



## ADMINISTRATIVE PANEL DECISION

### Kristallglasfabrik Spiegelau GmbH v Spiegelau Australia Pty Ltd

#### 1. THE PARTIES

- 1.1 The complainant is Kristallglasfabrik Spiegelau GmbH C/- Mallon & Co Lawyers, 1 William Street, Perth WA 6000 (**Complainant**).
- 1.2 The respondent is Spiegelau Australia Pty Ltd of PO Box 7131, Shenton Park WA 6000 (**Respondent**).

#### 2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name is <spiegelau.com.au> (**Domain Name**). The registrar is Connect West.

#### 3. PROCEDURAL HISTORY

- (a) The complaint was submitted for decision in accordance with the auDRP Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
- (b) The complete application was received from the Complainant by LEADR on 7 July 2006.
- (c) On 5 July 2006, the Complainant sent a copy of the application to the Respondent.
- (d) On 12 July 2006 LEADR contacted the Respondent via phone and email and confirmed that the application had been received on 12 July 2006. The email sent to the Respondent subsequent to a telephone conversation, contained a copy of the Complaint without the annexures.
- (e) On 7 July 2006 LEADR sent the Respondent a dispute notification letter and a copy of the application by express post.
- (f) A copy of the application and a copy of the dispute notification letter were also posted to the registrar Connect West on 7 July 2006. The Registrar confirmed that the website was locked on 11 July 2006.

- (g) LEADR advised auDA of the complaint on 7 July 2006 via email.
- (h) On 7 July 2006 the provider approached the Panelist. The Panelist confirmed her availability, informed LEADR that there were no conflict issues with the parties and accepted the matter on 7 July 2006.
- (i) The response was due on 31 July 2006. An extension of time to 7 August 2006 was granted pursuant to s5(d) of the auDA Dispute Resolution Policy. The Response was received via email on 4 August 2006 and via post on 7 August 2006.
- (j) The Panelist was informed on 8 August 2006 that the package was being sent for Adjudication.
- (l) On 14 August 2006, the Complainant notified LEADR in writing of its objection to the extension of time granted to the Respondent under Rule 5 of the auDRP Rules on the grounds that the Respondent had not demonstrated the extension was required due to exceptional circumstances. LEADR has provided a copy of this correspondence to the Panelist as requested by the Complainant.
- (m) On 22 August 2006, the Complainant forwarded to LEADR further submissions in respect of the response received and the extension of time granted the Respondent, and requested that this be considered by the Panelist. An extension of time for the decision was granted under Rule 10(c) of the auDRP Rules.
- (o) Rule 10(b) of the auDRP Rules states that the Panelist will ensure that the parties to a dispute are treated equally and that each party is given a fair opportunity to present its case.
- (p) Rule 10(c) of the auDRP Rules further grants the Panelist unilateral power to extend the period of time fixed by the Rules. As a matter of natural justice, I consider it appropriate to consider the Respondent's response having regard to the fact that the sole director, Mr Richard Ellis, was on annual leave at the time of receiving the complaint.

## **4. FACTUAL BACKGROUND**

### **4.1 The Complainant**

The Complainant is a German manufacturer of drinking glasses, which are sold in Australia under its registered trade marks "SPIEGELAU", the earliest of which was registered in 1984. The Complainant has been continuously promoting its "SPIEGELAU" glassware both globally and in Australia, including via the Internet at its website [www.spiegelau.com](http://www.spiegelau.com).

### **4.2 The Respondent**

The Respondent was transferred the Domain Name by Wine Minded Pty Ltd on 22 February 2006. Wine Minded Pty Ltd was, at least until 23 September 2005, an Australian distributor of "SPIEGELAU" drinking glasses for the Complainant. The Respondent claims that the Domain Name was transferred to it after negotiations for

the continued distributorship with the Complainant broke down. Mr Richard Ellis is a director of both the Respondent and Wine Minded Pty Ltd.

