

ADMINISTRATIVE PANEL DECISION

Mr William Tindall, Escapade Silverstone v. Michael Altenberg, ROM AG
Case No. D2022-3551

1. The Parties

Complainant is Mr William Tindall, Escapade Silverstone, United Kingdom, represented by Michelmores LLP, United Kingdom.

Respondent is Michael Altenberg, ROM AG, Belgium.

2. The Domain Name and Registrar

The disputed domain name <escapade.com> (the “Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 26, 2022. On September 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on September 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 30, 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 Respondent of the Complaint, and the proceedings commenced on October 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 27, 2022. The Response was filed with the Center on October 26, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on November 17, 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. Procedural Issues

A. Identity and Standing of Complainant

The Panel notes that in the amended Complaint the identity of Complainant was changed from Mr. William Tindall, Escapade Silverstone to Escapade Silverstone Limited, namely from a natural entity to a legal entity. The Center invited Complainant to amend the Complaint in view of the information provided by the Registrar about Respondent, namely information that did not concern the identity of Complainant. While the Panel notes that this change in the identity of Complainant is not connected to the disclosure of the registrant details for the Domain Name, the Panel will proceed based on the amended Complaint.

B. Identity of Respondent

On October 3, 2022 and October 5, 2022, an individual sent, from the email address "[...].@rom.be", an email to the Center signing it as "brand manager" of "ROM AG" (in English ROM SA), a company seated in Belgium with VAT: 0441 826 783. Respondent's email address as appearing in the Domain Name Whols information provided by the Registrar is "[...].@rom.be" but is different from the sender of those emails. In the above email, the sender was enquiring on the amendment of contact details and information in relation to the Complaint and alleged that the Domain Name belongs to the entity ROM AG, seated in Belgium. He also stated that "our daughter company" 20cm S.A., seated in Luxembourg is the owner of European trademark 001277128 ESCAPADE. The email contains a forwarding by Respondent to this sender, of the email of the Center's Notice of Registrant Information. In this forwarded message, Respondent appears as "Leiter IT", namely "IT Manager" in English, of ROM AG with VAT: BE 0441 826 783. In the sender's email a copy of the above trademark registration was attached in German and English. On October 6, 2022, following a request for clarification by the Center, Respondent confirmed that the sender of the previous emails is a colleague of Respondent and "is handling this issue". In a second email of the same date Respondent stated *inter alia* the below:

- that he is employed by the company ROM SA seated in Belgium as IT-Manager;
- that the registration of the Domain Name was made for and on behalf of the company ROM SA; and
- that the sender of the previous emails is appointed as contact person for the dispute.

Given that the named Respondent is listed as the registrant of the Domain Name, in these circumstances, the Panel finds that it is the correct Respondent as the holder of the Domain Name registration (see paragraph 1 of the Rules). Furthermore, the Panel accepts the filing made by the sender, who has also filed the Response, who seems to have an interest in the Domain Name, and treats himself as Respondent and the term Respondent below shall also refer to him.

5. Factual Background

Per Complaint, the company Escapade Silverstone Limited is the owner of the United Kingdom trademark registration No. UK00003508503, ESCAPADE (word), filed on July 6, 2020, and registered on October 30, 2020, for goods and services in international classes 25, 37, 39, 41, 43 and 44.

The Domain Name was registered on February 26, 1999, and leads to an inactive website. Per Respondent, he registered the Domain Name in his own name but on behalf of his employer, the company ROM AG seated in Belgium.

Initially the company ROM AG seated in Belgium and subsequently the company 20cm S.A., seated in Luxembourg, have been the owners of the European Union trademark registration No. 001277128, ESCAPADE (word), filed on August 13, 1999, and registered on November 13, 2000, for goods in international class 20. The trademark is currently held by 20cm S.A.

On October 18, 2022, and October 26, 2022, the Center received an email communication from a person appearing as Head of Marketing & Communications, Escapade Silverstone, enquiring on an update. In the email to the Center dated October 26, 2022, of that person, Respondent is recognised as “having a specific trademark”. In the Response, it is acknowledged that Complainant was requested USD 65,000 in order to sell the Domain Name.

6. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

The sender of the above emails of October 3 and 5, 2022, submitted a response stating that ROM ag is the real Respondent, as the Domain Name was registered by Respondent on its behalf, that this company is a manufacturer of upholstered furniture since 1961, that ROM ag applied for the registration of ESCAPADE as a trademark in 1999 for goods in international class 20, renewing it continuously since the registration in 2020 and that in 1999 they also registered the Domain Name. Per the Response, the ownership of the trademark has been transferred between different companies of the same group, namely from ROM sa in Belgium to ‘20cm sa’ in Luxembourg.

In the Response it is also invoked and demonstrated that in the late 1990’ and the early 2000’, ROM ag has actively commercialized and promoted the brand ESCAPADE in Europe, through at least catalogues and that therefore it has legitimate interests to register the Domain Name.

Respondent further denies that there was any bad faith in the registration of the Domain Name.

Lastly, Respondent admits that there has been an offering to sell the Domain Name to Complainant “according to common market practices at a price of EUR 65,000”. This amount, per the Response, is justified by the fact that any chances of reactivating the formerly used brand “Escapade” in the future are given up.

7. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Domain Name incorporates Complainant’s trademark ESCAPADE in its entirety.

The generic Top-Level Domain (“gTLD”) “.com” is disregarded, as gTLDs typically do not form part of the comparison as they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is identical to the ESCAPADE mark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to [Respondent] of the dispute, [Respondent's] use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) [Respondent has] been commonly known by the Domain Name, even if [Respondent has] acquired no trademark or service mark rights; or
- (iii) [Respondent is] making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent has rights and legitimate interests in respect of the Domain Name.

Respondent has submitted a Response and has claimed and demonstrated such rights and legitimate interests with respect to the Domain Name.

Respondent namely demonstrated such rights prior to the notice of the dispute, namely a trademark registration of the name ESCAPADE in connection with a *bona fide* offering of goods or services, registered on November 13, 2020, for ESCAPADE. It has also demonstrated some use of the ESCAPADE name in catalogues in 1998 and in 2001.

The Panel finds that these circumstances confer upon Respondent rights and legitimate interests in respect of the Domain Name.

Complainant has not established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, are evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

Complainant has not demonstrated rights through registration and use on the ESCAPADE mark that are prior to the Domain Name registration. On the contrary, the date of registration of the Domain Name is prior to Complainant's invoked registered trademark rights. The Domain Name was registered on February 26, 1999, while the invoked trademark of Complainant was filed subsequently, namely on July 6, 2020. Where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent ([WIPO Overview 3.0](#), sections 3.8.1).

The Domain Name at the time of filing of the Complaint lead to an inactive page.

As regards the amount of USD 65,000 that Respondent acknowledges was requested in order to sell the Domain Name, the Panel finds that the amount as such is not enough to establish bad faith, in view of the time of registration of the Domain Name, the fact that some use was made of the brand name "Escapade" and the explanation provided by Respondent, that the amount reflects the giving up of the reactivation of the brand name "Escapade" by Respondent.

Under these circumstances and on this record, the Panel finds that Respondent has not registered and is not using the Domain Name in bad faith.

Complainant has not established paragraph 4(a)(iii) of the Policy.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Marina Perraki/

Marina Perraki

le Panelist

Date: December 1, 2022