

ADMINISTRATIVE PANEL DECISION

Fresenius Kabi S.A. v. Domain Manager, EWEB Development, Inc.
Case No. D2018-0491

1. The Parties

The Complainant is Fresenius Kabi S.A. of Barcelona, Spain, represented by Ribas y Asociados, Spain.

The Respondent is Domain Manager, EWEB Development, Inc. of Richmond, British Columbia, Canada, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <nutrihome.com> is registered with Alpine Domains Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 5, 2018. On March 5, 2018, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 2018, 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. In response to a request of clarification by the Center, the Complainant filed an amendment to the Complaint on March 7, 2018.

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” or “UDRP”), 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 8, 2018. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2018. On March 18, 2018, the Respondent requested an extension to file a Response. On March 19, 2018, the Center granted the automatic 4-day Response extension until April 1, 2018. The Response was filed with the Center April 1, 2018. The Respondent filed an amended Response on April 5, 2018.

The Center appointed Steven A. Maier, Roberto Bianchi and Diane Cabell as panelists in this matter on May 15, 2018. The Panel finds that it was properly constituted. Each member of 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 a company which provides clinical nutritional support services to patients at home. It submits limited information concerning its business activities, but appears to operate principally in Argentina and in Spain.

According to the Complaint, the Complainant is (or has been) the owner of the following trademark registrations:

- Argentina trademark registration number 1729168 for the word mark NUTRI-HOME, registered on April 6, 1999 in Class 42¹
- Spain trademark registration number 3553182 for a combined mark NUTRIHOME NUTRICIÓN CLÍNICA DOMICILIARIA, comprising the stylized terms “nutri” and “home” together, with the addition of the words “Nutrición Clínica Domiciliaria”, registered on July 8, 2015 in Classes 5 and 44
- A further trademark registration for the stylized mark NUTRIHOME BY FRESENIUS KABI, of which the Complainant provides an image but no further details.

The Respondent is a company located in Canada. It offers web development and branding services including the sale of Internet domain names.

The Respondent registered the disputed domain name on August 22, 2009.

The disputed domain name has resolved to a website at “www.nutrihome.com”, indicating that the name is “ready for development” and offering a form for contact “to check availability for ownership, customer use, partnership or other development opportunities.”

5. Parties’ Contentions

A. Complainant

The Complainant refers to the trademarks mentioned above and to websites which it operates at “www.nutrihome.es” and at “www.nutrihome.com.ar”.

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademarks comprising or including the terms NUTRI-HOME and NUTRIHOME.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has no trademark rights or other title to that name.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. The Complainant contends that there is a presumption of bad faith in circumstances where a registrant does not have rights or legitimate interests in the domain name in question. The Complainant further contends that the Respondent registered the disputed domain name with the sole intention of selling it and that its interest in the disputed domain name is purely speculative. The Complainant exhibits correspondence dated between July and September 2017 in which it contacted the Respondent to enquire about the disputed

¹ This trademark registration appears to the Panel to have expired on April 6, 2009, although it also appears from the Panel’s own enquiries that the Complainant registered similar trademarks in Argentina on April 1, 2009 in Classes 42 and 44.

domain name (although without disclosing its corporate identity) and was quoted a single-payment price of USD 19,750 by the Respondent.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent denies that it registered the disputed domain name in the knowledge of, or by reference to, the Complainant's trademarks.

The Respondent states that its business includes the lawful registration of non-infringing Internet domain names, including those which are descriptive in nature. It states that it registered the disputed domain name in 2009 because it was an attractive combination of the term "nutri", being a short-form prefix for nutrition, with the dictionary word "home". It states that it is also the registrant of numerous other domain names including the term "nutri", such as <nutri-shop.com> (registered in 2007), <nutrisuccess.com> (registered in 2008) and <nutriconcept.com> (registered in 2009). The Respondent states that it expected the disputed domain name to be of interest to a potential customer in the field of nutrition, looking to establish an online presence.

The Respondent denies that the prefix "nutri" is exclusively associated with the Complainant and provides evidence of numerous other uses of this term in business by parties other than the Complainant, including "Nutrisystem", "Nutri-health" and "Nutri-supplements". The Respondent also provides examples of trademark registrations by parties other than the Complainant, including (among others) Cypriot trademark NUTRIHOME registered in 2003 for bleaching preparations, German trademark NUTRIHOME registered in 1995 for outpatient and nutritional care, and Brazilian trademark NUTRIHOME registered in 2012 for feeding stuffs and related services. The Respondent refers additionally to Internet domain names operated by parties other than the Complainant, including <nutrihome.it>, <nutrihome.com.au> and <nutrihome.pt>.

With regard to its knowledge or otherwise of the Complainant's trademark, the Respondent submits that, at the date of registration of the disputed domain name, *i.e.* 2009, the Complainant's trademarks had no reputation outside Argentina and certainly none in Canada. The Respondent contends that the Complainant has provided no information about its services or where they were offered and no evidence of any advertising or marketing spend or sales volumes at the relevant time. The Respondent also points out that the Complainant only acquired its Spanish trademark, which is itself a design mark, in 2015.

