

ADMINISTRATIVE PANEL DECISION

Softway AG v. Web Master Internet Services Private Limited
Case No. D2014-0376

1. The Parties

The Complainant is Softway AG of Hirschaid, Germany, represented by Aumueller Kessler & Kollegen, Germany.

The Respondent is Web Master Internet Services Private Limited of Thane, India, self-represented.

2. The Domain Name and Registrar

The disputed domain name <softway.com> is registered with Tirupati Domains and Hosting Private Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 11, 2014. On March 11, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 13, 2014, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on March 20, 2014.

The Center verified that the Complaint together with the amendment to 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 March 21, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was April 10, 2014. The Response was filed with the Center on April 8, 2014. The Complainant and the Respondent filed supplemental submissions with the Center on April 11, 2014 and April 15, 2014, respectively.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on April 16, 2014. 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

As reflected in the registration record for the disputed domain name in the Registrar's Whois database (a copy of that record is annexed to the Complaint), the disputed domain name was registered on December 7, 1993 and is set to expire on December 6, 2014.

A. Complainant's SOFTWARE Marks

The Complainant owns trademark registrations in Germany and the European Community (OHIM) for various marks for the term "software" either in a typed or stylized fashion. The Complainant has provided copies of: (a) its European Community registration, and (b) for its German registrations, entries from publicly accessible databases from the German Patent and Trademark Office. Pertinent details of these registrations are as follows:

1. SOFTWARE
Community registration no.: 011472289
registered: April 30, 2013

This mark is registered in international class 9 for use in conjunction with computer software, class 35 for use in conjunction with commercial project management, and class 42 for use in conjunction with software development service, updating and maintenance of computer software and programs, and computer hardware and consultancy services.

2. SOFTWARE (stylized)
German registration no.: 30510502
registered: May 13, 2005

This mark is registered in international class 9 for use in conjunction with computer software, class 35 for use in conjunction with commercial project management, and class 42 for use in conjunction with software development service, updating and maintenance of computer software and programs, and computer hardware and consultancy services.

3. SOFTWARE (stylized)
German registration no.: 302008081287
registered: April 27, 2009

This mark is registered in international class 9 for use in conjunction with computer software, class 35 for use in conjunction with commercial project management, and class 42 for use in conjunction with software development service, updating and maintenance of computer software and programs, and computer hardware and consultancy services.

B. The Parties' Conduct

The Complainant, a German software design and consultancy firm, has been using the term SOFTWARE as its corporate name since it was established in 1989.

The Respondent registered the disputed domain name in December 1993. The name currently resolves to a blank web page.

Approximately 13 1/2 years later, on June 27, 2007, the Complainant registered the domain name <softway.de> which the Complainant continues to use as the address of its web site. A copy of its home page from that site is annexed to the Response.

On November 7, 2007, the Complainant, having noticed that the Respondent had by then parked the disputed domain name for sale, submitted an initial offer of \$100 to the Respondent to purchase the disputed domain name. That offer was accompanied by an inquiry from the Complainant as to what amount the Respondent was willing to accept from the Complainant for purchase of the disputed domain name. On November 16, 2007, the Respondent replied, by e-mail, with the amount of \$ 6,500. Through an e-mail dated November 19, 2007, the Complainant declined this amount and counteroffered with \$1,000. On the following day, November 20, 2007, the Respondent, by e-mail, declined the counteroffer and stated it paid \$1,300 for the disputed domain name. No further negotiations occurred. Copies of the salient e-mail correspondence between the parties accompanies the Complainant's supplemental submission.

On December 24, 2008, the Complainant filed an application to register its stylized SOFTWAY mark in Germany. That application eventually matured into the 302008081287 registration.

Approximately 5 1/2 years later, on March 11, 2014, the Complainant filed the present complaint seeking transfer of the disputed domain name <softway.com>.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant simply contends, by listing its trademark registrations, that the disputed domain name is confusingly similar or identical to the Complainant's SOFTWAY marks as the disputed domain name contains the term "Softway" and also that the Complainant has used the term "Softway" in its corporate name since 1989.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant merely sets forth each alternate element of paragraph 4(c) of the Policy (any one of which, *i.e.*, elements 4(c)(i)-(iii), if satisfied by a respondent demonstrates that the respondent has rights or legitimate interests in a disputed domain name) and contends that the Respondent does not meet any of those elements, by stating:

"There is not any notice to the Respondent of the dispute, that there is any [no] evidence of the Respondent's 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 ..." (para. 4(c)(i));

"The Respondent as an business organisation [sic] has not been commonly known by the domain name, even the Respondent has not acquired trademark or service mark rights;" (Para. 4(c)(ii)); and

"The Respondent is not making a legitimate noncommercial or fair use of the domain name(s), without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue." (para. 4(c)(iii)).

