

PANEL DECISION

iManage LLC, NetRight Spain Holdings S.L. v. Dieter Kann,
Cyberstore GmbH
Case No. DEU2024-0035

1. The Parties

The Complainants are iManage LLC, United States of America, and NetRight Spain Holdings S.L., Spain, represented by McDonald Hopkins LLC, United States of America ("US").

The Respondent is Dieter Kann, Cyberstore GmbH, Germany.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <imanager.eu> is the European Registry for Internet Domains ("EURid" or the "Registry"). The Registrar of the disputed domain name is Knipp Medien und Kommunikation GmbH.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 7, 2024. On November 8, 2024, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On November 12, 2024, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the "Supplemental Rules").

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 14, 2024. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was December 4, 2024. The Respondent did not submit any response by this deadline. Accordingly, the Center notified the Respondent's default on December 6, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on December 19, 2024. 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complaint has been submitted by two complainants (hereafter, collectively: "Complainant"). The first Complainant, iManage LLC, is a US software company. The second Complainant, NetRight Spain Holdings S.L., is a wholly-owned subsidiary of the first Complainant providing sales and software support services for the iManage computer software and related services in Spain.

The first Complainant owns numerous trademarks in IMANAGE, among which European Union Trademark No. 001771419 for IMANAGE, registered on November 21, 2001 in International Class 9.

The Complainant also owns the <imanager.com> and <imanageshare-eu.com> domain names comprising the mark IMANAGE.

The disputed domain name was registered on April 7, 2006, well after the first Complainant secured rights in the mark IMANAGE. The disputed domain name is not currently being used. The evidence submitted by the Complainant shows that the disputed domain name previously redirected to the third-party website "www.sedo.com" that buys and sells domain names and which purported to be willing to sell the disputed domain name for EUR 900. Moreover, the same evidence shows that the Respondent has previously used the disputed domain name to register the subdomain <fieldfisher-it-mobility-eu.imanager.eu>. Fieldfisher is a European law firm with multiple law offices in European Union countries and a customer of the Complainant.

The Respondent appears to be an Internet marketing company based in Frechen, Germany.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the three elements specified in Article 4(4) of Regulation (EU) 2019/517 (the "Regulation") and Paragraph B(11)(d) of the ADR Rules are present. The three elements being: (i) the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either; (ii) the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name; or (iii) the disputed domain name has been registered or is being used in bad faith.

(i) The disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law

The Complainant contends that it has rights to the mark IMANAGE and that they are well known for providing industry-leading document management software for businesses and law firms throughout the world, including in the European Union. Moreover, the Complainant asserts that the disputed domain name is identical or confusingly similar to the Complainant's IMANAGE mark because the disputed domain name consists of the IMANAGE Mark with the ".eu" country code Top-Level Domain (ccTLD) added to it. The Complainant notes that Panels agree that the presence of the ccTLD is irrelevant to the confusing similarity analysis and does not distinguish the domain name from the mark contained therein.

(ii) The disputed domain name has been registered by the Respondent without rights or legitimate interest in the name

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since it is not commonly known by the disputed domain name and the Complainant has not licensed or permitted the Respondent to use the IMANAGE mark. In addition, the Complainant asserts, the Respondent does not currently use the disputed domain name and previously offered the disputed domain name for sale for an amount of EUR 900, which exceeds the Respondent's out-of-pocket expenses. Moreover, the Complainant points out that the Respondent previously used the disputed domain name to register the

subdomain <fieldfisher-it-mobilityeu.imanage.eu> in an apparent attempt to try and confuse Fieldfisher or others into believing that the Respondent is the Complainant, likely as a phishing scam to make money illegally. According to the Complainant, such improper prior use of the disputed domain name is further evidence of no rights or legitimate interests in the disputed domain name. Finally, the Complainant notes that the mark IMANAGE is a made-up word and has no meaning other than the Complainant's trademark. Thus, the Complainant claims, there is no reason for the Respondent to register or use the disputed domain name except for a bad faith intent to profit from use of the Complainant's longstanding and well known IMANAGE mark, such as by confusing people into thinking emails or websites using the disputed domain name originate from or are associated with the Complainant or to extract money from the Complainant.

