



NATIONAL ARBITRATION FORUM

DECISION

Lauritz Knudsen A/S (Schneider Electric Danmark A/S) v. W Y SOH
Claim Number: FA0707001045079

PARTIES

Complainant is **Lauritz Knudsen A/S (Schneider Electric Danmark A/S)** (“Complainant”), represented by **Peter Gustav Olson**, of **Plesner Svane Gronborg Law Firm**, Amerika Plads 37, Copenhagen 2100, Denmark. Respondent is **W Y SOH** (“Respondent”), represented by **Teresa O'Connor**, of **INFINITUS LAW CORPORATION**, 77 Robinson Road, #16-00 Robinson 77, Singapore 068896.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**lauritzknudsen.com**>, registered with **Melbourne It, Ltd.** d/b/a **Internet Names Worldwide**.

PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Daniel Banks, Chair, Houston Putnam Lowry, Chartered Arbitrator, and David Tatham as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on July 24, 2007; the National Arbitration Forum received a hard copy of the Complaint on July 30, 2007.

On July 25, 2007, Melbourne It, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the National Arbitration Forum that the <**lauritzknudsen.com**> domain name is registered with Melbourne It, Ltd. d/b/a Internet Names Worldwide and that the Respondent is the current registrant of the name. Melbourne It, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne It, Ltd. d/b/a Internet Names Worldwide registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On August 7, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of August 27, 2007 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@lauritzknudsen.com by e-mail.

A timely Response was received and determined to be complete on September 17, 2007.

A timely Additional Submission was received from Complainant and determined to be complete on September 24, 2007.

Respondent submitted additional material on October 1, 2007.

On September 27, 2007, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Daniel Banks, Chair, Houston Putnam Lowry, Chartered Arbitrator, and David Tatham as Panelists.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Trademark/Service Mark Information: ICANN Rule 3(b)(viii)

The Complaint is based on the Complainant's registered and common law rights in the trademark LAURITZ KNUDSEN.

FACTUAL AND LEGAL GROUNDS

The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights (UDRP ¶ 4(a)(i) and ICANN Rule 3(b)(ix)(1)).

The Complainant is a leading Danish company specialized in the production and development of electrical networks comprising circuit breakers, plug-and-socket-connections and intelligent data installation materials etc. The company was established in 1893 by the Dane Lauritz Knudsen who named it after himself. Lauritz Knudsen is a very well-known company in the relevant market in Denmark and has a substantial market share.

Lauritz Knudsen and the abbreviations of the name - "Laur. Knudsen" and "LK" - have been used as interchangeable trading names since the company's establishment in 1893 and so they have been used for nearly 114 years. Thus, it is obvious that Complainant's extensive use of its trading names predate the Respondent's registration of the domain name in issue by more than 100 years.

In 2003 Complainant filed for registration of its LAURITZ KNUDSEN trademarks - merely to confirm their existence.

Complainant filed a declaration by Mr. Carl Trock, its chief executive officer, setting out the history of the company, including partial printouts of its own web site as well as Respondent's web site. He attached what was described as "a collection of advertisements and marketing materials" showing use of the Lauritz Knudsen trademark and a copy of a settlement agreement dated December 20, 2004 between Lauritz Knudsen A/S and LK-Electric Europe A/S.

The fact that the trademark registrations postdate the Respondent's registration of the disputed domain name on 12 July 2001 is of no consequence to this proceeding. *See, e.g., Brooklyn Inst. of Arts and Scis. v. Fantastic Sites Inc.*, FA 95560 (Nat. Arb. Forum Nov. 2, 2000) ("ICANN dispute resolution policy is "broad in scope" in that "the reference to a trademark or service mark in which the complainant has rights' means that ownership of a registered mark is not required - unregistered or common law trademark or service mark rights will suffice - to support a domain name complaint under the policy.").

It is also a well established UDRP practice that Paragraph 4(a)(i) applies in respect of trademarks that are registered after the registration of the domain name in dispute. Thus, the legal grounds for a transfer of a domain name can be found in a subsequent trademark registration. *See, e.g., AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003) ("Paragraph 4(a)(i) does not require that the trademark be registered prior to the domain name. The fact that the disputed Domain Name predates Complainant's trademark registration may only be relevant to the assessment of bad faith pursuant to Paragraph 4(a)(iii).").

