Decision for dispute CAC-UDRP-101988

Case number	CAC-UDRP-101988
Time of filing	2018-05-15 08:54:16
Domain names	sante.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	LOGOCOS Naturkosmetik AG

Complainant representative

Name	Simon Heinrich

Respondent

Organization	Anything.com, Ltd.

Respondent representative

Organization	ESQwire.com, P.C.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies in particular on:

International trademark no. 1017713 for a combined logo and device mark containing the words “SANTE NATURKOSMETIK” registered on 8 September 2009 for various goods in classes 3, 16, 21, 29, and 30;

International trademark no. 663706 for a combined logo and device mark containing a representation of the words “KOSMETIK SANTE” registered on 7 October 1996 for various goods in class 3; and

German trademark no. 304450510 for a combined logo and device mark containing the words “SANTE NATURKOSMETIK” registered on 27 January 2005 for various goods in classes 3, 5, 16, 21, 29, and 30.

The Complainant also relies on 13 further German, EU or international trademark registrations for various combined logo and device marks containing the word SANTE on dates ranging from 1992 to 2015.

FACTUAL BACKGROUND

The Complainant has registered a number of international, EU or German trademarks consisting of devices and logos containing the word SANTE between 1992 and 2015. The Complainant has also registered the domain name sante.de.

The Respondent registered the domain name sante.com on 28 April 1997. The Respondent has also registered a number of .com domain names containing common English words such as medicine.com, public.com, woman.com and manager.com.

The disputed domain name is directed to a web page which displays pay-per-click links based on a Yahoo or Google advertiser feed. One of the links has been to the web page www.bio-naturel.de/sante where products of the Complainant are sold.

The Complainant offered to buy the disputed domain name from the Respondent for $5000. The Respondent rejected this offer, stating “The domain is valued in the 6 figures USD”.

PARTIES CONTENTIONS

The Complainant contends that the disputed domain name is identical or confusingly similar to its registered trademarks, that the Respondent does not have any rights or legitimate interests in the disputed domain name and that it was registered and is being used in bad faith.

The Complainant notes that the disputed domain name was registered after the earliest of its international trademark registrations and states that it is plausible that the Respondent registered the domain name after recognising that the Complainant is using this mark worldwide.

According to the Complainant, the Respondent is cybersquatting, seeking to sell the disputed domain name and other domain names for prices not justified by any use made of them by the Respondent. The Complainant also observes that a link provided on the Respondent’s web page shows that its products are associated with the disputed domain name.

The Respondent denies that the disputed domain name is identical or confusingly similar to the Complainant’s marks, pointing out that these marks are not for the word “sante” itself, but for composite marks which do not confer rights in the generic word “sante” contained in them. The Respondent draws attention to decisions under the UDRP in which domain names consisting of generic words were found not to be confusingly similar to composite marks containing those words.

The Respondent claims that it has rights and a legitimate interest in the disputed domain name by virtue of its longstanding registration, its plain meaning and inherent value, and its use in connection with the bona fide offering of goods and services and for a legitimate purpose.

The Respondent states that it registered the disputed domain name because it consists of the French word “sante”, meaning health, that it had no knowledge of the Complainant at the time, and that it did not target the Complainant. The Respondent submits that its registration of other domain names consisting of common dictionary words supports its good faith and demonstrates that it is not a cybersquatter. The Respondent adds that its response to the Complainant’s unsolicited offer to purchase the disputed domain name does not evidence bad faith and that the Complainant’s 21 year delay in taking action itself raises an inference that the Complainant did not believe that the disputed domain name was registered or used in bad faith.

Emphasising that the Complainant has failed to prove any of the requirements of the UDRP despite waiting 21 years to

initiate its claim to the disputed domain name, the Respondent submits that the Complainant is using the UDRP in bad faith and that this is unequivocally a case of reverse domain name hijacking.

RIGHTS

The Panel finds that the Complainant has registered rights in various composite trademarks which contain the word SANTE.

The Panel considers that the disputed domain name is not identical to any of these marks since none of them is the word SANTE by itself.

The Panel is also not satisfied on the evidence that the disputed domain name is confusingly similar to any of these marks.

As the Respondent rightly points out, a domain name consisting of a common word or phrase as its second-level domain (SLD) is not necessarily confusingly similar to a composite mark containing that word or phrase: see, for example, Deutsche Post AG v. NJDomains (WIPO Case No. D2006-0001), Meat and Livestock Commission v. David Pearce aka OTC / The Recipe for BSE (WIPO Case No. D2003-0645). Whether a domain name is confusingly similar to a mark of this nature depends on the circumstances.

