

By E-mail: domain.disputes@wipo.int

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Our Ref. 1682/09 KJ-GE (please always quote)

26 January 2010

Amendment to Complaint in Case No.

D2010-0016

mydhl.com

DHL Operations B.V.
Gebouw Office Center
Jozef Israelskade 48 G
1072 SB Amsterdam
The Netherlands

(Complainant 1)

DHL International GmbH
Charles-de-Gaulle-Straße 20
53113 Bonn
Germany

(Complainant 2)

Rechtsanwälte:

Kay Uwe Jonas * **
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* Geschäftsführer
** Fachanwalt für
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Disputed Domain Name:

-v-

mydhl.com

Eric White
108 N 2nd St.
Wrightsville
Pennsylvania 17368
USA

(Respondent)

Amtsgericht Köln
HRB 59300

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We wish to make the following amendments to the Complaint dated 5 January 2010:

A. **The domain name is identical or confusingly similar to Complainants' Trademarks, Trading Name and Domain Names**

(Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1))

Respondents allegations do not change the Complainants' assertion that the domain name **mydhl.com** is confusingly similar to the aforementioned Complainants' trademarks, domain names and company name "DHL" set out in the Complaint under Section V.A.

The American and Canadian case law, Respondent is citing in his Response, is not at all relevant in this case. The same applies to the cited UDPR case No. 2004-0648. "Sallie Mae" and "Sallie" being not confusingly similar does not affect the disputed domain name **mydhl.com**, i.e. the present case. Furthermore, it is only relevant that the Respondent registered the domain name **mydhl.com** in 2003 as Respondent registered the domain name and is using it in bad faith. However, Complainants have to contest the allegation, the domain name had been registered before (Annex C).

After receipt of Complainants letter, dated 23 December 2009 and the Complaint, dated 05 January 2010, Respondent changed the content of the webpage connected to the disputed domain name and now thinks he may fool the Panel to believe the webpage contained the alleged contend beforehand which is not the case (**see forthwith below**).

Nevertheless, it remains that consumers and Internet users will be confused and misled into thinking that the domain name **mydhl.com** belongs to Complainants and that by typing the domain name in the address line of the browser they will be linked to the website of Complainants, whereas in fact they are not. The use of the domain name **mydhl.com** itself by Respondent for it's own business, regardless of whether or not it is used as a website or for correspondence, will set up a false assumption with other internet users that the owner of this domain is, or is at least economically connected or affiliated with, Complainants and, therefore, will cause confusion to such users. Thus, the Respondent has furthermore no legitimate interest in the domain as he only tries to divert traffic from Complainants' websites (see also forthwith below).

B. **The domain Name was registered and is being used in Bad Faith**

(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

- 1 Further evidence the disputed domain **mydhl.com** was not only registered but is also used in bad faith by the Respondent is evidenced by the internet-printout from the website connected to the disputed domain name (attached as **Annex 14**) of **December** and **25 November 2009**, the domain is currently parked, showing "DHL" sponsored listings which

the Complainants hat just recently found out (see Annex 13). The same occurred in 2008 as shown by the internet-printout from the website connected to the disputed domain name on **08 June 2008** (attached as **Annex 15**), retrieved via the "WayBackMachine" under "archive.org". The printouts and screenshots were made by the undersigned representative Gabriele Engels. Their correctness is legally affirmed by the undersigned.

The non-use of this domain in combination with the absence of legitimate interest reveals the domain was registered in bad faith. Thus, in WIPO decision Ceyx Technologies v. CeysCom of 9 July 2001, Case No. D2001-0681, it was held, that

"the opinion of this Panel that Respondent has been "parking" the contended domain name with the knowledge that it infringes the trademark of another", which constitutes evidence of bad faith, according to Little Six, Inc. d/b/a Mystic Casino Hotel v. Domain For Sale a/k/a Anatoly Polishchuk, Case No. FA103000096967 NATIUNAL ARBITRATION FROUM, April 20, 2001."

Moreover, this parking website provides several sponsored links to commercial websites mostly of competitors of the Complainant in the filed of transport and shipping services such as "speedpack.eu" (SPEEDPACK fast delivery), "ecoparcel.eu" (European Courier Service) and "smart-post.eu" (SmartPOST SOLUTIONS). This facts makes it obvious that Respondent is aware of both the Complainant's trademarks and its activities. The maintenance of a domain name which is – as established above – confusingly similar to Complainant's trademarks and company name in order to divert internet users to websites of companies who compete with the Complainant clearly has to be considered as a use of the domain name at issue in bad faith according to paragraph 4 (a) (iii) of the ICANN Policy.

