Decision for dispute CAC-UDRP-101043

Case number	**CAC-UDRP-101043**
Time of filing	**2015-09-29 12:27:16**
Domain names	**mediatouch.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Mediatouch Medien- u. Werbeagentur GmbH**

Complainant representative

Organization	**BAX Rechtsanwälte**

Respondent

Organization	**Media Touch**

IDENTIFICATION OF RIGHTS

The Complainant mainly relies on his Community Trade Mark (CTM) No. 012567517 .This trademark was registered on 14 August 2014 for classes 35 and 38. It is a word/figurative trademark consisting of the wording "Mediatouch. Werbung, die berührt!" and an additional logo coloured orange.

FACTUAL BACKGROUND

The Complainant is a German marketing company. The Complainant has registered the domain www.mediatouch-online.de where he offers his services.

In the beginning of 2015, the Complainant decided to register further domains for his businesses. The domain was the most interesting domain name for the Complainant to register as he renders his services in the U.S., too.

The Respondent has registered the wording "mediatouch" in Texas as his company name in 2008. He purchased the URL MediaTouch.com for $1,000US from APlus.net in 2007 for use as his business' name and URL.

When the Complainant tried to register the domain, he found out, that it has already been registered by the Respondent.

The Complainant asked a third party to contact the Respondent via mail. The he Respondent (06/25/2015) replied that "any offer less than $100,000 for MediaTouch.com will not even be considered".

The Disputed Domain Name is currently inactive. The only content of the website accessible through the domain name is a website showing the lettering "Welcome to MediaTouch.com".

PARTIES CONTENTIONS

The Complainant states that he is the registered proprietor of the word/figurative Trade Mark "Mediatouch". He refers to unregistered rights arising from the goodwill. The Complainant states that he is also the only legal entity with the name "Mediatouch" that is registered at any commercial register in Germany. The Complainant held that the Disputed Domain Name is identical to the Mediatouch Trade Mark. In the view of the Complainant, the Respondent has no legitimate rights or interests in the Disputed Domain Name. It is only held by the Respondent for the purpose of selling it for a very high price.

The Respondent claims that he is the sole rightful owner of www.MediaTouch.com and the name "Media Touch" and should continue to be so until a time his own choosing

RIGHTS

The Complainant has, to the satisfaction of the Panel, not 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). First, it has to be stated that the UDRP cannot be used to enforce the name of a company. Furthermore, the fact that the Complainant has applied for a trademark in the United States is irrelevant especially as a documentation for that application is missing. Furthermore, the Complainant relies on unregistered rights but fails to provide any evidence in that regard. Therefore, the Panel finds the Complainant does not show that its name has become a distinctive identifier associated with the Complainant or its goods or services and accordingly it has no unregistered rights in the name “Mediatouch”.

Thus, the Complainant can only rely on his CTM trademark registered on 14 August 2014. This trademark is a combined word/figurative trademark. It combines the wording "Mediatouch. Werbung, die berührt!" (translated: “marketing that touches!”) with a figurative logo. The word “Mediatouch” is written in the trademark in bigger letters compared to the writing “Werbung, die berührt!”. The word “Media” is written in bold letters. The logo consists of a symbol similar to a dog´s paw. The colour of the logo is orange and it is turned into a kind of globe perspective. The whole structure of the trademark is pictorial with an artistic combination of the logo with the text written in a specific font design. Therefore, the specific distinctiveness of the trademark consists of the wording in combination with the logo.

In this situation, it is difficult to determine whether the domain name consisting only of one word can be confusingly similar with such a figurative trademark. That problem was discussed in several UDRP cases. Some UDRP panelists have held that in making the comparison presently under discussion, devices and similar figurative depictions should be ignored so that a straight comparison can be made between the words. Thus, the panel in Sweeps Vacuums & Repair Ctr. v. Nett Corp., WIPO Case No. D2001-0031 said that ‘graphic elements . . . not being reproducible in a domain name, need not be considered when assessing identity or confusing similarity.’ On the other hand, the panel in Curvon Corp. v. Lauren Kallareou, WIPO Case No. D2001-0565, said that ‘The Mark . . . is the whole of the composite of design matter and word matter [that] is shown in the registration document,’ which is the same view taken by other panelists (for instance Yell Ltd. v. Ultimate Search, WIPO Case No. D2005-0091; Deutsche Post AG v. NJDomains, WIPO Case No. D2006-0001; ELK Accesories Pty Ltd. v. Parnaz Farahani, WIPO Case No. D2012-0455). Applying that test, the overall impression of the trademark in the present case is entirely different from that conveyed by the domain name.

It is thus rather doubtful whether the domain "mediatouch.com " is confusingly similar with the CTM trademark in question.

NO RIGHTS OR LEGITIMATE INTERESTS

Even if we acknowledge the likelihood of confusion, the Complainant has, to the satisfaction of the Panel, not 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). In that regard it should be noted the Respondent does not provide sufficient evidence it is commonly known under the name “Mediatouch” (the Respondent only submits a photo of its credit card and t-shirt with “MediaTouch.com” logo which is obviously not enough). However, it is not necessary to prove that the company name is commonly known. The

Respondent has proven that he is registered already since 2008 in Texas with the company name "Mediatouch".

BAD FAITH

But even we disregard the (weak) use of the company name by the Respondent, the Complainant has, to the satisfaction of the Panel, not 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). It should be noted that the CTM trademark of the Complainant was only registered in 2014 while the Respondent registered his company name in 2008 and bought the domain in 2007. The Respondent therefore has been using the name in question long before the Complainant expressed its interest in the domain. The Respondent is therefore entitled to ask for a remuneration he finds adequate for a transfer of the domain name; 100000 $ are not "excessive fees" in that particular case.

The transfer of a domain name to a third party does amount to a new registration. Therefore, for the purpose of assessing whether the Disputed Domain Name was registered in bad faith it has to be taken into account that the Respondent purchased the Disputed Domain name in 2007, i. e. several years before the Complainant has registered its trademark. In that regard the Complainant has not shown that by that time the Respondent was aware or should have been aware of the Complainant or its rights. Furthermore, there is no evidence that the Respondent has been using the Disputed Domain Name in bad faith within the meaning of the Policy. It is true that the only content of the website accessible through the domain name is a website showing the lettering "Welcome to MediaTouch.com". However, the Complainant has not shown to have a well-known trademark and the Respondent has not taken active steps to conceal its true identity. Therefore, given the circumstances surrounding the registration and use of the Disputed Domain Name the Panel is not convinced that such holding of the Disputed Domain Name should amount to acting in bad faith

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 domain in question does not violate the rights of the Complainant. There are doubts whether the domain name is not confusingly similar with the figurative/word trademark owned by the Complainant. Furthermore, the Respondent has a legitimate interest to use the domain name and he acted not in bad faith in registration and use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2015-11-06

Publish the Decision