

ADMINISTRATIVE PANEL DECISION

Boller, Winkler AG v. Craig Schlossberg, Image Info, LLC
Case No. D2022-2222

1. The Parties

The Complainant is Boller, Winkler AG, Switzerland, represented by Wild Schnyder AG, Switzerland.

The Respondent is Craig Schlossberg, Image Info, LLC, United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, PC, United States.

2. The Domain Name and Registrar

The disputed domain name <schlossberg.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 17, 2022. On June 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 2022, 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.

The Center verified that 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 June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. The Response was filed with the Center on July 15, 2022.

The Center appointed John Swinson as the sole panelist in this matter on July 26, 2022. 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

The Complainant is a Swiss stock corporation. The Complainant is a Swiss company producing and selling textiles for bath and bed and related goods. The Complainant's goods are sold worldwide.

The Complainant owns trademark registrations for SCHLOSSBERG, including Swiss mark CH P-365 027 (registered on July 27, 1988) and United States Registration No. 3268631 (filed on September 18, 2006 and registered on July 24, 2007).

The Respondent is a company that was founded in 2004 by Craig Schlossberg of Brooklyn, New York. Mr. Schlossberg has used this company for over 15 years to provide personal consulting services. Mr. Schlossberg works in the tech and fashion industries in New York.

Mr. Schlossberg is also the "tech name" and the "admin name" for the disputed domain name as published in the Whois records for the disputed domain name. Mr. Schlossberg is the sole member of the Respondent.

The disputed domain name was registered by Mr. Schlossberg on February 6, 1996.

The disputed domain name resolves to a registrar generated "Under Construction" webpage. There is no evidence that the disputed domain name has been used by the Respondent.

The Complainant contacted Mr. Schlossberg in 2018 with the aim of buying the disputed domain name, knowing that the disputed domain name corresponded to Mr. Schlossberg's name. The Complainant wrote: "The correspondence of a domain with a family name is always a cause for discussion. Therefore, we would like to make a fair offer right from the beginning". The Complainant offered USD 1,500 as the purchase price. This offer was not accepted.

5. Parties' Contentions

A. Complainant

The Complaint is not detailed. The Complainant submits the following:

The Complainant owns registered trademarks for SCHLOSSBERG including the registrations listed above in section 4.

The Respondent is not using the disputed domain name.

The Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name. The Complainant contends that the disputed domain name has resolved to an advertising/placeholder website for decades but also claims that it resolves to a blank page. Even if the Respondent's family name corresponds with the disputed domain name, he has no legitimate interest after all these years of lack of use.

The Complainant's complete submission in respect of bad faith registration and use is as follows:

"Respondent has never hosted any content of the website. For years the domain is a mere blank site. This lets assume that the domain name was registered mainly to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, given that the Respondent has failed to respond to any of the several contact and buy attempts of the owner."

B. Respondent

The Respondent filed a detailed Response. In summary, the Respondent made the following submissions in respect of the second and third elements of the Policy:

The Policy makes it clear that a registrant has legitimate rights in a domain registration if the respondent is commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights in their name. When a respondent is commonly known by a name corresponding to the disputed domain name, that constitutes *prima facie* support for a finding of rights or legitimate interests under the Policy.

The Complainant concedes that the Respondent is named Schlossberg. The Complainant reached out by email to the Respondent, identifying the Respondent by his surname and acknowledged in an August 2018 email that the disputed domain name corresponds to the Respondent's family surname.

In 2004, Mr. Schlossberg founded the Respondent. Mr. Schlossberg is the sole member of the Respondent.

The Respondent has been providing consulting and other services under his name since prior to the registration of the disputed domain name.

Through the Respondent, Mr. Schlossberg has provided personal consulting services, and intends to do so upon termination of an existing non-compete agreement.

Where the surname of the Administrative and Technical contact shown in the WhoIs records is identical to the disputed domain name, this is sufficient proof to demonstrate the Respondent's legitimate interest in the disputed domain name.

The Respondent was unaware of the Complainant's company, products, or foreign trademark registrations at the time he first registered the disputed domain name and thus could not have possibly had the requisite bad faith required by the Policy.

The Complainant offers no evidence that its name was or should have been known to the Respondent. In 1996, at that time the disputed domain name was registered, the Complainant owned just one Swiss trademark registration. The Complaint does not include any assertion or proof that the SCHLOSSBERG trademark was in use by the Complainant in the United States or elsewhere at the time the disputed domain name was registered. Furthermore, the Complainant does not claim that its goods bearing the SCHLOSSBERG trademark were being marketed or sold in the United States at the time the disputed domain name was first registered, or that the Complainant had developed any goodwill in the SCHLOSSBERG trademark as of the registration date of the disputed domain name.

The Complainant had not yet launched its corporate website at <schlossberg.ch> at the time the Respondent first registered the disputed domain name.

