

DISPUTE RESOLUTION SERVICE

D00014977

Decision of Independent Expert

Staatliche Porzellan-Manufaktur Meissen GmbH

and

Mark Rowswell

1. The Parties:

Complainant: Staatliche Porzellan-Manufaktur Meissen GmbH
Talstr. 9
Meißen 01662
Germany

Respondent: Mr Mark Rowswell
800 Rene-Levesque Blvd
Montreal QC
H3B 1Y8
Canada

2. The Domain Name:

meissen.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

31 October 2014 14:58 Dispute received
03 November 2014 11:22 Complaint validated
03 November 2014 11:31 Notification of complaint sent to parties
20 November 2014 01:30 Response reminder sent
25 November 2014 08:35 No Response Received
25 November 2014 08:35 Notification of no response sent to parties
02 December 2014 16:37 Expert decision payment received

4. Factual Background

4.1 The Complainant is a German based corporation which manufactures porcelain under the brand Meissen. Its predecessors commenced manufacture of porcelain as long ago as 1710. It owns numerous registered trademarks either for or including the word Meissen. These include for example:

Stylised German registered trademark MEISSEN with Registration Number 949873 registered on 5 October 1976 with a priority of 3 June 1972 for porcelain products of all kinds in classes 21, 11, 14, 19, 20 and 34:

Community trade mark for the word MEISSEN registration number 3743663 dated 1 April 2004, registered on 16 June 2006 for in particular porcelain wares in classes 11, 14 and 21;

Community trademark number 007533862 for MEISSEN-SHOP which *inter alia* covers goods in classes 11, 14 and 21 (registered on 19 January 2009);

There are more such registered trademarks listed in the Complaint which cover a variety of different marks, including or referring to the word Meissen.

4.2 The Complainant has registered and used the domain names meissen.ge; meissen.com as well as meissener-porcelain.com and meissen-manufaktur.com. In total it owns 450 domains, of which 395 include the element "meissen". The Complainant obtained an interim injunction at the District Court of Cologne to prohibit a company called Von Meissen Ltd from using www.vonmeissen.com and/or Von Meissen in connection with the sale of porcelain goods on 18 May 2010.

4.3 The Complainant has successfully conducted *inter alia* seven administrative domain name dispute proceedings before the WIPO Arbitration and Mediation Centre relating to the name Meissen between 2013 and 2014. It was successful in obtaining transfer of the various disputed domain names (which all included the word Meissen) in these cases.

The Respondent

4.4 The Respondent registered the Domain Name on 17 February 2011. It chose not to file a response to the Complaint. It currently has no online presence or active website at the Domain Name. The website to which the Domain Name resolved showed advertising links to various manufacturers of porcelain as at 30 October 2014.

5. Parties' Contentions

The Complainant

5.1 The Complainant asserts as follows:

It is the oldest and most famous manufacturer of porcelain in the world and started to manufacture porcelain on 6 June 1710 at the "Royal Saxonian Porcelain Manufactory of Meissen" and its porcelain very soon became well known all over the world. It became the "Staatliche Porzellanur Manufaktur Meissen" in 1918 and after the reunification of Germany was incorporated as a private limited company under its present name. Ever since the 18th century it has enjoyed a famous reputation with regard to porcelain and ceramics. Its porcelain is only and exclusively made in its factory by especially trained craftsmen. It is able to produce more than 175,000 different porcelain products all of which have been exclusively designed by and for the Complainant which makes its product line unique in the world.

5.2 Since the beginning of its activities the designation Meissen has been continuously used as the name of its factory. Further the name Meissen together with the "crossed swords" symbol have been used by it to mark all of its products since 1722. These signs soon became a synonym for the highest art of porcelain all over the world. These marks are two of the oldest known trademarks in the world, having been used for more than 275 years.

5.3 It refers to numerous various registered trade marks as mentioned above. Meissen is used by it in all of its advertising activities in print and other media and in particular every major national and international market. It has an active presence on the Internet using some of the domain names mentioned above which are in its name, and on an average basis more than 80,000 visits are registered daily on its Internet website.

5.4 It asserts that Meissen must be regarded as a well-known and famous trademark. It also refers to various public opinion polls conducted for it in 2003 and 2011. These, it says, demonstrated the notoriety of its trademark Meissen which was demonstrated to have significance for the vast majority of all consumers as being associated with the product porcelain. It has produced copies of the results of these public opinion polls in the German language and

has offered to provide an English translation if directions are given to that effect. The Expert does not consider it necessary to have these translations produced as she considers that sight of these would make no difference to her decision.

5.5 The Complainant further asserts that the notoriety of Meissen has been acknowledged by several Court decisions including *inter alia* by the German Federal Supreme Court, and refers to the above legal proceedings in the District Court of Cologne as well as the successful WIPO complaints.

