

## **ADMINISTRATIVE PANEL DECISION**

Protanium B.V. v. Lars Munksoe

Case No. D2022-0030

### **1. The Parties**

The Complainant is Protanium B.V., Netherlands, represented by DLA Piper Nederland N.V., Netherlands.

The Respondent is Lars Munksoe, Denmark.

### **2. The Domain Name and Registrar**

The disputed domain name <protanium.com> is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2022. On January 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 12, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 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 January 18, 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 January 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2022. The Response was filed with the Center February 7, 2022.

The Center appointed Luca Barbero, Tobias Cohen Jehoram and Knud Wallberg as panelists in this matter on March 4, 2022. 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 was incorporated on February 28, 2008 as part of the Accell Group, a European market leader in e-bikes, bicycle parts and accessories. The Complainant is currently fully owned by Accell Global B.V.

The Respondent was one of the shareholders (holding 20% of the shares) and a member of the board of the Complainant from 2008 to October 2015, when the Respondent left the company after executing a settlement agreement with the Complainant.

The Complainant is the current owner of several trademark registrations for PROTANIUM, including the following, as per trademark certificates submitted as annexes to the Complaint:

- Danish trademark registration No. VR 1995 00644 for PROTANIUM (figurative mark), filed on November 8, 1994 and registered on January 27, 1995, in classes 9, 11, 12 and 25;
- European Union trademark registration No. 006307516 for PROTANIUM (word mark), filed on September 25, 2007 and registered on September 11, 2008, in classes 9, 11, 12 and 25;
- United Kingdom (“UK”) trademark registration No. UK00906307516 for PROTANIUM (word mark), filed on September 25, 2007 and registered on September 11, 2008, in classes 9, 11, 12 and 25.

The disputed domain name <protanium.com> was registered on April 3, 2006 and is pointed to a website providing information about PROTANIUM products and history, although the last updates date back to 2014.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that disputed domain name <protanium.com> is identical to the trademark PROTANIUM in which the Complainant has rights as it reproduces the trademark in its entirety.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that (i) considering the trademark PROTANIUM was registered in 1995 and that the Respondent registered the disputed domain name on August 1, 2011, that (ii) the Respondent had full knowledge of the Complainant's intellectual property rights at the time of registering the disputed domain name; and that (iii) the Complainant owned a substantial intellectual property portfolio including patent rights registered by the Complainant but invented by the Respondent (who at the time was a board member and 20% shareholder of the Complainant), the Respondent does not have any rights in the disputed domain name.

Moreover, the Complainant contends that, following the settlement agreement between the Complainant and the Respondent dated October 2015, all rights and obligations between the Complainant and the Respondent ended, as the Respondent ceased to own any shares in the Complainant and was not licensed by the Complainant to use its intellectual property rights in any way.

The Complainant further submits that, before any notice of the dispute, the Respondent did not use, or make demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services, since the website at the disputed domain name does not offer any goods or services but merely refers to outdated and incorrect information on the presence of PROTANIUM at international trade shows dating back to March and August 2014. Moreover, the download page on the website only shows brochures dating from 2012 and 2013. Therefore, the Complainant asserts that the use of the disputed domain name does not show any credible investment in website development or promotional materials and does not constitute a *bona fide* offering of goods or services.

The Complainant also highlights that the Respondent is not commonly known by the disputed domain name and is not made fair use of the same because, by registering the disputed domain name and pointing it to a website providing information on the Complainant's history, philosophy, products and services, the Respondent has attempted to falsely suggest an affiliation with the Complainant.

Moreover, the Complainant points out that the website to which the disputed domain name resolves also provides information on other brands owned by the Accell Group, such as Sparta, Koga and Batavus, in which the Respondent has no rights.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent, as former board member and shareholder of the Complainant, registered the disputed domain name without the Complainant's consent but with full knowledge of the Complainant's intellectual property rights, as highlighted by the contents of the website, including information on the Complainant's history, philosophy, products and services as well as patent rights owned by the Complainant, not by the Respondent himself.

The Complainant emphasizes that, in light of the fact that the Respondent was a shareholder and board member of the Complainant and considering the prior relationship between the Complainant and the Respondent, the Respondent could not ignore the Complainant's trademark rights and even the Respondent's former capacity does not justify the use of the trademark PROTANIUM without the Complainant's consent.

The Complainant informs the Panel that the settlement agreement with the Respondent included an obligation on the Respondent to provide the Complainant with all necessary information regarding the affairs of the company, including information on intellectual property matters, but the Respondent never notified the Complainant of the ownership of the disputed domain name, nor did he ever hand over any relevant data on this topic to the Complainant which, according to the Complainant, constitutes both a violation of the settlement agreement and use of the disputed domain name in bad faith.

Furthermore, the Complainant asserts that the above is even more substantiated by the fact that the Respondent uses a privacy shield to cover its identity excluding himself from the need to comply with the abovementioned obligation.

The Complainant also states that the Respondent's conduct described above demonstrates that the Respondent is actively preventing the Complainant from reflecting its trademark in the corresponding domain name.

