

ADMINISTRATIVE PANEL DECISION

Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen Case No. D2013-1687

1. The Parties

The Complainant is Staatliche Porzellan-Manufaktur Meissen GmbH of Meissen, Germany, represented by LS-IP Loth & Spuhler GbR Intellectual Property Law, Germany.

The Respondent is Buy Meissen of London, United Kingdom of Great Britain and Northern Ireland.

2. The Domain Name and Registrar

The disputed domain name <buymeissen.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2013. On September 27, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 27 and October 2, 2013, 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. The Center sent an email communication to the Complainant on October 2, 2013 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 7, 2013.

The Center verified that the Complaint together with the amended Complaint (for simplicity both will hereinafter be referred to as collectively the “Complaint”, unless the specific context mandates otherwise) satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“Supplemental Rules”).

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 9, 2013. In accordance with paragraph 5(a) of the Rules, the due date for Response was originally set for October 29, 2013. Upon a request dated October 28, 2013 to the Center from the Respondent, to which the Complainant subsequently agreed, the Center extended the due date for the Response to November 7, 2013. The Response was filed with the

Center on November 7, 2013.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on November 13, 2013. 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 paragraph 7 of the Rules.

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 appears in Annex LS 1 to the Complaint) and confirmed by the Registrar, the disputed domain name was registered on October 25, 2001, and is set to expire on October 25, 2014.

A. Complainant's MEISSEN Marks

The Complainant owns trademark registrations in Germany and the European Community for various marks containing the term "Meissen" in block letters or in a stylized fashion, the latter both with and without a design element. In Annexes LS3 - LS16 to the Complaint, the Complainant has provided entries from publicly accessible databases from the German Patent and Trademark Office and the OHIM providing details on these marks. Pertinent details of some of those registrations are as follows:

1. Meissen (stylized)
German registration no.: 949873
registered: October 5, 1976

This mark is registered in international class 21 for use in connection with various porcelain products.

2. Meissen (stylized) with crossed swords design
German registration no.: 1179748
registered: August 1, 1991

This mark is registered for use in connection with: porcelain products, jewelry products and other related goods, all in international class 21.

3. Meissener Porzellan (block letters)
German registration no.: 2025676
registered: December 2, 1992

This mark is registered in international class 21 for use in connection with various porcelain products.

B. The Parties

The Complainant, based in the German town of Meissen, manufactures over 175,000 different high-quality porcelain and ceramic products, and is extremely well-known and very highly regarded in the marketplace for doing so. It traces its history to a memorial of King August the Strong of Saxony published in January 1710 who, at the beginning of the 18th Century, had commissioned a task of discovering the secret of manufacturing porcelain to Johann Friedrich Bottger. On June 6, 1710, the "Royal Saxonian Porcelain Manufactory of Meissen" (which ultimately became the Complainant) was founded at Castle Albrechtsburg in Meissen and very shortly thereafter commenced manufacturing porcelain items. With the abolishment of the German monarchy in 1918, the Complainant became the "Staatliche Porzellan Manufaktur Meissen". During the time of the former German Democratic Republic (East Germany), the Complainant's corporate form was changed to "VEB Staatliche Porzellan Manufaktur Meissen". Following the reunification of Germany, the Complainant was then incorporated as a private limited liability corporation under its present name.

Since 1722, the Complainant has continuously used the term "Meissen" together with its crossed swords design, with minimal variations over the ensuing years, as a mark on all of its products. The mark MEISSEN and that mark together with the crossed swords design are two of the oldest trademarks in the world that remain in current use.

The Complainant maintains an active web presence, using, among its 369 domain names (330 of which include the term "Meissen"; a complete list of all its names appears in Annex LS 17 to the Complaint), the domain names <meissen.de>, <meissen.com>, <meissener-porcelain.com>. The Complainant's websites receive approximately 80,000 visits per day.

