

ADMINISTRATIVE PANEL DECISION

Venderstorm Ventures GmbH & Co. KG v. Domain Administrator, PTB Media Ltd

Case No. D2024-1287

1. The Parties

The Complainant is Venderstorm Ventures GmbH & Co. KG, Germany, represented by Ladenburger Partnerschaft von Rechtsanwälten mbB, Germany.

The Respondent is Domain Administrator, PTB Media Ltd, Hong Kong, China, represented by ESQwire.com PC, United States of America.

2. The Domain Name and Registrar

The disputed domain name <babista.com> is registered with GoDaddy Online Services Cayman Islands Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 26, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 26, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to amend the Complaint. The Complainant filed an amendment to the Complaint on March 27, 2024.

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 April 3, 2024. In accordance with the Rules, paragraph 5,

the original due date for Response was April 23, 2024. The Respondent sent an email communication to the Center on April 4, 2024, notifying its authorized representative's email address for correspondence. On April 18, 2024, the Respondent requested an extension of time of eleven calendar days to respond to the Complainant citing, among other reasons, the Passover holiday. On the following day, the Center granted the Respondent an extension of four calendar days in accordance with paragraph 5(b) of the Rules and invited the Complainant to comment on the additional requested extension of time. The Complainant objected to the additional requested extension of time on April 22, 2024. In accordance with paragraph 5(e) of the Rules, the Center granted the Respondent an additional extension of time until May 4, 2024 to respond to the Complaint. The Response was filed with the Center on May 4, 2024.

The Complainant made an unsolicited supplemental filing on May 17, 2024. The Respondent made an unsolicited supplemental filing in reply on May 24, 2024.

The Center appointed Matthew Kennedy, Anne-Virginie La Spada, and Gerald M. Levine as panelists in this matter on June 21, 2024. 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 men's fashion company that in 2023 acquired various trademarks and domain names associated with the BABISTA brand of men's clothing, shoes, and underwear. On February 27, 2024, the Complainant was recorded as the holder of International trademark registration number 729727 for BABISTA, registered on March 3, 2000, specifying goods in classes 14, 18, 24, and 25. That registration remains current with respect to Switzerland only. It was based on German trademark registration number 39974185, registered on January 20, 2000, which expired in 2009. The Complainant also holds later International, European Union, and German trademark registrations for a semi-figurative BB BABISTA mark and for BABISTA.

The Complainant's predecessor-in-interest also registered the domain name <babista.de> no later than March 22, 2004, and <babista.ch>, on April 26, 2005, which resolved to active websites no later than February 15, 2006, and March 14, 2007, respectively, at which time they displayed an advertisement celebrating the 15th anniversary of BABISTA.¹ The Complainant's predecessor-in-interest also registered the domain name <babista.nl> no later than January 22, 2004, which resolved to an active website no later than July 26, 2011. The Complainant now uses these domain names in connection with online shops in German, French, and Dutch that offer BABISTA brand men's clothing and accessories for sale. The Complainant also uses <babista.at> to redirect to <babista.de>.

The Respondent is a domain name investor and seller incorporated in Hong Kong, China. Its portfolio manager is Mr. Michael Goetz.

The disputed domain name was registered on October 17, 2005. It resolves to a landing page displaying Pay-Per-Click ("PPC") links and a notice advertising it for sale. The evidence shows that, as at January 17, 2024, the PPC links related to men's clothing and men's shoes and resolved to websites of the Complainant's competitors. Since the Respondent received notice of this dispute, the PPC links have related to general interest topics rather than clothing or shoes. The disputed domain name is listed for sale on a broker's website for the price of USD 32,200, or for one year at prices over EUR 32,000.

¹ The Panel recalls its general powers articulated inter alia in paragraphs 10 and 12 of the Rules and has searched for archived Web pages in the Internet Archive (www.archive.org), which is a matter of public record, to verify the Complainant's assertions regarding the time when these websites went live. The Panel considers this process of verification useful in assessing the case merits and reaching a decision. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its BABISTA trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. Neither the Complainant nor its predecessors-in-interest have ever assigned, licensed or in any way authorized the Respondent to register or use the BABISTA mark in any manner. The disputed domain name resolves to a webpage offering it for sale and displaying PPC links to the websites of the Complainant's competitors.

