

NOMINET DISPUTE RESOLUTION SERVICE

DRS 000106

Commerzbank AG -v- Castellomedia Limited

Decision of Independent Expert

1. **Parties:**

The Complainant is Commerzbank Aktiengesellschaft (referred to as Commerzbank AG) of 60 Gracechurch Street, London, EC3V OHR.

The Respondent is Castellomedia Limited of Becker Gundahl Strasse 24, Muenchen, 81479.

2. **Domain Name:**

The domain name in dispute is Commerzbank.org.uk (“the Domain Name”).

3. **Procedural Background:**

A complaint in respect of the Domain Name (“the Complaint”) under Nominet’s Dispute Resolution Service Policy (“the Policy”) was received by Nominet from the Complainant on 16 November 2001. The Complaint was forwarded to the Respondent on 19 November 2001 and the Respondent was informed that it had 15 days within which to lodge a Response. The Respondent has failed to respond. Mediation was therefore not possible. On 31 December 2001 the Complainant paid Nominet the appropriate fee for the decision of an expert pursuant to paragraph 21 of the Nominet Dispute Resolution Service Procedure (“the Procedure”).

On 8 January 2002 Andrew Clinton (“the Expert”) confirmed to Nominet that he was independent of each of the parties but that he wished to disclose certain circumstances as they might have been of such a nature as to call into question the Expert’s independence in the eyes of one or both of the parties. The disclosure by Andrew Clinton was in the following terms:-

“I own an Individual Savings Account which is invested with Jupiter Unit Trust Managers Limited which I understand is a member of the Commerzbank Group. The value of the investment as at 5 October 2001 (the

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date of the last statement) was £1,085.55. I do not believe that this investment in any way affects my independence”.

Nominet forwarded the disclosure by the Expert to the parties on 8 January 2002 asking the parties to confirm whether they had any objection to the appointment of the Expert. On 15 January 2002 Nominet confirmed to the Expert that neither party had objected to the Expert’s appointment and that the Expert should proceed to a decision.

4. **Outstanding Formal/Procedural Issues**

The Respondent has not submitted a Response to Nominet in time (or at all) in compliance with paragraph 5a of the Procedure.

Paragraph 15b of the Procedure provides that “If, in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint”. The Expert is not aware of any exceptional circumstances and therefore proceeds to a Decision on the Complaint notwithstanding the absence of a Response.

Paragraph 15c of the Procedure provides that “If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure ..., the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate”. The Expert is not aware of any exceptional circumstances in this case and so will draw such inferences as he considers appropriate and as indicated in this Decision.

The fact that the Respondent has failed to reply does not in any way absolve the Complainant from the burden of having to prove its case (in accordance with the requirements of the Policy) on the balance of probabilities.

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5. **The Facts:**

The Complainant is Commerzbank Aktiengesellschaft (also referred to as Commerzbank AG) which (according to its letterhead) is a limited liability company incorporated in the Federal Republic of Germany. The Complainant is registered in England and Wales under registration number BR001025, is a member of the London Stock Exchange and is regulated by the SFA for the conduct of investment business in the UK.

The WHOIS query result dated 19 November 2001 (enclosed with the papers sent by Nominet to the Expert) records the following:-

Domain Name registered on 1 November 2000
Registered for: Castellomedia Ltd
Domain registered by: ACTIVEISP-NO.

There is very little information at all about the Respondent in the papers before the Expert.

The address www.commerzbank.org.uk resolves to a website hosted by active isp. It does not appear that the Respondent has an active website which uses the Domain Name.

6. **The Parties' Contentions:**

The Complainant

The Complainant's contentions in support of its request that the Domain Name be transferred are as follows:-

1. The Domain Name is identical or similar to a name or mark in which the Complainant has Rights;

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2. The Complainant is the holder of Trade Mark Certificates in Class 36 and Class 16 issued by the German Patent Authority in Munich in relation to the trade mark “Commerzbank”;
3. The Complainant registered the trade mark “Commerzbank” under Class 36 in respect of financial services and under Class 16 in respect of printed matter at the Trade Mark Registry of Great Britain and Northern Ireland;
4. The trade mark “Commerzbank” has been in use by the Complainant for a considerable period of time;
5. Registration of the Domain Name by the Respondent infringes the Complainant’s registered trade mark;
6. The registration of the Domain Name by the Respondent, at the time the registration occurred, took unfair advantage of and was unfairly detrimental to the Complainant’s Rights;
7. The Complainant has acquired considerable reputation in both the retail and investment banking markets;
8. The name “Commerzbank” is globally recognised as a key player in the retail and investment banking markets and goodwill and reputation have been established in the name “Commerzbank”;
9. The Domain Name registered by the Respondent offends the goodwill and reputation established in the “Commerzbank” mark;
10. The Domain Name is an Abusive Registration because the Respondent has offered to sell the Domain Name to the Complainant for more than the Respondent paid for it. Reliance is placed on an e-mail dated 20

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March 2001 asking the Complainant to provide the Respondent with travellers cheques to the value of US\$2,500 for a transfer of the Domain Name;

11. Repeated requests to the Respondent by the Complainant to instigate the procedures for transfer of the Domain Name to the Complainant have failed, despite the Complainant's willingness to incur the cost of any transfer fees.