In UDRP case *Aktiebolaget Electrolux v. 2220 Internet Coordinator*, WIPO case D2005-1184 – *electroluxkelvinator.com* – (attached as **Annex 16**) the Panel attested a registration and use of respective domain name "electroluxkelvinator.com" since

"the Respondent registered the domain name due to the considerable value and goodwill of the trademarks ELECTROLUX and KELVINATOR and in order to take advantage of the two trademarks by generating traffic to the Respondent's website containing sponsored links. These circumstances strongly suggest that the domain name was registered and has been used in bad faith."

That directing potential costumers to competitors of the Complainant by using a domain name confusingly similar to a trademark the Complainant has rights in is a strong evidence for registration and use in bad faith, can be regarded as settled legal practice in WIPO decision. Correspondingly, in *National City Corporation v. MH Networks LLC*, Case D2004-0128 - *national-city-mortgage.com* – the Panel held:

“Numerous panels have held that using a domain name confusingly similar to a complainant’s mark to link to a website of the complainant’s competitor constitutes “bad faith” under the Policy. See, e.g. Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319 (February 1, 2002) (“[R]egistration and use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy.”); Netwizards, Inc. v. Spectrum Enterprises, WIPO Case No. D2000-1768 (April 4, 2001) (“[R]egistration and continued use of the contested domain name for re-directing Internet users, i.e. particularly customers and potential customers of the Complainant, from the Complainant’s website to the website of . . . a company which directly competes with the Complainant, constitutes bad faith registration and use.”); Zwack Unicom Ltd v. Duna, WIPO Case No. D2000-0037 (March 10, 2000) (respondent’s linking to complainant’s competitor held to constitute bad faith); Oly Holigan, L.P. v. Private, Case No. FA0011000095940 (N.A.F. December 4, 2000) (finding bad faith where respondent used the disputed domain name to “redirect[] the Complainant’s consumers and potential consumers to commercial websites which are not affiliated with Complainant”); Marriott International, Inc. v. Kyznetsov, Case No. FA0009000095648 (N.A.F. October 24, 2000) (finding bad faith where respondent registered the domain name <marriottrewards.com> and used it to route internet traffic to another website that “promotes travel and hotel services . . . identical to the services offered by the Complainant”).”

Since this conclusion also applies to the present case, the fact that Respondent attracts Internet traffic and diverts it to websites offering services of Complainants’ competitors by using a confusingly similar domain name for a parking page that provides sponsored links is evidence of bad faith under paragraph 4(b)(iv) of the Policy.

- 2 Further evidence the disputed domain **mydhl.com** was not only registered but is also used in bad faith by the Respondent is evidenced by the Respondent **changing the content** of the internet webpage connected to the disputed domain name **mydhl.com** after having received the Complainants’ letter of 23 December 2009 and the Complaint on 06 January 2010. Respondent’s internet printout (Annex A) is dated, 16 January 2010, i.e. **after** the receipt of Complainants’ letter of 23 December 2009 and the Complaint on 06 January 2010. Annex A is thus **not proving Respondent’s allegations**, but only showing that Respondent changed the content of the website connected to the disputed domain name after having received the Complainants’ letter of 23 December 2009 and the Complaint on 06 January 2010, so that the Panel would believe, the webpage had this content by the time of Complainants’ cease and desist letter. Annex D is as well not providing evidence in this respect as it is not showing the content of the website connected to the disputed domain name **mydhl.com**. Furthermore, Complainants’ deny that Annex F shows

the website connected to the domain name after registration in 2003. First, the page does not seem to be an internet printout and does not show any relevant content of the webpage. Secondly, the date (January 2010) and content (Ms. (Mr.?) Clinton) shown is the same as in Annex A. It is obvious, that both printouts were generated after 06 January 2010.

- 3 In this context, it has to be pointed out that Respondent cannot deny having received Complainants' letter of 23 December 2009 by facsimile and e-mail. It is a blunt defensive maneuver alleging he did not receive the letter. These allegations are untrue as proven by the Complainants.

It has to be stressed that Complainants' letter of 23 December 2009 was sent to the Respondent by e-mail to ejwhite@inetconnect.com, **and** via facsimile to the number indicated under Section II. 2 of the Complaint. The **transmission report** of 23 December 2009 was attached as **Annex 13**, proving that the Respondent received the letter on the morning of 23 December 2009. Moreover, as today (attached as **Annex 17**) Respondents' same contact information, including fax number and email address, Complainants sent their letter to, are provided by the concerned registrar's Whois database search for the disputed domain name **mydhl.com** on 25 January 2010 (after being updated on 2 January 2010) as it was on 23 December 2009 (see: Annex 2). There is no sign the Respondent moved offices or changed his contact details. Anyway, it is Respondents obligation to provide for the right and updated Whois contact information.

