Decision for dispute CAC-UDRP-106685

Case number	CAC-UDRP-106685
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Domain names	gonso.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Schwanhäußer Industrie Holding GmbH & Co.KG

Respondent

Organization	Germanium World LLC

Respondent representative

Organization	Cylaw Solutions

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 a German functional bikewear supplier company. Founded in 1926 by Johannes Gonser, who initially manufactured lingerie, stockings, nightgowns, and tracksuits for women. Since 1980, the Complainant supplies, functional cycling clothing, including cycling shorts with synthetic seat padding.

The Complainant owns the following trademark:

- EUIPO Trademark for GONSO (word mark), Reg. No. 000182444, in International Classes 18, 25 and 28, filed on April 1, 1996, registered on August 21, 1998, and in force until April 1, 2026.

FACTUAL BACKGROUND

The Complainant is a German functional bikewear supplier company. Founded in 1926 by Johannes Gonser, who initially manufactured lingerie, stockings, nightgowns, and tracksuits for women. In 1979, as a result of -the grandson- Hans Gonser's severe arthritis experience in cycling, after several experiments and in collaboration with Bayer, in 1980, the Complainant produced the first collection of functional bike clothing in Germany and introduced the first cycling shorts with a synthetic seat pad. Since then, the Complainant supplies, functional cycling clothing, including cycling shorts with synthetic seat padding. The Complainant is a subsidiary of Schwanhäußer Industrie Holding GmbH & Co. KG.

The Complainant also owns the domain name <gonso.de> from which operates its official website https://gonso.de/int-en to promote its products.

The Panel notes that the Complainant is also active on the main social media, as Facebook, Instagram and YouTube.

The disputed domain name <**gonso.com**> was registered on **October 23, 2011**, and resolves to an active website, where the disputed domain name it is offered for sale, as part of a domain name's investment business.

The Respondent is an experienced Domain Name Investor, who holds a portfolio of approx. 5000 common words, inherently valuable ".COM" domain names.

PARTIES CONTENTIONS

Complainant Contentions:

Regarding the first element of the Policy, the Complainant merely asserts that the disputed domain name <gonso.com> is identical to the trademark GONSO.

Regarding the second element of the Policy, the Complainant merely asserts that the Respondent has no rights or any legitimate interest in the disputed domain name.

Regarding the third element of the Policy, the Complainant asserts that the disputed domain name was registered, and it is being used in bad faith, given that the Respondent has incurred in paragraph 4.(b)(i) of the Policy, where the disputed domain name is offered for sale for the amount of $24,500 at the Respondent's website.

The Panel notes that the Complainant limited each one of the elements of the Policy, to mere brief assertions.

Response

The Respondent replied to the Complainant's contentions, denying most of the Complainant's allegations and highlighting that the Complainant has incurred in Reverse Domain Name Hijacking.

The Respondent contends that the Complaint is brief; that the section containing "Factual and Legal Grounds" comprises only a handful of short paragraphs in less than one page, just making use of approx. 200 words (excluding titles), which it is an attempt to hijack the 2011-registered domain name and mislead the proceedings, by suppression of relevant information.

The Respondent contends that in a UDRP proceeding, Higher Standards are expected from a complainant, given that as in this case, the Complainant is represented by counsel, who ought to know better and who is under an obligation imposed by paragraph 3(b)(xiii) of the Rules to undertake at least minimal due diligence before filing a complaint, citing e.g.: BERNINA International v. Domain Administrator, WIPO Case No. D2016-1811; WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 4.16.

The Respondent contends/requests that the evidence submitted by the Complainant in German language, shall be disregarded in accordance with paragraph 11(a) of the Rules and Article 11 of the CAC's UDRP Supplemental Rules.

The Respondent contends that the disputed domain name <gonso.com> was acquired in 2011 as part of its investment strategy of acquiring meaningful and short dot-com domains as part of its portfolio of domain names at <domainshop.com>; that the Respondent selected the disputed domain name because it is a personal name (first or last) for many individuals around the world and expected the disputed domain name to be of interest to a potential customer having a similar personal name, looking to establish an online presence. The Respondent also provided details of over 100 individuals on LinkedIn and Facebook respectively, and a list of companies, having either first or last name as GONSO, looking to prove that 'GONSO' is a common name for individuals/businesses globally, including the USA, where the Respondent is located. The Respondent contends that the word "GONSO" is also a short 5-letter word, to which Domain Name Investors are normally attracted, citing Endo Pharmaceuticals Inc. v. Tanzim Ahmad, WIPO Case No. D2021-0511 and Advice Group S.p.A. v. yang jin jie, WIPO Case No. D2019-2829.

