Decision for dispute CAC-UDRP-102295

Case number	CAC-UDRP-102295
Time of filing	2019-01-25 09:40:15
Domain names	plieger.com

Case administrator

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

Complainant

Organization	Plieger B.V.

Complainant representative

Organization	ICTRecht B.V.

Respondent

Name	Domain Admin

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

- PLIEGER (word), the BENELUX Trademark Registration No. 0805368, registered on August 17, 2006 and renewed;

- PLIEGER (word), the International Trademark Registration No. 1081792, registered on April 28, 2011.

FACTUAL BACKGROUND

The Complainant is wholesaler in plumbing, heating, electricity installation material and renewable energy solutions and employs over 750 people. The head office is located in Zaltbommel, the Netherlands.

The Complainant owns the following “PLIEGER” word trademarks: Benelux trademark registration No. 0805368, registered on August 17, 2006 and international trademark registration No. 1081792, effective in China, registered on April 28, 2011.

The disputed domain name is registered by the Respondent in 2018 and is not actively used on the date of this decision.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS.

The Complainant relies on its word trademark registrations referred to above and states that the disputed domain name includes the PLIEGER trademark in its entirety.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME.

According to the Complainant, the Respondent is not known under the disputed domain name and has not been licensed or authorized by the Complainant to use its PLIEGER trademark or to register the disputed domain name. There is no indication that the Respondent has been using the word PLIEGER as a tradename or otherwise.

The Complainant refers to previous communication with the Respondent where the Respondent stated that he would be willing to sell the disputed domain name at 55,000 US dollars.

In a later communication with the Complainant's representative the Respondent stated that the disputed domain name was bought because it is a generic family name and the Respondent is developing the website to provide personalized email services for Plieger families. In the future, other services like personal pages and family tree database may be added, according to the Respondent's statement.

The web site under the disputed domain name was not actively used and the landing page was updated in December 2018. The Complainant alleges that such an update was a result of Complainant's notice and states that this must not be considered as using the disputed domain name nor as an indication that the Respondent has any legitimate interests.

The Complainant claims that the Respondent is a registrant of more than 2,000 .com-domain names and also relies on its anonymous communication with the Respondent in respect of a different domain name which the Respondent offered to buy at 15,000 US dollars.

In the opinion of the Complainant, the facts that the Respondent is (i) registrant of a large amount of un-used domain names, and (ii) is willing to transfer these upon first request for large sums, and (iii) considering the other above mentioned, should result in concluding that the Respondent lacks any legitimate interest in the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH.

The Complainant's submissions can be summarized as follows.

1) The Complainant's trademark registrations precede the registration by the Respondent of the disputed domain name.

2) The Complainant believes that the Respondent should have been (reasonably) aware of Complainant's trademarks as the Complainant contends that PLIEGER is not generic but is rather unique and distinctive.

3) The Complainant argues that the Respondent acted willfully blind when registering the disputed domain name, whereas he willfully disregarded the risk and possibility of registering a domain name that consisted of a unique trademark.

4) The Respondent offered to transfer the disputed domain name to the Complainant for a sum of 55,000 US dollars and this amount should be considered as exceeding Respondent's out-of-the-pocket expenses. The Complainant argues that the fact that the Complainant reached out to Respondent first, does not negate the assumption that the Respondent primarily registered the disputed domain name for purposes of selling it to a (potential) trademark holder or one of his competitors. The Complainant believes that such should be considered as 'sitting and waiting until someone approaches me'.

RESPONDENT:

The Respondent's submissions can be summarized as follows.

RIGHTS AND LEGITIMATE INTERESTS

1) According to the Respondent, PLIEGER is a generic family name and is not inherently distinctive. Search of "plieger last name" and "plieger family name" in Google returns more than 129,000 and 33,000 results respectively. The Respondent also states that PLIEGER is used by other companies in their business and domain names and provides some examples of such use.

The Respondent states that anyone is entitled to register a generic term and the registration of a domain based on the fact that it is a generic surname establishes Respondent's legitimate interest in the disputed domain name.

2) Respondent's use of the disputed domain name is to provide personalized e-mail services for Plieger families and it is a legitimate use.

The Respondent adds that development of personal e-mail services is time consuming. It requires high security and stability and many technical issues need to be addressed. Several months or one year is a reasonable amount of time needed to finalize all the details.

The Respondent finalized its hosting plans and setup the hosting for the project on December 15, 2018. This is the reason behind the change of the landing page. This proves Respondent's legitimate interest. The Respondent alleges that he has setup testing e-mail accounts at backend to test the performance of the servers. The frontend (landing pages) is not yet uploaded because the service is still under testing and not yet ready for the public.

