Decision for dispute CAC-UDRP-102351

Case number	CAC-UDRP-102351
Time of filing	2019-02-18 12:37:31
Domain names	oknoplast-store.com, oknoplastitalia.com, oknoplast-finestre.com, oknoplastfinestre.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Kallisto 7 spółka z ograniczoną odpowiedzialnością spółka komandytowa

Complainant representative

Organization	Avvocati Associati Franzosi Dal Negro Setti

Respondent

Organization	SKEMA LIBERO S.r.l.s unipersonale

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

1) International Trade Mark no. 0903237 “OKNOPLAST”, registered on June 20, 2006 for the class 19 (non-metal building materials, windows, doors and door frames, building panels, shop windows, partitions, windowsills, mobile constructions);

2) European Union Trade Mark no. 007490345 “OKNOPLAST”, filed on August 18, 2009 and registered on May 17, 2010 for classes 6 (metal: building materials, transportable buildings, door and window fittings, door frames, window and door stops, fittings for building, door and window closers, hinges, windowsills), 19 (Not metal: building materials, door and window frames, windows, doors and frames, door and window fittings, partitions, displays, walls, windowsills, transportable buildings) and 37 (Construction information, building construction supervision, technical supervision, building construction, construction, finishing, installation and replacement of window and door frames) ;

3) European Trade Mark n. 010291061, see figure below, filed on November 18, 2011 and registered on March 28, 2012 for classes 6 (metal: windows, balcony windows, terrace windows, roller shutters, roller blinds, doors, balcony doors, terrace doors, folding shutters, windowsills, gates, garage doors, window systems, door systems, door and window frames, window accessories, roller shutter accessories, roller blind accessories , door accessories, folding shutter accessories, window

equipment, roller shutter equipment, roller blind equipment, door equipment, folding shutter equipment, building profiles, window profiles, roller shutter profiles, roller blind profiles, door profiles, folding shutter profiles, building fittings, window fittings, roller shutter fittings, roller blind fittings, door fittings, folding shutter fittings, building materials, building constructions, walls, partitions, displays, sunrooms), 19 (Not metal: windows, balcony windows, terrace windows, roller shutters, roller blinds, doors, balcony doors, terrace doors, folding shutters, windowsills, gates, garage doors, window systems, door and window frames, window accessories, roller shutter accessories, roller blind accessories , door accessories, folding shutter accessories, window equipment, roller shutter equipment, roller blind equipment, door equipment, folding shutter equipment, building fittings, window fittings, roller shutter fittings, roller blind fittings, door fittings, folding shutter fittings, building materials, building constructions, walls, partition, displays, sunrooms; glass for building; insulating glass; glass for windows; plate glass; hardened glass; drawn glass; window glass; glazing), 35 (retail services relating to the sale of: windows, balcony windows, terrace windows, roller shutters, roller blinds, doors, balcony doors, terrace doors, folding shutters, windowsills, gates, garage doors, window systems, door and window frames, window accessories, roller shutter accessories , roller blind accessories , door accessories, folding shutter accessories, window equipment, roller shutter equipment, roller blind equipment, door fittings, folding shutter equipment, building fittings, window fittings, roller shutter fittings, roller blind fittings, door fittings, folding shutter fittings, building materials, building constructions, walls, partitions, displays, sunrooms, glass for building, insulating glass, glass for windows, plate glass, hardened glass, drawn glass, window glass, glazing; franchising; professional business consultancy; administrative processing of purchase orders; business assistance; business management assistance), 37 (Building materials information (construction information); building construction supervision; building construction; construction; finishing works; assembly, installation and replacement of windows, balcony windows, terrace windows, roller shutters, roller blinds, doors, balcony doors, terrace doors, folding shutters, windowsills, gates, garage doors, window systems, door and window frames, window accessories, roller shutter accessories , roller blind accessories , door accessories, folding shutter accessories, window equipment, roller shutter equipment, roller blind equipment, door equipment, folding shutter equipment, building fittings, window fittings, roller shutter fittings, roller blind fittings, door fittings, folding shutter fittings, building materials, building constructions, walls, partitions, displays, sunrooms, glass for building, insulating glass, glass for windows, plate glass, hardened glass, drawn glass, window glass, glazings), 40 (window tinting; glass-blowing; glass grinding; glass processing; polymers processing; polymers extrusion; building profiles extrusion; window profiles extrusion; roller shutter profiles extrusion; roller blinds extrusion; door profiles extrusion; folding profiles extrusion), 41(teaching; practical training; arranging and conducting of trainings; arranging and conducting of workshops; publication of texts, other than publicity text), 42 (Architecture; technical research; construction drafting; architectural consultation; engineering; technical project studies; industrial design; technical supervision), 45 (licensing of intellectual property; licensing of industrial property) .