With respect to the issue of identity or confusing similarity of the disputed domain name with the Complainant's trademark, the Respondent contends that the trademark certificate evidence provided by the Complainant was in German, and that in accordance with Article 11 of CAC's Supplemental Rules, might be disregarded by the Panel.

The Respondent also contends that the trademark evidence provided by the Complainant, sourced from the EUIPO website, does not constitute an official trademark registration certificate, citing Notino Europe Ltd. v. rf fw, CAC-UDRP-106622.

With reference to rights or legitimate interests in respect of the disputed domain name the Respondent contends that the Complainant has failed to present any arguments under the second clause of legitimate interest, nor it has offered any rationale for assuming that the Respondent lacks legitimate rights or interests in the disputed domain name. That is, a prima facie case is not made out against the Respondent, who is a Domain Name Investor.

The Respondent also contends that speculating and investing in inherently valuable domain names is a legitimate and well-established business, and that in itself, confers 'legitimate interest' in the disputed domain name; that the Respondent operates a

platform for selling domain names at <domainshop.com>; that by October 2011, its portfolio already included several similar domain names, featuring first names like 'avika.com' or last names like 'debert.com'. Having encountered the last name GONSO before domain registration, he registered the domain name <gonso.com> for resale when it became available, citing Allocation Network v. Steve Gregory, WIPO Case No. D2000-0016.

The Respondent contends that although Complainant's prima facie case has not been made out, the Respondent argues that:

-As it has been held that where the Respondent registers a domain name consisting of a personal name/common word because he has a good faith belief that the domain name's value derives from its common qualities rather than its specific trademark value, the use of the domain name consistent with such good faith belief would establish a legitimate interest, citing CRS Technology Corporation vs. Condenet, Inc., Forum Case No. FA0002000093547.

-Previous panelists have found in favor of investing in common-word domain names as a perfectly legitimate business, which can qualify as a bona fide offering of goods or services, as long as the Respondent did not target a specific complainant or protected mark with a particular domain name, citing Platterz Inc. v. Andrew Melcher, Forum Case No. FA1705001729887.

-The Respondent owns similar domain names based upon personal (first or last) name, which were majorly registered earlier to the disputed domain name; that the Respondent selected the disputed domain name because it is a personal (first/last) name for individuals and expected the disputed domain name to be of interest to potential customers, mainly named GONSO, looking to establish an online presence, citing Deep Focus v. Doman Admin, Abstract Holdings International LTD, WIPO Case No. D2018-0518 and BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI), WIPO Case No. D2016-1811.

With reference to the circumstances evidencing bad faith, the Respondent indicates that the Complainant's didn't provide a copy of the WhoIs information, where the registration date of the disputed domain name should be acknowledged, being October 23, 2011.

The Respondent asserts and proves that the disputed domain name was acquired in October 2011, for the purchase acknowledgment dated October 26, 2011, and also the historical WhoIs record dated October 29, 2011; further the Respondent provides a historical screenshot from 2014, showing that the disputed domain name has been on sale for a decade, while the Complainant approached the Respondent anonymously in 2020 only.

The Respondent contends that the Complainant, other than asserting its EU trademark registration of 1998, no information was provided about the Complainant's business, reputation, sales volumes, advertising, marketing, revenue, or any other facts which could establish that the Complainant and its mark were particularly well known (specifically in the USA) when the disputed domain name was registered in 2011; that as such, there is absolutely no evidentiary basis to conclude that anyone, and the Respondent (in the USA) in particular, ought to have heard of the German Complainant at the time that the disputed domain name was registered.

The Respondent contends that to prove bad faith registration, it must be shown that the Respondent registered the domain name not because it is a personal name but rather specifically because it corresponded to a protected trademark, citing Ancien Restaurant Chartier v. Tucows.com, WIPO Case No. D2008-0272.

The Respondent contends that the Complainant makes a single argument under the Bad Faith clause as to its offer for sale of US $24,500 by referring to the communication it had with the Respondent in the year 2020 and additionally, to the <domainshop.com>

parking page at the disputed domain name; that the Complainant does not specifically argue Bad Faith Registration; that there is simply no evidence whatsoever to support the complainant's limited contention that the disputed domain name was registered because of the Complainant in 2011.