The Respondent sells the Complainant's products and is a well-known expert in those products. His expertise is based on more than 30 years of buying and selling predominantly 18th and 19th century pieces of Meissen porcelain manufactured by the Complainant. His website, to which the disputed domain name had resolved, was an online resource that followed the publication of his book "The Meissen Collectors Catalogue" in 2004 by The Antiques Collectors Club (ISBN 1851494057). The book was mentioned in a number of catalogs for major auction sales, including those of Bonhams, Christies and Sotheby's. The Respondent intended his site to be an extension of his book and, by in so doing, provide a free information resource for those interested in antique Meissen pieces, whether they be novices, collectors, investors, buyers and sellers. The parties differ as to whether the Respondent sold any of the Complainant's products through his website: the Complainant alleges that the Respondent maintained an "online shop" and thus implicitly alleges that the Respondent had engaged in such commercial transactions; while the Respondent denies that any such sales occurred.

Upon receiving a letter dated March 22, 2010 from counsel for the Complainant, the Respondent in either late 2010 or during 2011 ceased operating his website. While the Respondent still possesses the disputed domain name, the disputed domain name has been inactive ever since.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark MEISSEN as the disputed domain name contains that mark in combination with the prefix "buy", where the latter fails to add any distinctiveness whatsoever to the disputed domain name sufficient to distinguish it from the mark so as to mitigate any resulting confusion of Internet users. In fact, the prefix exacerbates confusion as Internet users would likely think that the Respondent's site is a source of the Complainant's products -- when, in actuality, it is not.

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.

First, the Respondent owns no rights in the term "Meissen", nor has the Complainant licensed or otherwise authorized the Respondent to use the term as a mark or within a domain name.

Second, the Respondent, who is an individual, is not engaged in any business activities that utilize the disputed domain name nor is he commonly known by that disputed domain name.

Lastly, the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name and, to the best of the Complainant's knowledge, has never done so.

(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.

First, given the longevity and renown of the mark MEISSEN, the Respondent was well aware of that mark when he registered the disputed domain name. Moreover, as the Respondent's website through which the disputed domain name resolves has been and continues to be inactive, the Respondent is passive holding the disputed domain name, thus evincing bad faith.

Second, the disputed domain name falsely suggests that a relationship exists between the parties or that the Complainant has endorsed the website of the Respondent when, in fact, it has not. Accordingly, the Respondent, when its website was operational and should it return to operation, was and would be intentionally attempting to attract Internet users to his own site for commercial gain by creating a likelihood of confusion between his site and the Complainant's mark. By so doing, the Respondent did and would attract and divert web traffic from the Complainant to the Respondent's business and exploit the goodwill of the Complainant and its marks to the Respondent's own benefit.

B. Respondent

The Respondent contends that he has rights and legitimate interests in the disputed domain name because he did not sell any of the Complainant's porcelain products through his website and only operated the website as a free information resource. In that regard, the Respondent, who is a recognized expert with over 30 years of experience in buying and selling predominantly 18th and 19th century pieces manufactured by the Complainant, established the website as an extension of his book entitled "The Meissen Collectors Catalogue". The site was directed to novices, collectors, investors, buyers and sellers who saw it as a safe online environment through which they could freely acquire pertinent information about antique Meissen-branded porcelain objects.

The Respondent acknowledges that, as a result of legal advice he obtained in response to a letter he received from counsel for the Complainant, he took his website down in either late 2010 or during 2011, and has not operated it since then.

The Respondent also asserts that the mark MEISSEN is generic inasmuch as it is the name of a city in the German state of Saxony and thus implicitly is incapable of functioning as a trademark.

6. Discussion and Findings

A. Identical or Confusingly Similar

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

From a simple comparison of the disputed domain name to the Complainant's mark MEISSEN, no doubt exists that the disputed domain name is confusingly similar to the Complainant's marks. The primary difference between the disputed domain name and the mark MEISSEN is prepending the term "buy" to form a separate corresponding composite term "buymeissen" along with, secondarily, appending the generic Top-Level Domain (gTLD) ".com" to that term to form the disputed domain name, with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly

descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding the word “buy”, in the manner which the Respondent specifically did, to the mark MEISSEN clearly resulted in such a minor variation. See, e.g., *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. 117876.