The Complainant further contends that the disputed domain name was registered and is being used in bad faith. The Respondent was aware of the pre-existing BABISTA trademark when the disputed domain name was registered. Men's fashion has been sold under the BABISTA brand since the early 1990s. The BABISTA trademark was registered in 2000 and the <babista.ch> domain name was registered on April 26, 2005. The Complainant and its predecessor-in-interest were and are also active outside Germany and Switzerland, in the Netherlands (Kingdom of the), Belgium, and Austria, and the business activities there are so substantial that the Respondent could not have overlooked them. Further, the Respondent has placed the disputed domain name with a service that shows PPC links to competitors indicating an intent to trade off the goodwill of the Complainant. In addition, the disputed domain name is offered for use for one year at a price that exceeds the acquisition costs many times over.

In its supplemental filing, the Complainant argues that the Response is based mainly on Mr. Goetz's assertions, which are not further substantiated. It remains completely unclear where he is supposed to have gained his knowledge of historical events. The statements are not plausible in this form. In a prior UDRP proceeding, despite him consenting to the transfer of a domain name in his capacity as manager of PortMedia Inc, the prior panel considered the merits and ordered a transfer. See *Société Nationale des Chemins de Fer Français, SNCF v. Moniker Privacy Services / 3597435 Domain Administrator Port Media Sales*, WIPO Case No. [D2011-0527](#). The circumstances of the registration of the disputed domain name do not match those of the Respondent's other 10 registrations ending in "-ista", as the others are all descriptive. The Respondent's submission is clearly a subsequent whitewashing of the actual events that took place in 2005. Mr Goetz's declaration incorrectly states that the PPC links relate to general interest topics; merely asserts without evidence that the PPC links related to clothing appeared recently; and it is not clear what he means when he declares that the Respondent "develops" domain names. The Respondent has engaged in a pattern of registering domain names corresponding to prior third party trademarks, for example, <catequista.com> and <okista.com>.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name. Rather, this appears to be a case where the Complainant purchased a few pre-existing trademarks and two domain names and then decided to file a UDRP complaint to see if it could secure the corresponding ".com" domain name.

The Response and the Respondent's supplemental filing each annex a declaration by Mr. Goetz, the latter of which is sworn. The Respondent asserts that it registered the disputed domain name along with 49 other domain names because it has qualities it deems to be valuable for domain investing: it is a ".com" domain name that is short in length, pronounceable in English and other languages, easy to spell, and brandable for any number of potential uses. The Respondent had not heard of the Complainant or its trademark at the time of registration nor since. From 2003 to approximately 2006, the Respondent registered 11 domain names with the suffix "-ista". Additionally, the Respondent currently owns 3,760 7-letter ".com" domain names, of which 313 fit the same consonant and vowel pattern.

The Respondent acknowledges that the Complainant has alleged it is the owner of registered trademark rights in BABISTA. It is unclear how or when Complainant became the owner of the marks. There is no evidence of widespread awareness of the Complainant today and certainly not in October 2005 when the disputed domain name was registered.

Registration of brandable domain names and use as an investment establishes rights and a legitimate interest. Sale of commercially valuable domain names without targeting of trademark holders is a legitimate interest. Years of use with a parking provider and non-infringing PPC links are a legitimate interest. The disputed domain name is hosted with a service that places PPC advertising links related to general interest topics. More recently due to a change in parking providers and the algorithm, it appears that generic links related to clothing appeared on the webpage associated with the disputed domain name. The Respondent only became aware of these links upon receipt of the Complaint. Out of caution and respect for the Complainant, the Respondent requested its parking service provider to remove and replace them with more general topics of interest.

