Decision for dispute CAC-UDRP-106217

Case number	CAC-UDRP-106217
Time of filing	2024-02-16 09:20:15
Domain names	abdcosmeticsgmbh.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	ABD Cosmetics GmbH

Complainant representative

Organization	DIEKMANN Rechtsanwälte

Respondent

Name	Bah Silver

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 Complainant is ABD Cosmetics GmbH, a limited liability company under German law. The Complainant relies on its unregistered trademark “ABD Cosmetics GmbH” as well as different rights, such as name rights, firm rights, rights to a business name.

FACTUAL BACKGROUND

FACTS PROVIDED BY THE COMPLAINANT:

The Complainant distributes cosmetic products to end customers and commercial customers in the Federal Republic of Germany.

The disputed domain name <abdcosmeticsgmbh.com> (hereinafter, the “Disputed Domain Name”) is identical to the Complainant´s company name “ABD Cosmetics GmbH". The Respondent offers cosmetics in a German webshop using the Complainants company data in the website´s imprint without any authorization of the Complainant whatsoever.

The Complainant provided with a Statutory Declaration of the Complainant´s CEO, which in his function as managing director of ABD Cosmetics GmbH, the CEO declared, after being informed about the punish ability of a false statutory declaration pursuant to Section 156 of the German Penal Code, that the fraudulent website “www.abdcosmeticsgmbh.com”, which the Complainant neither operates nor hosts, nor to which the Complainant has any kind of administrative access or relation to whatsoever, uses ABD

Cosmetics GmbH´s firm and following company data: ABD Cosmetics GmbH Anni-Eisler-Lehmann-Straße 7 55122 Mainz, without its permission, supplemented by an external telephone number "+49 152 15898762" and an external e-mail address: info@abdcosmeticsgmbh.com neither of which are from the Complainant.

The Complainant also asserted that the Disputed Domain Name was registered by Registrar Namecheap Inc., while the identity of the Registrant/Respondent it-/him-/herself remains undisclosed and therefore unknown to the Complainant.

The Complainant established that the Disputed Domain Name is obviously solely based on the Complainant´s firm/name/trademark/business designation "ABD Cosmetics GmbH" in order to make the Complainant´s customers believe that the offers on the Disputed Domain Name are offers by the Complainant, which is not the case. Furthermore, the Complainant asserted that the Disputed Domain Name abuses the Complainant´s reputable standing and intends to deceive the Complainant´s customers to divert them to the Respondent´s offers and to trick them into ordering and paying cosmetics without most likely ever receiving them.

The Disputed Domain Name is identical to the Complainant´s firm "ABD Cosmetics GmbH" to which the Complainant holds name rights (§ 12 German Civil Code – "BGB"), firm rights (§ 37 German Commercial Code – "HGB"), trademark use rights and rights to a business name following § 4 No. 2, § 5 paragraph 2 sentence 1, § 15 German Trademark Act. Moreover, identical goods and services are offered under the firm/trademarks/designation/domain causing a high risk for the general public to confuse the Complainant with the Respondent´s offerings under the Disputed Domain Name.

The Complainant indicated that Disputed Domain Name has been registered and is being used in bad faith with the aim to take advantage of the Complainant´s company data/designation/firm etc. to divert customers to the Respondent´s fraudulent online shop under the disputed domain. Consequently, the Complainant requested that the Disputed Domain Name should be revoked. Finally, the Complainant concluded by indicating that since the fraudulent website addresses customers in German language German and European (trademark, firm, name, domain) law shall be applicable.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

Procedural Order Nr. 1

In reaction to Procedural Order No. 1 issued by this Panel, the Complainant submitted the following documents to show that the company name "ABD Cosmetics GmbH" has been used as a trademark and/or has acquired public recognition as a trade mark with the affected trade circles as stated at Article 4, Fraction 2 of the German Trademark Act in force:

The Complainant has provided an evidence via Annexes attached in the Complaint:

An invoice/credit note in favor of one of the Complainant's clients on the Complainant's letterhead dated 2023.

2 invoices from UPS to the Complainant (from 2022 and 2024).

3 photos showing the outer packaging of 2 of the Complainant's current products "Ardell" and "Lefurell" (eyelash serum) on which the Complainant is named.

In addition, The Complainant also included the following arguments:

Even if some of the Annexes would not be considered to be sufficient to prove trademark rights under German law, the website in dispute and the domain under which it can be accessed, which purports to be from the Complainant but in fact is not, nevertheless constitute an unlawful offer that must be removed immediately, as the Complainant has also asserted in the complaint. The misleading use of that domain/website is opposed by at least the following rights of the Complainant, so that the existence of trademark rights to the name "ABD Cosmetics GmbH" is not necessary in the dispute:

- Company rights according to § 37 HGB;
- name rights according to § 12 BGB;
- rights due to the infringement of the entrepreneurial personality right of the complainant according to Art. 12 GG; - claims for injunctive relief under competition law for misleading information pursuant to Sections 8, 5, 5a UWG.