On this background, the domain name <**lauritzknudsen.com**> is clearly identical or at the very least confusingly similar to the common law rights as well as the registered trademark rights of the Complainant relating to the name LAURITZ KNUDSEN. Consequently, Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

The Respondent has no rights or legitimate interests in respect of the domain name that is subject of the complaint (UDRP ¶ 4(a)(ii) and ICANN Rule 3(b)(ix)(2)).

"Rights" in respect of the domain name

The Respondent is known to exercise controlling influence over the company LKE Power Distribution Systems, to whose website the domain name at issue points. Respondent has been employed by the Complainant until approximately 1990, and thereafter undertook to do business under a name not similar to Complainant's name.

According to the relevant case law a respondent has no "rights" in a domain name when the respondent is not known by the mark. *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001). In the present case, therefore, Respondent has no rights in the disputed domain name since Respondent has never been known by the mark "Lauritz Knudsen."

Furthermore, it is UDRP practice to "require a showing that one has been commonly known by the domain name prior to registration of the domain to prevail." *See RMO, Inc. v. Bur-bridge*, FA 96949 (Nat. Arb. Forum May 16, 2001). It must be emphasized that the burden of proof thus shifts to Respondent in a situation such as the present. However, in this connection it can be noted that Respondent uses the domain name to point to www.lkepower.com, which -in itself -is conclusive evidence to the fact that Respondent is not commonly known as "Lauritz Knudsen" but rather by its alter ego "LKE power." Consequently Respondent has no rights in respect of the domain name.

"Legitimate interests" in respect of the domain name

Complainant has used "Lauritz Knudsen" as either a primary or secondary company name for nearly 114 years. In addition, Complainant exerts a major presence in the Danish market for electrical networks with a substantial market share. This makes it understandable that Respondent wishes to be associated with Complainant in the marketing of Respondent's own products. This interest, however, is not legitimate.

Respondent and Respondent's Danish company have expressly undertaken not to use names confusingly similar to Complainant's. Therefore, the Respondent's lack of legitimate interest in the domain name in dispute has been clearly established and acknowledged by the Respondent prior to these proceedings.

On the basis of the above, it is apparent that Respondent has neither rights nor any legitimate interests in respect of the domain name that is subject of the Complaint. Consequently, Complainant has satisfied Paragraph 4(a)(ii) of the UDRP.

(UDRP ¶ 4(a)(iii) and ICANN Rule 3(b) (ix)(3)).

UDRP Paragraph 4(b) reads:

For the purposes of UDRP Paragraph 4(a)(iii), the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith [. . .]

(iv) by using the domain name, [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] web site or location or of a product or service on [Respondent's] web site or location.

Policy ¶ 4(b)(iv). Respondent uses the Complainant's trademark to point to its own website, which creates a strong likelihood of confusion as to the affiliation of the Respondent's website with the Complainant. Indeed, one gets the impression that the Respondent is the Complainant, in that the domain name does not just redirect to the

Respondent's website, but rather stays at <**lauritzknudsen.com**> which gives visitors seeking Complainant the impression that she or he has reached the Complainant's website.

Respondent uses the domain in dispute with the clear intention of capturing Complainant's present as well as potential customers. This undertaking is accomplished through the use of a strong and recognized brand that - so far - has been utilized by Complainant for a period of well above 100 years. Accordingly, the registration of the domain name in dispute was, by definition, an activity carried out in bad faith by Respondent.

Respondent's organization has expressly undertaken to refrain from using . . . "Lauritz Knudsen" in any kind of marketing . . ." This clearly demonstrates an awareness of Complainant's company name and products within Respondent's organization.

In addition, it is well established in UDRP case law that a domain name can be so obviously connected with a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith. *Cf., e.g. PepsiCo, Inc. v. PEPSI, SRL*, D2003-0696 (WIPO Oct. 28, 2003). This view seems to be relevant in the case at hand.

