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

5 January 2010

Before the:

WORLD INTELLECTUAL PROPERTY ORGANIZATION ARBITRATION AND MEDIATION CENTER

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)

Disputed Domain Name:

-v-

mydhl.com

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

(Respondent)

Rechtsanwälte:

Kay Uwe Jonas ***
Dr. Martin Viefhues *
Karl Hamacher *
Dr. Nils Weber ***
Katja Grabienski **
Dr. Jan Schumacher
Hanna Karin Held
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** Fachanwalt für
gewerblichen Rechtsschutz

Amtsgericht Köln
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COMPLAINT

(Rules, para. 3(b))

I. Introduction

This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999 and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

1. The Complainants

(Rules, para. 3(b) (ii) and (iii))

- 1.1** The Complainants are affiliated companies. Complainant 1 in this administrative proceeding is DHL Operations B.V., a corporation established on August 13, 1979, having its seat and its principal place of business in Amsterdam, the Netherlands. Complainant 2 has its business seat and its principal place of business in Bonn, Germany. Complainants' group of companies has currently some 500.000 employees in more than 220 countries and territories. The trademarks used by the Complainants' group/affiliated companies all over the world are mainly registered in the name of Complainants 1 and 2, as stated, e.g., in the group's advertising sheets enclosed as **Annex 1**.
- 1.2** As affiliated companies both Complainants have a common interest in the domain name "mydhl.com" as they seek to protect the numerous trademark rights in the designation DHL which are registered in the name of either Complainant 1 or Complainant 2 (see under Sec. V. A.).
- 1.3** Complainant 1's contact details are:

Address: Jozef Israelskade 48 G, 1072 SB Amsterdam, the Netherlands
Telephone: + 31 20 3051800
Fax: + 31 20 3051801
E-Mail: Benjamin.Heinke@deutschepost.de

Complainant 2's contact details are:

Address: Charles-de-Gaulle-Straße 20, 53113 Bonn, Germany
Telephone: + 49 228 18236776
Fax: +49 228 1827039
E-Mail: Benjamin.Heinke@deutschepost.de

1.4 Complainants' authorized representative in this administrative proceeding is:

Attorneys-at-Law

Law Firm: JONAS Rechtsanwaltsgesellschaft mbH
Address: Hohenstaufenring 62, 50674 Cologne, Germany
Telephone: + 49 (0) 221 277 58 0
Fax: + 49 (0) 221 277 58 1

The lawyers responsible for this matter are Kay Uwe Jonas and Gabriele Engels.

E-Mail: jonas@jonas-lawyers.com; engels@jonas-lawyers.com

1.5 Complainants' preferred method of communications directed to Complainants in this administrative proceeding is e-mail to jonas@jonas-lawyers.com for electronic-only material and courier for hardcopy material, sent to JONAS Rechtsanwaltsgesellschaft mbH, attn. Kay Uwe Jonas, at the address given in paragraph 1.4.

2. Respondent

(Rules, para. 3(b)(v))

According to the concerned Registrar's Whois database at "godaddy.com", Respondent in this administrative proceeding is:

Eric White

Extracts from the Whois database search conducted on 23 December 2009 are provided as **Annex 2**. Based on this, all information known to Complainants regarding how to contact the Respondent is as follows:

Name: Eric White
Address: 108 N 2ND ST
Wrightsville
Pennsylvania 17368
USA
Telephone: +1.07174173344
Fax : +1.07174173344
Email: ejwhite@inetconnect.com.

The administrative and technical contact details are the same as above.