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Complainant contends, under paragraph 4(b)(i) of the Policy, that the Respondent registered the disputed domain name primarily for the purpose of selling it to the owner of the trademark or service mark (the Complainant) or a competitor thereof for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the name. In that regard, the Complainant points to a web page (a copy of which appears annexed to the Complaint) through which, so the Complainant asserts, the Respondent is currently offering the disputed domain name for sale.

B. Respondent

Through the Response, the Respondent raises several defenses to the Complainant's allegations.

First, the Respondent contends that the term "Softway" is generic. As such, the Respondent implies that the Complainant has no trademark rights in that term.

Second, in 1993, when the Respondent registered the disputed domain name, the Respondent had no knowledge of the Complainant. To support this, the Respondent notes that the Complainant did not have any trademark registrations at that time.

Third, the Complainant registered its current domain name <softway.de> approximately 14 years after the Respondent registered the disputed domain name.

Fourth, the Respondent denied that it ever engaged in any conduct that constituted bad faith under any of paragraphs 4(b)(i)-(iv) of the Policy, specifically:

- (a) on its own initiative, it never contacted the Complainant or its agents for the purpose of renting, selling or otherwise transferring the disputed domain name to the Complainant;
- (b) it did not register the disputed domain name to prevent the Complainant from reflecting any of its SOFTWAY marks as a domain name;
- (c) it did not register the disputed domain name to disrupt a competitor's business -- as the parties here are not competitors and the Complainant had no web presence for 14 years after the Respondent registered the name; and
- (d) it did not intentionally attract, for commercial gain, any Internet user to its website or other on-line location by creating a likelihood of confusion with the Complainant's marks.

Lastly, the Complainant failed to show why it waited more than 20 years, after the Respondent registered the disputed domain name, to file the present complaint.

The Respondent requests that the Panel declare the Complainant to have engaged in reverse domain name hijacking.

C. Supplemental Submissions

As noted above, each party filed a supplemental submission with the Center. UDRP Panels have wide discretion as to whether to accept an unsolicited supplemental filing from either party, bearing in mind the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case. The party submitting its filing would normally need to show its relevance to the case and why it was unable to provide that information in the complaint or response. See

paragraph 4.2 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”). The submissions here, being unsolicited by the Panel, consisted for the Complainant of a letter from the Complainant’s counsel dated April 11, 2014 along with attached e-mail correspondence occurring between November 7 and 20, 2007 between the parties, which, in turn, was followed on April 15, 2014 by a response from the Respondent to that submission.

As both of these submissions were rather abbreviated and collectively constituted a complete round of submissions, the Panel, concluding that no process inefficiency would arise from considering these submissions, exercised its discretion by having fully considered them.

Having done so, the Panel finds that both submissions add little useful information to that previously of record. Both supplemental submissions primarily address the legal effect under the Policy of the Respondent having parked the disputed domain name for sale and subsequent, though short-lived and ultimately failed, negotiations during November 7-20, 2007 between the parties over a purchase price. This issue is quite collateral to the dispositive issue here, *i.e.*, whether in 1993 the Respondent registered the disputed domain name in bad faith. In the interest of brevity, the Panel sees no need to summarize these filings any further.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s SOFTWARE marks.

From a simple comparison of the disputed domain name to the Complainant’s registered mark SOFTWARE, no doubt exists that the disputed domain name is identical to the Complainant’s marks. The only difference between the disputed domain name and the mark SOFTWARE is the addition of the generic Top-Level Domain “.com” to that term to form the disputed domain name, with that addition being generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus typically ignored.

Thus, the Panel finds that the disputed domain name is identical to the Complainant’s SOFTWARE marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Though the Respondent argues that the term SOFTWARE is generic and thus not susceptible of trademark protection, assessing whether any term is generic or not lies well outside the rather narrow jurisdiction and competence of a UDRP panel. Moreover, the rather summary nature of a UDRP administrative proceeding is simply not suited for the necessarily detailed factual inquiry involved in reaching such an assessment. Accordingly, such an assessment must be left to competent governmental trademark offices and national courts, not a UDRP panel, to determine.