In the light of the above, it appears that past as well as present actions of Respondent's group as a whole strongly signifies an on-going campaign of utilizing the name of the Complainant to increase their market share at the expense of Complainant. Thus, it is clear that Respondent deliberately uses the domain name lauritzknudsen.com to misleadingly divert consumers to its own website for commercial gain at the expense of Complainant.

On these grounds it is established that Respondent has registered and used the domain name <**lauritzknudsen.com**> in bad faith. Similarly, Respondent's maintenance and continuous use of the disputed domain name is exerted in bad faith.

Consequently, Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

B. Respondent

This Response specifically responds to the statements and allegations contained in the Complaint and includes any and all bases for the Respondent to retain registration and use of the disputed domain name, ICANN Rule 5(b)(i).

The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (UDRP ¶ 4(a)(i) and ICANN Rule 3(b)(ix)(1)).

Whilst the name "lauritzknudsen" appearing in the Respondent's domain name can be regarded as being identical to the name of the long-deceased Danish gentleman "Lauritz Knudsen" who was the founder of the Complainant in 1893, the Respondent disagrees

with the Complainant's claims that "Lauritz Knudsen" was ever used as a trademark of the Complainant prior to the relevant date i.e. the registration of the domain name, on 12 July 2001.

In Carl Trock's Declaration, the Complainant admits to have originally traded under the abbreviated trading name "Laur. Knudsen" (not "Lauritz Knudsen") when the founder first incorporated the limited company. The Complainant further admits to have consciously dropped the "Laur. Knudsen" name as a trading name between 1954 and 1968 when they were known as LK A/S, then became known as LK-NES from 1968 to 1986 when they were merged with the company "NES." After 1986, the Complainant admits to a reversion to the use of the company name LK A/S. One surmises from the Complaint that it was not until the year 2003 that the Complainant activated "Lauritz Knudsen" as a trademark.

Therefore for most of its history the Complainant has in fact been known as "LK." It is incorrect and illogical that "LK is interchangeable with "Lauritz Knudsen", although certainly, customers and persons in Denmark may have known of its derivation due to the fame of the founder as a local inventor. While the inventor Lauritz Knudsen and the history of his life and work may be well known to the general public in Denmark, including his establishment of a company called LK A/S in Denmark, it does not automatically imply that the company LK A/S had extensively and consciously used Lauritz Knudsen as a trademark in any manner prior to 2003/4.

The Complainant claims that "Lauritz Knudsen" had been in use as a "secondary trademark" but he offers no examples or evidence of this use between 1917 and 2001. Carl Trock only includes one product brochure to evidence his claim of advertisements and marketing materials using the trademark "Lauritz Knudsen." However, that is entitled "LK DECO®" as the trademark for the products, with "LAURITZ KNUDSEN LK" being shown in the form of a corporate name and not a trade mark. Furthermore, the last page of this brochure shows that it was printed in 2004. This product brochure therefore does not prove that "Lauritz Knudsen" was used actively as a trademark prior to the registration of the disputed domain name in 2001. Examples of use of "Lauritz Knudsen" on the Complainant's web site are also from a date after 2001.

The Respondent has found that the Complainant had taken steps in Europe since the 1920s, to register two variants of their trademark "LK" in International Class 9 covering electrical apparatus and instruments. This positive action taken to protect the trademark "LK" contradicts the Complainant, since there is no explanation why they did not take similar steps for "Lauritz Knudsen."

The Respondent therefore contests the Complainant's claims to have used "Lauritz Knudsen" as a trademark prior to the registration of <lauritzknudsen.com> in 2001 by the Respondent.

On the other hand, the Respondent's associated companies had used "Lauritz Knudsen" as a trademark since approximately 1996 onwards. The significance of the name "Lauritz

Knudsen" to the Respondent and his associated companies is that the predecessor of the Respondent's companies were originally wholly-owned subsidiaries of the Complainant and thus, owed their establishment to a common founder.