III. The Domain Name and Registrar

(Rules, para. 3(b)(vi) and (vii))

- 1 This dispute concerns the domain name identified below:

mydhl.com

- 2 The registrar with which the domain name is registered is:

GoDaddy.com, Inc

According to the Descriptions and Contact Information for ICANN- Accredited Registrars the concerned registrar's contact details are as follows:

GoDaddy.com, Inc. (United States)
http://www.godaddy.com
Tim Ruiz
Tel: +1 480 505 8800
E-mail: tim@godaddy.com

The Registrar's website www.godaddy.com indicates the following contact details:

Address: 14455 N. Hayden Rd.
Suite 219
Scottsdale, AZ 85260
USA
Telephone: +1 480 505 8800
Fax: +1 480 505 8844

IV. Jurisdictional Basis for the Administrative Proceeding

(Rules, paras. 3(a), 3(b)(xv))

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name **mydhl.com** that is subject to this Complaint is registered, incorporates the Policy and is in English. A true and correct copy of the domain name registration agreement (as provided on the website www.godaddy.com) that applies to the domain in question is attached as **Annex 3** to this Complaint. Consequently, according to the Rules the language of the proceeding is English.

In addition, in accordance with the Policy, Paragraph 4 (a), Respondent is required to submit to a mandatory administrative proceeding, because:

- (1) The domain name **mydhl.com** is identical or confusingly similar to a trademark or service mark in which Complainants have rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name **mydhl.com**; and
- (3) The domain name **mydhl.com** was registered and is being used in bad faith.

V. Factual and Legal Grounds

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

This Complaint is based on the following grounds:

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))

1 Complainants' Trading Names

Complainants' trading names are "DHL Operations B.V." respectively "DHL International GmbH" or, in short, "DHL".

Complainant 1's company was registered in the Company Register under No. 33157351 by the Amsterdam "Kamer van Koophandel" on August 13, 1979. According to this registration, the subject of Complainant 1's business is:

"All kind of transport services by land, sea and air"

A true and correct copy of the Company Register is provided as **Annex 4a**. Further translation can be provided upon request.

Complainant 2's company was registered in the Company Register under No. HRB 13678 by the "Amtsgericht Bonn" (Local Court Bonn) on April 11, 2005. According to this registration, the subject of Complainant 2's business is:

"Coordination, support and maintenance of networks for rendering logistic services, especially courier and express delivery"

A true and correct excerpt from the Company Register is provided as **Annex 4b**. Further translation can be provided upon request.

Founded in San Francisco almost 40 years ago, DHL has continued to expand at a phenomenal rate. Today, it stands tall as the global market leader of the international express and logistics industry. In 2002, Deutsche Post AG became the sole shareholder in the DHL group before consolidating all of its express and logistics activities into one single

brand in 2003: DHL. The brand was further strengthened by the acquisition of Excel in December 2005.

DHL is now one of the major logistics brands worldwide. Complainants' group (since 2009 operating under the brand name "Deutsche Post DHL") is the world's largest express provider and involves supply logistics, warehousing, distribution logistics, global airfreight and ocean freight, project freight forwarding and European overland transport service.

2 Complainants' Trademarks

Complainants (both Complainants 1 and 2 are hereinafter referred to as "Complainants") - and their affiliates - are the sole legal holders of numerous trademarks worldwide which consist of the designation "DHL" or contain this designation as a significant component.

These trademarks cover a large range of goods and services, inter alia transportation of documents, goods and parcels by land, sea and air, express courier services, packaging and storage of goods, delivery of goods, freighting, shipping, sacks, namely sacks for transporting packages and documents, cardboards and paper boxes used for packaging, adhesive labels, stationeries, cardboard tubes and envelopes, wall hangings, namely maps, posters and calendars, promotional clothing, customs brokerage services and forwarding of cargo.

