

Decision for dispute CAC-UDRP-100201

Case number	CAC-UDRP-100201
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Time of filing	2010-11-11 22:39:36
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Domain names	bilderwelten.net
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Case administrator

Name	Tereza Bartošková (Case admin)
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Complainant

Organization	mantiburi GmbH & Co. KG
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Complainant representative

Name	Peter Hense
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Respondent

Organization	Lucas Promotion GmbH&Co.KG/Andre Lucas
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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

Complainant owns the registered German trademark no. 302009007806 “bilder-welten” with a priority date of 25 March 2009, which is protected for various goods in classes 16 and 20 as well as for “cutting of fabrics” (class 40). Complainant had originally sought registration of this mark for additional goods and services in classes 16, 20 and 40, but the German Patent and Trademark Office (partially) refused this application as being descriptive for picture-related products.

Complainant further claims to be the licensee of an unregistered “common law trademark ‘bilder-welten’ according to § 5 of the German Act on Trade Marks” owned by its CEO and managing partner, who is also the registered owner of the domain name “bilder-welten.net”. The Panel notes that Section 5 German Trademark Act does not govern unregistered trademarks or service marks pursuant to paragraph 4(a)(i) of the Policy, but rather rights in other “commercial designations”. The requirements of Section 4 no. 2 German Trademark Act for unregistered trademark (!) rights are not addressed in the Complaint.

FACTUAL BACKGROUND

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

Complainant and its predecessor company have used the domain name “bilder-welten.net” since May 2006 to operate an online

shop for pictures and other interior design products. Complainant claims that it currently spends 1.2 million Euro per year for marketing, most of it for search engine marketing. The goods sold via Complainant's online shop are of high quality and have a good reputation.

Respondent acquired the disputed domain in September 2009, and uses the disputed domain name to forward website users to a Respondent website under the domain name "artstore.de", where Respondent (since 2005) operates an online shop for pictures and art prints that directly competes with Complainant's online shop. Complainant claims to be one of the major competitors of Respondent, and therefore concludes that Respondent must have been aware of Complainant's online shop under "bilder-welten.net" when it acquired the disputed domain name "bilderwelten.net" in September 2009.

In the past there have been a number of irritated customers asking Complainant about its relationship to the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

See above.

RESPONDENT:

No response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to the registered German trademark no 302009007806 "bilder-welten" in which the complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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 Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the 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

1) The domain name is confusingly similar to the Complainant's registered trademark, despite the lack of the hyphen between the words "bilder" and "welten" and despite the fact that the name, when taken as a whole, may be descriptive. The descriptive nature of the domain name is better addressed under the third requirement, whether the domain name has been registered and is being used in bad faith (cf. WIPO Case No. D2008-0983 <club-amenities.com>).

2) Regarding Respondent's lack of rights or legitimate interests in respect of the Domain Name Complainant has made the allegation and has put forward what Complainant can in support, namely that Respondent has no rights to the name "bilderwelten" of which Complainant is aware. Respondent would have been obliged to demonstrate any existing rights or

legitimate interests in respect of the Domain Name, but has failed to do so (cf. WIPO Case No. D2004-0110 <belupo.com>; WIPO Case No. D2001-0121 <julianbarnes.com>).

3) Respondent has, by using the domain name, intentionally attempted to attract, for commercial gain, Internet users to Respondent's online shop at "artstore.de", by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this web site (cf. paragraph 4(b)(iv) of the Policy). When acquiring the disputed domain name "bilderwelten.net" in September 2009 Respondent must have been aware of the major competitors of its "artstore.de" online shop, which includes Complainant's successful and well-known website operated under "bilder-welten.net" (cf. WIPO Case No.D2000-0521 <hifog.com>; WIPO Case No.D2000-0139 < moanapacific.com>). Having this knowledge when acquiring the almost identical domain name „bilderwelten.net“, and then using it to forward web users to Respondent's competing online shop at "artstore.de", is even for a somewhat descriptive domain name a registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BILDERWELTEN.NET**: Transferred

PANELLISTS

Name	Dr. Thomas Schafft
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DATE OF PANEL DECISION	2010-12-10
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Publish the Decision	
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