The Respondent

The Respondent has not responded.

7. **Discussion and Findings:**

The Complainant is required, under paragraph 2 of the Policy, to prove to the Expert that both of the following elements are present on the balance of probabilities:-

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Paragraph 1 of the Policy defines Rights as including, but not limited to, rights enforceable under English law.

UK Trade Mark Registry

The Complainant has attached copies of various documents to the Complaint which include copies of various trade mark registration and renewal certificates that establish the following:-

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1. The Complainant is the registered proprietor of the trade mark “Commerzbank” registered at the UK Trade Marks Registry under No. 1302336 in Class 36 in respect of banking and credit services as of 27 February 1987;
2. The trade mark registration No. 1302336 in Class 36 registered in the name of the Complainant was renewed for a period of 14 years from 27 February 1994;
3. The Complainant is the registered proprietor of the trade mark “Commerzbank” registered at the UK Trade Marks Registry under No. 924366 in Class 16 in respect of office requisites (other than furniture), stationery, printed time tables, calculating tables, graphic tables and prints as of 30 April 1968;
4. The trade mark registration No. 924366 in Class 16 registered in the name of the Complainant was renewed for a period of 14 years from 30 April 1989;

German Trade Mark Registry

The Complainant also attached copies of trade mark certificates issued by the German Patent and Trade Mark Office, together with (certified copies of) English translations thereof that establish the following:-

1. The Complainant is the registered holder of the trade mark Commerzbank registered under No. 1124923 in Class 36 in respect of financial services, in particular bank and credit business on the German Patent and Trade Mark Register as of 18 July 1998. The certificate states that the protection of the trade mark will end on 31 January 2008.

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2. The Complainant is the registered holder of the trade mark Commerzbank registered under No. 510191 in Class 16 in respect of printing products on the German Patent and Trade Mark Registry as of 24 April 1939. The certificate states that the protection of the trade mark will end on 30 September 2008.

Trade marks that have been protected through registration at the UK Trade Mark Registry confer on the registered proprietor certain rights that are enforceable under English law. The Expert is satisfied, on the balance of probabilities, that by virtue of the UK registered trade marks the Complainant has Rights in respect of the name or mark “Commerzbank”.

The only difference between the Domain Name and the name in respect of which the Complainant has Rights is the addition (in the case of the Domain Name) of the .org.uk domain suffix, which is without legal significance for these purposes.

Accordingly, the Expert is satisfied that the Complainant has Rights in respect of a name or mark which is identical to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines “Abusive Registration” as meaning:-

“a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR
- (ii) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights”.

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The Policy provides (at paragraph 3a) a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

Paragraph 3(a)(i)A Submission

The Complainant contends that the Domain Name is an Abusive Registration because the Respondent has offered to sell the Domain Name to the Complainant for more than the Respondent paid for it. Under paragraph 3(a)(i)A of the Policy one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-

“circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name”.

The Complainant attached to its Complaint copies of various e-mails and a letter. The first e-mail in the sequence is from the e-mail address CastelloMedia@aol.com to the e-mail address saju.jacob@CommerzbankIB.com and is recorded as sent on 20 March 2001 at 20:50. The text of the e-mail is as follows:-

“Dear Dr. Jacob,

sorry that you have to wait some days. I have spoken with the new owners of castello media ltd.

They say it’s possible to make a fast solution for this problem.

They want to have only 2.500.-USD for their own costs. The procedure will be taken as follows:

At current time myself is the adminC and Domainregistrator at Aktive ISP. So it makes no sense to make a transkription to the new owner so I shall do it for them.

Send a document about the transkription of the domain at my postal address in Germany

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*Becker-Gundahl-StraBe24
81479 Munich.*

*with a traveller check about 2.500 USD an you will get the domain into 24
Hours to your company.*

I think this can be a good solution for both sides.

Please inform me about your decision.

For one week I stay in Malaysia an return at 28 March back to Munich.

Sincerely,

Dr. Ralph Rieder”

The e-mail was sent from the e-mail address CastelloMedia@aol.com which is the same e-mail address given as part of the contact details for the Respondent in the Nominet Domain Name register database entry for the Domain Name, a copy of which was supplied to the Expert by Nominet. The e-mail is addressed to saju.jacob and it is clear from the subsequent e-mails that Saju Jacob is (or was at the relevant time) employed in the Legal Department of the Complainant. The subject heading at the top of the e-mail expressly refers to the Domain Name. In the opinion of the Expert this e-mail amounts to an offer by the Respondent to sell or transfer the Domain Name to the Complainant for US\$2,500.

