

ADMINISTRATIVE PANEL DECISION

Reusch International S.P.A. v. Santiago Praolini, Tactic Sports SAS
Case No. DCO2022-0093

1. The Parties

The Complainant is Reusch International S.P.A., Italy, represented by Weinmann Zimmerli, Switzerland.

The Respondent is Santiago Praolini, Tactic Sports SAS, Colombia.

2. The Domain Name and Registrar

The disputed domain name <reusch.com.co> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 7, 2022.

The Center verified that the Complaint together with the amended 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 November 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 28, 2022. The Respondent did not submit a formal response although, on November 24, 2022, he sent an email to the Center which is considered further below. On November 25, 2022, an email explaining the process for a possible settlement was sent by the Center to the Parties. However, a suspension of these proceedings was not requested by the Complainant and the Center accordingly notified the Commencement of Panel Appointment Process on December 5, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on December 9, 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 company with its head office in Italy and is a designer and manufacturer of gloves, for use in a variety of sports. The Complainant's brand name is REUSCH and it owns many trade marks to protect this trading style including, by way of example, European Union Trade Mark, registration number 008699721, for REUSCH, registered on May 27, 2010 in classes 9, 18, 25 and 28.

The disputed domain name was registered by the Respondent on September 16, 2019. It presently resolves to a website promoting the Complainant's products in Colombia.

On December 2, 2019 the Complainant and the Respondent entered into a written license agreement, which appears to have been ancillary to a separate distribution agreement entered into by the parties. Pursuant to the terms of the license agreement, the Respondent was given an express license to register and use the disputed domain name, albeit the license post-dates the date of registration of the disputed domain name. The license provided that the Respondent would not claim any ownership rights to any domain names incorporating the Complainant's REUSCH mark and that, upon termination, the Respondent was obliged to transfer the disputed domain name to the Complainant.

The license was determined by the Complainant on April 8, 2022. When the disputed domain name was not transferred to the Complainant, it sent a letter to the Respondent on May 27, 2022 formally requiring the transfer of the disputed domain name to it. On June 9, 2022, the Respondent replied, setting out a number of grievances it had against the Complainant relating to the conduct of their commercial relationship and its termination and seeking compensation from the Complainant.

5. Parties' Contentions

A. Complainant

For reasons which are set out below, it is not necessary, to deal with the Complainant's assertions in detail. In brief, it asserts that the disputed domain name is identical or confusingly similar to a trade mark in which it has rights, that the Respondent has no rights or legitimate interests in the disputed domain name and that the disputed domain name was both registered and is being used by the Respondent in bad faith.

B. Respondent

The Respondent did not reply to the Complaint but, on November 24, 2022, the Respondent sent an email to the Center indicating that, whilst he did not accept many of the contentions in the Complaint, "I don't want to initiate an administrative process with the WIPO, so I kindly ask you to let me know what is the process to release the domain and get myself out of this. I would love to have WIPO involved during the transfer process in order to avoid future misunderstandings".

6. Discussion and Findings

Section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") deals with the position in which a respondent has given informal consent to the transfer of a domain name outside of the more formal settlement process. It explains that whilst in these circumstances many panels will order the remedy requested by the complainant on the basis of the respondent's consent, in some cases a panel may still find it appropriate to proceed to a substantive

decision on the merits. Section 4.10 explains that scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits, notably if there is a pattern of bad faith conduct, (ii) where the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.

The Panel is satisfied that notwithstanding that the Respondent has, by implication, disclaimed any bad faith on his part, it is not necessary to proceed to a substantive decision on the merits. In particular, whilst the Complainant did not seek a suspension of the proceedings in response to the email from the Center dated November 25, 2022 explaining the process for a possible settlement, neither did it provide any indication that it preferred that the Panel proceed to a recorded decision. Furthermore, the Panel notes that, irrespective of whether or not the Respondent's complaints against the Complainant, as articulated in his letter to it dated June 9, 2022, have any merit, the circumstances of the Respondent's registration and use of the disputed domain name do not comprise typical cybersquatting activity of the type most usually considered under the Policy. In particular, as part of a broader commercial agreement, the Parties entered into a license agreement which expressly (albeit retrospectively) authorized the Respondent's registration of the disputed domain name and it would be necessary for any decision on the merits in these proceedings to consider the potential significance of the terms of the license and the circumstances in which it was entered into by the Parties when assessing the issue of bad faith registration.

The Respondent has unhelpfully delayed in agreeing to transfer the disputed domain name to the Complainant notwithstanding that the Complainant appears to have a contractual entitlement to secure its transfer following termination of the license agreement. It is also unsatisfactory that he has not taken down his website following termination of the license, notwithstanding the broader commercial dispute which appears to have arisen between the parties. The Panel notes that the Respondent's email communication may be perceived as a consent to "release" the domain name, without the sufficient clarity on what does the Respondent mean with "release". However, the Respondent continues his email communication referring to "the transfer process", which affirms the Panel's interpretation that the Respondent's communication shall be considered as an unequivocal consent to such a transfer. In these circumstances, it is appropriate for the Panel to make an order for transfer of the disputed domain name to the Complainant on the basis of that consent. See, by way of example, *Lidl Stiftung & Co. KG v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / christie made*, WIPO Case No. [D2021-2227](#) and *LIDL Stiftung & Co. KG v. WhoisGuard Protected, WhoisGuard, Inc. / Web Server Kft., Web Server Kft.*, WIPO Case No. [D2020-3181](#).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <reusch.com.co> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: December 23, 2022