By way of example, details of the trademark registrations in various countries are set out below:

2.1 German Trademark Registrations

1146023 DHL WORLDWIDE EXPRESS in class 39 (filing date 28/08/1986)
2065293 DHL in class 39 (filing date 18/05/1992)
653698 DHL in class 39 (filing date 01/02/1990)

2.2 European Community Trademark Registrations

208876 DHL WORLDWIDE EXPRESS in classes 16, 35, 39 (filing date 01/04/96)
3056421 DHL in classes 35, 36, 39 (filing date 17/02/2003)
3492311 DHL in classes 16, 20, 35, 36, 38, 39, 42 (filing date 31/10/2003)
3493954 DHL EXPRESS in classes 16, 36, 39 (filing date 31/10/2003)
3519634 DHL FREIGHT in classes 16, 36, 39 (filing date 31/10/2003)
3865136 DHL in classes 16, 36, 39 (filing date 01/06/2004)
4183976 DHL in classes 18, 25, 28 (filing date 09/12/2004)

2.3 US Trademark Registrations (registered in the name of Complainant's affiliated company Deutsche Post AG)

1398896 DHL in class 39 (filing date 02/12/1985)

2827803 DHL in class 39 (filing date 14/10/2002)
3174845 DHL in class 16, 35, 36, 39 (filing date 04/03/2004)
3174839 DHL in class 16, 20, 35, 36, 38, 39, 42 (filing date 27/02/2004)
3329095 DHL in class 28 (filing date 04/05/2005)

2.4 International Registrations (including the US)

773127 DHL MIDDAY EXPRESS claimed in 20 countries in class 39 (filing date 09/01/2002)
835140 DHL claimed in 38 countries in classes 16, 20, 35, 36, 38, 39, 42 (filing date 29/04/2004)
841763 DHL claimed in 44 countries in classes 16, 36, 39 (filing date 31/08/2004)
860071 DHL claimed in 32 countries in class 28 (filing date 18/04/2005)
836678 DHL SOLUTIONS claimed in 37 countries in classes 16, 35, 36, 39 (filing date 29/04/2004)
836679 DHL EXPRESS claimed in 35 countries in classes 16, 35, 36, 39 (filing date 29/04/2004)
836946 DHL FREIGHT claimed in 36 countries in classes 16, 35, 36, 39 (filing date 29/04/2004)
874743 DHL GLOBAL MAIL claimed in the EU and 10 other countries in classes 35, 36 and 39 (filing date 06/07/2005)

2.5 Australian Trademark Registrations

445410 DHL in class 39 (filing date 16/05/1986)
860775 DHL DELIVERS MORE in class 39 (filing date 14/12/2000)
980819 DHL in class 39 (filing date 03/12/2003)

2.6 Canadian Trademark Registrations

255297 DHL in class 39 (filing date 10/03/1980)
360527 DHL in class 39 (filing date 15/05/1986)
710045 DHL in classes 16, 20, 35, 36, 38, 39, 42 (filing date 11/03/2004)

2.8 United Kingdom Trademark Registrations

1278479 DHL in class 39 (filing date 01/10/1986)
1278480 DHL in class 39 (filing date 01/10/1986)
1410607 DHL in class 38 (filing date 16/01/1990)
2357432 DHL in class 16, 20, 35, 36, 38, 39, 42 (filing date 03/03/2004)

Databank excerpts of the aforementioned German, Community, US, International, Australian, Canadian and UK trademark registrations are enclosed as **Annex 5a**.

A complete list of Complainants' German, Community and International Registrations including the term "DHL" is enclosed as **Annex 5b**.

3 Domain Names

Complainants' group of companies is owner of various domain names including the mark "DHL" such as **www.dhl.co.uk** (registered by DHL World-Wide Express UK on 13/01/1997), **www.dhl.ch** (registered by DHL Express (Schweiz) AG, Basel, Switzerland), **www.dhl.net**, **www.dhl.de** as well as of the Global web site available under **www.dhl.com** (the last three registered by Complainants' parent company Deutsche Post AG, Bonn, Germany) which leads to different country area sites all over the world. The domain "**dhl.com**" attracted at least 6.8 million visitors annually by 2008 according to a Compete.com study.

Complainants' DHL web presence for the United States is accessible under the domain name "**dhl-usa.com**" (registered by C).

