Decision for dispute CAC-UDRP-104779

Case number	CAC-UDRP-104779
Time of filing	2022-10-12 09:06:27
Domain names	orwo.shop

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	ORWO Net GmbH

Complainant representative

Organization	lexTM GmbH Rechtsanwaltsgesellschaft

Respondent

Name	Jake Seal

Respondent representative

Organization	Harper James Solicitors

OTHER LEGAL PROCEEDINGS

See below.

IDENTIFICATION OF RIGHTS

See below.

FACTUAL BACKGROUND

See below.

PARTIES CONTENTIONS

See below.

RIGHTS

See below.

NO RIGHTS OR LEGITIMATE INTERESTS

See below.

BAD FAITH

See below.

PROCEDURAL FACTORS

The Complaint was filed with regard to two domain names, which are, according to the registrar verifications, registered in the name of different persons, namely James Nash/Black Hangar Studios (<orwo.wtf>) and Jake Seal/Creation (<orwo.shop>). The Complainant requested to consolidate both domain name disputes in accordance with the Policy and the Rules.

Pursuant to paragraph 3(c) of the Rules and in accordance with paragraph 10(e) of the Rules, consolidation of multiple domain name disputes is appropriate where the disputed domain names are registered by the same domain holder, or there are indicia of common control of the disputed domain names, and if consolidation would be equitable and procedurally efficient.

In view of the circumstances of the case, the Panel decided to accept the Complainant's request for consolidation because the websites available at the two domain names partly contain identical text passages, are linked to each other and refer to each other. In addition, although the domain names have both been registered with different registrars, they are managed via the same name servers. In the Panel's view, there appeared to be sufficient indicia of common control of the disputed domain names.

The Respondent did not object to the consolidation and replied without further reference to it with respect to both domain names.

Therefore, the Panel deemed it appropriate to accept the Complainant's request to consolidate the proceedings regarding the two domain names.

PRINCIPAL REASONS FOR THE DECISION

In the view of the Panel, the facts of the case were presented by the parties partly in an incomplete, if not deliberately one-sided manner. The documents available to the Panel show that the dispute between the parties is not limited to the two domain names which are subject to the present proceedings. Rather, the parties seem to be involved in a full-blown trademark conflict with international references. In the opinion of the Panel, it is also not clear if the parties, at least to a limited extent in terms of geography and content, can use the sign "ORWO", which is essentially the subject matter of the dispute, in parallel.

1. Parties' rights

With respect to potentially opposing rights of the parties, the parties have referred to the following rights:

Complainant:

• European Union trademark 2147379 "OR WO", priority March 26, 2001, registration date August 19, 2002, protected inter alia for "services of a photo laboratory; picture and film processing", and corresponding international registration
• European Union trademark 2146967 "ORWO", priority March 26, 2001, registration date August 19, 2002, protected inter alia for "photographic laboratory services; image and film processing", and corresponding international registration

• German trademark 30 2021 111 500 “ORWO”, priority July 1, 2021, registration date September 23, 2021, protected inter alia for clothing, bags and sports articles, and corresponding international registration
• German word-and-device mark 30 2021 115 221 “ORWO” (block logo), registration date September 10, 2021, protected inter alia for photochemical products, and corresponding international registration
• Rights in the complainant’s trade name “ORWO” under Section 5 (2) of the German Trademark Act

Respondent or, according to its allegation, affiliated companies:

• ORWO STUDIOS (logo) – US trademark application no. 97274282
• ORWO – US trademark application no. 97274195
• ORWO (logo) – US trademark application no. 97274210
• ORWO – UK trademark application no. UK00003756606
• ORWO (logo) – UK trademark application no. UK00003757125
• ORWO STUDIOS (logo) – UK trademark application no. UK00003757177
• ORWO (logo) – UK trademark application no. UK00003757199
• license in place with Campbell Representation Inc, allowing the Respondent to make use of a US trademark for ORWO ORIGINAL WOLFEN (logo) – US trademark no. 90407280

The Respondent expressly points out that the above-mentioned trademarks have not yet been registered but only applied for. According to the excerpts from the relevant trademark databasesubmitted as Annex to the Response, the trademarks were applied for in the period between February 18, 2022 and February 23, 2022, and the US trademark, which was licensed according to the Respondent’s allegation, was applied for on December 23, 2020.