It should further be noted that the Respondent's company is actually called Lauritz Knudsen Electric Co. Pte Ltd. On the other hand, the Complainant's company name is not primarily or actually Lauritz Knudsen A/S. The primary or actual name of the Complainant is Schneider Electric Denmark A/S due to the fact that they were merged with a French company called Schneider some time in 2000. They use "Lauritz Knudsen" merely as a division name or "supplementary name." We have been advised by Danish lawyers that whilst the official company name is Schneider Electric Danmark A/S, Lauritz Knudsen A/S is a supplementary name that the company can also perform business under.

The case of *Regal Petroleum PIC v. Digi Real Estate Found.*, D2007- 0405 (WIPO May 15, 2007) refused a complaint essentially on the grounds that a trade name is not a trademark or service mark. The issue in that case was to what degree a trade name is to be protected under the UDRP. In the Second WIPO Internet Domain Name Process, WIPO examined the question as to whether the UDRP process should be expanded to protect trade names, and ultimately made a recommendation against extension of the process. This was for the reason that "[t]he UDRP was designed for, and applies to, straight-forward disputes, where there are rights on one side and no rights or legitimate interests on the other side. It was not designed to accommodate disputes involving interests on both sides, which requires a more extensive procedure, perhaps involving the hearing of evidence and oral arguments. Many trade name disputes, because of the relatively light burden imposed to establish eligibility for trade name protection, will involve interests on both sides." It is the Respondent's contention in this case that as at 2001, the most that could have been shown by the Complainant is that "Lauritz Knudsen" was the name of their founder long ago in 1893 (not well publicized by them at that time) and possibly at one time, their business name or trade name. The Complainant is thus not able to satisfy paragraph 4(a) of the UDRP Policy, being the very first hurdle.

The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of the complaint (UDRP ¶ 4(a)(ii) and ICANN Rule 3(b)(ix)(2))

The Respondent notes that in considering whether he has rights or legitimate interests in respect of the domain name, the Panel may consider any relevant aspects included in but not limited to ICANN Policy ¶ 4(c) which are for convenience set out below under (i), (ii) and (iii) together with Respondent's submissions relative thereto : (i) "Whether, before any notice to the Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services."

As the history and chronology of events is long and protracted, we submit as part of this Response, a concise Chronology of Events for the ease of reference of the Panel.

The background leading to the Respondent's ownership of businesses using the company name and trademark "Lauritz Knudsen"

The Respondent is a Singaporean and was born in the year 1972. His full name is Wee Yong Soh. The Respondent is the son of a Singaporean Mr. Soh Kim Wat who was the Managing Director of LK-NES (S.E.A.) Pte Ltd, a company incorporated in Singapore on 7th October 1976 (hereinafter called "LK-NES S'pore") Soh Kim Wat was the Managing Director of LK-NES S'pore from 1st January 1980 until 1992.

As at 30th June 1986, the issued shareholding of LK-NES S'pore was as follows:-

<u>Name of Shareholder</u>	<u>Number of shares held</u>
LK-NES A/S	3,810,494
Estate of Frederick Edward George Rothwell	530,106
L E Charles Letts	21,180
Soh Kim Wat	373,486
Total	4,735,266 shares

However, as at 27th June 1988, the shareholding of LK-NES S'pore was as follows -

<u>Name of Shareholder</u>	<u>Number of shares held</u>
GN Laur Knudsen A/S	9,470,532

LK-NES A/S was thus a wholly-owned subsidiary of the Complainant. In addition, the Complainant also owned subsidiaries which operated in Malaysia, Brunei and Thailand, all bearing the name prefix "LK-NES." During the years when the Complainant had its subsidiaries in these countries, its trademark for its products was either "LK" or "LK-NES." "Lauritz Knudsen" was not used in any way by these companies.

Between 1986 and 1990 the Complainant sold their shares in these companies in Asia when the Complainant came under financial difficulties in Denmark and was taken over by new owners. This "management buy-out" took place in mid-1990, when there was good relations between the Complainant and its employees in Asia. In fact, it may be said that the Complainant felt an obligation and sense of regret towards its Asian employees due to their decision to pull out, and the prospect of retrenching its hundred odd employees. It was fortunate for the Complainant that Soh Kim Wat was in a position to effect the management buy-out.