Finally, Complainants' parent company Deutsche Post AG, Bonn, Germany, is owner of the domain names "**mydhl.net**", "**mydhl.biz**", "**mydhl.org**", "**mydhl.info**" and "**mydhl.de**" which are (virtually) identical to the domain name in dispute as the only difference concerns the TLD.

Print-outs from the Whois databases confirming ownership are attached as **Annex 5c**.

4 Complainants' Activities

4.1 In 2003, DHL merged with one of the largest enterprises in the German Federal Republic, Deutsche Post AG. The latter was privatized in 1995 after it had held the postal monopoly in Germany before. The DHL brand was further strengthened by the group's acquisition of Exel, a company which primarily offers transport and logistics solutions for key customers, in December 2005. Today, Complainants' group is the global market leaders in international express, overland transport and air freight. It is also the world's number 1 in ocean freight and contract logistics. DHL's international network links more than 220 countries and territories worldwide and employs some 300,000 employees.

4.2 Complainants' core business is international transportation of documents and goods. In nearly every country of the world, Complainants have a business location as shown on the internet page "**dhl.com**". Furthermore, Complainants transport and deliver millions of mailings and parcels throughout the world. Thus, Complainants are widely recognized by the public due to their omnipresence aroused by their thousands of yellow trucks and airplanes with the sign "DHL" or their dense network of offices worldwide. A company profile

from the online encyclopaedia "Wikipedia" which overviews the DHL history and its integration in the Deutsche Post AG's worldwide operating group is enclosed as **Annex 6**.

- 4.3** Also the USA - the country of the Respondent - Complainants operate various business locations as shown on Complainants' official American internet presence available under "**dhl-usa.com**". Printouts from Complainant's American internet presence are attached hereto as **Annex 7**.
- 4.4** In the light of these facts, it cannot seriously be disputed that Complainants are well-known within Germany, Europe, USA and internationally as the owner of worldwide trademark registrations for "DHL" for years. Accordingly, in UDPR case *DHL Operations B.V. v. Ali Kazempour*, Case No. D2004-1094 - dhlmail.com - (attached as **Annex 8**), the WIPO panel stated that

"the "DHL" marks are notorious all over the world".

5 Summary

The domain name **mydhl.com** is confusingly similar to the aforementioned Complainants' trademarks, domain names and company name "DHL", for the reasons set out below:

- 5.1** It is commonly accepted that generic top level domains such as ".com", ".net" or ".info" do not produce any distinctiveness, since the public will recognize these parts as a mere description of the generic type of the domain name. The addition of the gTLDs is technically required for registration of the domain names and has thus no distinguishing capacity in the context of domain name and does not alter the value of the trademark represented in a domain name. Therefore, such inclusion must not be taken into account in assessing the identity or similarity between the disputed domain name and Complainants' marks (see e.g. *Société Générale and Fimat International Banque v Lebanon Index/La France DN and Elie Khouri*, Case No. D2002-0760; *New York Insurance Company v. Arunesh C. Puthiyoth*, WIPO Case No. D2000-0812 or *A & F Trademark, Inc., Abercrombie & Fitch Store, Inc., Abercrombie & Fitch Trading Co., Inc. v. Party Night, Inc. et al.*, WIPO Case No. D2003-0172). In this context we refer, as an example, to *Pomellato S.p.A v. Richard Tonetti*, Case No. D 2000-0493, where the Panel stated that

"the addition of the generic top-level domain [...] is not relevant, since use of a gTLD is required, necessary and functional to indicate use of a name in Internet and for the average Internet user it would not confer any further distinctiveness to any name.

The same conclusion was drawn in WIPO Case No. D2007-1653 *DHL Operations B.V. v. zhangyl* regarding the domain name "dhl.name" (enclosed as **Annex 9**) where the Panel held:

"It is well-established in many panel decisions that suffixes such as ".com", ".org" or ".net" should not be taken into account when considering the issue whether a domain name is identical or confusingly similar to a trademark."