The Respondent denies that he changed the landing page in response to Complainant's communication.

3) The Respondent states that owning more than 2,000 domains and hosting underdeveloped domain names with domain name parking services does not indicate that he has no rights or legitimate interests in these domains. Respondent contends that his rights and interests are bolstered by providing a bona fide advertising services by parking the domain names in their generic sense.

The Respondent adds that he registered many of his domain names more than ten (10) years ago.

4) Respondent's willingness to sell its generic domains for a profit is not improper and is itself an accepted business practice. The Respondent notes that prior panels have determined that the sale of domain names containing generic terms can constitute a bona fide offering of goods and services under the Policy. It was the Complainant that initiated the contacts with the Respondent asking to buy the disputed domain name and Respondent's willingness to sell is just a response to Complainant's buying inquiries.

GOOD FAITH REGISTRATION AND USE

The Respondent puts forward the following arguments in support of his position.

1) The Respondent alleges that he had not previously heard of the Complainant or its trademark until contacted by its trademark representative in July 2018 and also notes that the Complainant has produced no evidence that its trademark is

famous outside of the Netherlands, or specifically in the United States where the Respondent resides. The Complainant has proffered no evidence of any kind demonstrating that the Respondent had any knowledge of its mark or business operations at the time that the disputed domain name was bought.

2) Respondent's use of the disputed domain name evidences its good faith as it is used to provide personalized e-mail services for Plieger families.

3) Respondent's willingness to sell the disputed domain name to Mr. John van Schaijk at 55,000 USD in response to his inquiry is not evidence of bad faith. John van Schaijk contacted the Respondent in private emails and did not identify himself. The Respondent did not know whom Mr. John van Schaijk was representing and therefore his willingness to sell the domain name to Mr. John van Schaijk cannot be understood as an attempt to sell the domain name to the Complainant. Besides, it was the Complainant that initiated the contact with the Respondent asking to buy the disputed domain – this is insufficient evidence of bad faith.

4) The Respondent states that Plieger is a generic surname. It is also a surname of the Complainant's founder – Hary Plieger.

REVERSE DOMAIN NAME HIJACKING

The Respondent alleges reverse domain name hijacking by the Complainant. According to the Respondent, the Complainant acted in bad faith and this constitutes an abuse of the administrative proceeding. In particular, the Respondent alleges that the Complainant made false inquiries to manufacture evidence in support of this Complaint. In addition to that, after failing to buy the disputed domain name from the Respondent, the Complainant uses the administrative proceeding as a venue of "last resort" to hijack the disputed domain name from Respondent. The use of false inquires also shows that Complainant knew at the time it filed the complaint that it could not prove the essential elements required by the test under the Policy.

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

In the view of the Panel, taking into account findings in respect of the bad faith issue, there is no need to consider this element for the purpose of this proceeding.

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, 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 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

A. Identity or confusing similarity

The Complainant owns registered "PLIEGER" word trademarks.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima

facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name entirely incorporates the Complainant's PLIEGER trademark.

As stated in WIPO Overview 3.0 "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing" (see par. 1.7).

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

Both parties made some statements and put forward arguments in support of their positions. The Complainant made an allegation of absence of any rights or legitimate interests of the Respondent in respect of the disputed domain name, while the Respondent's main arguments were that the disputed domain name is a generic family name, not inherently distinctive and was registered to provide personalized e-mail services for Plieger families and such use is legitimate.

The web site under the disputed domain name is not actively used and the nature of Respondent's intended use of the disputed domain name is not apparent. While Respondent's arguments in respect of his rights or legitimate interests in the disputed domain name have some merits and would require a deeper thought (see e.g. Grasso's Koninklijke Machinefabrieken N.V., currently acting as Royal GEA Grasso Holding N.V. v. Tucows.com Co, WIPO Case No. D2009-0115 – "The evidence provided by the Respondent, as outlined above, indicates that the Respondent is instead using the disputed domain name because of its association as a surname"), the Panel decided for the sake of speed and efficiency of this administrative proceeding and taking into account Panel's findings in respect of the third element as set out below, not to analyze the second element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The Complainant alleges the Respondent should have been (reasonably) aware of Complainant's PLIEGER trademarks and was "willfully blind when registering the disputed domain name". Besides, the Complainant argues that the fact that the Respondent offered to sell the disputed domain name to the Complainant at the amount of 55,000 US dollars indicates that the Respondent primarily registered the disputed domain name for purposes of selling it to a (potential) trademark holder or one of his competitors.