Wine Minded Pty Ltd continues to sell its remaining stock of "SPIEGELAU" drinking glasses, and which is advertised on the website at [www.wineminded.com.au](http://www.wineminded.com.au). The Respondent does not advertise the "SPIEGELAU" drinking glasses or claim any association with the Complainant at its website [www.spiegelau.com.au](http://www.spiegelau.com.au) (*Website*). Further, the Respondent has advised that the specific activities intended to be promoted at the Website are only in respect of tourism services for the German town of Spiegelau.

## 5. PARTIES' CONTENTIONS

### 5.1 Complainant

- (a) The Complainant relies on the following in support of paragraph 4(a)(i) of the auDRP:

The Complainant is the registered owner of the following:

- (i) Trade Mark No. 356539 "S SPIEGELAU Logo" stated as being registered on 22 March 1984 (but in fact was registered from 13 February 1981 as shown in the evidence provided, with 22 March 1984 being the date the Certificate of Registration was issued); and
  - (ii) Trade Mark No. 977880 "SPIEGELAU", registered on 16 September 2003,
- (together the *Trade Marks*)

The Complainant's goods are sold in Australia under the Trade Marks, and as such the Complainant has acquired a significant reputation in its Trade Marks. It is also the owner of the website at <http://www.spiegelau.com>, which it uses to actively promote its goods worldwide by reference to its Trade Marks.

The Complainant therefore submits that the Domain Name is identical to its well known Trade Marks.

- (b) The Complainant relies on the following in support of paragraph 4(a)(ii) of the auDRP:

To the Complainant's knowledge, the Domain Name was transferred to the Respondent from Wine Minded Pty Ltd on or before 26 June 2006. Wine Minded Pty Ltd was formerly the Australian distributor for the Complainant's goods (which bear the Trade Marks). Mr Richard Ellis is a director of Wine Minded Pty Ltd and sole director of the Respondent.

As a result of having common directors, the Respondent is and was at all times intimately aware of the business activities and intentions of Wine Minded Pty Ltd.

The Domain Name was registered by Wine Minded Pty Ltd on 12 March 2001. The Complainant was unaware of this until about September 2005, whereupon the Complainant's lawyers sent a letter demanding that Wine Minded Pty Ltd immediately cease any unauthorised use of its Trade Marks. The Complainant received no response from Wine Minded Pty Ltd.

A further letter was forwarded to Wine Minded Pty Ltd on 15 February 2006, demanding that all unauthorised use of the Complainant's Trade Marks and the Domain Name cease. Again, no response was received by the Complainant.

On 28 June 2006, Wine Minded Pty Ltd was notified that an action under the auDRP would be commenced should the Complainant's rights in the Trade Marks and Domain Name and demands continue to be ignored. On 29 June 2006, the Complainant received correspondence from Wine Minded Pty Ltd advising that the Domain Name had been "sold" to a third party. Searches of the Whois database revealed that the new registrant of the Domain Name was the Complainant. No other details for the Domain Name had been changed and Mr Ellis (a director of both companies) continued to be the administrative contact for the Domain Name.

Further, until conducting the Whois search, the Complainant was not aware of the existence of the Respondent or any other company incorporating the Complainant's Trade Marks in its trading name.

In following communications between the parties, Mr Ellis on behalf of the Respondent refused to transfer the Domain Name.

The Complainant has not licensed or otherwise authorised the Respondent to use its name and Trade Marks. Any implied licence that existed between the Complainant and Wine Minded Pty Ltd was properly revoked upon that company receiving the first letter of demand.

The Complainant therefore submits that the Respondent has no rights or legitimate interests in respect of the Domain Name on the basis of not only its pre-existing rights in its Trade Marks, but that the Domain Name was transferred to the Respondent by Wine Minded Pty Ltd purely to evade legitimate efforts by the Complainant to obtain the Domain Name under the auDRP.

- (b) The Complainant submits that the Respondent has registered or subsequently used the Domain Name in bad faith under paragraph 4(a)(iii) of the auDRP.

The Domain Name was transferred the Respondent by Wine Minded Pty Ltd specifically to avoid having to transfer the Domain Name to the Complainant under a auDRP complaint, as was notified in writing to Wine Minded Pty Ltd.