With its statutory declaration the Complainant has already proven, that the fraudulent website www.abdcosmeticsgmbh.com, which the Complainant neither operates nor hosts, nor to which the Complainant has any kind of administrative access or relation to whatsoever, uses the designation "ABD Cosmetics GmbH" and the Complainant´s company data without the Complainant´s permission.

Respondent did not reply to the Complaint.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has not, 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).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel did not assess the second element of the Policy.

BAD FAITH

The Panel did not assess the third element 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

First element.

The Uniform Domain Name Dispute Resolution Policy (the Policy) in its Paragraph 4(a)(i) indicates the obligation of the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

The Complainant does not own a trademark registration for ABD Cosmetics GmbH, however, the Complainant claims that the Disputed Domain Name is identical to the Complainant´s company “ABD Cosmetics GmbH” to which the Complainant claims trademark use rights and rights to a business name following § 4 No. 2, § 5 paragraph 2 sentence 1, § 15 German Trademark Act – among other rights.

Regarding unregistered or common law trademark rights, paragraph 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 (“WIPO Jurisprudential Overview 3.0.) provides information about the elements that Complainant need to show to successfully assert those rights; e.g. the Complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services to establish unregistered or common law trademark rights for purposes of the UDRP.

In this regard, relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.

The Complainant did not provide with any evidence showing the duration and nature of use of the mark, the amount of sales under the mark, the nature and extent of advertising using the mark, the degree of actual public (e.g., consumer, industry, media) recognition, and consumer surveys. As a consequence of the Procedural Order Nr. 1, the Complainant only provided as Annexes an invoice/credit note in favor of one of the Complainant's clients on the Complainant's letterhead dated 2023 as well as 2 invoices from UPS to Complainant and 3 pictures showing the outer packaging of 2 of the Complainant's current products "Ardell" and "Lefurell" (eyelash serum) on which the Complainant is named.

Knowing the fact that the provided evidence might not be sufficient, the Complainant also mentioned that even if the evidence would not be enough to prove trademark rights under German law, the website in dispute and the domain under which it can be accessed, which purports to be from the Complainant but in fact is not, nevertheless constitute an unlawful offer that must be removed immediately. Furthermore, the Complainant also indicated that the misleading use of that domain/website is opposed by at least the following rights of the Complainant, so that the existence of trademark rights to the name "ABD Cosmetics GmbH" is not necessary in the dispute.

At this point, it is important to remind the Complainant that the scope of the UDRP process is limited to cases of deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks and service marks (see paragraph 170 of WIPO's Final Report of the WIPO Internet Domain Name Process dated April 30, 1999).

In this sense, the UDRP process is only related to the protection of trademarks and service marks (registered or unregistered but with secondary meaning). The formation of a company does not qualify has having trademark or service mark (see Electrosoft Services, Inc. v. TechOps / SyncPoint FA Nr. FA2110001969515). Therefore, the Complainant was requested via the Procedural Order Nr. 1 to provide with additional evidence to support that its unregistered trademark rights have acquired secondary meaning.

For the current case, the Complainant provided with only some limited evidence which cannot prove a long and continuous use of the mark and, therefore, it is impossible to confirm that the mark has become a distinctive identifier which consumers associate with the complainant's goods and services. Thus, the Complainant has no UDRP standing based on unregistered trademark rights - see, for instance, Worldwide Perfumes LLC vs Eduardo Vargas, CAC Case Nr. 100951 where the Panel indicated the following:

"…In the case at hand the Complainant did not explain the legal source of his unregistered trademark rights and, in addition, the Complainant failed to submit evidence which clearly prove a long and continuous use of the mark".

The argument raised by the Complainant that no trademark rights to the name "ABD Cosmetics GmbH" are necessary in the dispute due to the existence of additional rights e.g. company rights, name rights, rights due to the infringement of the entrepreneurial personality right of the complainant, it is contrary to the spirit of the UDRP Policy.

As above explained, this administrative proceeding only applies to disputes involving trademark or service marks and it does not cover trade names, company names or any other rights. To receive the proper relief based on rights outside trademark or service marks, the Complaint should search for options provided by the relevant national judicial systems - see for instance 01059 GmbH v. VARTEX Media Marketing GmbH/Stefan Heisig, WIPO Case Nr. D2004-0541 where the panelist indicated the following:

"…

It is the clear language of the Policy that this administrative proceeding does only apply to disputes involving trademarks or service marks, but does not offer relief to holders of trade names, company names or any other commercial designations. As a result, in the event of abuse, holders of these rights are required to defend their legal rights through national judicial systems. (See The Recognition of Rights and the Use of Names in the Internet Domain Name System, Report of the Second WIPO Internet Domain Name Process, September 3, 2001, http://wipo2.wipo.int, at 138, in the following "Final Report", at 21 et seq. and 138). "

As the first element of paragraph 4(a) of the Policy has not been met, the other elements need no further discussion.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **abdcosmeticsgmbh.com**: Remaining with the Respondent

PANELLISTS

Name	**Victor Garcia Padilla**

DATE OF PANEL DECISION 2024-04-01

Publish the Decision