

Decision for dispute CAC-UDRP-104535

Case number CAC-UDRP-104535

Time of filing 2022-05-03 08:42:21

Domain names tucon.com

Case administrator

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

Complainant

Name Andreas Willmann

Respondent

Name Garry Chernoff

Respondent representative

Organization John B. Berryhill LLC

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 Complaint is based on two signs containing the verbal elements "TUCON VERBINDUNGSTECHNIK" and a figurative element for goods services in classes 6, 37, 40, i.e.

- Austrian trademark registration no. 227549 (appl. number AM 5806/2005) filed on 30 August 2005, registered on 4 October 2005; and

- Swiss trademark application filed on 14 September 2020 (with Priority of the afore mentioned Austrian trademark). The Complainant did not provide any further information as to the further development of this application since the date of application.

FACTUAL BACKGROUND

The Complainant is an individual located in Austria.

The Respondent describes itself as principal of Netincome Ventures Inc. a well-known dealer in domain names, including

non-English terms and surnames.

The disputed domain name was first registered on 17 October 1996 by an US company TUCON Construction Corporation, apparently dissolved in 2013. On 18 October 2015 the disputed domain name has expired and was proceeding to the delete cycle. In November 2015 the Respondent acquired the disputed domain name as part of a public auction for abandoned domain names. On 26 November 2015 the disputed domain name has been registered to the Respondent.

At the time of this decision, the disputed domain name resolves to a website by GoDaddy, where it is offered for sale at a price of roughly 14.000 EUR.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Firstly, the Complainant contends that the disputed domain name is identical to the protected rights on which he relies and which he owns, i.e. registered trade/service marks protected in several countries and company name. With regard to that latter company name no further information is provided.

Secondly, the Complainant contends that the Respondent does not have any rights or legitimate interest in the domain name, since the domain name is merely parked. In addition, the Complainant raises the argument of non-use/passive holding.

Thirdly, the Complainant contends that the domain name has been registered and is being used in bad faith for the following reasons: (i) Speculation in domain names, (ii) Holding domain name for purposes of selling, licensing or renting, namely offer to public and (iii) Selling, licensing or renting was the primary purpose.

In the light of the above, the Complainant argues that despite requests, the Respondent did not transfer the disputed domain name to him free of charge. The Respondent only bought said domain name for speculative purposes. Since he (the Complainant) is the only one who registered the TUCON trademark, he is also the only one who has this trademark right.

The Complainant therefore requests the disputed domain name to be transferred.

RESPONDENT:

Respondent firstly points out that neither the Complainant's claim to have rights in "TUCON", nor the Complainant's claim to be the "only" registrant of rights therein, are correct. Respondent argues that the Swiss registration is chronologically irrelevant. Furthermore, Respondent contends that the element "TUCON" in the disputed domain name only constitutes approximately 22% of the textual content of the registered mark, the main part being the second verbal element "VERBINDUNGSTECHNIK". The claim of confusing similarity is therefore based on a minority component of the purely textual content. Furthermore, Respondent notes that Complainant provides zero information on the extent of its reputation, volume of business, or even what that business may be. Respondent therefore assumes the Complainant is an individual engaged in some sort of trade relating to pipe connectors who appears to run his own service business. Finally, it results from the evidence provided by the Respondent, that there are in fact four registered marks in various jurisdictions for marks consisting of the sole textual component "TUCON" and another 73 pending or registered trademarks in numerous jurisdictions containing the verbal element "TUCON" together with further verbal and/or figurative elements.

