



DECISION

Kompan A/S v. Elliott Scott / Elliott Scott Company LLC / ESC LLC

Claim Number: FA1505001620597

PARTIES

Complainant is **Kompan A/S** (“Complainant”), represented by **Kasper Frahm** of **Plesner Law Firm**, Denmark. Respondent is **Elliott Scott / Elliott Scott Company LLC / ESC LLC** (“Respondent”), California, USA.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**kompan.mobi**> and <**kompan.tv**>, registered with **Godaddy.Com, Llc**; and <**kompan.org**>, registered with **Network Solutions, Llc (R63-Lror)**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

dr. Katalin Szamosi as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on May 21, 2015; the FORUM received payment on May 20, 2015.

On May 21, 2015, Network Solutions, Llc (R63-Lror) confirmed by e-mail to the FORUM that the <**kompan.org**> domain name is registered with Network

Solutions, Llc (R63-Lror) and that Respondent is the current registrant of the name. Network Solutions, Llc (R63-Lror) has verified that Respondent is bound by the Network Solutions, Llc (R63-Lror) registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 22, 2015, Godaddy.Com, Llc confirmed by e-mail to the FORUM that the <kompan.tv> domain name is registered with Godaddy.Com, Llc and that Respondent is the current registrant of the name. Godaddy.Com, Llc has verified that Respondent is bound by the Godaddy.Com, Llc registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 26, 2015, Godaddy.Com, Llc confirmed by e-mail to the FORUM that the <kompan.mobi> domain name is registered with Godaddy.Com, Llc and that Respondent is the current registrant of the name. Godaddy.Com, Llc has verified that Respondent is bound by the Godaddy.Com, Llc registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On June 1, 2015, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of June 22, 2015 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@kompan.mobi, postmaster@kompan.tv, postmaster@kompan.org. Also on June 1, 2015, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all

entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on June 20, 2015.

On June 26, 2015, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Dr. Katalin Szamosi as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant asserts its rights in KOMPAN mark as it has registered the mark with United States Patent and Trademark Office ("USPTO") (Reg. No. 1,396,926, registered June 10, 1986). Furthermore, Complainant argues that Respondent's <kompan.mobi>, <kompan.tv>, and <kompan.org> domain names are identical to Complainant's mark as they fully incorporate the KOMPAN mark and merely add the generic top-level domain ("gTLD") ".mobi" or ".org," or the country-code top-level domain ("ccTLD") ".tv."

Complainant argues that Respondent has no rights and legitimate interests in the disputed domain name. In support of this, Complainant asserts that Respondent is neither commonly known by <kompan.mobi>, <kompan.tv>, or <kompan.org>, nor has Complainant authorized Respondent to incorporate the KOMPAN mark in any domain registrations. Furthermore Respondent has not utilized the disputed domain name in connection with any bona fide offering of goods or services or for any legitimate noncommercial or fair use and has registered the names to serve as a bargaining tool to compel Complainant to pay invoices allegedly due to Respondent.

Complainant argues that Respondent registered and uses the disputed domain names in bad faith, as a bargaining tool to induce Complainant's payment of allegedly unpaid invoices per a business arrangement between the parties which ended over a year before the registration of the <kompan.mobi> and <kompan.tv> domain names. Complainant also asserts that, due to the past working relationship between the parties, Respondent had actual and/or constructive knowledge of the KOMPAN mark and Complainant's rights therein.

B. Respondent

Respondent argues the following in the Response:

- the disputed domain names do not portray the dancing man motif that Complainant's trademark bears;
- the term "kompan" in Polish translates to "comrade" and is therefore a generic term;
- it makes a noncommercial use of the <kompan.mobi>, <kompan.tv>, and <kompan.org> domain names while it waits for Complainant to fulfill its obligations to Respondent;
- the disputed domain names were not registered as a bargaining tool, but under the agreement Complainant and Respondent

entered into together which permits registering of domains during and after termination of the agreement as a protective measure for Complainant;
- and it never offered the disputed domain names for sale or auction to a competitor of Complainant.