The Respondent contends that the Complainant claims that it has owned a trademark in the EU since 1998, however, although knowledge and targeting of the complainant may be proven inferentially, it will not be presumed merely from the complainant's ownership of a similar or identical registered trademark, citing Clearwater Systems v. Glenn, WIPO Case No. WIPO-D2014-0878; that there is no evidence that the Respondent had any

knowledge of the Complainant or targeted it; that, there is no place for constructive knowledge under the UDRP, citing The Way International v. Diamond Peters, WIPO Case No. D2003-0264.

The Respondent contends that the Complainant's allegation that the Respondent's offer to sell the disputed domain name for $24,500 is evidence of bad faith, is false and self-serving; that selling the domain name for the price that the Complainant wanted, would according to the self-serving Complainant, be "good faith"; that at no time did the Respondent solicit the sale from the Complainant; it was the other way around – the Respondent, via a service provider, responded to a request to purchase initiated by the Complainant. Responding to a request to purchase is not considered bad faith; that an offer to sell a domain name that a party otherwise has rights to; is not bad faith, rather it is nothing more than a legitimate effort to sell property properly owned by the party, citing Personally Cool v. Name Administration, Forum Case No. FA1212001474325.

The Respondent contends, that the Complainant's delay in acting against the Respondent over the past 12 years raises the inference that the Complainant did not truly believe that the disputed domain name was registered or used in bad faith; that the Complainant slept on its rights and filed the Complaint only after it was unsuccessful in purchasing the disputed domain name anonymously, which seems to be a matter for reverse domain name hijacking (RDNH) in terms of UDRP Rule 15(e), citing in support among others, Proto Software v. Vertical Axis, WIPO Case No. D2006-0905; TOBAM v. Thestrup/Best Identity, WIPO Case No. D2016-1990; Patricks Universal Export v. David Greenblatt, WIPO Case No. D2016-0653; GWG Holdings v. Jeff Burgar, Alberta Hot Rods, WIPO Case No. D2016-1420; Zenni Optical, LLC. v. Cykon Technology Limited, WIPO Case No. D2009-1594; WIPO Overview 3.0, section 4.16.

RIGHTS

To this Panel, the Complainant's trademark rights over the term GONSO, are not in dispute. Despite the Complainant has submitted a single printout of the EUIPO's trademark database, the Panel, in this case, considers it as appropriate evidence, for the purposes of the first element of the Policy.

Considering the very limited evidence submitted by the Complainant and the facts of this case, the Panel, in accordance with paragraph 10 of the Rules, has conducted its own research and found that the trademark GONSO has been registered across multiple jurisdictions, another fact that calls the attention of this Panel (see UDRP Perspectives, section 0.3).

However, given the evidence submitted, the Panel finds that the Complainant's trademark GONSO it is exactly reproduced in the disputed domain name, therefore, the disputed domain name is identical to Complainant's GONSO trademark. See WIPO Overview 3.0, section 1.7.

In relation to the generic Top-Level Domain ".com", it may be ignored. See WIPO Overview 3.0., section 1.11.1.

Therefore, the Complainant has shown that the disputed domain name is identical to the trademark GONSO in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

Given the facts and evidence submitted in this case, in particular the almost total absence of Complainant's contentions linked to specific evidence, the Panel finds that the Complainant has not established a prima facie case that Respondent lacks rights and legitimate interests under the Policy 4(a)(ii).

Despite such absence, the Respondent assumed the burden of proof, strongly argued and provided the corresponding evidence before the Panel, essentially that Respondent's use of the disputed domain name is in connection with a bona fide offering of goods and services, based on the potential value of the word "GONSO" as a personal name, and not around the Complainant's trademark GONSO. The Respondent provided copy of the disputed domain name's WhoIs history, where the registration date it is shown, being October 23, 2011, meaning 13 years before this Complaint. The Respondent also has made special emphasis that Domain Name Investment of genuine common-words, unrelated to a trademark in a domain name, constitutes a legit business model according with the Domain Name Jurisprudence, see e.g.: X6D Limited v. Telepathy, Inc., WIPO Case No. D2010-1519; Allocation Network GmbH v. Steve Gregory, WIPO Case No. D2000-0016; Deep Focus Inc. v. Doman Admin, Abstract Holdings International LTD, WIPO Case No. D2018-0518; Voys United B.V. v. Thomas Zou, WIPO Case No. D2017-2136; Academy, Ltd. v. Ramesh Singh, File No. FA2301002026883; Ultrafem Inc. v. Warren R. Royal, File No. FA0106000097682; iEnterprises, Holdings, LLC v. Private Domain, CAC-UDRP 103374; WIPO Overview 3.0, section 2.10.