Secondly, Respondent contends that Complainant has not carried its burden of demonstrating that the Respondent's use, prior to notice of this dispute, is in any way illegitimate in relation to Complainant's limited and non-exclusive claim in its asserted mark, nor has the Complainant shown that the Respondent's offer to sell the domain name is premised on the

Complainant's Austrian pipe business. The Respondent contends that he was attracted to the disputed domain name because it is a short, memorable two-syllable name, which - as resulting from the evidence provided by the Respondent - corresponds in both Spanish and Italian to "You With". Furthermore, the Respondent also contends - based on respective evidence - that "TUCON" is a minor surname. Being aware of that significance, the Respondent after the acquisition of the disputed domain name targeted it to genealogical and family name relevant PPC to advertising categories of "Ancestry", "Family Tree", "Family Reunion" etc. Registration of a surname and use consistent with that significance is a legitimate use of a domain name.

Thirdly, the Respondent points out that Complainant has provided no reason to believe that either registration or use of the domain name was inspired by the Complainant's claim of trademark right. In this context it confirms that the Complainant's arguments are following which (i) the Respondent didn't give the domain name to the Complainant "free of charge" and (ii), the Respondent bought the name for speculative purposes, are true. In fact, the Respondent admits that it has indeed a history of buying and selling abandoned domain names. However, the Respondent underlines that he acquired the disputed domain name at a public auction, after it was abandoned by a long time registrant thereof. The Respondent further wonders why Complainant did not explain how the domain name registration was not an issue when it was used by a US company for many years, but only became an issue when the Respondent acquired it and pointed it to genealogy resources, or merely offered it for sale. Finally, the Respondent alleges that he was not aware of the Complainant upon registering the mark, and even if he had conducted a broad trademark search at the time, he would have seen that many parties use "TUCON" for a variety of things around the world, and none of those uses would conflict with the Respondent's belief that it is primarily a surname and a Spanish/Italian phrase. In other words, the Respondent would have had every reason to proceed to acquire the domain name, as the Respondent has had no intention of using it for any purpose relating to pipes, pipe connectors, or whatever pipe business the Complainant conducts, nor of targeting the Complainant or a competitor for selling the name.

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).

1.

Firstly, the generic Top-Level-Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the confusing similarity test (WIPO Overview 3.0 at section 1.11.1).

2.

Secondly, it results from the evidence provided, that the Complainant is the registered owner of national Austrian trademark registration no. 227549 (appl. number AM 5806/2005) filed on 30 August 2005, registered on 4 October 2005 for goods services in classes 6, 37, 40. Unlike the Complainant claims, this Austrian trademark is not identical to the disputed domain name. In fact, said trademark contains figurative and further verbal elements which are not reflected in the disputed domain name.

3.

With regard to the figurative element, it is acknowledged amongst UDRP-panels that trademark registrations with design elements do prima facie satisfy the requirement that the complainant show "rights in a mark" for further assessment as to confusing similarity (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "WIPO Jurisprudential Overview 3.0" at section 1.10). To the extent that the figurative element is incapable of representation in a domain name, this Panel disregards this element for purposes of assessing identity or confusing similarity under the first element.

4.

The Panel further notes that the above Austrian trademark is not only composed of the verbal element "TUCON" but additionally contains the verbal element "VERBINDUNGSTECHNIK". The Complainant did not provide any explanations on this second verbal element "VERBINDUNGSTECHNIK", which, as the Respondent correctly points out, constitutes the quantitatively larger verbal part of the registered trademark. However, the presiding Panelist, who is a German native speaker, notes that this term is a German language dictionary term meaning "connection technologie" or "connecting

technology" in English.

In addition, the Panel notes that the Complainant communicated under an e-mail address "...@tucon.at". Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, the Panel undertook limited factual research into matters of public record by accessing that website. In doing so, the Panel noted that the website available under this domain name (in German language only) shows some pipe connecting systems and the above-mentioned trademark "TUCON VERBINDUNGSTECHNIK (fig.)". The Panel therefore concludes that the element "VERBINDUNGSTECHNIK" is descriptive for the products (pipe connection systems) advertised under tucon.at.

5.

Despite the absence of any explanations by the Complainant, but noting in particular the general powers of a panel as explained above, the Panel accepts that the verbal element "VERBINDUNGSTECHNIK", which is not reflected in the disputed domain name, does not overtake the overlapping verbal element "TUCON".

