Decision for dispute CAC-UDRP-100716

Case number	CAC-UDRP-100716
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Domain names	meissenerporzellan.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Staatliche Porzellan-Manufaktur Meissen GmbH

Complainant representative

Organization	Lubberger Lehment

Respondent

Organization	GoldDay Corporation X Rick Sorentos

OTHER LEGAL PROCEEDINGS

On 11 October 2013 the Regional Court of Berlin had issued a preliminary injunction concerning the disputed domain name against its previous owner, Mr Dariusz Herman.

IDENTIFICATION OF RIGHTS

The Complainant holds the following trademarks:

a) German trademark registration no. 2025676 „Meissener Porzellan“ with priority date 23.10.1991, claiming protection in classes 11, 14, 15, 16, 20, 21, 28 and 34 for the following goods and services: Porcelain products, namely board, coffee, tea- and mocha service, liquor and smoke service, household items, candy service, confectionery leaves and shells, place settings, with the exception of cutlery, toilet sets, writing sets, ashtrays, decorative porcelain, namely, lamp vases, lamp bases, vases, boxes , wall plates, dessert bowls, baskets, leaves brooch, ring stones, art porcelain, namely, figurines, candlesticks, watch case, mirror frames, chess sets, Lithoponien, wall and table tops, bells and chimes, coins and plaques.

b) Community trademark registration no. 3743689 “Meissener Porzellan” with priority date 01.04.2004, claiming protection in classes 11, 14 and 21 for the following goods and services: Goods of porcelain, namely toilet fittings, lamp vases and lamp pedestals; clock cases; brooch leaves; ring stones; coins; badges; Household or kitchen utensils and containers not of precious metal or coated therewith; goods of porcelain, terracotta and glass, in particular table, coffee, tea, mocha, liqueur and confectionery services; artificial porcelain, in particular vases, boxes, wall plates, dessert bowls, baskets, figurines,

candlesticks.

FACTUAL BACKGROUND

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

Since 1710 the Complainant produces the world-famous Meissen Porcelain. The products of the Complainant enjoy an outstanding reputation worldwide - not least because of their exclusively hand-painted decoration and innovative visual design. Moreover, since the mid-18th century the Complainant produces jewellery.

In the process of its regular market monitoring activities the Complainant became aware of the disputed domain name, which was originally registered by Mr Dariusz Herman on December 26th, 2006. Mr. Herman used the domain for the placement of advertising links relating to web sites where porcelain products were offered as well as for links leading to websites relating to porcelain products (“Related Searches”). The website also contained the link "Buy This Domain". Accordingly, the domain was offered for sale on the domain parking platform sedo.de.

By letter dated August 14th, 2013 the Complainant claimed the violation of its trade mark rights to the name "Meissener Porzellan" and asked Mr Herman to sign a Cease and Desist Declaration. As Mr Herman did not respond to this and also not to additional letters of the Complainant, the Complainant requested a preliminary injunction at the Regional Court of Berlin on October 10th, 2013. By order dated October 11th, 2013 the court issued the injunction, which prohibited Mr. Herman to use, or to permit third parties to use, the disputed domain name within the European Union for the promotion and/or distribution of goods or the provision of services. The court order was served to Mr Herman on October 16th, 2013. On exact the same day Mr Herman transferred the domain name to the Respondent

In a letter dated November 4th, 2013 the Complainant informed the Respondent about the injunctive order of the Berlin Regional Court and asked the Respondent to transfer the domain to the Complainant by November 13th, 2013. The Respondent did not respond to this letter.

The URLs http://meissenerporzellan.com/ and/or http://www.meissenerporzellan.com/ do not resolve to an active website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

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

Except for the space between "Meissener" and "Porzellan" (which for technical reasons cannot be represented in an internet

domain name) and the suffix ".com" (which is also owed to the technical requirements of the domain name system) the disputed domain name is practically identical, but at least confusingly similar, to Complainant's German and Community trademarks cited above.

The Panel further finds that the Complainant successfully submitted prima facie evidence that the Respondent has neither made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent was aware of Complainant's rights in the well-known designation "Meissener Porzellan" when he acquired the domain name from its previous owner, Mr Dariusz Herman. Again this prima facie evidence was not challenged by the Respondent, which supports the conclusion that the domain name was REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

Given the fact that the disputed domain name does not resolve to an active website the primary question of this proceeding is whether or not the Respondent has also USED the domain name in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). The Complainant's case regarding such bad faith use is that the Respondent is effectively engaged in “passive holding” of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to the issue in the present case:

(i) the Complainant's trademark has a long history, a strong reputation, is highly distinctive (particularly in countries with a non-German language) and is widely known;

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;

(iii) the Respondent has failed to respond to the Complainant's reasonable attempts to correspond with him over his registration and use of the disputed domain name;

(iv) taking into account the nature of the disputed domain name the Panel cannot conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law; and

(v) the Respondent has acquired the disputed domain name from its previous owner on the same day that an interim injunction was served to this previous owner banning the use of the disputed domain name.

Given all of these circumstances the Panel finds that the manner in which the disputed domain name is being used constitutes use in bad faith. The requirements of paragraph 4(a)(iii) of the Policy have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MEISSENERPORZELLAN.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2014-01-16

Publish the Decision