Preliminary Issue: Multiple Respondents

In the instant proceedings, Complainant has alleged that the entities which control the domain names at issue are effectively controlled by the same person and/or entity, which is operating under several aliases. Paragraph 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) provides that a “complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.” Based on the evidence submitted by the Complainant and the fact that Respondent 1 and Respondent 2 submitted a common response in which they did not question the common control of the disputed domain names, the Panel found it proven that the disputed domain names were subject to common control by a single Respondent who is using multiple aliases.

Preliminary Issue: Business/Contractual Dispute Outside the Scope of the UDRP

Respondent argues its rights in the disputed domain names as per a contractual agreement in which Complainant enlisted Respondent to build lead generation systems and processes which contractual relationship lasted for over an eight year period. The Respondent submitted under Exhibit E2 the Services Agreement concluded between Complainant and Respondent. During the contractual relationship (pursuant to Complainant’s contentions and Attached Exhibits 10 and 11), Complainant engaged Respondent to make its Google AdWords advertisements more effective in order to generate more sales, which included domain name registrations on behalf of Complainant.

Based on the foregoing the Panel finds that this is a business and/or contractual dispute between two companies that falls outside the scope of the UDRP. In *Love v. Barnett*, FA 944826 (Nat. Arb. Forum May 14, 2007), the panel stated:

“A dispute, such as the present one, between parties who each have at least a prima facie case for rights in the disputed domain names is outside the scope of the Policy ... the present case appears to hinge mostly on a business or civil dispute between the parties, with possible causes of action for breach of contract or fiduciary duty. Thus, the majority holds that the subject matter is outside the scope of the UDRP and dismisses the Complaint.”

Respondent - pursuant the agreement concluded with Complainant - has to transfer the domain names it registered for Complainant within 60 days of the final license payment. Complainant has terminated the contract with Respondent and did not transfer the final license fee due to facts and reasons unknown to the Panel.

In *Love v. Barnett*, FA 944826 (Nat. Arb. Forum May 14, 2007), the panel was also concerned with possible causes of action for breach of contract. According to the panel in *Love v. Barnett*, complex cases such as the one presented here may be better decided by the courts than by a UDRP panel:

“When the parties differ markedly with respect to the basic facts, and there is no clear and conclusive written evidence, it is difficult for a Panel operating under the Rules to determine which presentation of the facts is more credible. National courts are better equipped to take evidence and to evaluate its credibility.”

Additionally the submitted communications that occurred between Complainant and Respondent (either directly or through their legal representative) supports the Panel's view that the case at hand is complex and may be better decided by the courts than by a UDRP panel. Although the Rules empower the Panel to request additional evidence from the parties, the Panel has taken the view that even in case the parties would have submitted additional evidence it would not have altered the Panel's view and would instead have led to an unnecessary delay in the issue of this decision.

The panel in *Luvilon Indus. NV v. Top Serve Tennis Pty Ltd.*, DAU2005-0004 (WIPO Sept. 6, 2005) concurred with this reasoning:

“[The Policy's purpose is to] combat abusive domain name registrations and not to provide a prescriptive code for resolving more complex trade mark disputes The issues between the parties are not limited to the law of trade marks. There are other intellectual property issues. There are serious contractual issues. There are questions of governing law and proper forum if the matter were litigated. Were all the issues fully ventilated before a Court of competent jurisdiction, there may be findings of implied contractual terms, minimum termination period, breach of contract, estoppels or other equitable defenses. So far as the facts fit within trade mark law, there may be arguments of infringement, validity of the registrations, ownership of goodwill, local reputation, consent, acquiescence, and so on.”

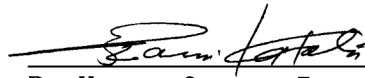
Based on the above the Panel concludes that the present case is too complex, outside the scope and purpose of the UDRP.

For the reasons stated above, the Panel finds it unnecessary to consider the three elements of the Policy.

DECISION

For the reasons presented above, the Panel concludes that relief shall be DENIED.

Accordingly, the Complaint is DISMISSED.


DR. KATALIN SZAMOSI, ESQ.

Dr. Katalin Szamosi, Panelist

Dated: July 9, 2015