Therefore, the gTLD “.com” must not be taken into account in assessing the identity or similarity between the disputed domain name and Complainants’ marks.

- 5.2 Moreover, the disputed domain name **mydhl.com** is a mere combination of Complainants’ famous trademark / company name “DHL” and the possessive pronoun “my”. The addition of the prefix “my” does not prevent the domain name from being confusingly similar to Complainants’ trademark / company name; it rather enforces the confusion. The element “my” is clearly related to the Complainants and tries to establish a personal identification of the consumers with the services and goods involved. The prefix “my” focuses the reader’s attention on the Complainants’ trademark and company name. Thus, the only dominant and distinctive element of the domain **mydhl.com** is Complainants’ famous trademark / company name, the combination of the three letters “DHL”, which is entirely incorporated in the disputed domain name. Therefore, the reader of the domain name will be confused into thinking that the domain name is associated with the Complainants.

In this context we refer to UDPR case *Ferrero S.p.A. v. Mr. Jean-Francois*, Case No. D2000-1534 – “mynutella.org” - (attached as **Annex 10**), where the WIPO panel decided as follows to the question of confusing similarity in a similar case:

“The combination of an existing name (i.e. a trademark) with a possessive pronoun (such as “my” or “your”) does not basically change the significance of the existing name as such in the combined expression. The added prefix “my” has, both grammatically and phonetically, an inferior distinctive importance compared to the principal component of the word; the term “my-Nutella” is clearly dominated by its principal component “Nutella”.

In addition, it is a popular marketing strategy to combine the name of a product or service with the add-on formative “my...” or “your...”, to create a personal identification of consumers with the product or service involved. This is especially common for Internet sites which can be personalized by the users according to their own interest and desire (e.g. “my.yahoo.com”, my.netscape.com”, “My Excite”). The prefix “my” plus a famous trademark in a domain name refers evidently to a special service in connection with that trademark.

The Panel therefore cannot support the contention that there is a “flagrant difference” between the Domain Names and the trademark “Nutella”, as maintained by Respondent. From the point of view of ordinary consumers and Internet users - as well as from an objective viewpoint -, the Domain Names are confusingly similar to Complainant’s trademark and the distinctive element of the Domain Names and Complainant’s trademark are identical.”

The same conclusions drawn with regard to the domain names “mynutella” must apply to the domain name “mydhl”. Therefore, persons encountering Respondent’s domain name will in view of that incorrectly believe that the domain name directs to Complainants’ web presence.

As the dominant part and distinctive element of the domain **mydhl.com** is the Complainant's famous trademark / company name, the addition of the element "my" does not prevent the domain name from being confusingly similar to the Complainant's trademark / company name. The addition of the prefix "my" does not avoid confusion, especially because the Complainant's has well-established trademark rights in the famous designation "DHL" all over the world (including the USA).

In view of the disputed domain name **mydhl.com** Internet users will undoubtedly be confused into thinking that the domain name was associated with Complainants and their businesses. The Complainants' famous DHL mark is entirely incorporated in the contested domain name. The addition of the further element "my" is not sufficient to avoid the likelihood of confusion between the domain name in dispute and Complainants' trademarks DHL but only reinforces the likelihood of confusion.

- 5.3** A likelihood of confusion is also to be stated with regard to Complainants' series of trademark and service mark registrations incorporating the DHL mark in combination with other terms related to their activities such as the marks "DHL EXPRESS", "DHL GLOBAL MAIL", "DHL SOLUTIONS", "DHL MIDDAY EXPRESS" or "DHL WORLDWIDE EXPRESS" consumers will inevitably believe that the designation "MYDHL" is just a further sign of this series. For the reasons set out above, the fact that the Respondent's domain name includes, in addition to Complainants' well-known trademarks "DHL", a term which is directly related to Complainants' business activities, will provoke the incorrect belief that the domain name leads to the internet offer of the Complainants' DHL group.