There is no evidence of bad faith registration or use. The Respondent did not register the disputed domain name with the Complainant's purported trademark in mind. Indeed, at the time the disputed domain name was registered, the Complainant was either non-existent or unknown in the marketplace. For almost two decades, the Complainant did not contact the Respondent regarding the disputed domain name and the Respondent was not aware of the Complainant. At no time did the Respondent target or intend to target the relatively unknown Complainant. The disputed domain name is evocative of the English word "barista" and contains the recognizable suffix "-ista". Given its structure, it also has a potential connotation of an expert or specialist in babies or babes. Thus, the disputed domain name has inherent value. The Respondent registered almost 50 similarly valuable names on or around the same time it registered the disputed domain name that were available for registration on a first-come, first-served basis. The Respondent's good faith is also supported by the 10 other domain names it owns that end in "-ista". The Complainant's own domain name <babista.ch> was registered in April 2005, so the earliest date it may have had any online presence was a mere few months prior to the disputed domain name registration.

In its supplemental filing, the Respondent argues that the Complainant's supplementary submission makes no serious effort to address the Respondent's objections regarding the Complainant's lack of trademark rights or customer awareness at the time when the disputed domain name was registered in 2005. It appears that only a few months separate the registration dates of the Complainant's ".ch" domain name and the disputed domain name. But there is no evidence that the Complainant was using its domain name at that time and there is no evidence that in 2005 consumers knew of the Complainant outside of Switzerland (and/or possibly Germany) as the Complainant's online presence could not have existed prior to that date. It is more likely than not that the Respondent (based out of Hong Kong, China) would never have heard of the Complainant when it found the disputed domain name available for registration and the Respondent merely registered it along with many other similar domain names.

6. Discussion and Findings

6.1 Preliminary Issue: Unsolicited Supplemental Filings

The Complainant made an unsolicited supplemental filing after the filing of the Response. The Respondent made an unsolicited supplemental filing in reply, prior to the appointment of the Panel.

Paragraph 10(d) of the Rules provides that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence". Although paragraph 12 of the Rules empowers the Panel, in its sole discretion, to request further statements or documents from either of the Parties, this does not preclude the Panel from accepting unsolicited filings. See *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. [D2001-1447](#).

Neither Party formally objects to the admission of the other Party's supplemental filing. The Complainant seeks to justify its unsolicited supplemental filing on two grounds. First, it argues that it did not know who the Respondent was at the time of the Complaint. However, this argument overlooks the fact that the Center provided the registrant and contact information disclosed by the Registrar prior to the amendment of the Complaint, and that the Complainant did not avail itself of that opportunity to update its submission in light of that information. The Complainant is on firmer ground when it argues that the Response presents new circumstances that were not foreseeable to the Complainant when it filed the Complaint. The Panel observes that the Complainant's supplemental filing seeks to rebut allegations in the Response regarding the Respondent's domain name portfolio and the use to which it puts the disputed domain name, and that these allegations could not reasonably have been anticipated at the time of filing the Complaint. The Respondent has taken the opportunity to respond to the Complainant's supplemental filing in its own supplemental filing. Both supplemental filings were made before the appointment of the Panel and neither will unduly burden this proceeding.

Therefore, the Panel exercises its discretion to admit both Parties' supplemental filings and will take them into consideration in this decision according to their respective relevance, materiality, and weight as part of the evidence on the record.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (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 burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. See [WIPO Overview 3.0](#), section 1.7.

The Panel notes that the Complainant was recorded as the holder of an International trademark registration for BABISTA, designating Switzerland, in February 2024, prior to filing the Complaint in March 2024. Accordingly, the Complainant has shown rights in respect of a BABISTA trademark at the relevant time for the purposes of the first element of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the BABISTA mark is reproduced within the disputed domain name. The only additional element is a generic Top-Level Domain ("gTLD") extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity for the purposes of the Policy. Accordingly, the disputed domain name is identical to the BABISTA mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.11.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Given the Panel's findings below regarding the third element of the Policy, it is unnecessary for the Panel to consider the second element.