By registering the Domain Name, and using it in respect of Wine Minded Pty Ltd's website, the Respondent is misrepresenting itself as either the connected to or associated with the Complainant, or authorised to use the Trade Marks, in respect of the goods.

Further, the Complainant states that by the Respondent "purchasing" the Domain Name with full knowledge of the pre-existing trading relationship between Wine Minded Pty Ltd and the Complainant (as well as the revocation of licence to use the Trade Marks), the Respondent is passing off on the Complainant's reputation and goodwill, as well as misleading and/or deceiving consumers under sections 52 and 53 of the *Trade Practices Act 1974* (Cth).

Lastly, the Complainant states that any use by the Respondent of its Trade Marks, including registration of the Domain Name, is an infringement under s120(3) of the *Trade Marks Act 1995*. By having the Domain Name transferred to it, the Complainant has prevented the Complainant from reflecting its Trade Marks in the corresponding domain name. The Domain Name was therefore registered by the

Respondent primarily for the purpose of disrupting the business activities of the Complainant.

Accordingly, the Complainant requests that the Domain Name be transferred to it.

## 5.2 Respondent

The Respondent asserts that:

- (a) the Domain Name was registered by Wine Minded Pty Ltd with the knowledge and approval of the Complainant. Further that it has expended a substantial amount of money in establishing and maintaining the Domain Name since registration;
- (b) the only communication received by Wine Minded Pty Ltd was the letter of 27 March 2006 terminating the trading arrangements. The Respondent claims it has built up intellectual property rights over 6 years by virtue of this trading arrangement, including in and to the Domain Name;
- (c) the Domain Name had not been used to sell or promote glass and the Respondent undertakes to not use the Domain Name for the purpose in the future;
- (d) that the name "Spiegelau" is that of a German town and therefore it is a geographical domain name in which the Respondent has legitimate rights. The Respondent states that trade marks which are geographical are excluded from protection;
- (e) ownership of the Complainant changed in September 2004 (the Complainant was purchased by Reidel). Mr Ellis of Wine Minded Pty Ltd was verbally advised on 11 May 2005 that following despatch of a final order trading relationships would be terminated. This was relayed to Wine Minded Pty Ltd by a Mr Mark Baulderstone (a representative of the Reidel Family interests in Australia). Mr Ellis sought confirmation of this from the Complainant in Germany, who indicated its interest in maintaining some trading relationship;
- (f) the only option provided to Wine Minded Pty Ltd was that it would purchase the goods through a new distributor in Australia for "prices that would not be competitive enough" to make it worthwhile;
- (g) Wine Minded Pty Ltd offered to sell its remaining stock of glassware, the Domain Name, 1800 free call numbers and Australian white pages listings under "Spiegelau" for \$25,000. The Complainant rejected this offer and threatened the matter would be referred to lawyers;
- (h) until 22 February 2006, Wine Minded Pty Ltd was still listed on the Complainant's global website as a distributor in Australia. However, Wine Minded Pty Ltd ceased using the Domain Name and on 22 February 2006, Wine Minded Pty Ltd split its website into 2 distinct web addresses: [www.spiegelau.com.au](http://www.spiegelau.com.au) and [www.wineminded.com.au](http://www.wineminded.com.au). The former website has no reference to glassware, whilst the latter continues to sell its remaining stock;
- (i) the Domain Name is geographical and that the Complainant has no rights in it. The Complainant has only ever used the registered logos which include the word "Spiegelau" and therefore, not only has there been no infringement by the

Respondent, but that the Complainant has no right in the word mark "Spiegelau" on its own;