The Respondent also denies that the Complainant operated the websites to which it has referred at material times. The Respondent provides evidence from "www.archive.org" that there was no active website at the URL "www.nutrihome.com.ar" between 2005 and a date in mid-2009, or between a date in early 2010 and a date in mid-2015. It also alleges that the domain name <nutrihome.com.ar> was re-registered by the Complainant in 2013 after several years of non-use. With regard to the domain name <nutrihome.es>, the Respondent submits that this domain name was only registered in 2017.

The Respondent reiterates in all the circumstances that it was not targeting the Complainant's trademark when it registered the disputed domain name in 2009 and says that Complainant has provided no evidence that it did so. It adds that, had it indeed been targeting the Complainant's (then only) trademark NUTRI-HOME, it would surely have registered the domain name <nutri-home.com> as opposed to the disputed domain name.

The Respondent submits that the Complainant misrepresented itself when it approached the Respondent about the disputed domain name, because it denied owning any trademarks similar to the disputed domain name. The Respondent states that this represented a breach of the Respondent's published terms and conditions, which state that any breach of those terms shall be deemed to be reverse domain name hijacking. The Respondent seeks a finding of reverse domain name hijacking accordingly. It further alleges that the Complainant knew the Respondent had legitimate rights in respect of the disputed domain name and brought this proceeding only because it was unhappy with the price quoted by the Respondent.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

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

A. Identical or Confusingly Similar

The Panel is satisfied that Complainant has registered trademark rights in the mark NUTRI-HOME in Argentina and in stylized marks in Spain which contain the elements NUTRI and HOME together. In the view of the Panel, neither the hyphen in the Argentinian trademark nor the stylized elements of the Spanish trademarks is sufficient to distinguish the disputed domain name <nutrihome.com> from the Complainant's trademarks (it being immaterial for the purpose of the present comparison that the Spanish trademarks were registered after the disputed domain name). The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the disputed domain name is effectively the same as some of the Complainant's trademarks, the Panel is not of the view that the names "nutri-home" or "nutrihome" can be regarded as associated exclusively with the Complainant in the minds of consumers. As much is clear from the numerous examples provided by the Respondent of the use of these or similar names as business names, trademarks and domain names by parties other than the Complainant.

The Respondent is in the business of *inter alia* trading in domain names and claims to have registered the disputed domain name, combining the commonplace prefix "nutri-" with the dictionary word "home", as being of potential interest to customers wishing to offering nutrition-related services online. It provides evidence of other "nutri-" related domain names that it registered in the same year as the disputed domain name or in the preceding two years.

The Panel accepts that, where a party legitimately registers a domain name comprising commonplace or dictionary elements nature for sale, without intent to target the trademark of an existing trademark owner, then that offer for sale can give rise to rights or legitimate interests in the domain name as a *bona fide* offering for the purposes of paragraph 4(c)(i) of the Policy (see *e.g. Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016; and *Voys B.V., Voys United B.V. v. Thomas Zou*, WIPO Case No. D2017-2136). The question in this case, therefore, is whether the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and with the intention of taking unfair advantage of the goodwill attaching to that trademark, or legitimately in the circumstances described above.

Based on the parties' submissions in this case, the Panel can find no evidence upon which to conclude that the Respondent was aware of the Complainant's Argentinian trademark NUTRI-HOME at the date it registered the disputed domain name (being the Complainant's only registered trademark at that date) or that it registered the disputed domain name with the intention of taking unfair advantage of that trademark. The Complainant has provided little or no evidence of its business activities and public profile in 2009 and (while there was a brief period prior to August 2009 during which its website at "www.nutrihome.com.ar" appears to have been active) it has adduced no evidence that the Respondent was in fact aware of its trademark, or identified circumstances from which to infer that it must have been so aware. On the contrary, the Panel finds the Respondent's explanation for its choice of the disputed domain name to be credible, and concludes therefore that the Respondent has rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

In the light of the Panel's findings in respect of rights or legitimate interests, the question of registration and use in bad faith does not technically require to be considered. However, the Panel notes for completeness that, for the same reasons as set out above, it would not find that the disputed domain name was registered or has been used in bad faith.

7. Reverse Domain Name Hijacking

According to paragraph 15(e) of the Rules:

"If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

The Panel rejects the Respondent's submission that the Complainant's approach to the Respondent concerning the possibility of purchasing the disputed domain name should give rise to a finding of bad faith. In particular, the Panel considers it commercially reasonable both that the Complainant should investigate the possibility of purchasing the disputed domain name before incurring the costs of proceedings under the UDRP and that it should avoid disclosing any existing connection with a name similar to the disputed domain name. The Panel is not, of course, bound by what is stated in the Respondent's terms and conditions.

The Panel does, however, find this claim to be speculative and considers that the Complainant lacked reasonable grounds for contending that the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and with the intention of taking unfair advantage of that mark. The Panel also notes that the Complainant is legally represented. That said, the Panel considers on balance that this proceeding was misguided rather than dishonest and the Panel therefore declines to make a finding of reverse domain name hijacking.

8. Decision

For the foregoing reasons, the Complaint is denied.

Steven A. Maier
Presiding Panelist

Roberto Bianchi
Panelist

Diane Cabell
Panelist
Date: May 24, 2018