C. Registered and Used in Bad Faith

The Panel recalls that the third element in paragraph 4(a) of the Policy sets out two conjunctive requirements, which means that the Complainant must show both that the disputed domain name was registered in bad faith and that it is being used in bad faith. Failure to satisfy either requirement will result in denial of the Complaint.

As regards registration, the Complainant must demonstrate that it is more likely than not that the Respondent was aware, or should have been aware, of the Complainant or its BABISTA mark at the time when the Respondent registered or acquired the disputed domain name and that the Respondent intended to benefit unfairly from that mark and/or to damage the business of the Complainant. See *Rba Edipresse, S.L. v. Brendhan Hight / MDNH Inc.*, WIPO Case No. [D2009-1580](#).

In the present case, the disputed domain name was registered on October 17, 2005. Both Parties have addressed bad faith and adduced evidence as at that time; as such, the Panel will assess bad faith in light of the circumstances prevailing at that time.

The Respondent argues that the long delay in taking any action against the disputed domain name for almost 20 years raises the inference that the Complainant's predecessor-in-interest did not truly believe that the disputed domain name was registered or being used in bad faith. The Panel does not consider that mere delay between the registration of a domain name and the filing of a complaint either bars a complainant from filing such a case, nor from potentially prevailing on the merits. See [WIPO Overview 3.0](#), section 4.17. However, the Panel notes that the delay in this case may affect the weight to be given to certain evidence regarding the time at which the disputed domain name was registered.

The disputed domain name was registered in 2005, after German and International registrations of the BABISTA mark in 2000. The disputed domain name is identical to that mark but the Respondent submits that it had not heard of the Complainant or its mark at the time of registration nor since. The Panel notes that there is no evidence on record of any online use of the BABISTA mark prior to the registration of the disputed domain name in 2005. Although the Complainant's predecessor-in-interest registered "babista" in domain names from 2004 onwards, there is no evidence that it established any associated website until 2006, nor that it ever used the BABISTA mark on another website. While the Complainant asserts that men's fashion has been sold under the BABISTA brand since the early 1990s, the sole piece of supporting evidence is an online advertisement marking the 15th anniversary of BABISTA in 2006-07. The use of the brand in the intervening years must have been offline, possibly in mail order catalogues. Further, this offline use presumably occurred in Germany and Switzerland. Given that the Respondent is based in Hong Kong, China and has no obvious link (geographic or otherwise) with Germany or Switzerland, it is not clear how the BABISTA mark would have come to its attention prior to the registration of the disputed domain name. The Panel does not impute the Respondent with constructive notice of the contents of the German and International trademark registers. In sum, the Panel does not infer from these circumstances that the Respondent was aware, or should have been aware, of the Complainant or its BABISTA mark at the time when the disputed domain name was registered.

The Complainant alleges that the Respondent's recent use of the disputed domain name indicates an intention to trade off the goodwill of the Complainant. It presents screenshots of the landing page associated with the disputed domain name offering the disputed domain name for sale and showing PPC links related to clothing, which resolve to websites of the Complainant's competitors. The Parties dispute when these links began to appear. Given that the screenshots were taken in January 2024, 19 years after the registration of the disputed domain name, they do not allow the Panel to infer anything regarding the intentions behind the registration of the disputed domain name in 2005.

The Complainant draws attention to a prior UDRP case in which a panel ordered the transfer of a domain name from a portfolio managed by Mr. Goetz. See *Société Nationale des Chemins de Fer Français, SNCF v. Moniker Privacy Services / 3597435 Domain Administrator Port Media Sales*, supra. The Panel has taken note that the domain name in that prior case was registered and used in bad faith in connection with a

webpage that featured services comparable to those of the trademark owner. However, that domain name was composed of two trademarks owned by the same party, which made it unlikely that the combination was a mere coincidence, whereas in the present case the Respondent offers an explanation for the identity between the disputed domain name and the BABISTA mark. Accordingly, this prior UDRP case does not give rise to any inference regarding the registration and use of the disputed domain name in the present case.