2. Previous and ongoing disputes between the parties

With respect to previous ad ongoing disputes, the parties have submitted the following:

• A preliminary injunction was issued against the Respondent and its company forbidding the use of a certain logo containing the letters "ORWO" and the disputed domain name "orwo.wtf" in connection with content that was specifically objected to. However, this decision only prohibits use in commerce in the Federal Republic of Germany. In addition, the parties' submissions suggest that the court's decision was probably made based on existing company rights to the sign "ORWO" under Section 5 of the German Trademark Act. The court's decision further shows that the appellant was partially unsuccessful in the proceedings. The exact subject matter of the proceedings is not clear to the Panel. In particular, the statement of claim on which the decision is based was not submitted by the Complainant.
• The Respondent points out that the Complainant has filed oppositions to the UK trademark applications of the Respondent or the companies, which are related to the Respondent’s allegations.
• Finally, the Respondent points to the fact that the parties have already met in a previous proceeding under the UDRP and submitted WIPO Decision Number D2021-2607 (ORWO Net GmbH v. Jake Seal) in this respect. In these proceedings, the complaint was rejected. About the respondent’s own rights or legitimate interests, the Panel in this proceeding expressly stated: „Overall the Panel has reached the conclusion that in these circumstances there is insufficient information before it to reach a conclusion that the Respondent was not acting bona fide. “

The latter two complexes have not been referred to by the Complainant.

3. Parties’ contentions regarding their respective legal succession

The parties both plead that they are acting in legal succession from a former German company. In this respect, the parties state as follows:

Complainant:

„The Complainant ORWO Net is the legal successor of the historical company Aktien-Gesellschaft für Anilin-Fabrikation ("AGFA"), which has been operating under the name Filmfabrik "Agfa Wolfen" from the town of Wolfen (Bitterfeld) in Saxony-Anhalt since 1909. In 1964, the Filmfabrik "Agfa Wolfen" adopted the name "ORWO". The abbreviation ORWO stands for "Original Wolfen" (Wolfen being the town where the Complainant is based). In 1990, the company was transformed into ORWO AG. After its insolvency, Lintec Computer AG took over the company's assets and founded PixelNet AG and ORWO Media GmbH for the purpose of restoring the historic site to photography. The Complainant ORWO Net continues on with AGFA's the industrial heritage after PixelNet's insolvency.

Today, the Complainant is engaged in the production of media, in particular the processing of photographs and their printing on paper and other media."

Respondent:

"The Respondent, Jake Seal, is the director of Filmotec GmbH ("Filmotec"), along with ORWO Production Studios Inc, and Black Hangar Studios Limited. ORWO Limited is also part of the same family, with the director, Michael Seal being Jake Seal's father. We refer to them collectively as the "Group."

Filmotec GmbH and the Complainant share a common ancestry with AGFA and ORWO who produced photographic film at the beginning of the 20th Century.

The historic business of ORWO related to the manufacturing and sale of film to be used in the photographic and movie industries. Following the breakup of the assets of AGFA after World War II, the ORWO brand was created. The name is an abbreviation of the words 'ORIGINAL' and 'WOLFEN'. Wolfen being the town in which the ORWO brand was based. In the years following World War II, ORWO had a monopoly on photographic film manufacturing in East Germany. ORWO photographic film was also sold outside of Germany where it provided a cheaper alternative to those products offered by Kodak and Ilford.

Following the privatization of ORWO AG in 1990 and its subsequent liquidation in 1994, photographic film production under the ORWO name ceased. In 1998, The Respondent's Filmotec GmbH was incorporated to restart the production of photographic film under the ORWO brand.

The Complainant, ORWO Net, was re-incorporated on November 4, 2002, after the incorporation of the Respondent. The Complainant has stated that it took over the business and assets of its predecessor PixelNet AG. PixelNet AG was incorporated with the purpose of preparing for the age of digital photography. […] The Complainant follows PixelNet's legacy of providing printing services and photo gifts such as photobooks and calendars.