Consequently, there can be no doubt that the domain name **mydhl.com** is confusingly similar to Complainants' "DHL" trademarks and company name.

- 5.4** Thus, 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** by Respondent for its 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.

B. The Respondent has no Rights or Legitimate Interests in Respect of the Domain Name

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))

- 1** Before Respondent became aware of the conflict, Respondent had not been using either the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods and services. Although Respondent never had any own or derived rights to use Complainants' well-known trademark / company name, Respondent is using "DHL" as the significant part of his domain name and causes the evident risk of setting 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. Given this, it is obvious that Respondent has not been / is not using the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods and services.

- 2 At that time, Respondent or any other person not connected to Complainants was not generally known by the domain name **mydhl.com**.
- 3 Neither did Respondent or any other person not connected to Complainants use the domain name for any legitimate, non-commercial or fair purpose. As already shown, Complainants' group's brand name "DHL" is famous all over the world.
- 4 Respondent does not own any rights in the name or mark "DHL". Complainants have not licensed or otherwise, expressly or implied, permitted Respondent to use their well-known and distinctive company name "DHL" or their trademarks "DHL" or to apply for the registration of the domain name in dispute. Therefore, Respondent should not be considered as having any legitimate interest in the famous and distinctive worldwide trading name, company name and trademark "DHL". In contrast, the evident aim of Respondent's use of the contested domain name is to misleadingly divert consumers and to abuse the distinctiveness and reputation of Complainants' famous trademark "DHL".

C. 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))

The domain name **mydhl.com** has been registered and is being used by Respondent in bad faith for the following reasons:

- 1 At the time the domain name **mydhl.com** was created (07 October 2002), just as today, neither Respondent nor any other person not connected to the Complainants had a legitimate interest in registering Complainants' famous trademark / company name "DHL" as a domain name. In accordance to established WIPO practice (see e.g. cases No. D2004-0250 *Autoshop 2 Di Battaglia Ferruccio C. S.N.C v. Willamette RF Inc.* as well as D2000-0003 (telstra.org), WIPO/D2000-0620 (internet-in-the-sky.org), WIPO/D2000-0627 (polyesters.com), WIPO/D2000-0727 (bancodobrasil.com), WIPO/D2000-0022 (christiandiorcosmetics.com, christiandiorfashions.com, diorcosmetics.com, diorfashions.com), WIPO/D2000-0502 (etogesic.com), WIPO/D2000-0732 (somlivre.com), WIPO/D2000-0815 (sintoplast.com), WIPO/D2000-0826 (betwilliamhill.net), DeC/AF-349 (2pac.org), WIPO/D2001-1391), the fact that the domain name is presently not used for a clear commercial purpose does not affect the finding of bad faith under Policy 4(a)(iii), in particular as the circumstances of the case are such that Respondent is continuing to act in bad faith, for the reasons set out below:
- 2 Complainants' trademarks, domain names and company name "DHL" listed under Section V. A. 1-3 have been widely used by Complainants and their internationally operating groups for many years and thus are well-known throughout the world. Therefore, it is in-

conceivable that the registration for **mydhl.com** was made without full knowledge of the existence of Complainants and their marks. In this context, we point to several UDRP decisions in which it was stated that bad faith may be inferred from the registration of a well-known mark. Accordingly, in NAF decision *The Caravan Club v. Mrgsale* of August 30, 2000, Claim Number: FA0007000095314, the panel held that

“Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith.”

Given this, it seems obvious that the domain name was registered in bad faith.

The same finding was made in WIPO decision Case No. D2004-1094 *DHL Operations B.V. v. Ali Kazempour* of 24 February 2005 concerning the domain “dhlmail.com” (attached as Annex 8). There, the panel found bad faith arguing that,

“It has been established in certain circumstances that when a domain name incorporates a famous mark comprised of a coined or fanciful term, no other action, aside from registering the domain name, is required for demonstrating bad faith. This is based upon the premise that “it would be difficult, perhaps impossible, for Respondent to use the domain name as the name of any business, product or service for which it would be commercially useful without violating Complainant’s rights.” Cellular One Group v. Paul Brien, WIPO Case No. D2000-0028 (March 10, 2000). The Panel finds an analogous situation in the circumstances of this case, considering that Complainant’s name is well known and that Respondent, at the time he registered Complainant’s name as a domain name, knew Complainant and was familiar with the commercial potential of Complainant’s personal name”.