According to the Complaint, Soh Kim Wat was permitted to continue the Complainant's Asian business under the name "LK-NES" without restriction, but with an undertaking to change the name of the company within two years to one not resembling "LK-NES" or "LK." The Respondent is not able to procure a copy of any sale and purchase agreement due to the age of the transaction, despite best efforts. However, the agreement would not have made reference to "Lauritz Knudsen" in any case, since it was neither the name of the company in Singapore or in Europe, nor being used as a trademark for its products at the material time.

At that time, the name "Lauritz Knudsen" was significant only in that the persons involved (meaning the directors and shareholders) knew that he was the original founder of the company in Denmark. However, this was never promoted or projected to the relevant Asian customer base at that time.

On 28 October 1992, Soh Kim Wat incorporated a new company in Singapore named "LK-Electric Co Pte Ltd" (hereinafter called "LK-Electric"). This umbrella organization was incorporated with the positive acknowledgement of the Complainant, to own and continue the business formerly carried out by "LK-NES S'pore" and the other "LK-NES" subsidiaries in the region which the Complainant had sold to him.

In 1997, after he graduated from university, the Respondent joined LK-Electric as a director and shareholder and was employed as its Marketing Director. At around the same time, the LK-Electric group of companies in Asia started to operate using "Lauritz Knudsen" as its trademark. The choice of the trademark was made with reference to the group's factual historical background.

Prior to the receipt of this Complaint in August 2007, the Respondent owned 34% of the shares of LK-Electric (incorporated in 1992) and 50% of the shares in Lauritz Knudsen Electric Co Pte Ltd (incorporated in 2003).

The Respondent's use of the domain name or a name corresponding to the domain name in a *bona fide* offering of product or service prior to notice of the dispute.

Since 1997 to the present, the businesses of the Respondent has grown exponentially. In particular, the Respondent established companies in China called in English translation.

- (i) LKE-Lauritz Knudsen Electric (Medium Voltage Systems) as early as 1996;
- (ii) Lauritz Knudsen Electric-Power Automation Systems Ltd in 2003, and
- (iii) LK-HTS (Lauritz Knudsen High Tension Systems) in 2005.

The Respondent points out that the physical products sold by the above three companies have been bearing the actual label of "Lauritz Knudsen Electric" as far back as 1997 when he first joined the company.

The Respondent had registered the domain name <**lauritzknudsen.com**> in 2001 as a natural extension of the business in view of the increasing use of the Internet for purposes of information and communication between a company and its potential and existing customers. From its inception, the <**lauritzknudsen.com**> website, contrary to the allegations of the Complainant, had many substantial pages that pointed to its companies in Singapore and China. It may be mentioned that during the relevant time period, the Respondent has not registered any other domain names apart from the domain names containing "lauritzknudsen" legitimately required to support his business.

On 10th February 2003, the Respondent incorporated Lauritz Knudsen Electric Co Pte Ltd. (hereinafter called "Lauritz Knudsen Electric" in Singapore. This company was

incorporated as a holding company for all of the group's businesses that were established after the management-buyout of 1990, while LK-Electric owned businesses that were existent prior to the management buyout of 1990. Apart from being the majority shareholder of the above three companies in China, Lauritz Knudsen Electric also acquired shares in the following companies:

- (i) IPEC (UK) Ltd in 2002
- (ii) EMV Engineering (UK) Ltd in 2005
- (iii) LKE-Europe A/S in 2005

All these active use of the trademark and company name of "Lauritz Knudsen" took place well before receiving any notice of the dispute. In all the above commercial activities and in others, the Respondent had used his email address at weiyongsoh@lauritzknudsen.com extensively until the end of 2004, for reasons which will be explained hereafter.