In 2020 FilmoTec GmbH was brought under common ownership with film coating company InovisCoat, based in Monheim am Rhein, Germany to offer products for the film industry under the brand 'ORWO', both companies sharing AGFA heritage, AGFA employees and AGFA Machinery and the intellectual property required to produce traditional ORWO photographic film.

The Complainant argues in the Complaint that its logo and headquarters are 'iconic'. The Respondent wholly disagrees with this statement. The predecessor to the ORWO brand created a brand that was well known in relation to photographic film. The Respondent's Filmotech GmbH rose from the ashes of the ORWO group of companies with a sole purpose of providing photographic film using ORWO's old emulsion formulas (which it inherited from its predecessor) and once again innovated in the photographic film industry like its predecessor had done for over 60 years prior.

The Complainant and its predecessor PixelNet AG have only ever (as far as the Respondent is aware) provided white-label digital printing services and photographic (print and copy) services, this has no similarity to the Respondent's analogue photographic film products. As far as the Representative is aware, the Complainant has no modern connection with ORWO's iconic photographic film products and is not recognized by the public as being connected with the iconic brand. The Complainant has never sold photographic film and it does not have the technology or machinery in order to do so. In

addition, the Complainant's website does not even make use of the 'block-logo', which it argues is 'iconic'. […] As a result of the Complainant solely providing white-label products, the public has no awareness of the Complainant being connected with or using the ORWO name.

Conversely, the Respondent's Filmotec GmbH is well-known in the market for manufacturing and selling film products under the 'ORWO' brand name and is recognized by the public as the true successor to the ORWO name for the iconic photographic film goods. Attached in one of the annexes is an extract from Wikipedia regarding the 'ORWO' brand and lists the Respondent's Filmotec GmbH as continuing the ORWO legacy and lists the Respondent's current product lines that it manufactures and sells. Despite the Complainant's allegations, the Respondent's Group has a well-known business activity and is the only business to be known under the ORWO brand in relation to photographic film."

Parties' use of the sign "ORWO" prior to the present dispute

Furthermore, each party submits that it legitimately used the sign "ORWO" in commerce prior to this dispute. In this context, the Complainant seems to primarily refer to the use in connection with its company name. The Respondent submits (undated) web page printouts of numerous online stores from Australia, the UK, and the US, in which products are offered under the sign "ORWO", some of which are also marked with the company name "FILMOTEC", which, according to the respondent's submissions, refers to one of the Respondent's affiliated companies.

Summary

Numerous questions arise from the parties' submissions that cannot be conclusively answered based on the submissions and evidence of the parties. These include:

• Similarity between the opposing goods and services ("production of films for analog photography" on the one hand and "digital printing services and photographic (print and copy) services" on the other hand).

• Questions concerning the actual use of the conflicting trademarks and the question if some of the trademarks are subject to deletion based on non-use.

• Existence and scope of possible company rights.

Furthermore, according to the parties' submissions, the following facts of the case are partly unclear, and the parties have not submitted any supplementary documents to enable the Panel to review them:

• The Complainant alleges that the Respondent's websites untruthfully claim that the Respondent has a warehouse located in Röntgenstraße 3, D-06766 Bitterfeld-Wolfen, Germany, the Complainant's registered office. In reply, the Respondent literally states: "However, the Respondent's Group has a lease over these premises from the Complainant. The Complainant is well aware of this and by making this statement in its Complaint, it is once again attempting to mislead the CAC.". However, the Respondent did not submit any evidence for the existence of the alleged lease agreement.

• Respondent alleges that there has a relationship with numerous companies, including Filmotec GmbH, ORWO Production Studios Inc, Black Hangar Studios Limited, and ORWO Limited. Evidence to support this has not been provided.

• The Complainant argues that the Respondent "usurpes the iconic ORWO "block-logo" which enjoys a high recognition on the market […]. It is particularly this historic block logo with its square appearance that has a high recognition value associated with the Complainant (and its iconic headquarter), so that the likelihood of confusion is additionally increased;" The Respondent replies that the block logo and the "iconic headquarter" primarily establishes a mental link to the former company that produced films and that the Complainant, unlike the Respondent, is no longer engaged in that field of business.