The same conclusions must be drawn in this case.

In UDRP decision *Axel Springer AG v. Jack Tubal* Case No. D2005-0554 “autobild.com” (enclosed as **Annex 11**), WIPO panel held in respect to bad faith in a further similar case:

“That the domain name was registered in bad faith may be argued from the fact that AutoBild is an internationally well-known magazine and it is extremely unlikely that Respondent has just selected the name by mere chance.”

The same is applicable here.

- 3 Moreover, the domain name “**mydhl.com**”, which is composed of the Complainant’s famous trademark with the prefix “my” evokes an association with the Complainant and its products and services. Only someone who was familiar with the mark and what it stands for would register the domain name at issue - and thus register the domain name in bad faith.

In this context we also refer to UDRP case *Robert Bosch GmbH v. Gurol Yardimci*, WIPO Case No. D2005-0147 - “mybosch.com” - (attached as **Annex 12**), where the WIPO panel decided as follows to the question of registration and usage in bad faith in a highly similar case:

"It is a popular and well-known marketing strategy to combine the name of a product or service with the add-on formative "my..." or "your..." to create a personal identification of consumers with the product or service involved. This is especially common for Internet sites; the prefix "my" plus a famous trademark in a domain name refers evidently to a special service in connection with that trademark (see e.g. Ferrero S.p.A. v. Mr. Jean-Francois Legendre, WIPO Case No. D2000-1534; Sony Kabushiki Kaisha also trading as Sony Corporation v. Sin, Eonmok, WIPO Case No. D2000-1007). The Panel, therefore, believes that the disputed domain name was registered in bad faith, because the domain name, which is composed of the Complainant's famous trademark with the prefix "my" evokes an association with the Complainant and its products/services. It is reasonable to conclude that only someone who was familiar with the mark and what it stands for would register the domain name at issue."

The same conclusions must be drawn here.

- 4 Further evidence the disputed domain **mydhl.com** was not only registered but is also used in bad faith by the Respondent is his failure to respond to Complainant's cease and desist letter.

On 23 December 2009, the Complainant's representatives sent a cease and desist letter (attached as **Annex 13**) to the Respondent's e-mail address as well as facsimile indicated under Section 2. However, the Respondent failed to show any reaction. In similar cases, where the registrant of the contested domain did not respond to Complainant's cease and desist letter, the WIPO panel held, for example, in its decision *NFL Properties, Inc. et al. v. BBC AB*, Case No. D2000-0147, that

"Respondent's failure to respond to the inquiries of Complainants or to the Notification of Complaint and Commencement of Administrative Proceeding sent by the Center supports the inference that the registration and the use of the domain name has been in bad faith".

Since this conclusion also applies to the present case, this is moreover a factor in considering bad faith under paragraph 4(b)(iii) of the Policy.

Finally, the Respondent uses the disputed domain with the intention to attract Internet users to his website by creating the likelihood of confusion with the Complainants' "DHL" trademarks.

- 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, 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.

VI. Remedies Requested

(Rules, para. 3(b)(x))

In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section V. above, Complainants request the Administrative Panel appointed in this administrative proceeding to issue a decision that the contested domain name

mydhl.com

be **transferred to Complainant 2.**

VII. Administrative Panel

(Rules, para. 3(b)(iv))

Complainants elect to have the dispute decided by a single-member Administrative Panel.