The Panel, however, disagrees with the Complainant and finds Respondent's arguments more persuasive.

First, as stated in WIPO 3.0 Overview, bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of WIPO 3.0 Overview).

Second, while the Complainant has registered trademarks for the word "PLIEGER", Plieger is indeed a family name and nothing in the present case indicates that Plieger is associated exclusively or primarily with the Complainant.

Nor is there any evidence that demonstrates that the Complainant, its business and trademarks were known in the US, the country of the Respondent's residence.

The WHOIS data indicates that the disputed domain name was first registered in 2000 and acquired by the Respondent in 2018. There is no evidence available in this case that the Respondent targeted the Complainant or had the Complainant in mind during the registration of the disputed domain name. In particular, there is no information or data that would prove Complainant's business activity in the US or that the Respondent knew or should have known about the Complainant.

In other words, there is no evidence that demonstrates the Respondent's intent to profit in some fashion from or otherwise exploit the Complainant's trademark.

Third, with regard to the sale offer the Panel would note the following. The inquiry to buy the disputed domain name from the Respondent was made by an individual who did not disclose any affiliation or connection with the Complainant nor did he state that he acted on behalf of the Complainant.

Therefore, it cannot be said that the Respondent intended to sell the disputed domain name to the trademark owner or its competitor.

As confirmed by WIPO 3.0 Overview (see par. 3.1.1.) and case law (see e.g. CAC Case No. 101261, Billy Bob's Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI), WIPO Case No. D2016-1221 and Puky GmbH v. Ignatius Agnello, WIPO Case No. D2001-1345) an offer to sell, even at a rather high price, as such is insufficient proof of bad faith in the absence of other indicia.

The Policy in 4 (b)(i) refers to "the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant or to a competitor of that complainant". The purpose element is clearly absent in the present case as nothing indicates that the disputed domain name was registered with the purpose to sell it to the Complainant (or any of its competitors). Evidence submitted by the Complainant does not prove that.

As stated by one of the previous panels "paragraph 4(b)(i) does not prohibit commercial sales of domain names for more than their costs. It says that it is evidence of bad faith if there are circumstances indicating intent at the time of registration to sell to specific people (the owner of a trademark or competitor) at a price above the out-of-pocket costs" (see Bible Study Fellowship v. BSF.ORG / Vertical Axis Inc., WIPO Case No. D2010-1338, see also CAC Case No. 101331 - "the Panel's role is to apply the Policy, not to re-write it. Applying the Policy, it is an essential element required to be proved by Paragraph 4(b)(i) that when the registrant registered the domain name it not only intended to make money out of the trademark owner by trying to sell it the domain name at a profit but that this was its primary intention").

The fact that the Respondent is a registrant of many domain names does not prove any bad faith on the Respondent's side in this particular proceeding.

Paragraph 4(b)(i) of the Policy requires some form of targeting (or, at least, awareness) of the Complainant and its trademark rights by the Respondent at the time of registration of the domain name (see Compañía Logística de Hidrocarburos CLH, S.A. v. DropCatcher.Info / Badminton, Inc., WIPO Case No. D2018-0973) and this is not the case in this administrative proceeding.

There is also no other evidence in this proceeding that would demonstrate Respondent's bad faith.

The Panel holds that the Complainant failed to satisfy the third requirement of the Policy.

REVERSE DOMAIN NAME HIJACKING

The Respondent has also raised the issue of whether the Complainant may have engaged in Reverse Domain Name Hijacking (RDNH).

While the Panel would agree that the Complainant's case is not very strong, it believes there is not enough evidence to find

RDNH (“Panels have generally held that Respondent bears a heavy evidentiary burden to justify such a finding”, see Rudy Rojas v. Gary Davis, WIPO Case No. D2004-1081).

As highlighted in WIPO 3.0. Overview “the mere lack of success of a complaint is not itself sufficient for a finding of RDNH” and there has to be a bad faith element of the Complainant in bringing the complaint (see par. 4.16).

The Complainant has registered trademarks that pre-date Respondent’s registration of the disputed domain name and the facts of previous communication with the Respondent were disclosed by the Complainant to the Panel so there was no attempt to mislead the Panel in this regard.

While this previous communication in respect of both the disputed domain name and a different domain name does not help the Complainant’s case, in the view of the Panel, it does not evidence Complainant's bad faith. The Panel would view Complainant’s actions as incorrect assessment of the situation and evidence available rather than bad faith attempt.

Therefore, the Panel does not find that the Complainant’s conduct constitutes Reverse Domain Name Hijacking within the meaning of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2019-03-06

Publish the Decision