In this case, the Complainant has provided no evidence at all to show that the word SANTE has become distinctive by itself of the Complainant's business, so that Internet users would assume that the disputed domain name must be connected with the Complainant. The fact that one of the links on the Respondent's web page located a website that sold the Complainant's products is quite insufficient to establish this. Conversely, the Complainant's long delay in pursuing any complaint suggests that there has not been any confusion, as was observed in the Meat and Livestock Commission case mentioned above.

The Panel concludes that that the Complainant has failed to establish this requirement of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

Panels have recognised that the bona fide use of a domain name consisting of a common word to locate a web page displaying pay-per-click links relating to the descriptive meaning of that word may give rise to a right or legitimate interest of the holder of the domain name within the meaning of paragraph 4(a)(ii) of the UDRP, if it does not take advantage of the reputation of the owner of an identical or confusingly similar trademark or otherwise mislead Internet users: see, for example, Instrumentation Northwest, Inc. v. INW.COM c/o Telepathy, Inc. (WIPO Case No. D2012-0454), E-Renter USA Ltd. v. Domain Hostmaster, Customer ID: 55391430909834, WhoIs Privacy Services Pty. Ltd. / Domain Administrator, Vertical Axis Inc (WIPO Case No. D2015-0784).

In this case the domain name consists of a common word and has been used for many years to locate a web page displaying pay-per-click links relating to the descriptive meaning of that word, with one exception of a link to a page which offered the Complainant's products. The Complainant has not shown that the Respondent has taken advantage of its reputation or that of any other owner of a similar trademark or that the Respondent has otherwise misled Internet users.

In these circumstances, the Complainant has failed to establish this requirement of the UDRP.

BAD FAITH

The Complainant has not provided any evidence that the disputed domain name was registered in bad faith. On the contrary, on the available information, it is entirely plausible that the Respondent registered the disputed domain name because its SLD is a common French word, and this is also consistent with other domain names registered by the Respondent.

The fact that the Respondent recently rejected an unsolicited offer by the Complainant to purchase the disputed domain name, pointing out that it was worth much more than the amount offered, is no evidence that it was originally registered more than 20 years ago with a view to sale to the Complainant.

There is also no evidence that the disputed domain name is being used in bad faith. The Respondent's reply to the

Complainant's offer to purchase the domain name is not evidence of use in bad faith, since the Respondent was entitled to sell the domain name to a purchaser who would use it legitimately. Nor is the value of the domain name suggested by the Respondent any indication of bad faith, since a domain name whose SLD is a common word in a widely used language may fairly be expected to have considerable value for use in a legitimate, descriptive manner.

The complaint must therefore be rejected for failure to satisfy any of the cumulative requirements set by the UDRP, let alone all of them.

In accordance with paragraph 15(e) of the UDRP Rules, the Panel must state if it finds that the complaint was brought in bad faith, for example in an attempt at reverse domain name hijacking, which is defined in those Rules as using the UDRP in bad faith in an attempt to deprive a registered domain-name holder of a domain name.

The mere failure of a complainant to establish the requirements of the UDRP is not sufficient to amount to reverse domain name hijacking, since a complaint may be brought erroneously in good faith. However, in this case the complaint is so lacking in substance and so devoid of any evidence of bad faith on the part of the Respondent that the Complainant could not have genuinely believed that the requirements of the UDRP were satisfied.

The Panel therefore finds that the complaint was brought in bad faith in an attempt at reverse domain name hijacking.

PROCEDURAL FACTORS

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

None of the requirements of the UDRP is met.

The SLD of the disputed domain name is a common word in French. Although that word is included in various composite trademarks registered by the Complainant, the disputed domain name is not identical to any of those marks and there is no evidence that it is confusingly similar to any of them.

The Complainant has not shown that the Respondent's longstanding use of the disputed domain name to locate a page of automatically generated pay-per-click links relating to the descriptive meaning of its SLD is not bona fide or takes advantage of the Complainant's reputation or is otherwise inconsistent with the Respondent having acquired a right or legitimate interest in it.

There is no evidence that the Respondent registered or is using the disputed domain name in bad faith.

The complaint is so devoid of any evidence of bad faith on the part of the Respondent that the Panel finds that it is a case of reverse domain name hijacking.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Jonathan Turner, Dr. Thomas Schafft, The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2018-07-21