dispute which cannot be resolved within the limited scope of the UDRP, which is for clear cases of abusive domain name registration and use. The dispute in substance involves allegations of breach of contract, competition law and the terms of a shareholders' agreement. Those areas of the law will ultimately resolve the dispute between the parties and not the UDRP.

The Panel will therefore also reject the Complaint as it is outside the ambit of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **FITNESSPEOPLE.CLUB**: Remaining with the Respondent

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2017-08-23

Publish the Decision