



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0893

Entscheidung vom 22. Dezember 2003

1. The Parties

The Complainant is Deutsche Telekom AG of Bonn, Germany ("the Complainant"), represented by Dr. Mathias Koch of Lovells of Munich, Germany.

The Respondent is Ronan Bairead, [Ronan Barrett], of Dublin, Ireland ("the Respondent").

2. The Domain Name and Registrar

The disputed domain name ("the Domain Name") is registered with Register.com ("the Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 10, 2003. On November 10, 2003, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name at issue. On November 10, 2003, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, technical, and zone contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 12, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was December 2, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 4, 2003.

The Center appointed Tony Willoughby as the sole panelist in this matter on December 12, 2003. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is one of Europe's largest telecommunications companies. It is the registered proprietor of German trade mark registration number DE 30007682 dated February 3, 2000, for the numeral 11833 for a wide variety of goods and services associated with its business in classes 9, 16, 35, 36, 38, 39 and 42. The

Complainant uses its trade mark 11833 as the telephone number for its directory enquiry service. The Complainant is also the registrant of the domain names and .

The Respondent appears on the Registrar's WHOIS database as Ronan Bairead. In his email exchange with the Center (see below) he has identified himself as "Ronan Barrett, Managing Director, MYMANC Limited."

The Respondent registered the Domain Name on August 13, 2001.

In the course of September/October 2003, the Complainant's representative has attempted to contact the Respondent by post, email and telephone, but without success.

On November 10, 2003, the Respondent emailed the Center using a different email address from that recorded on the Registrar's database, but indicating that (a) he had received an email addressed to him at the address recorded on the Registrar's database and (b) was aware of the existence of the Complaint. The former point is relevant to an allegation by the Complainant that the contact details on the Registrar's database are false.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is identical to a trade mark in which it has rights and provides proof of a German trade mark registration for the mark 11833.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant asserts that the Respondent is not and never has been a representative or licensee of the Complainant. The Complainant observes that although the Respondent registered the Domain Name over two years ago, he has never made any active use of the Domain Name. Accordingly, he cannot claim to have made any uses of the kind contemplated by paragraph 2(c) of the Policy.

The Complainant further contends that the Domain Name was registered in bad faith and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy. The Complainant puts forward in support of this contention that the Respondent has "interfered with the Complainant's trade mark"; that the Domain Name cannot have been a coincidence, because the 11833 telephone number is so well-known in Germany, but that if the Respondent did not know, a simple trade mark search would have drawn the Complainant's trade mark to his attention; that the Respondent has not used the Domain Name for over two years; that the registration of the Domain Name "prevents the Complainant from registering the disputed domain name"; that there is no legitimate use that the Respondent can make of the Domain Name; that the Respondent's contact details on the Registrar's database are false.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that

- (i) The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name has been registered in bad faith and is being used in bad faith.

A. Identical or Confusingly Similar

The Domain Name comprises the Complainant's German registered trade mark and the generic domain suffix. In assessing identity/confusing similarity for the purpose of paragraph 4(a)(i) of the Policy the generic domain suffix may be ignored.

The Panel finds that the Domain Name is identical to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Proving that a respondent has no rights or legitimate interests in respect of a domain name is commonly a

very difficult task for any complainant. More often than not, the relevant information is not readily available to the complainant. Accordingly, for the purposes of paragraph 4(a)(ii) of the Policy, the burden on the complainant is to make out a prima facie case. A prima facie case having been made out, paragraph 4(c) of the Policy comes into play. Paragraph 4(c) of the Policy, which is addressed to respondents and headed "How to demonstrate your rights to and legitimate interests in the domain name in responding to a complaint" reads as follows:

"When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Accordingly, once a prima facie case has been made out, it is for the respondent to demonstrate that he has rights or legitimate interests in respect of the domain name.

In this case, the Panel is satisfied that the Complainant has made out a prima facie case. The Complainant's enquiries have thrown up no obvious connection between the Respondent and the Domain Name other than the fact of registration. The Complainant's trade/service mark is unusual in that it is a numeral. Moreover it is not a numeral which has any obvious meaning at any rate to the Panel. The Complainant's evidence supports the Complainant's claim that the numeral is very well-known in Germany as the telephone number for the Complainant's directory enquiry service. In the absence of any other explanation, the Panel believes it to be a real possibility that the Respondent knew of the Complainant and its directory enquiry service telephone number when he registered the Domain Name and registered it not because it was a number in which he had any right or legitimate interest, but because it was the Complainant's directory enquiry service telephone number.

The Respondent has a case to answer; yet, the Respondent has failed to provide an answer. There has been no Response.