All these companies, together with the companies in Singapore, are ongoing businesses established prior to 2007 with an estimated net annual net turnover of US\$ 40,000,000.00. The Respondent's associated company's products bearing the label "Lauritz Knudsen Electric" have been deployed in several thousand power stations around the world for more than a decade and the Respondent's companies are now renowned in the Asia-Pacific region. In switchgear products alone, between 1997 and July 2007 the Respondent's company has sold more than 50,000 units of switchgear with the label "Lauritz Knudsen Electric" prominent to the following countries: Argentina, Australia, Chile, Cyprus, China, India, Indonesia, Malaysia, Pakistan, Philippines, South Africa, Thailand and Vietnam. The cumulative value of these switchgear sales bearing the mark of "Lauritz Knudsen" amounts to no less than US\$90,000,000.00 for the period between 1997 and 2007.

Therefore there is no question as to the Respondent's use of the domain name and a name corresponding to the domain name in a bona fide offering of product or service and in other legitimate business activities prior to notice of the dispute.

(ii) "Whether Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if Respondent has not acquired trademark or service mark rights."

There is no doubt that the Respondent's associated businesses were commonly known by the domain name both prior to the registration of the domain name and prior to the dispute. Furthermore the Respondent has acquired trademark rights in Singapore, China, Malaysia, Vietnam and Thailand as far back as 2002.

The Respondent has operated as a business and traded using the domain name and trademark "Lauritz Knudsen" as far back as 1997. This is evident in its Sales Contracts with its clients, its advertisements in trade journals and in exhibitions as well as in its Requisition Contracts with its suppliers and contractors. The Respondent calculates that

his companies have already signed more than 10,000 contracts with the "Lauritz Knudsen" mark to the aforementioned value of US\$ 90,000,000.00 from 1997 to 2007.

Furthermore the Respondent's group of companies has been spending more than US\$ 3,000,000.00 annually on advertising and promotion in various media including participation in trade exhibitions and seminars on an international basis, specifically to promote its "Lauritz Knudsen" switchgear products. See ANNEX 3(a) for advertisements in China, the latter ones featuring the domain name <lauritzknudsen.com>.

The fact that the Respondent's company had been commonly known as Lauritz Knudsen Electric is also evident in mundane items such as its employee's business cards, its internal memorandums, quality inspection sheets, letterheads, employment contracts and so on, all bearing the mark of Lauritz Knudsen Electric from as far back as 1997.

(iii) "Whether Respondent is making a legitimate non-commercial 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."

Not applicable

Why the domain name should not be considered as having been registered and being used in bad faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶ 4(a)(iii).

(i) Whether there are 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 the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) Whether 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) Whether Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) Whether by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

Policy ¶ 4(a)(ii). The relevant time for consideration of whether the domain name had been registered and used in bad faith is at the original date of registration in 2001. It is clear that the Complainant only decided to activate use of the name "Lauritz Knudsen" as a trademark in the year 2003. The Respondent has not before this Complaint in 2007 received any notice or intimation of the Complainant's objection to the registration and use of <lauritzknudsen.com>.

The Respondent recalls that in 1996/7, they did make searches and enquiries and first satisfied themselves that "Lauritz Knudsen" was not being used as a company name or trademark by the Danish company for nearly 80 years before that (starting from 1917). Although the Complainant was taken over by the Great Nordic Group between 1986 and 1990, and was hence incorporated as "GN Laur Knuden", this company was soon broken up so that by 1992, the company had been renamed LK A/S. At no time in this period running up to 1997 did the Complainant actually file or use the trademark "Lauritz Knudsen."

The Respondent notes that the Complainant took steps to register a domain name <lk.dk> on 9th January 1998, thereby supporting that they were using "lk" as their trading name and trademark rather than "Lauritz Knudsen." The Complainant did not register <lauritzknudsen.dk> until 21st November 2003. Furthermore until the end of 2001, a search for "Lauritz Knudsen" would not automatically resolve to the Complainant's website <lk.dk> as its web-content made no reference to "Lauritz Knudsen" that he, the Respondent could recall. The web-content which Carl Trock submitted is not dated, but the Respondent believes that that particular page was an addition made in 2002.

- i) It is clear that the Respondent did not register the domain name with the intention of reselling it to the Complainant. At no time prior to or since the dispute had the Respondent made advances or suggestions to the Complainant indicating his willingness to sell the domain name to the Complainant.
- ii) The Respondent had never engaged in a pattern of registering domain names to prevent the owner of the trademark from owning the domain names reflecting their mark.