(iii) The disputed domain name has been registered or is being used in bad faith

The Complainant claims that IMANAGE is a made up word and has no meaning other than the Complainant's trademark. Accordingly, the Complainant notes, there would be no reason for the Respondent to register or use the disputed domain name except for a bad faith intent to profit from use of the Complainant's IMANAGE mark, such as by confusing people into thinking emails or websites using the disputed domain name originate from or are associated with the Complainant or to extract money from the Complainant. Currently, the disputed domain name is not being used. However, the Complainant points out that the Respondent previously used the disputed domain name to redirect to the third-party website "www.sedo.com" that buys and sells domain names and which purported to be willing to sell the disputed domain name for EUR 900, which exceeds the Respondent's out-of-pocket expenses. Neither using the disputed domain name (which consists of the Complainant's IMANAGE mark and the ".eu" ccTLD) to redirect to a third-party site nor offering to sell the disputed domain name for more than the Respondent's out-of-pocket expenses constitutes a bona fide right or interest, according to the Complainant. Moreover, the Complainant points out that the Respondent previously used the disputed domain name to register the subdomain <fieldfisher-it-mobilityeu.imanage.eu> in an apparent attempt to try and confuse Fieldfisher or others into believing that the Respondent is the Complainant, likely as a phishing scam to make money illegally. According to the Complainant, such improper use of the disputed domain name further evidences that the disputed domain name is being used in bad faith. In addition, the Complainant notes, the Respondent's use of the Complainant's customer's unique name ("Fieldfisher") in a subdomain further evidences that the Respondent is aware of the Complainant's IMANAGE mark, its business, and its customers, and must intend to deceive others into believing the Respondent is the Complainant. Finally, the Complainant claims that the TLS certificate history and MX record for the disputed domain name and its subdomains indicate that the disputed domain name has been or has a high likelihood of being used in bad faith for illegal purposes, including phishing emails.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, the Center received an email from the Respondent on December 19, 2024, two weeks after the due date for a Response. The email stated the following:

"Hello,

in order to avoid a legal dispute, we have given up the domain imanage.eu.

We are no longer the owner of the domain.

The deletion of our ownership took place on 27. of September 2024.

We are no longer involved in this process.

For us, the case is now closed.

We do not want to keep this domain!"

6. Discussion and Findings

A. Consolidation of the Complaint

The Panel notes that the Complaint was filed by two Complainants. The Panel is therefore required to decide whether it will permit this consolidation of the Complaint (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1).¹

The Panel finds that the Complainants have a common grievance against the Respondent since the second Complainant is a wholly-owned subsidiary of the first Complainant. Moreover, the first Complainant owns the IMANAGE trademarks that this Complaint relies on, and the second Complainant uses these trademarks within the European Union. Furthermore, only the second Complainant satisfies the general eligibility criteria for registration set out in Article 3 of Regulation (EU) 2019/517, which is necessary for transfer of the disputed domain name in case of a favourable decision. Finally, considering these facts, the Respondent's failure to submit any response to the Complaint, and its email to the Center stating that it does not wish to keep the disputed domain name, the Panel believes that it would be equitable and procedurally efficient to permit the consolidation.

Accordingly, the Panel permits the consolidation of the Complaint.

B. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Complainant is required to establish: (1) that it owns a right or rights that are recognized or established by national law of a Member State and/or European Union law in a name and, if so, (2) that the disputed domain name is identical or confusingly similar to this name.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns rights in IMANAGE that are recognized or established by national law of a Member State and/or European Union law since it is the owner of registered European Union trademark rights in IMANAGE.

Secondly, the Panel finds that the disputed domain name is identical to the Complainant's registered trademarks since it consists of the IMANAGE mark in its entirety without the addition of any additional terms (see [WIPO Overview 3.0](#), section 1.7).

Finally, as for the applicable ccTLD, *i.e.*, the suffix ".eu", the Panel holds that this can be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#), as well as for instance *CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#)).

On the basis of the foregoing findings, and according to Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules, this Panel finds and concludes that the disputed domain name is identical to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law.

C. Rights or Legitimate Interests

Paragraph B(11)(e) of the ADR Rules non-exhaustively lists three circumstances that if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights to or legitimate interests in the disputed domain name for the purposes of Paragraph B11(d)(1)(ii) of the ADR Rules:

¹ Considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Panel also refers to UDRP case law and analysis, where appropriate.

- (1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
- (2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or European Union law;
- (3) the Respondent is making legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in respect of which a right is recognized or established by national law and/or European Union law.