There is no evidence to suggest that the Respondent's registration of the disputed domain name is intended to trade upon the Complainant's reputation in any manner. The disputed domain name has not been used by the Respondent to target nor is it intended to target the Complainant in any way. Indeed, there is no evidence that the disputed domain name was or will be used to promote bedding or linens, the products offered by the Complainant under the SCHLOSSBERG trademark.

The Respondent also has not sought to sell the disputed domain name to the Complainant or any other party.

Passive holding alone, without additional evidence, is an insufficient basis for finding that a domain was registered or used in bad faith.

The Respondent also made detailed submissions regarding Reverse Domain Name Hijacking.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for SCHLOSSBERG. The disputed domain is identical to the Complainant's trademark.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

The Respondent relies on paragraph 4(c)(ii). The Respondent has provided evidence that that Mr. Schlossberg has had this name since birth, and that his parents also had this surname when he was born.

Mr. Schlossberg states in a signed declaration that he has tried to change the ownership of the disputed domain name into his personal name, but received error messages from the Registrar.

According to the Respondent, since its creation in 1996, the disputed domain name has been registered by Mr Schlossberg or through one of his companies. Mr Schlossberg has always been clearly identified as the Registrant and/or the Administrative and Technical Contact for the disputed domain name in publicly available Whois records. There is no evidence that a privacy shield has ever been used in respect of the disputed domain name.

The Panel finds that Mr Schlossberg is the founder, controlling mind and owner of the named Respondent. Compare *Perfetti Van Melle S.p.A. v. Pi-Effe S.a.s.*, WIPO Case No. [D2003-0067](#), where the disputed domain name in that case was identical to the surname of an 80% owner of the Respondent.

The Respondent's owner has been commonly known by the disputed domain name, and in the present case, this is sufficient for the Respondent to demonstrate the Respondent has rights or legitimate interests in the disputed domain name.

The Complainant fails on the second element of the Policy.

C. Registered and Used in Bad Faith

Because the Complainant fails on the second element of the Policy, there is no requirement for the Panel to consider the third element of the Policy. However, the Panel will briefly do so.

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

The Respondent registered the disputed domain name because it was Mr. Schlossberg's name. At the time of first registration, Mr. Schlossberg had not heard of the Complainant. This is believable. The Complainant's United States trademark registration was not filed until 10 years after Mr Schlossberg registered the disputed domain name. There is no evidence that the Complainant was trading in the United States in 1996 when Mr. Schlossberg registered the disputed domain name. In short, there is no evidence that the disputed domain name was registered to trade off the reputation of the Complainant or its trademark.

The disputed domain name has not been used. Therefore, there is no evidence of bad faith use of the disputed domain name by the Respondent. The Complainant does not argue passive holding amounting to bad faith under the *Nuclear Marshmallows* doctrine (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)); nor do the facts in this dispute support a finding of passive holding amounting to bad faith. See, for example, the discussion regarding pass holding in *Kelin S.r.l. v. Privacy Service provided by Withheld for Privacy ehf / Vincent Cammarata*, WIPO Case No. [D2022-0746](#).

The Complainant's argument regarding bad faith is that the Respondent has held the disputed domain name for a long time without using it, and that this is evidence that the Respondent registered the disputed domain name to prevent the Complainant from registering the disputed domain name. At best, this argument is weak, and is not supported by the facts of this dispute.

The Complainant fails on the third element of the Policy.

7. Reverse Domain Name Hijacking

The Respondent asks that a finding of Reverse Domain Name Hijacking (“RDNH”) be made against the Complainant.

Under the Rules, RDNH is defined as “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

The Panel finds that this is a clear case of RDNH.

The Complainant tried to buy the disputed domain name from the Respondent, and was unsuccessful. At that time, the Complainant knew the weakness of its position because the disputed domain name corresponded to Mr. Schlossberg’s name.

The Complainant, who was represented by a specialist intellectual property law firm, filed a Complaint that did not address the Policy, offered little evidence to support the assertions made in the Complainant, and did not cite a single prior decision under the Policy to support the Complainant’s position.

The Complainant did not disclose relevant correspondence, which was helpfully provided by the Respondent. Even worse, the Complainant stated that “the Respondent has failed to respond to any of the several contact and buy attempts of the owner”. This statement is not supported by the evidence and is at least partly untrue.

Before filing the Complaint, the Complainant was aware or should have been aware of the extreme weakness of its case. If it was not, then it was made aware of the problems with its case in a letter from the Respondent’s attorneys of June 30, 2022, inviting the Complainant to withdraw its Complaint. The Complainant did not do so, putting the Respondent to the expense of preparing a Response.

The Complainant’s conduct in this case was woeful. The Complainant attempted to use the Policy in bad faith to deprive a long-standing domain name holder of its domain name.

8. Decision

For the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: August 9, 2022