B. Rights or Legitimate Interests

Given the Panel’s determination, as discussed below, that the Respondent did not register the disputed domain name in bad faith, any determination as to whether the Respondent has rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy is moot. Hence, the Panel need not and will not opine as to whether the Respondent has satisfied any of the elements recited in paragraphs 4(c)(i)-(iii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent did not register the disputed domain name in bad faith. There are simply no facts of record which indicate that the Respondent had any knowledge whatsoever of the Complainant in December 1993 when the Respondent registered the disputed domain name. The facts

which do exist convincingly persuade the Panel of the opposite conclusion: at that time, the Respondent was completely unaware of the Complainant.

Specifically, the Complainant did not register its own domain name and start establishing a web presence until 2007 – some 14 years after the Respondent registered the disputed domain name.

Furthermore, none of the Complainant's SOFTWAY marks were registered before 2005 – some 12 years after the Respondent registered the disputed domain name.

Moreover, the Complainant put forth absolutely no proof by virtue of, for example, any public relations materials, market surveys, advertising campaigns (in any form) or other market-based evidence sufficient to establish that it may have acquired a reputation in its marketplace or industry in late 1993 such that it would be reasonable for the Panel to infer that the Respondent then knew or reasonably should have known of the Complainant when it registered the disputed domain name. In the absence of any such knowledge, the Respondent was incapable of harboring any intent at that time with respect to the Complainant, whether adverse or not and let alone one that, in some manner, would reflect any desire to exploit or somehow injure the Complainant through registration of the disputed domain name, and thus reflect bad faith. See WIPO Overview 2.0, paragraph 3.1. From the scant evidence of record, the Panel is left to conclude that the fact that the formative portion of the disputed domain name happens to match the Complainant's mark is mere coincidence.

While during the post-registration period since December 7, 1993, the Respondent may not have used the disputed domain name for a significant portion of that time, with such non-use apparently continuing to the present, such passive use by itself is insufficient to satisfy the bad faith element of paragraph 4(a)(iii) of the Policy. If a complainant cannot prove bad faith registration, as paragraph 4(a)(iii) of the Policy is conjunctive in requiring both bad faith use and bad faith registration, by expressly stating: "(iii) your domain name is registered and is being used in bad faith", then its allegation of bad faith under this paragraph must fail. So it must here. There are simply no facts of record which establish that the Respondent registered the disputed domain name in December 1993 in bad faith.

Hence, the Panel finds that the Complainant has failed to meet its burden under paragraph 4(a)(iii) of the Policy.

D. Reverse Domain Name Hijacking

The Complainant clearly knew, based on the Whois record for the disputed domain name annexed to the Complaint, that the Respondent registered the disputed domain name in December 1993 – some 14 years before the Complainant first contacted the Respondent in an effort to purchase the disputed domain name. There is no indication in the record that the Respondent had any prior knowledge of the Complainant or any trademark rights the Complainant may have then had. Certainly, none of the Complainant's marks were registered at that time, with the earliest mark having been registered during 2005 – some 12 years after the Respondent registered the disputed domain name.

Nevertheless, to prove reverse domain name hijacking, a respondent must show that a complainant brought its complaint in bad faith and thus constitutes an abuse of the administrative process. Through such a showing, the respondent must persuade a UDRP panel that the complainant knew or should have known that its complaint was baseless and thus brought to basically harass the respondent. Mere lack of success is not sufficient. In that regard, if the complainant had a colorable basis for asserting its complaint, even if that basis was ultimately proven wrong, then a finding of reverse domain name hijacking will not lie. See WIPO Overview 2.0, paragraph 4.17.

At a cursory level, particularly in light of the long intervals during which the Complainant abstained from even engaging with the Respondent let alone instituting any action against the Respondent, the Complainant's conduct here may well appear to reflect harassment. However, on close examination, the Panel believes that the Complainant, in having started use of the term "Softway" as part of its corporate name in 1989 – 4

years before the Respondent registered the disputed domain name, may have believed that it had (common law, unregistered) trademark rights that predated the 1993 registration date, rights that might have sufficed under paragraph 4(a)(iii) of the Policy. Hence, the Complainant may have believed that it had a colorable basis for its Complaint – however unsuccessful that basis might ultimately be found to be.

Though the Complainant neither argued this point nor established, as it would clearly need to, under German or other applicable relevant national law that it had such rights, nevertheless in assessing whether reverse domain name hijacking exists or not, the intent of the Complainant in instituting the proceeding governs, not the ultimate strength or correctness of its beliefs and positions. Hence, the Panel cannot conclude under the facts of record that the Complainant's intent in filing the Complaint was sufficiently egregious such that the Complainant's conduct constituted an abuse of the administrative process and, as such, reverse domain name hijacking.

7. Decision

Accordingly, the Panel denies the relief sought by the Complainant.

Peter L. Michaelson
Sole Panelist
Date: April 29, 2014