Decision for dispute CAC-UDRP-101656

Case number	CAC-UDRP-101656
Time of filing	2018-01-29 09:43:22
Domain names	atiago.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Name	Michel Fielitz

Complainant representative

Name	Claudia Hahn

Respondent

Organization	Nexperian Holding Limited

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns

- the German trademark “ATIAGO Management- und Personalberatung”, registered on November 4, 2010, with Registration No. 302010026365 for human resources consulting, business consulting, advertisement, desktop publishing, organization and operation of trainings and workshops, website and IT consulting in classes 35, 41 and 42; and

- the US trademark “ATIAGO” with Registration No. 5346072, registered on November 28, 2017, for business consultancy, marketing consulting and personnel recruitment in class 35.

The Respondent has registered the disputed domain name on December 14, 2015, i.e. after registration of the Complainant’s German trademark “ATIAGO Management- und Personalberatung” but before registration of the Complainant’s US trademark “ATIAGO”.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

1. According to the concerned registrar's Whois database the owner of the disputed domain name at the time of Complainant's original complaint filing was Nexperian Holding Limited, China (the "First Respondent"). According to information provided by the registrar in the course of this administrative proceeding the current owner of the disputed domain is Atiago Cosmetics Beijing, China (the "Second Respondent"). The Complainant has chosen to add the disclosed underlying registrant Atiago Cosmetics Beijing as a co-respondent, and to pursue this administrative proceeding against both the First Respondent and the Second Respondent (together "the Respondents").

2. The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademarks cited above.

3. The Complainant further contends that he has created and used the trademark "Atiago" in connection with the relevant services as early as March 20, 2008. The Complainant advertises his business with the trademark "Atiago" on his business cards and letterheads. Since March 20, 2008, the Complainant owns the domain name <atiago.de>, which he uses for an operating commercial website. The Complainant offers his services in both German and English language to the German and English-speaking market.

4. According to the Complainant there is no information available that the Respondents have used or made demonstrable preparations to use the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods and services. The Complainant is not in any way affiliated with the Respondents. The Complainant has not licensed to the Respondents the right to use the "Atiago" mark, and the Respondents are not otherwise authorized to act on the Complainant's behalf. The Complainant alleges that the Respondents are not owner of any trademark or service mark rights related to the word "Atiago". The Complainant further alleges that the Respondents have never been commonly known by the disputed domain name. The disputed domain name does not resolve to an active website.

5. The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant had tried to purchase the disputed domain name at an auction on December 14, 2015, but states that he failed to acquire it "through no fault of its own". Instead, the Respondents acquired the disputed domain name at that auction. The Complainant sent a cease and desist letter to the First Respondent on May 19, 2017 in which the Complainant offered to purchase the domain name for the price of the Respondents' cost of registration of the domain name. The Respondents have not replied to this letter.

6. The Complainant contends that the word "Atiago" was created by the Complainant in 2007 and used in business as early as March 20, 2008. It is not a word commonly known or used in any language in the word.

7. The Complainant contends that a brief research on internationally well-known search engines shows the Complainant's current use of "Atiago" and would therefore have revealed the Complainant's rights in the "Atiago" mark to the Respondents.

8. Since its acquisition in 2015, the Respondents have inactively held the disputed domain name and failed to use it for any purpose, which the Complainant regards as an indication of bad faith. The Second Respondent's use of the First Respondent for privacy protection purposes is regarded as another indication of bad faith. The Complainant finally contends that among the 2,269,079 domain name registrations currently held in the name of the First Respondent are several others that misappropriate the trademarks of well-known brands and businesses (e.g. <siemenssoftware.com> and <toyotapartsco.com>). This, according to the Complainant, shows that the First Respondent is engaged in a pattern of cybersquatting and has registered the disputed domain name in order to prevent the Complainant from reflecting its trademark in a corresponding domain name.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, 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

It remains open whether or not the Respondent has 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 shown that 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 language of the registration agreement is Chinese. The Complainant has submitted its complaint in English and has requested that the language of proceedings be English. Given the Respondents' domicile in China and the absence of any reply to the English language communications before and within this administrative proceeding, the Panel is not fully convinced that the Respondents have sufficient command of the English language. Given the Panel's decision discussed below, however, it would be overly formalistic to deny the Complainant's request for proceedings in English language. The Panel, exercising its discretion, therefore finds that the language of the proceeding will be English.

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

PRINCIPAL REASONS FOR THE DECISION

The Panel does not consider the Complainant's trademark to be very well-known. Furthermore, the Complainant's trademark has only been registered in Germany and – after Respondent's registration of the disputed domain name – in the USA. The Complaint has described various search results for the word "Atiago" at several online search engines. The Panel notes, however, that online search results of today only provide limited information about the situation in 2015 when the disputed domain name was registered. The Panel further notes that the Complaint has not addressed the search results for "Atiago" at www.baidu.com, which is the market leading search engine in China, the Respondent's home country. Given this situation and the uncertainty about the Respondent's command of English language the Panel has considered it adequate to consult www.baidu.com and the Chinese Trademark Office's online trademark database at http://wsjs.saic.gov.cn/ (cf. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 4.8).

The first search results for the word "Atiago" at www.baidu.com do not refer to the Complainant, but rather to a company "()" (English: Dì ā kòu (Beijing) Cosmetics Co., Ltd.) and its "Atiago" cosmetics products. The Panel considers it likely that "" or "Dì ā kòu" is the Chinese equivalent of "Atiago" in western letters, so that this company and the Respondents are identical.

The Chinese Trademark Office's online trademark database at http://wsjs.saic.gov.cn/ lists the following "Atiago" (in western letters) trademarks:

-- Chinese trademark no. 6218918, registered in class 3 with application date 13 August 2007;
-- Chinese trademark no. 6218917, registered in class 14 with application date 13 August 2007;
-- Chinese trademark no. 6218926, registered in class 25 with application date 13 August 2007;
-- Chinese trademark no. 6218927, registered in class 30 with application date 13 August 2007;
-- Chinese trademark no. 6218919, registered in class 44 with application date 13 August 2007;
-- Chinese trademark no. 6476889, registered in class 3 with application date 26 December 2007;

Owner of all these trademarks is a company "·()". The relationship between the Respondent and this trademark owner remains unclear. It does seem clear to the Panel, however, that the Respondent was not at all interested in the Complainant's business and/or trademark when registering the disputed domain name but was rather concerned about the Chines "Atiago" trademarks listed above. Given this situation the Panel does not see that the Respondent has registered and/or used the

disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

As the three elements of paragraph 4(a) of the Policy are cumulative requirements, it is not necessary to analyze the Respondents potential rights or legitimate interests (within the meaning of paragraph 4(a)(ii) of the Policy) in more detail.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2018-03-19

Publish the Decision