Based on the provided evidence and the circumstances of this case, where the Respondent acting as a Domain Name Investor, selected and registered the term GONSO, for its potential value as a personal name, without intent to target or taking advantage of the Complainant's trademark GONSO, the Panel is ready to accept that the Respondent offer for sale, in this case, constitutes a bona fide offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy, therefore the Respondent owns rights and legitimate interests in the disputed domain name (see Voys B.V., Voys United B.V. v. Thomas Zou, WIPO Case No. D2017-2136; Deep Focus Inc. v. Doman Admin, Abstract Holdings International LTD, WIPO Case No. D2018-0518).

The Complainant has failed to demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

BAD FAITH

According with the evidence submitted by the Complaint in this case, the trademark GONSO was registered in 1998. As described along this Decision, the Respondent acquired and registered the disputed domain name in 2011, meaning 13 years after such trademark. However, the Panel can find no evidence upon which to conclude that by the time of the registration of the disputed domain by the Respondent, located in the United States, was aware of the Complainant's business and/or trademark. As also stated along this Decision, the Complaint has provided less than the minimum evidence and almost no arguments to support this case, despite of being legally represented, conduct that this Panel finds against the meaning of the Policy ("Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard." See WIPO Overview 3.0, section 4.16).

On the contrary, the Respondent has argued and provided all the necessary evidence before the Panel, explained the motivations of the registration of the disputed domain name, which this Panel accepts, and finds that Respondent did not register the disputed domain name in bad faith.

In relation to the use in bad faith, and of course, based in the parties' submissions, the Panel finds that the term GONSO, it is not

exclusively associated to the Complainant's trademark. Additionally, the Complainant has failed to prove such condition in this case. Therefore, and again, the Respondent's offer for sale of the disputed domain name, in this case, doesn't constitute bad faith under the Policy ("registration of domain names with a view to selling them at a profit is not of itself objectionable under the Policy." Voys B.V., Voys United B.V. v. Thomas Zou, WIPO Case No. D2017-2136).

The Complainant has failed to prove that the disputed domain name has been registered and is being used in bad faith.

Reverse Domain Hijacking ("RDNH")

Paragraph 15(e) of the UDRP Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

In addition to the facts and circumstances of this case, in July 2020 the Complainant contacted the Respondent indirectly, to potentially explore the acquisition of the disputed domain name. However, giving the price of the disputed domain name, estimated in $24,500, the negotiation did not advanced. Instead, the Panel notes that, almost 4 years after, the Complainant decides to submit a sort of "empty" Complaint, with mere supporting evidence, avoiding the resources available on the CAC's website, performing intentional substantial omissions, "presumably in an effort to acquire the disputed domain name with minimal cost". Motive that "belies the Complainant's undertaking, required by paragraph 3(b)(xiii) of the Rules, "that this Complaint is not being presented for any improper purpose"". (see e.g.: Dumankaya Yapi Malzemeleri San. VE TiC. A.S v. Domain Administrator, Name Administration Inc. (BVI), WIPO Case No. D2015-1757; Voys B.V., Voys United B.V. v. Thomas Zou, WIPO Case No. D2017-2136; Mountain Top (Denmark) ApS v. Contact Privacy Inc. Customer 0133416460 / Name Redacted, Mountaintop Idea Studio, WIPO Case No. D2020-1577; Mangels Industrial S.A. v. Mira Holdings, Inc., WIPO Case No. D2024-2275; WIPO Overview 3.0, section 4.16).

Therefore, the Panel finds in the circumstances that the Complaint was brought in bad faith, for example in an attempt at RDNH.

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.

Respondent Request (Art. 11 CAC's UDRP Supplemental Rules) translation Non-English Complainant's Submitted Evidence

As a previous point, in relation to the Complainant's Annexes submitted in German and not in English as the Respondent pointed out, this Panel, in accordance with paragraphs 10(d) decides to admit all the limited evidence submitted by the Complainant in this case, except from Annex labeled as "Organigramm", in accordance with Article 11 of the CAC's UDRP Supplemental Rules.

Unsolicited Supplemental Filing

On September 3, 2024, the Panel was informed about an email of August 28, 2024, sent by the Complainant to CAC where it looked to add further evidence related to the registration of the trademark GONSO in different jurisdictions and a list of domain names owned by the Complainant as well. The Panel after careful review of such communication, pursuant to paragraph 10 of the Rules, decides to not admit it, given that a) constitutes part of the basic evidence for proceedings under the Policy which shall be submitted initially with the Complaint, b) it didn't comply with paragraph 2(h)(iii) of the Rules, and c) because at the end, in this case, it will not alter the outcome of this Decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2024-09-02

Publish the Decision