Decision for dispute CAC-UDRP-103529

Case number	CAC-UDRP-103529
Time of filing	2021-02-11 10:10:49
Domain names	chrisofix.com

Case administrator

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

Complainant

Organization	Chrisofix AG

Respondent

Organization	Sano-Trend Orthoservice GmbH

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the trade mark 'CHRISOFIX' (registered under the Madrid international system, 630757; valid in various territories including Germany, where the Respondent is established; first registered in 1995 on the basis of a 1994 mark in Switzerland, and duly renewed) and a number of marks registered under national legal systems in respect of the same string. These registrations subsist in class 10, in respect of splints for emergency, orthopaedic and surgical treatment.

FACTUAL BACKGROUND

The Complainant, a company with its seat in Neuhausen am Rheinfall, Switzerland, manufactures and holds patents in respect of medical devices for the splinting of broken ribs and associated activities. It operates a website at CHRISOFIX.CH.

The Respondent, a company with its seat in Bayreuth, Germany, registered the disputed domain name in August 2010 (in its own account, as noted in earlier correspondence with the Complainant), though the domain name itself was first registered 14 January 2003 (according to information provided by the Registrar). It appears from its correspondence with the Complainant that it has previously been an exclusive distributor of the Complainant's products in Germany and sold them for some time, though the Complainant states that no such sales are currently taking place.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. The CAC is not aware of whether written notice was received by the Respondent, though one of the e-mail notices was successfully relayed. The Respondent never accessed the online platform.

The Complainant contends that CHRISOFIX is its registered trade mark and that the Respondent is using it without any

written or mutual agreement, against its expressed complaints. It asks that the Respondent cease the use of the mark or any mark confusingly similar to it, online or offline, and to immediately cease any infringing activities. It asks that the disputed domain name be transferred to it.

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).

The disputed domain name, disregarding the top level domain .COM in accordance with established practice under the Policy, is identical to the mark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, 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).

The Complainant has made out a prima facie case in respect of the absence of rights or legitimate interests. In particular, the Complainant contends that the Respondent is not, as of the time of the Complaint, selling the Complainant’s products, and that and former agreements between the parties have been terminated (e-mail from the Complainant to the Respondent of August 2019, annexed to the Complaint). It is open to the Respondent to challenge this submission, but the Respondent's failure to participate in these proceedings means that the Panel can accept what the Complainant has submitted in this regard. Similarly, the Panel notes that the disputed domain name is being used to redirect users to the Respondent's own website, which does not provide any clarity as to the subsistence of rights or legitimate interests relevant to the present dispute. As such, although paragraph 4(a)(ii) can encompass certain activities of resellers, distributors and the like, there is no evidence available to the Panel that could be the basis for a finding in favour of the Respondent under the Policy. The Panel notes, in particular, that this assessment takes place in light of the Respondent's activities at the time of the Complaint (see e.g. WIPO Jurisprudential Overview, version 3.0, para 2.11).

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).

It is a requirement of the Policy that a Complainant make out both the registration and use of a disputed domain name in bad faith; see e.g. cases at this Provider ranging from 2011's CAC Case 100281, My Art v Domain Discreet- MyArt.com to 2021's CAC Case 103443, Renson Ventilation v Renee Benham.

It is apparent, from the annexes supplied by the Complainant, that the Respondent answered the Complainant's earlier cease-and-desist correspondence, in June 2019, by noting that in 2010, the disputed domain name was registered by it (the Respondent) with the agreement of the Complainant, and, as noted above, in the context of the Respondent's role as a seller of the Complainant's products. The Respondent explained, to the Complainant, that it effected such registration due to the unavailability of a .de domain name. The Complainant has not provided any further information regarding these matters. On these grounds, the Panel cannot find that registration was in bad faith.

Regarding use, the Panel notes that the disputed domain name is currently used to redirect Internet users to the Respondent's own website at WWW.SANO-TREND.DE, that the Respondent told the Complainant in 2019 that it was 'open for offers...that accounts its previous faithfulness' for the disputed domain name and places all due weight upon the apparent failure of the Respondent to respond to the most recent communications from the Complainant (and, of course its decision not to participate in these present proceedings). There is, accordingly, the possibility that the present use of the disputed domain name is in bad faith. However, the Panel also notes that the Complainant has not identified the nature of the alleged bad faith use in the Complaint itself, nor referred to any of the examples set out in the Policy (in paragraph 4(b)). The Annexes provided, which consist of evidence of the marks and the correspondence between the Complainant and the Respondent, do not provide a wholly clear basis for a finding in this regard. The Panel recalls rule 3(b)(ix) of the UDRP Rules,

which obliges a Complainant to describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular, 'why the domain name should be considered as having been registered and being used in bad faith', and that such a description should 'discuss any aspects of paragraphs 4(b) that are applicable'.

In light of the Panel's decision regarding registration not being in bad faith (which necessitates dismissal of the Complaint), and that the Complainant already filed an Amended Complaint following the CAC's advice regarding the need to specify factual and legal grounds and to prove all three elements of the Policy, prior to the commencement of the proceedings, it is not necessary to consider the question of use in bad faith any further.

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.

The Panel notes that a number of the requests made by the Complainant (that is, referring to offline activities, seeking that the Respondent desists from certain behaviour, alleging trade mark infringement, and the like) are outwith the scope of the Policy and so the Panel can make no ruling on such matters. This decision is limited to the application of the Policy, namely whether the disputed domain name should be transferred to the Complainant.

PRINCIPAL REASONS FOR THE DECISION

The reasons for the Panel's unanimous decision are set out above. The Panel found that the disputed domain name, which was registered by the Respondent over ten years ago, is identical to the Complainant's mark, and that, considering the activities of the Respondent at the time of the Complaint, the Complainant had demonstrated that the Respondent has no rights or legitimate interests in respect of the disputed domain name (noting in particular that the Respondent's former activities as a seller of the Complainant's products had come to an end, and that the Respondent did not provide any evidence or legal arguments to challenge the Complainant's prima facie case).

However, applying the requirement that a Complainant show that both registration and use of a disputed domain name is in bad faith, the Panel concluded that the Respondent did not register the disputed domain name in bad faith, taking account of the then agreement between the parties regarding registration of the name, and the purpose for which registration took place, in the context of the Respondent's then role as a distributor or seller. The Panel noted the possibility that the disputed domain name is presently being used in bad faith (considering the Complainant's arguments such as those regarding redirecting users to the Respondent's own website), albeit with the Complaint and associated evidence not presented with the necessary clarity; in light of the finding regarding registration, however, the Panel did not need to reach a conclusive finding in respect of use.

The Panel therefore rejected the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Prof Daithi Mac Sithigh, JUDr. Petr Hostaš, Assen Alexiev**

DATE OF PANEL DECISION 2021-04-05

Publish the Decision