- (j) Wine Minded Pty Ltd spent 5 years promoting the "Spiegelau" brand in Australia via trade show promotion, web presence, Yellow and White Pages, magazine advertisements and general promotion to potential customers. It still has extensive stock of the Complainant's glassware and, although not using the Domain Name for promotion, it will continue with all other promotion in order to sell its stock and recoup its costs.
- (k) because the Complainant declined to continue discussions in respect of the Domain Name, it does not have any interest in it. Further, commercial consideration was paid by the Respondent to Wine Minded Pty Ltd for the transfer of the Domain Name;
- (l) the transfer of the Domain Name was not made to evade the Complainant's claims. The original intent was always that the Domain Name would be held by the Respondent, however, since the <wineminded.com.au> was registered at the same time as the Domain Name, they were registered to Wine Minded Pty Ltd. The transfer was done only to correct the registrations to their original intent, which was conveyed to the Complainant;
- (m) Wine Minded Pty Ltd was much more than a customer of the Complainant, which is evidenced by the Complainant's authorisation to register the Domain Name and the exclusive distribution arrangements in Australia. Wine Minded Pty Ltd was a distributor for the Complainant until it was notified otherwise by Reidel;
- (n) although Mr Richard Ellis is a director of both Wine Minded Pty Ltd and the Respondent, the ownership of these companies is different (there is one other director of Wine Minded Pty Ltd) and they are separate legal entities;
- (o) the issue surrounding the Domain Name only arose after commercial discussions regarding continued trading arrangements with the Complainant. It had not been in the previous 18 months;
- (p) on 1 March 2006, the Respondent did provide a full response to the Complainant's letter dated 16 February 2006;
- (q) the Domain Name was not acquired by the Complainant when it was offered and the Respondent decided to "cut its losses" regarding the trading arrangements and look at other avenues to utilise the assets of Wine Minded Pty Ltd, including the Domain Name (which includes exploiting it in relation to European tourism potential);
- (r) the Respondent refuses to transfer the Domain Name to the Complainant, and has provided undertakings to not use it in relation to the sale of glassware. Its registration and intended use of the Domain Name does not infringe the Complainant's trade mark rights. Nor was the transfer of the Domain Name to the Respondent by Wine Minded Pty Ltd for the purpose of evading the Complainant's rights;
- (s) Wine Minded Pty Ltd has (and will continue to sell) its stock of the Complainant's goods as it is entitled to do so, however, it does not pass itself off as a distributor for the Complainant;

- (t) there is no misleading or deceptive conduct as the Domain Name is not, nor will it in future, be used by the Respondent to promote or sell glassware;
- (u) registration of the Domain Name by the Respondent is not trade mark infringement as it intends to promote Spiegelau in Germany for tourism via links to other tourism sites;
- (v) but for the “reckless termination of the trading arrangements”, the Respondent would still be using the Domain Name (as had been previously approved by the Complainant’s predecessor) to sell and promote the Complainant’s goods. Further, because the Respondent does not intend to use the Domain Name for the sale/promotion of glassware, and the Domain Name reflects a geographical place, the Respondent is not in breach.

## **6. DISCUSSION AND FINDINGS**

In order to have the Domain Name transferred to it, the Complainant must make out each of the following elements under the auDRP:

- (a) the Respondent’s domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
- (b) the Respondent has no rights or legitimate interests in the domain name (paragraph 4(a)(ii)); and
- (c) the Respondent registered or subsequently used the domain name in bad faith (paragraph 4(a)(iii)).

### **A. Identical or Confusingly Similar to a Name, Trade Mark or Service Mark in Which the Complainant has Rights.**

The Complainant has submitted that the Domain Name is identical to its well known registered trade marks for SPIEGELAU. The Respondent counters this by stating that the Trade Marks are logos and not just the word “Spiegelau”. The Domain Name is unavoidably identical to the main feature of the Complainant’s Trade Marks, being the word “Spiegelau”, and it is a name by which the Complainant is commonly known. In that regard, the Trade Marks are various logos containing the word “SPIEGELAU” together with an “S” device and one of these registered marks is merely the stylised word “Spiegelau”. I find that the Domain Name is in fact substantially identical to the Complainant’s well known name and Trade Marks.

On that basis, and pursuant to paragraph 4(a)(i), I find that Complainant is able to establish that it has rights in the name “SPIEGELAU” and that the Domain Name is substantially identical to the Complainant’s name and Trade Mark.