In addition, Paragraph B11(d)(1) of the ADR Rules provides that the Complainant has the burden of proof that the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name. However, it is a well-established view in UDRP and case law under the ADR Rules that a prima facie case advanced by a complainant is generally sufficient to satisfy this burden and the burden of production then shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the present case, taking into consideration the Respondent's default above-mentioned factual background, and the factors mentioned below, the Panel finds that the Complainant has made out an un rebutted prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel agrees with the Complainant that there is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. On the contrary, the Respondent does not currently use the disputed domain name. Furthermore, the evidence on record indicates that the Respondent previously offered the disputed domain name for sale for an amount of EUR 900, which more likely than not exceeds the Respondent's out-of-pocket expenses. Moreover, the Complainant has shown that the Respondent previously used the disputed domain name to enable the subdomain <fieldfisher-it-mobility-eu.imanage.eu>. The Panel notes that the Respondent did not provide any explanation as to the reason for the enabling of such subdomain, and no explanation is apparent for the Panel, except as pointed out by the Complainant in an apparent attempt to try and confuse Fieldfisher or others into believing that the Respondent is the Complainant, likely as a phishing scam to make money illegally. This kind of use of the disputed domain name can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), Sections 2.5.2 and 2.13.1, as well as *Asurion, LLC v. Charles Reed*, WIPO Case No. [D2024-2937](#)).

In addition, the Complainant asserts the Complainant has not licensed or permitted the Respondent to register domain names incorporating the Complainant's IMANAGE trademarks. The Panel has taken note of the Complainant's confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

The Panel also agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name.

Finally, it should also be mentioned that the nature of the disputed domain name, which is identical to the Complainant's IMANAGE mark, carries a high risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name.

D. Registered or Used in Bad Faith

Under Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules a complaint will succeed if a complainant either proves that the Respondent registered the disputed domain name without rights or legitimate interests in the name or that the registration or use of the disputed domain name are in bad faith. Since the Panel has already found that the Respondent lacks rights or legitimate interests in the disputed domain name there is strictly speaking no need for a discussion of bad faith registration or use. The Panel will nonetheless briefly discuss the circumstances and evidence presented by the Complainant.

In the present case, the Panel notes that the Respondent previously offered the disputed domain name for sale for an amount of EUR 900, which more likely than not exceeds the Respondent's out-of-pocket expenses. This indicates that the registration of the disputed domain name was made in bad faith (Paragraph B11(f)(1) ADR Rules).

In addition, the fact that the disputed domain name is identical to the Complainant's IMANAGE mark and the Respondent's apparent use of the Complainant's customer's unique name ("Fieldfisher") in a subdomain further evidences an intent to deceive others into believing the Respondent is the Complainant. Intentionally using the disputed domain name to attract Internet users for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with a name in respect of which a right is recognised or established by national and/or European Union law, with such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location of the Respondent is another strong indicator of bad faith (Paragraph B11(f)(4) ADR Rules).

Paragraph B11(f) of the ADR Rules sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's IMANAGE trademark. This is another indicator of bad faith (see [WIPO Overview 3.0](#), section 3.2.2). As demonstrated by the Complainant, one of the IMANAGE trademarks was registered many years before the registration of the disputed domain name in several countries including in the European Union and therefore with effects in Germany, the country of residence of the Respondent according to the Whois records. Moreover, the Respondent's use of the Complainant's customer's unique name ("Fieldfisher") in a subdomain further evidences that the Respondent was aware of the Complainant's IMANAGE mark, its business, and its customers at the time of registration of the disputed domain name.

Furthermore, the Respondent used the Complainant's customer's unique name ("Fieldfisher") in a subdomain and the TLS certificate history and MX record for the disputed domain name indicate that the disputed domain name has been or has a high risk of being used in bad faith for illegal purposes, including phishing emails. Panels have held that the use of a domain name for illegitimate or illegal activity, here claimed impersonation/passing off of the Complainant, constitutes bad faith (see [WIPO Overview 3.0](#), section 3.4).

Finally, the fact that the disputed domain name is no longer being used, does not prevent this finding. It is a well-established view of panels, including in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding (see also Section 3.3 of the [WIPO Overview 3.0](#)). The Panel agrees with this view and finds that since the Respondent has not submitted any evidence of good faith use and the Respondent has used the disputed domain name in bad faith before, it is implausible that the disputed domain name will be put to any good faith use in the future.

In light of the above, the Panel finds that the disputed domain name was registered and is being used by the Respondent in bad faith and that therefore the condition set out in Article 4(4)(b) of the Regulation and Paragraph B(11)(d)(1)(iii) of the ADR Rules has also been satisfied.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name, <imanager.eu>, be transferred to the second Complainant, NetRight Spain Holdings S.L. The second Complainant satisfies the general eligibility criteria for registration set out in Article 3 of Regulation (EU) 2019/517 since it is an undertaking that is established in the Union (Article 3(c)).²

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: January 2, 2025

² The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.