## **B. Respondent**

The Respondent denied all the Complainant's allegations, rebutting that he has always been the legitimate owner of the disputed domain name since April 2006 and that only for a certain period of time (specifically between March 2008 and October 2015) he granted the Complainant use of his domain name considering he was also a manager and shareholder of said company at that time.

The Respondent submits that the disputed domain name has always been (and still is) maintained and paid by himself and not by the Complainant, that he stopped working for the Complainant 6 years and 3 months

ago and that the Complainant owns its own official domain name <protanium.nl>, registered on March 25, 2016 but never used.

The Respondent disagrees with the Complainant's alleged exclusive rights on PROTANIUM based on trademark registrations in few countries and points out that many other people or companies in other countries have registered PROTANIUM as a trademark.

The Respondent indicates that, to his knowledge, the Complainant has stopped selling PROTANIUM branded products since shortly after he left the company 6 years and 3 months ago and submits that, therefore, the Complainant's trademarks are not currently in use.

The Respondent informs the Panel that, in view of the above non-use of trademark by the Complainant, the Respondent has filed, in the name of his company Lynx ApS, a European Union trademark application for PROTANIUM on January 31, 2022, as well as revocation applications against the Complainant's European Union and Danish trademark registrations for PROTANIUM.

The Respondent underlines that the date of incorporation of the Complainant was February 28, 2008 (as confirmed by the extract of the Chamber of Commerce in Annex 4 to the Complaint), which clearly proves that the disputed domain name, registered two years before, was not created with the Complainant in mind as claimed in the Complaint.

The Respondent also claims that, to the best of his knowledge, the Complainant has not been in business for many years and that the inactive company was finally sold in 2019 to focus on a different brand name and no longer on PROTANIUM branded goods.

The Respondent further contends that, considering the Complainant is no longer an active business and has not been for many years, it is highly unlikely that the Complainant should need the disputed domain name to conduct business, but more likely is aiming at obtaining the disputed domain name to sell it for a profit to the owner of the remaining activities of the Complainant, which would be the current beneficial owner of the company Protanium GmbH based in Switzerland.

## **6. Discussion and Findings**

According to paragraph 15(a) of the Rules: "A Panel shall decide a 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

### **A. Identical or Confusingly Similar**

The Complainant has provided evidence of ownership of trademark registrations for PROTANIUM in European Union, Denmark and United Kingdom, as mentioned under Section 4 above. Despite the Respondent's filing of revocation applications against the European Union and the Danish trademarks, they are both still registered at the time of the drafting of the Decision.

As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

In addition, as highlighted in section 1.7 of the [WIPO Overview 3.0](#), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

In the case at hand, the Complainant's word trademark PROTANIUM is entirely reproduced in the disputed domain name, with the mere addition of the Top-Level Domain ".com", which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

In light of the Panel's findings under the next section, it is not necessary to address the issue of whether the Respondent has rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

According to paragraph 4(a)(iii) of the Policy, the Complainant is required to demonstrate that the Respondent registered and is using the disputed domain name in bad faith.

As to bad faith at the time of the registration, the Panel finds that bad faith has not been sufficiently established by the Complainant, since its arguments concerning the rationale behind the registration are not convincing or plausible.

Indeed, the Complainant asserts that the Respondent registered the disputed domain name in bad faith, in 2011, since at that time he was a shareholder and board member of the Complainant and was thus aware of the Complainant's trademark rights.

However, according to the records, the disputed domain name was registered on April 3, 2006, whilst the Complainant was incorporated on February 28, 2008 (Annex 4 to the Complaint). The Complainant asserted that the Respondent registered the disputed domain name on August 1, 2011 but failed to provide any evidence to demonstrate that the disputed domain name was actually acquired by the Respondent on such date and not in 2006, as indicated by the Respondent.

In addition, the Complainant's European Union and UK trademarks were filed in September 2007, whilst according to the public records, its Danish trademark registration, filed in 1994, have been transferred from prior predecessors in rights to the Complainant in 2008.

The Panel also notes that the Respondent pointed the disputed domain name to a website providing information on the Complainant, its products, patent rights and history, including also reference to the foundation of PROTANIUM in 2006 by the Respondent and Brian Hoehl. As also highlighted by the Complainant, the website contains contents updated until 2014 - whilst the Respondent left the Complainant in 2015 -.

Therefore, the Panel finds that the Complainant has failed to demonstrate that the Respondent registered the disputed domain name in bad faith.

In view of the circumstances of the case, the Panel also finds that, on balance of probabilities, the Respondent, from 2008 when he joined the Complainant to 2015 when he left, maintained and used the disputed domain name for the purpose of promoting the PROTANIUM trademark and products.

Finally, the Panel notes that, considering the date of registration of the disputed domain name and the nature of the dispute between the parties, this is not a clear cybersquatting case to be handled according to the Policy but a complex dispute that should thus be more properly addressed in a civil Court.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Luca Barbero/*  
**Luca Barbero**  
Presiding Panelist

*/Tobias Cohen Jehoram/*  
**Tobias Cohen Jehoram**  
Panelist

*/Knud Wallberg/*  
**Knud Wallberg**  
Panelist  
Date: March 20, 2022