The Complainant has therefore established this element of its case and meets the criteria of Paragraph 4(a)(i) of the auDRP.

### **B. The Respondent has no Rights or Legitimate Interests in the Domain Name**

The Respondent has established that Wine Minded Pty Ltd did have an established trading relationship with the Complainant as a distributor of glassware in Australia. Further, the Complainant agreed that Wine Minded Pty Ltd could register the Domain Name for a website but the correspondence clearly indicates that this was to be for

the promotion of the Complainant and the goods. There is no evidence that the Complainant was ever notified of the successful registration of the Domain Name. Nevertheless, at best, any agreement by the Complainant that Wine Minded Pty Ltd could use the Trade Marks and register the Domain Name was an implied licence only. It cannot be gleaned that the Complainant has assigned any of its right, title and interest in and to its Trade Marks. The implied licence was clearly revoked upon notice to Wine Minded Pty Ltd that it would no longer be a distributor in Australia and by the earliest letter of demand dated 8 October 2005.

The Respondent has provided no evidence that it is commonly known by the name "Spiegelau" apart from the registration of a company name (which in itself does not give rise to trade mark rights). The ASIC report provided shows that the Respondent in fact changed its name to Spiegelau Australia Pty Ltd on 12 September 2002, which was after registration of the Domain Name and which was not discovered by the Complainant until this dispute arose.

Further, the Respondent has not provided any evidence of its business or marketing strategies other than that the Domain Name will in future be used for tourism in respect of the German town Spiegelau. As at the date of the Complaint, the Domain Name does not resolve to any holding page or website containing the Respondent's name.

The Respondent refuses to transfer the Domain Name (despite having been made aware of the Complainant's rights prior to the transfer) and, in support of its right to the Domain Name, has claimed that it is a geographic name which therefore cannot be protected as a trade mark. However, there is no evidence that the German town of Spiegelau is globally renowned or known for its glassware generally, such as is the case for Champagne in France or Murano (also for glassware) in Italy. In any event, the Complainant has a long standing reputation in its name and Trade Marks, of which the Respondent is well aware.

The Respondent has admitted that the proposed tourism website will be developed since Wine Minded Pty Ltd was unable to continue with its previous trading arrangement and recoup any costs incurred to date (including selling existing Spiegelau glassware in stock). It is not clear how the Respondent sees this as confirming its own rights in the Domain Name.

I find that the Respondent has failed to discharge the onus of proving that it does have rights in or a legitimate interest in the Domain Name, and that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

### **C. The Domain Name has been Registered or Subsequently Used in Bad Faith**

In order to assert a right or legitimate interest in the Domain Name, the Respondent must have made bona fide use or preparations to use the Domain Name in connection with offering goods or services.

The Respondent has provided no evidence that it is actively engaged in any business on the Internet or otherwise.

On the evidence and submissions provided by both parties, it is clear that the Domain Name was transferred to the Respondent following notification to Wine Minded Pty Ltd of an intended auDRP complaint (and which was also attached in draft form to the letter of demand of 30 June 2006). There is imputed knowledge by the Respondent of the dispute in respect of the Domain Name as Mr Richard Ellis is not

only a director of both companies, but has also been the contact person in relation to the dispute including this auDRP complaint.

I am satisfied that the Respondent was aware of the Complainant and the Trade Mark dispute at the time it accepted the transfer of the Domain Name from Wine Minded Pty Ltd.

As such, I find that Domain Name was registered by the Respondent primarily for the purpose of disrupting the business or activities of the Complainant.

Further, I am satisfied that the registration of the Domain Name by the Respondent is preventing the Complainant from reflecting its name and trade mark "SPIEGELAU" in a corresponding domain name.

The Complainant has satisfied the requirements of paragraph 4(a)(iii).

## **7. DECISION**

I find that the Complainant has made out all of the elements of paragraph 4(a) of the auDRP Rules. Accordingly, the domain name <spiegelau.com.au> is to be transferred by the Registrar, ConnectWest, to the Complainant.

Sara Delpopolo  
Sole Panelist

30 August 2006