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

Though the Respondent raises an issue as to whether the Complainant’s mark MEISSEN is generic given that the term “Meissen” is a geographic descriptor, *i.e.*, the name of a town in Germany, that issue is well beyond the competence of any UDRP panel and, as such, is one best left to the determination of the associated national/regional trademark offices which registered the mark and other appropriate national tribunals that have proper jurisdiction over such issues. Accordingly, the Panel will not opine on this issue.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

Currently, the Respondent does not use the disputed domain name and has not used the disputed domain name since at least sometime during 2011. As such, it is immaterial that the Respondent here had previously used the disputed domain name. For purposes of ascertaining the existence of rights or legitimate interests under paragraph 4(a)(ii) of the Policy, the Panel does not assess the disputed domain name against a prior, active use that has long since been discontinued, but rather in view of the nature and duration of its current use; the latter here being a multi-year period of non-use.

As to rights or legitimate interests, the Complainant has never authorized the Respondent to utilize any of the MEISSEN marks nor does the Complainant apparently have any relationship or association whatsoever

with the Respondent. Furthermore, given the exclusive trademark rights that reside in the Complainant, the Respondent could not legitimately acquire any public association between himself and the mark MEISSEN or even any mark similar thereto, at least for the goods provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark MEISSEN. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to the early 18th century. Needless to say, these rights and the Complainant's reputation substantially predate October 25, 2001 when the Respondent registered the disputed domain name. See, e.g., *Forideas, National Westminster, Tommy Bahama, Amy Stran, Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations, MySpace and Treeforms*, all cited *supra*; and *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, as the Respondent's website has not been operational since no later than 2011, that non-use does not constitute a legitimate noncommercial or fair use within the ambit of paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

There can be no question whatsoever that the Respondent was well aware of the Complainant and its mark MEISSEN when the Respondent registered the disputed domain name. Not only did the Complainant exist for approximately 280 years prior to the October 25, 2001 date on which the Respondent registered the disputed domain name, but by the Respondent's own admission he is an expert on the Complainant's 18th and 19th century porcelain products and has been so for at least the prior 30 years -- thus including some 18 years prior to the date on which he registered the domain name (now approximately 12 years ago).

Since at least sometime during 2011, the Respondent has not operated his website to which the disputed domain name resolved and hence has passively held the name ever since. Furthermore, there is no evidence in the record to conclude that the Respondent's use prior to 2011 was a legitimate noncommercial or fair use of the disputed domain name.

Consequently, under the facts here, the Panel views the Respondent's prior knowledge of the Complainant and its mark, the Respondent taking his website down after a letter from counsel for the Complainant which was followed by the Respondent having passively held the name for multiple years continuing to the present as constituting bad faith use and registration. See, e.g., *General Motors; National Football League and Cheesecake Factory*, all cited *supra*; also *Intelligent Medical Objects, Inc. v. Domains by Proxy, Inc. / Atif Zafar*, WIPO Case No. D2009-1342; *Bayer Aktiengesellschaft v. H. Monssen*, WIPO Case No. D2003-0275; *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758; *America Online, Inc. v. Curtis Woods*, WIPO Case No. D2001-0555; *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. D2001-0210; *402 Shoes, Inc. d/b/a Trashy Lingerie v. Jack Weinstock and Whispers Lingerie*, WIPO Case No. D2000-1223; *Liberty Public Limited Company v. Thomas Guarrera*, NAF Claim No. FA 95103; *V&S Vin & Sprit Aktiebolag v. Gunnar Hedenlans Peev*, NAF Claim No. FA 95078; *Revlon Consumer Products Corporation v. Yoram Yosef aka Joe Goldman*, WIPO Case No. D2000-0468; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; and

Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown d/b/a Big Daddy's Antiques,
WIPO Case No. D2000-0004.

Hence, the Panel concludes that the Respondent violated the general bad faith provision of paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <buymeissen.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: November 27, 2013