Furthermore, the e-mail as well was delivered to Respondent's email address ejwhite@inetconnect.com on 23 December 2009 just fine. There was no error/failure message.

Therefore, **until 6 January 2010** (Annex 13), the day of the transmission of the Complaint to the Center, the Respondent failed to show **any reaction** to Complainants' letter, not even asking for an extension of time for providing a statement to the Complainants' representatives. Thus, the Respondent had **2 weeks** to respond to Complainants' letter of 23 December 2009, which is more than enough time under the circumstances that Respondent provided a currently parked, commercial website connected to the disputed domain name, showing "DHL" sponsored listings to commercial websites of competitors of the Complainant in the filed of transport and shipping services.

Additional evidence, the Respondent received the letter of 23 December 2009 is shown by the Respondent's behavior. Just having sent the Complaint to Respondent's e-mail address ejwhite@inetconnect.com on 6 January 2010, the Respondent **immediately** answered the Complainants' representatives by e-mail from his e-mail-address ejwhite@inetconnect.com (attached as **Annex 18**) claiming it to be a political protest side. Thus, he received both e-mails, dated 23 December 2009 and 06 January 2010 just fine as well as the facsimile, dated 23 December 2009.

Respondent's attorney-at-law might as well stop his insults towards the Complainants' representatives as it is not helping his client. Complainants' proved that Respondent received the letter, dated 23 December 2009 via e-mail and facsimile and failed to respond to it for

two weeks. Thus, the disputed domain mydhl.com was not only registered but is also used in bad faith by Respondent as pointed out under Section V.C.4 of the Complaint.

- 4 Moreover, **Annexes 14 and 15** clearly show on the one hand that the website connected to the disputed domain name was **not at all** used as a political protest site throughout 2009 and 2008 and right before issuing the Complaint, dated 05 January 2010. It was used as a parked, commercial website by providing several sponsored links to commercial websites of competitors of the Complainant. On the other hand **Annexes 14 and 15** clearly show that the Respondent's statement, dated 19 January 2010 (Annex B), is untrue especially under no. 9, nos. 12 ff.. The website was parked during the last years, showing "DHL" sponsored listings. The Respondent changed the content of the webpage after having received the Complainants' letter of 23 December 2009. Bearing this in mind, the Complainants have to contradict the whole Declaration of Respondent, dated 19 January 2010, and that the webpage has ever been used as a protest page. Complainants' additionally reserve their right to press criminal charges against the Respondent.
- 5 Bearing all this in mind - the registration of a worldwide famous trademark in order to attract internet users, the lack of any rights or legitimate interests in respect of the domain name, clearly given an (at least partially) untrue statement about the website connected to the disputed domain name and the failure to respond to the cease and desist letter, and the lack of any plausible actual or contemplated use of the domain name by Respondent that would not be illegitimate, there is no doubt that the Policy's requirements of a registration and use of the domain name **mydhl.com** in bad faith are fulfilled.
- Thus, we respectfully request the Panel to grant the remedy as requested under Section VI. of the Complaint.

X. Communications

(Rules, paras. 2(b), 3(b)(xii); Supplemental Rules, paras. 3, 4)

A copy of this letter has been sent on **26 January 2010** to Respondent electronically by e-mail to the Respondent's email address ejwhite@inetconnect.com and postmaster@mydhl.com as well as his attorney-at-law Mr. Marc Randazza to mjrpa@me.com.

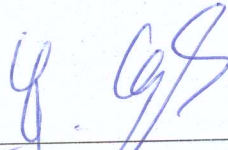
A copy of this Complaint has been sent to the concerned registrar on **26 January 2010** to the email address domaindisputes@godaddy.com.

For and on behalf of
DHL Operations B.V. and DHL International GmbH

Respectfully submitted,



Kay Uwe Jonas
Attorney-at-Law
Jonas Rechtsanwaltsgesellschaft mbH



Gabriele Engels
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Cologne, 26 January 2010

LIST OF ANNEXES

- Annex 14:** Internet-printouts of the web page connected to the domain name in dispute of December 2009 and 25 November 2009.
- Annex 15:** Internet-printout of the web page connected to the domain name in dispute of 08 June 2008.
- Annex 16:** UDRP case *Aktiebolaget Electrolux v. 2220 Internet Coordinator*, Case No. D2005-1184 – electroluxkelvinator.com
- Annex 17:** Printouts from the concerned registrar's Whois database search for the disputed domain name "mydhl.com" of 25 January 2010.
- Annex 18:** Respondent's e-mail, dated 06 January 2010.