In conclusion, the Panel assumes that numerous factual and legal issues are disputed between the parties. In the view of the Panel, it might in fact be possible that the Complainant is able to prohibit the Respondent from using the sign "ORWO" to a limited extent in terms of geography and content. However, it is also not impossible that corresponding claims could also exist in the opposite direction. Furthermore, according to the parties' submissions, some of the statements made on the Respondent's website might be misleading and thus vulnerable under competition law. However, in the view of the Panel, the submissions of the parties do not allow the conclusion that the registration and use of the disputed domain names is in any case unlawful within the meaning of the UDRP. According to the parties' submissions, there is also the possibility that the Respondent as well as possible affiliated companies, through their business activities, used the sign "ORWO" prior to knowledge of this dispute in a manner that gave rise to their own rights and legitimate interests pursuant to paragraph 4(a)(c) of the UDRP. Furthermore, given that one of the affiliated companies named by the Respondent is publicly named as the legal successor of the former company ORWO, it might be that there was already no bad faith in the registration of the disputed domain names. In this context, the Panel particularly refers to the following information contained in the encyclopaedia Wikipedia:

„One of the successor companies, ORWO FilmoTec GmbH was founded in 1998 to produce high quality black and white cinema and technical films, based in Wolfen under the ORWO brand. Currently, the ORWO range incorporates negative film for motion picture production (UN54 and N75), duplicating film, print film, sound recording film, and film leaders for the processing and distribution business.

In 2020 FilmoTec was brought under common ownership under Seal 1818 GmbH with film coating company InovisCoat GmbH, also based in Germany and with shared Agfa heritage to offer products for the film industry under the traditional brand "ORWO"."

Result

The Panel finds that the present dispute could not have been appropriately decided under the Policy. The Policy was adopted to deal with cases of cybersquatting. According to paragraph 170 of WIPO's Final Report of the WIPO Internet Domain Name Process of April 30, 1999, the scope of the process is limited to cases of "deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks and service marks". ICANN's adoption of WIPO's recommendations gives panelists limited latitude, in what is intended to be a summary proceeding (See Jason Crouch and Virginia McNeill v. Clement Stein, WIPO Case No. D2005-1201; Family Watchdog LLC v. Lester Schweiss, WIPO Case No. D2008-0183). In other words, the UDRP is designed to deal with simple cases of cyber-squatting (See Summit Industries, Inc. v. Jardine Performance Exhaust Inc., WIPO Case No. D2001-1001).

On the record of the present case, namely the statements and documents submitted by the parties, are underlying disputes regarding trademark rights and usage, trademark infringement, their legal consequences and effects, and related issues under national law. While paragraph 15(a) of the Policy provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the UDRP Rules, and any rules and principles of law that it deems applicable, which may also include provisions under national law, the questions that a panel has jurisdiction to address under the Policy are relatively simple and straightforward, and the decision framework of the UDRP generally does not require resort to concepts or jurisprudence specific to national law (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") with further references). The present case is way beyond the scope of the Panel's limited jurisdiction under the Policy as just described. It is evident from the record that this dispute involves broad factual and legal issues regarding trademark rights and usage under national law, and not only the more narrowly framed questions that can be decided under the Policy, which was never intended to serve as a vehicle for adjudication of traditional trademark disputes.

Domain name disputes such as the present are more appropriately decided by traditional means as they turn on questions of fact that cannot be resolved on the basis of the parties' statements and documents filed in a summary proceeding, and on questions of law beyond the limited scope of the Policy (See Clinomics Biosciences, Inc. v. Simplicity Software, Inc., WIPO

Case No. D2001-0823).

The Panel wishes to point out, however, that the present decision expresses no view on the respective merits of the parties' cases, as presented in the instant dispute. In any event, this decision would have no precedential effect upon any subsequent judicial proceedings.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ORWO.SHOP**: Remaining with the Respondent
2. **ORWO.WTF**: Remaining with the Respondent

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2022-12-05

Publish the Decision