In or about 2003 when the Complainant had registered the trademark in Denmark and began to use it actively in Denmark, the Respondent's associated companies had already been using "Lauritz Knudsen" as a trademark and trade name for some 7 years, beginning from 1996/7.

- iii) In 2001 the Complainant was not deemed as a competitor to the Respondent hence it was illogical for the Respondent

to register the domain name to disrupt the business of the Complainant.

After the management buy-out of 1990, LK-Electric focused on the medium and high voltage switchgear business (6 kilovolts to 220 kilovolts). The customers for the Respondent's switchgear products are essentially power stations. The Respondent's company did not deal in household electrical network products in anyway similar to the Complainant's. On the other hand, in Denmark, the Complainant was engaged in building mini-circuit breakers and wall-plugs for household applications at low voltage (110 volts). It is plain from the evidence submitted by the Complainant that their products have been small household electrical systems for the last 20 years.

Therefore the product-lines of the Respondent's companies and the Complainant's products in the Scandinavian market are completely different. They are neither complementary nor can it even be said that they are in competition. Under any international industrial standards, the respective products fall within completely distinct, unrelated categories.

Further, the Complainant prior to 2004 operated primarily in Scandinavia, whereas the Respondent operated in the Asia-Pacific. The Declaration of Carl Trock states in paragraph 2 that Denmark is their primary market. Hence the geographical location of the clients, the product categories as well as the client-profile of the two parties bear no similarity. The Respondent thus had no logical need to deliberately associate itself with the Complainant in the marketing of its own products when it registered the domain name under dispute in 2001.

The Respondent recalls that the results of his investigation in 2001 showed that the key words "Lauritz Knudsen" could not divert web-traffic from the Complainant's website <lk.dk> at the time of registration in 2001. By the Respondent's recollection, this was because the Complainant's website prior to the date of registration in 2001 did not contain "Lauritz Knudsen" as a key word. The Respondent recalls that the only reference to "Lauritz Knudsen" made in the Complainant's web site was the fact that he was the founder of the company LK A/S, and this, amounting to the only mention of "Lauritz Knudsen", was only added in late 2001. Furthermore, Internet users searching for "lauritz knudsen" in 2001 would not have been diverted to the disputed domain name because firstly they would have searched for "lauritz knudsen" as two words rather than as one continuous word. It would not occur to the Internet user to search for "lauritzknudsen" as a single word, when trying to locate the Complainant, as the Complainant's website "lauritzknudsen.dk" was not in existence in 2001

The Complainant specifically alleges that <lauritzknudsen.com> has no web-content and resolves to the Respondent's main website <lkepower.com>, and that this indicates, according to the Complainant, bad faith. However the Complainant could not have been ignorant of the fact that the domain name <lauritzknudsen.com> had been used in a substantial manner since 2001 until late 2004 when the Respondent established a new domain name <lkepower.com>. The Respondent notes that the Complainant claimed that

they knew of the Respondent's domain name <lauritzknudsen.com> as early as 2003. Until 2005, <lauritzknudsen.com> contained more than 30 pages of content offering the Respondent's actual products. Even today, a substantial record of these pages still exists in online web archives.

In 2005, the domain name <lauritzknudsen.com> was changed to point to <lkepower.com> instead of having its own web content. The reason for this was to correspond with the restructuring of the Respondent's businesses. The Respondent decided some time in 2004 to group his various associated companies under the "LKE" banner, the letters "LKE" standing for "Lauritz Knudsen Electric." All the various companies under the Respondent's management were to be known as Divisions of the LKE Power Distribution Systems Group and the overall shareholder of the group of companies was Lauritz Knudsen Electric Co Pte Ltd. However, the Respondent continued to use "Lauritz Knudsen" as a trademark for its products and the Respondent's products continue to bear the label of Lauritz Knudsen Electric.