In these circumstances, and the Panel being unable to think of any reason why the Respondent could reasonably be said to have rights or legitimate interests in respect of the Domain Name, the Panel finds that the Respondent has no such rights or interests.

C. Registered and Used in Bad Faith

For the Complainant to succeed under paragraph 4(a)(iii) of the Policy, the Respondent must ordinarily, at the very least, have had the Complainant in mind when registering the Domain Name. The Respondent, when registering the Domain Name, must have intended to damage the Complainant in some way or in some way derive an unfair benefit through use of the Complainant's trade mark as (or as part of) the Domain Name. Paragraph 4(b) of the Policy sets out four examples of what constitutes bad faith registration and use, but the Complainant does not contend that any of these are directly applicable in this case. Nonetheless, as indicated above, the Complainant makes a number of points in support of the bad faith claim and the Panel deals with each in turn.

First, the Complainant contends that the Respondent has "interfered with the Complainant's trade mark." That is as may be, but interference with a trade mark does not of itself fall foul of the Policy.

Secondly, the Complainant contends that the Respondent, when registering the Domain Name must have had the Complainant's trade mark in mind because of the fame of the mark in Germany. If this is so, the Complainant is on the right track, but there is no hard evidence to support this proposition. The Complainant's fallback position on this is that even if the Respondent was not aware of the Complainant's trade mark, a simple trade mark search would have alerted him to the Complainant's trade mark rights. The Panel is aware that some panels have entertained a concept of constructive bad faith in this context, but the Panel respectfully declines to adopt that approach. In this case, the Panel accepts, on

the balance of probabilities, that the Respondent knew of the Complainant's trade mark when registering the Domain Name. The Domain Name comprises a number which, on the evidence before the Panel, has no obvious meaning other than as the telephone number of the Complainant's directory enquiry service and the Respondent, despite having had the opportunity to come forward with a counter explanation, has not done so.

Thirdly, the Complainant relies on the fact that the Respondent has not used the Domain Name for over two years. This can be a relevant factor when taken together with other factors, but of itself is of no account. There may be any number of legitimate reasons why a registrant has not made immediate use of his domain name.

Fourthly, the Complainant asserts that registration of the Domain Name has prevented the Complainant from registering the Domain Name. That is true of every domain name registration and cannot of itself constitute bad faith registration and use. Indeed, the Panel observes that the Complainant cannot have been in any great hurry to register the Domain Name, given that it took the Complainant nearly two years to learn of the registration of the Domain Name.

Fifthly, the Complainant contends that the Respondent has filed false contact details with the Registrar and that this constitutes evidence of bad faith registration and use. The Panel accepts that in certain circumstances the filing of false contact details may indeed constitute evidence of bad faith registration and use. However, the Panel is far from convinced that this is what has happened here. The letter that the Complainant's representative sent to the Respondent was returned marked "Gone away," thereby implying that the address was once the Respondent's address. Failing to keep contact details up to date cannot, of itself, constitute bad faith registration and use. In any event it appears that the Respondent's email address recorded with the Registrar does in fact represent one of the Respondent's current email addresses. As observed above, it was an email address by which the Center was able to make contact with the Respondent in these proceedings.

Sixthly, the Complainant contends that there is no legitimate use that the Respondent can make of the Domain Name, it being the Complainant's trade mark. The Panel accepts that that is true of any use that the Respondent may make of the Domain Name in Germany, but is by no means sure that it is necessarily true of any use made of it outside Germany.

The Panel approaches this case as follows.

This is a domain name in respect of which, and for the reasons stated above, the Panel has concluded that the Respondent has no rights or legitimate interests. That leads to the question: why did the Respondent register it? Nobody goes to the trouble and expense of registering domain names for no purpose.

Given the Panel's finding above that the Respondent registered the Domain Name knowing of the Complainant's 11833 telephone number and intending that it should represent the Complainant's telephone number, the Panel concludes that the purpose was an illegitimate one. It may have been to sell it to the Complainant at a profit, it may have been with a view to using it to benefit in some way from the Complainant's reputation and goodwill.

The Respondent has allowed the Complainant and the Panel scope for speculation by failing to come forward with an explanation for his selection of the Domain Name. Had there been a legitimate reason, it would have been so easy for the Respondent to have provided it. The Respondent declined to do so. The Respondent cannot be surprised if adverse inferences are drawn from his failure to provide an explanation.

In the circumstances, the Panel finds on the balance of probabilities that the Respondent registered the Domain Name in bad faith and is using it in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4 of the Policy and 15 of the Rules, the Panel orders that the Domain Name, , be transferred to the Complainant.

(Sole Panelist)