The offer was rejected by the Complainant in an e-mail dated 22 March 2001 and the Complainant suggested that the Domain Name be transferred to the Complainant by utilising the transfer procedures of Activeisp Limited, the Domain Name Registrar. In a letter dated 6 August 2001 the Complainant asked the Respondent to contact the Registrar, Activeisp, in order to put in place the necessary formalities for the transfer. The Complainant confirmed to the Respondent that it would be pleased to provide the Respondent with any reasonable assistance to effect the transfer. The Complainant repeated the contents of its letter in an e-mail to the Respondent sent on 8 August 2001. The Respondent replied by e-mail dated 9 August 2001 in a rather confused manner but did state “you know about the conditions and I will help you for the transfer”. In an e-mail sent on 14 August 2001 the Complainant confirmed that it was

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willing to pay the Respondent's costs involved in the transfer of the Domain Name to the Complainant. There is no reply to that e-mail amongst the documents supplied by the Complainant.

A number of issues arise in relation to the paragraph 3(a)(i)A submission. The first is whether the offer of US\$2,500 exceeds the Respondent's documented out-of-pocket expenses directly associated with acquiring or using the Domain Name. The e-mail dated 20 March 2001 refers to the figure of US\$2,500 as being for the Respondent's "own costs". In the absence of a Response from the Respondent the Expert considers it appropriate to infer that the only out-of-pocket costs directly associated with acquiring or using the Domain Name would be the registration fee and any subsequent renewal fees.

The Expert considers it appropriate to infer, in the absence of a Response, that the sum of US\$2,500 exceeded the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name. This is on the basis that the Respondent failed to respond positively to the offer made by the Complainant to provide any reasonable assistance to effect a transfer of the Domain Name as well as the offer by the Complainant to pay the Respondent's costs involving in achieving such a transfer.

The Expert has had regard to the decision of the expert in respect of the domain name televes.co.uk (DRS 00074) and considers that he may have regard to publicly available records (in this case an inspection of the website at www.commerzbank.org.uk and the linked website at www.activeisp.com) in reaching his Decision when such material appears likely to be relevant and he has therefore done so in this case to the extent indicated.

The website at www.commerzbank.org.uk contains a logo for activeisp which contains a hyperlink to a website at www.activeisp.com. The current fee of activeisp.com for a domain name with the suffix .org.uk is US\$35 for the first year fee

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including set up. The current fee of activeisp.com for a renewal for such a domain name is US\$29.

The Expert is of the view that the Respondent offered to sell or otherwise transfer the Domain Name to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

The issue that then arises, if the paragraph 3(a)(i)A submission is to be made out, is whether the circumstances indicate that the Respondent registered or otherwise acquired the Domain Name primarily for that purpose. The Expert has had regard to the following factors:-

1. The Domain name was registered on 1 November 2000 and the offer to sell or transfer the Domain Name was made less than 5 months later on 20 March 2001.
2. No website has been established by the Respondent using the Domain Name. The Expert notes, and has had due regard to, the fact that under paragraph 3b of the Policy failure to use the Domain Name for the purposes of a website is not itself evidence that the Domain Name is an Abusive Registration.
3. The Complainant confirmed to the Respondent that it was willing to pay the Respondent's costs involved in the transfer of the Domain Name to the Complainant. The Respondent did not reply.
4. The Complainant confirmed to the Respondent that it was willing to provide the Respondent with any reasonable assistance to effect the transfer. The Respondent failed to respond positively to this offer.
5. The Complainant was clearly using the name "Commerzbank" many years prior to the registration of the Domain Name by the Respondent.

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6. The Respondent has not responded to the Complaint and there is therefore no evidence before the Expert suggesting any intention on the part of the Respondent to acquire or use the Domain Name for any purpose set out in paragraph 4 of the Policy, which sets out a list of non-exhaustive factors which may demonstrate that the Domain Name is not an Abusive Registration.
7. In the absence of a Response from the Respondent it is difficult to see what purpose the Respondent had in registering the Domain Name which incorporates the word “Commerzbank”, other than to sell or transfer it to the Complainant, something it subsequently offered to do.

In light of the above factors the Expert is satisfied on the balance of probabilities that the Respondent registered the Domain Name primarily for the purposes of selling or otherwise transferring the Domain Name to the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket expenses directly associated with acquiring or using the Domain Name.

Other Contentions

The Complainant has raised other contentions which are that the registration of the Domain Name by the Respondent infringes the registered trade marks and offends the goodwill and reputation established in the “Commerzbank” mark. The definition of Abusive Registration is set out in paragraph 1 of the Policy. The Expert agrees that the Respondent’s registration of the Domain Name is arguably capable of being unfairly detrimental to the Complainant’s trade marks, but the Complainant has made no effort to substantiate that submission. It is noted that no evidence of the Complainant’s goodwill and reputation has been provided by the Complainant. The Expert is not prepared to hold that the Domain Name is an Abusive Registration on those grounds.

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8. Decision

The Expert finds that the Complainant has Rights in the name or mark “Commerzbank”; that the name or mark “Commerzbank” is identical to the Domain Name; and that the registration of the Domain Name in the hands of the Respondent is an Abusive Registration.

The Expert directs that the Domain Name be transferred to the Complainant.

Andrew Clinton

23 January 2002