The Panel therefore concludes that despite the figurative element and said diverging verbal element "VERBINDUNGSTECHNIK" the Complainant's trademark registration is nevertheless sufficient by itself to support standing under the UDRP. Consequently, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

1.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

(iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

2.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a prima facie case against the respondent under this head and an evidential burden will shift to the respondent to rebut that prima facie case.

3.

In the case at hand, the Complainant limits its explanations to the allegations that the Respondent does not have any rights or legitimate interest in the domain name, since the domain name is merely parked. In addition, the Complainant raises the argument of non-use/passive holding.

The Panel notes that the Complainant's allegations are to a certain extent contradictory, since a domain name is either used for parking or not used and therefore susceptible to be passively held by the Respondent. It is acknowledged amongst UDRP Panels that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". Under this standard, a party should demonstrate to a panel's satisfaction that it is more likely than not that a claimed fact is true. It is further acknowledged by previous Panels that conclusory statements unsupported by evidence are normally insufficient to prove a party's case (see WIPO Jurisprudential Overview 3.0 at section 4.2).

In the case at hand, it is not possible for the Panel to verify both situations brought forward by the Complainant (i.e. parking, passive holding) since the Complainant failed to provide any evidence in support of his allegations. In the absence of any evidence, it is particularly not possible for the Panel to verify if the disputed domain name was indeed "parked" at the time the Complaint was lodged and - in the affirmative - if the parking page actually comprised pay-per-click links which compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see WIPO Jurisprudential Overview 3.0 at section 2.9 with further references on "parked pages").

In the present case, this requires a fortiori a careful analysis taking into account that - as evidenced by the Respondent - there are many other trademarks registered respectively in other jurisdictions for third parties for the sole textual component "TUCON" and another 73 pending or registered trademarks in numerous jurisdictions containing the verbal element "TUCON" together with further verbal and/or figurative elements. In addition, the Complainant has not put forward any evidence to allow the Panel to determine if its trademark "TUCON VERBINDUNGSTECHNIK" is eventually well known, or has developed secondary meaning, such that the Respondent was likely to have been aware of it. This point is particularly relevant for the outcome of these proceedings, since the Respondent, for his part, contends that (i) he was attracted to the disputed domain name because it is a short, memorable two-syllable name, which - as resulting from the evidence provided by the Respondent - corresponds in both Spanish and Italian to the meaning of "You With"; (ii) he was not aware of the Complainant upon registering the disputed domain name; (iii) that "TUCON" is a minor surname (as supported by respective evidence) and (iv) that the disputed domain name targeted amongst others to genealogical and family name relevant PPC to advertising categories of "Ancestry", "Family Tree", "Family Reunion" etc. (as supported by respective evidence). Therefore, the evidence before the Panel rather indicates that the Respondent might indeed have used the disputed domain name for the bona fide purpose of providing relevant advertising links to topics somehow relating to the surname significance of "TUCON".

In the light of the above, the Panel concludes that the Complainant did not succeed in proving the second element to be fulfilled.

BAD FAITH

Noting that Complainant must prevail on all three elements to succeed with his complaint and, further, that the second element is clearly not met in the case at hand, the Panel considers it unnecessary to address the third element (see WIPO Jurisprudential Overview 3.0 at section 4.2).

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

While 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, he failed to provide sufficient evidence to establish the second element of the Policy. Noting that Complainant must prevail on all three elements to succeed with his complaint and, further, that the second element is clearly not met in the case at hand, the Panel considered it unnecessary to address the third element. 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. TUCON.COM: Remaining with the Respondent

PANELLISTS

Name **Dr. Tobias Malte Müller, Bart Van Besien, Mike Rodenbaugh**

DATE OF PANEL DECISION **2022-06-10**

Publish the Decision