Abusive Registration

5.6 The Complainant asserts that it is obvious that the Respondent is aware of its lack of entitlement to use the Domain Name and is trying to use the goodwill of the Complainant's marks to attract customers to its website. It asserts that there is a likelihood of confusion on the part of the relevant public as users and trade circles facing the Domain Name will automatically be led to expect that it forms part of the Complainant's trademark and domain family. This is because of the high degree of recognition of Meissen in favour of the Complainant.

5.7 It asserts that its name and trademark Meissen is included identically in the Domain Name. The only difference is the suffix .co.uk which it states is a purely technical necessity and only constitutes an irrelevant distinction which does not influence the likelihood of confusion. Furthermore it asserts that the relevant part of the Domain Name is clearly Meissen which is itself clearly distinctive.

5.8 Furthermore the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name. It owns no rights in the indication Meissen and the Claimant has not licensed or otherwise permitted it to use this trademark or apply for the Domain Name. To the best of the Complainant's knowledge the Respondent has not engaged in any business activities that utilise the Domain Name, nor is it commonly known by it. It also alleges that the Respondent is not making any legitimate non-commercial or fair use of the Domain Name and according to its knowledge has never done so.

5.9 It also alleges that the Domain Name was registered and is being used in bad faith. The main grounds for this are that Meissen is a famous mark and as such it seems impossible to conceive of any circumstances in which the Respondent could legitimately use the Domain Name. It has intentionally attracted internet users to its site for commercial gain using the Domain Name by creating confusion with the Complainant's mark.

Response

As above the Respondent chose to file no Response.

6. Discussions and Findings

General

6.1 Under paragraph 2(a) of the Policy in order for the Expert to order a transfer of the Domain Name the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- (i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) The Domain Name in the hands of the Respondent, is an Abusive Registration”

Complainant's Rights

6.2 The Policy defines Rights as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.”

6.3 The Complainant has numerous registered trademarks in Germany and in Europe for the word Meissen or which include that word as an important element of them. These are registered rights which are enforceable by the Complainant under German Law and in the various other jurisdictions for which they are registered.

6.4 The Complainant and his predecessors have been trading under and using the name Meissen since the early 18th Century. The Complainant cites and produces a copy of at least one Court Decision in Germany mentioned above which suggests that the Court recognised it has enforceable trademark rights in the word Meissen.

6.5 The name Meissen has been used as a trademark to designate its goods by the Complainant for such a long time and to such an extent that in the Expert's view it has acquired secondary meaning.

6.6 In the expert's view the evidence submitted by the Complainant strongly supports it having Rights in the name or mark Meissen. That mark is to all intents and purposes identical to the Domain Name given that it is appropriate to discount the “.co.uk” suffix in these circumstances.

6.7 As a result the Expert concludes that Paragraph 2(a) (i) of the Policy is satisfied and accordingly finds that the Complainant has Rights in respect of a name which is identical to the Domain Name.

Abusive Registration

6.8 The term 'Abusive Registration' in paragraph 2(a) (ii) of the Policy is defined in Paragraph 1 of the Policy to mean a Domain Name which:

- "(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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

6.9 The screenshot of the Respondent's website on 30 October 2014 shows that it contained advertising links to various different manufacturers of porcelain. This amounts in the Expert's view to creating a false implication that there is a commercial connection with the Complainant. Furthermore the links include links to competitive goods of the Complainant.

6.10 The Respondent registered the Domain Name on 17 February 2011. At that time the Complainant's Rights were already very well established in the name Meissen and in the Expert's view the mark Meissen was and is well-known and famous. The Respondent has chosen not to file a Response or put forward any legitimate reason, for example, for registering the name of the German town Meissen as a domain name. Accordingly, on the balance of probabilities, the Expert finds that the Respondent would have had the Complainant in mind and been aware of the existence of the Complainant's mark and of its particular area of business at the time of the registration of the Domain Name.

6.11 Accordingly in all these circumstances the Expert considers that the Respondent registered the Domain Name deliberately in order to trade on the back of the goodwill of the Complainant's mark Meissen. This would result from the pay per click advertising revenue that the Respondent would receive from the website at the Domain Name.

6.12 The Expert also accepts that the Complainant's mark is so well-known that it is inevitable that Internet users and potential customers of the Complainant's product will automatically assume that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Internet users looking for the Complainant when they end up on the Respondent's website may realise that they are on the wrong website but still click on one of the links to other sellers of products similar to those marketed by the Complainant.

6.13 The Expert has already found above that the Respondent had prior knowledge of the Complainant and its Rights at the time of registration of the Disputed Domain Name. In addition there are no obvious reasons which support the Domain Name not being an Abusive Registration.

6.14 The Expert thus finds on the balance of probabilities that the Domain Name was registered and has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

7. Decision

7.1 The Expert finds that the Complainant has Rights in a name which is similar or identical to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive registration.

7.2 The Complaint is upheld and the Expert directs that the Domain Name be transferred to the Complainant.

Signed G. GASSIE

Dated 22/12/2014