4) Italian Trade Mark, n. 302014902318200, see the figure below, filed on December 19, 2014 and registered on November 11, 2014 for class 6 (Common metals and their alloys; metal building materials; transportable metal constructions; metal materials for railways; non-electric cables and wires; locks and metallic trinkets; metal pipes; safes; minerals) 19 (Building materials, not metals; rigid non-metallic pipes for construction; asphalt, pitch and bitumen; transportable buildings, not of metal; non-metallic monuments) 37 (Construction; repair; installation services).

FACTUAL BACKGROUND

Kallisto is a Polish company, owner of the "OKNOPLAST" trade marks. Kallisto, has been working for many years with the Polish company "Oknoplast spółka z ograniczoną odpowiedzialnością" (hereinafter only "Oknoplast") which is, as licensee of the aforementioned trademarks, owner of various domain names, such as, for example, <oknoplast.it> and <oknoplast.com>. The Complainant stated:

The Owner of the disputed domain names is the Italian Company Skema Libero srls (hereinafter only Skema) as indicated in the related Whois page. The Complainant after having sent a cease and desist letter to the Respondent, has already requested the Italian Arbitration Court to transfer the Italian domain name <oknoplast-store.it> and <oknoplast-italia.it> owned by Skema on November 8, 2018. The above mentioned request was granted on January 24, 2019 and Kallisto is now awaiting for the Italian Register to transfer the domain names. The two above mentioned .it domain name also redirected to the same page of the disputed domain names.

The Respondent, maintains commercial relations with the company Noskema VS srls (hereinafter only Noskema). This

relation is confirmed by the content of the website of the latter referring to Skema .

Until July 2017 Noskema has been the authorized distributor of "OKNOPLAST" brand products in Italy. Both during said commercial relationship and even more so after its termination Noskema was not allowed to register domain names containing the distinctive word "OKNOPLAST". The relevant clause of the collaboration Agreement between the companies Oknoplast and Noskema says: "§ 5. 1. The Commercial Partner [Noskema] in particular cannot: ... d) register internet domains to its name, the name of which will contain the item reserved for the Producer or other similar, including in particular the name "Oknoplast", or trade marks - either personally or through any person acting on his behalf ".

At the end of his complaint, the Complainant informs the panel that on February 14, 2019 kallisto 7 spółka z ograniczoną odpowiedzialnością “changed its company name” to Oknoplast IP Management Sp. z o.o. Sp. k.. I.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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). First it remains unclear whether the Complainant is the owner of the trademarks in question. At the end of his complaint, he informs the panel that on February 14,2019 kallisto 7 spółka z ograniczoną odpowiedzialnością “changed its company name” in Oknoplast IP Management Sp. z o.o. Sp. k.. In fact a new company is registered as the new owner of the trademarks. But it is unclear whether the old company has really only changed its company name or the trademarks have been transferred to a new company. The complaint is made on behalf of the old company and has not been changed in favour of the new company. Within the UDRP system, it could not be checked whether the trademarks have been transferred to a new company are whether the old company name simply has been changed.

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).

He refers to two companies as possible opponents. Noskema has been bound to the Complainant as being the distributor of his products in Italy for years. The Complainant refers to distribution agreements and their interpretation. The claim is thus originally based on contract law and not on trademark law. The relationship between Noskema and the Respondent remains very unclear. The Complainant only uses rumour in order to justify that the Eespondent has no rights in using the disputed domain names.

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) as the role of Noskema and kema remains unclear.

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

The complaint is very poorly drafted and does not justify a violation of trademark rights under the UDRP: It remains unclear whether the Complainant still owns trademark rights and what role the Respondent has. The whole case is fundamentally

more a question of contract law and a controversy between the Complainant and its former Italy distributor.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **OKNOPLAST-STORE.COM**: Remaining with the Respondent
2. **OKNOPLASTITALIA.COM**: Remaining with the Respondent
3. **OKNOPLAST-FINESTRE.COM**: Remaining with the Respondent
4. **OKNOPLASTFINESTRE.COM**: Remaining with the Respondent

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2019-04-15

Publish the Decision