VIII. Mutual Jurisdiction

(Rules, para. 3(b)(xiii))

In accordance with Paragraph 3 (b) (xiii), Complainants will submit, with respect to any challenges that may be made by Respondent, to a decision by the Administrative Panel to transfer or cancel the domain name that is the subject of this Complaint, to the jurisdiction of the courts at the location of the principle office of the concerned Registrar and the domain name holder's address, as shown for the registration of the domain name in the concerned registrar's Whois database at the time of the submission of Complaints to the Center.

IX. Other Legal Proceedings

(Rules, para. 3(b)(xi))

No other legal proceedings have been commenced or terminated in connection with or relating to the domain name that is the subject of this Complaint.

X. Communications

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

A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules has been sent on **5 January 2010** to Respondent electronically by e-mail to the email address specified under Sec. II, in accordance with Paragraph 2 (b) of the Rules.

A copy of this Complaint has been sent to the concerned registrar on **5 January 2010** to the email address tim@godaddy.com.

This Complaint is submitted to the Center in electronic form (except to the extent not available for annexes), and in four (4) sets together with the original.

XI. Payment

(Rules, para. 19; Supplemental Rules, Annex D)

As required by the Rules and Supplemental Rules, payment in the amount of **USD 1.500,00** has been made by bank transfer (WIPO Account IBAN CH68 0483 5063 0397 8200 0, Credit Suisse, 1211 Geneva 70, Switzerland, Swift Code: CRESCHZZ80A), indicating "UDRP procedure – DHL Operations B.V. v. Eric White; 1682/09 KJ.

XII. Certification

(Rules, para. 3(b)(xiv))

Complainants agree that their claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panellists, except in the case of deliberate wrongdoing, (b) the concerned registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees and agents.

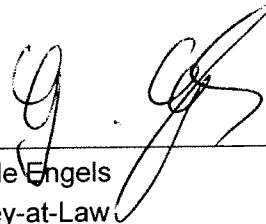
Complainants certify that the information contained in this Complaint is to the best of Complainants' knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

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
Attorney-at-Law
Jonas Rechtsanwaltsgesellschaft mbH

Cologne, 5 January 2010

LIST OF ANNEXES

- Annex 1:** Complainants' group's advertising sheets showing trademark ownership of both Complainants.
- Annex 2** Printouts from the concerned registrar's Whois database search for the disputed domain name "mydhl.com" of 23 December 2009.
- Annex 3:** Registration agreement, pursuant to which the domain name mydhl.com is registered.
- Annex 4a:** Excerpt from the Amsterdam Company Register regarding Complainant 1.
- Annex 4b** Excerpt from the "Amtsgericht Bonn" Company Register regarding Complainant 2.
- Annex 5a:** Databank excerpts of Complainants' German, Community, US, International, Australian, Canadian and UK trademark registrations.
- Annex 5b:** List of Complainants' German, Community and International Registrations including the term "DHL".
- Annex 5c:** Printouts from the Whois database searches for Complainants' and their affiliates' domain names.
- Annex 6:** Copy of a Complainants' group's profile from the online encyclopaedia "Wikipedia".
- Annex 7:** Printouts from the Complainants' US website at "dhl-usa.com".
- Annex 8:** WIPO decision *DHL Operations B.V. v. Ali Kazempour*, Case No. D2004-1094 – dhlmail.com.
- Annex 9:** WIPO decision *DHL Operations B.V. v. zhangyl*, Case No. D2007-1653 – dhl.name.
- Annex 10** UDPR case *Ferrero S.p.A. v. Mr. Jean-Francois*, Case No. D2000-1534 – "my-nutella.org".
- Annex 11:** UDPR decision *Axel Springer AG v. Jack Tubul*, Case No. D2005-0554 – auto-bild.com.
- Annex 12** *Robert Bosch GmbH v. Gurol Yardimci*, WIPO Case No. D2005-0147 - "my-bosch.com".
- Annex 13** Copy of Complainants' cease and desist letter sent to Respondent dated 23 December 2009.