Turning to the Respondent, it asserts that the disputed domain name was selected because “babista” has valuable qualities, i.e., it is short in length, pronounceable in English and other languages, easy to spell, and brandable for any number of potential uses. The Respondent asserts that the disputed domain name is also evocative of the word “barista” and has a potential connotation of an expert or specialist in babies or babes. The Panel accepts that “ista” is a regular suffix in Spanish and Portuguese which creates the adjectival form of certain nouns or refers to a person’s occupation, and that the suffix is also used infrequently in English in words such as “barista” and “fashionista”. The evidence shows that, at the present time, the Respondent’s portfolio includes, among many other domain names, 11 that end in the suffix “-ista”, namely <catequista.com>, <digitalvista.com>, <enchantedvista.com>, <golfvista.com>, <inforvista.com>, <kurdista.com>, <okista.com>, <orista.com>, <punkista.com>, and <satanista.com> as well as the disputed domain name. The Complainant argues that the other 10 ista-suffixed domain names can be distinguished from the disputed domain name because they are all descriptive. Specifically, it argues that “catequista” is a Spanish and Portuguese word; “vista”, “digital”, “enchanted”, “golf”, “in”, and “for” are all descriptive English words; “Kurdista” is a misspelling of “Kurdistan”; “ökista” is an organization in Austria and “okista” is a surname; “Oristà” is a municipality in Spain; “punkista” is a musical album title; and “satanista” is a Spanish and Portuguese word. However, leaving aside that the English words are not used in the Respondent’s domain names in isolation, the Respondent avers that “babista” appears to be a word related to followers of Babism and is also a Portuguese word, while the website that the Complainant consulted regarding “Okista” also lists “Babista” as a surname.² Accordingly, this evidence fails to distinguish the disputed domain name from the other 10 ista-suffixed domain names. In the Panel’s view, in the circumstances of this case, the more plausible available explanation for the registration of the domain name is that it was part of a naming pattern within the Respondent’s portfolio.

The Complainant further notes that two ista-suffixed domain names correspond to third party trademarks. These are <catequista.com> which is the singular form of a prior Spanish trademark registration for CATEQUISTAS (used with a Catholic magazine) and <okista.com> which is the international form of a prior Austrian trademark registration for ÖKISTA (an acronym of a student travel organization). However, the Complainant does not indicate how the Respondent was, or should have been, aware of either of these other marks without consulting a trademark database, such that their registration allows an inference to be drawn regarding the disputed domain name.

For the above reasons, the Panel does not consider that the evidence in the case file as presented indicates that the Respondent’s aim in registering the disputed domain name was to profit from or exploit the Complainant’s trademark.

Therefore, based on the record, the Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that 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 to harass the domain name holder, the Panel shall declare in its decision that the Complaint was brought in bad

² The Panel recalls its general powers articulated inter alia in paragraphs 10 and 12 of the Rules and has conducted a search for “babista” using Google and the same publicly available online tool as the Complainant (Forebears.com) to weigh the Complainant’s allegations regarding other domain names in the Respondent’s portfolio. The Panel considers this process of weighing useful in assessing the case merits and reaching a decision. See [WIPO Overview 3.0](#), section 4.8.

faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. See [WIPO Overview 3.0](#), section 4.16.

The Respondent asks the Panel to make a finding of reverse domain name hijacking. It argues that any amount of due diligence would have shown the Complainant (through its counsel) that this was a claim calculated and designed to steal a valuable domain name from its rightful owner.

The Panel notes that the disputed domain name is identical to the Complainant's trademark, which is not a common term. In these circumstances, the Panel does not consider that the Complainant, who has legal representation, clearly ought to have known that it could not succeed under any fair interpretation of the facts. Accordingly, the Panel does not find that the Complaint was brought in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy

Presiding Panelist

/Anne-Virginie La Spada/

Anne-Virginie La Spada

Panelist

/Gerald M. Levine/

Gerald M. Levine

Panelist

Date: July 5, 2024