The Complainant further alleges that the Respondent entered into an undertaking in 1990 to do business under a name not similar to Complainant's name. The Complainant has alleged that this forms the basis of their allegation of bad faith. It is evident that the Complainant had mistaken the identity of the Respondent with Soh Kim Wat. In 1990, the Respondent was still a college student. Further, this statement is misleading in that at that time, the Complainant was known as "LK-NES" and later as "GN Laur. Knudsen" but never as "Lauritz Knudsen." The undertaking or gentlemen's agreement was therefore in relation to "LK-NES" and not to "Lauritz Knudsen."

The Complainant has also alleged that the Respondent and his Danish company have expressly undertaken not to use names confusingly similar to the Complainant's by way of a Settlement Agreement which was signed on 20th August 2004 between LKE-Electric (Europe) A/S and the Complainant. The Complainant argues that this represents a deliberate act in bad faith as well as an acknowledgement by the Respondent of his lack of legitimate rights to the trademark and domain name.

However, the Respondent points out that the Respondent and his organization did not own LKE-Electric (Europe) A/S at the time of the Settlement Agreement of 2004. The Respondent points out that LKE-Electric (Europe) A/S was set up in 2000 by ex-employees of the Complainant independently of the Respondent or his associated companies. Furthermore the relationship between the Respondent's company and LKE-Electric (Europe) A/S was that of supplier and distributor between 2000 and 2004. It was not, as the Complainant implies, the relationship between a parent company and its subsidiary. The Respondent and his associated companies only began to own a minority shareholding in LKE-Electric (Europe) A/S as of 2005. This share acquisition came about because LKE-Electric (Europe) A/S required additional financing and the Respondent decided to inject cash into its Distributor's operations by way of a direct investment.

Although the acknowledgement in the 2004 Settlement Agreement was actually accurate because LKE-Electric (Europe) A/S was incorporated by 3 ex-employees of the

Complainant, and in the sense that it was indeed historically and structurally unrelated to the Complainant and had no claims to the trademark "Lauritz Knudsen", this has absolutely no bearing on the legitimate rights of the Respondent's associated companies, LK-Electric Co Pte Ltd and Lauritz Knudsen Electric Co Pte Ltd, with regard to the trademark and disputed domain name. The Respondent further points out that the Settlement Agreement of 2004 could not have been drawn up with the Respondent's rights to the trademark in mind since neither party to the agreement could have foreseen that the Respondent and his associated companies would acquire shares in LKE- Electric (Europe) A/S in 2005. As the Settlement Agreement of 2004 contained no reference to the Respondent or his associated companies in Singapore (LKE-Electric (M) SDN BHD is an independent company and the Respondent and his associated companies have no shares of or involvement in the management of this company.), the Respondent fails to see how the limitations placed upon LKE-Electric (Europe) A/S is related to the Respondent's companies' (Lauritz Knudsen Electric Co Pte Ltd of Singapore) use of the disputed domain name.

The Respondent points out that since the Settlement Agreement of 2004, LKE-Electric (Europe) A/S had complied to its terms stringently under the direction of its majority shareholders, Triax A/S, and the Complainant has found no cause to seek legal redress in any manner. The Respondent has respected this agreement between LKE-Electric (Europe) A/S and Complainant by labeling its products "LKE-Power Distribution Systems" when selling them to the Danish company, but however it has continued to label its products "Lauritz Knudsen Electric" when these are being supplied to other clients in Europe (Germany, Spain, UK and Italy) as well as other parts of the world. The Respondent has not received any notice from the Complainant contesting this form of labeling.

The ICANN Policy stipulates 3 factors that must be shown cumulatively, for applicability of a dispute to be resolved in favor of the Complainant. Insofar as the Settlement Agreement of 20th August 2004 is concerned, it takes place at a date anterior to the date of registration of the domain name and it does not specifically refer to or involve that domain name or the Respondent. The Complainant seems to be asking the Panel to make a finding based on the legal ramifications or effect of the Settlement Agreement. However, the Panel is required according to the ICANN Policy to decide the dispute taking into consideration whether all 3 points are found. It is not the function of the Panel to decide whether the Settlement Agreement on its own has possibly been breached such that the continued ownership of the domain name by the Respondent is in breach thereof. If the Complainant feels that a breach of the Settlement Agreement has occurred, it ought to seek redress in the proper forum.

The explanatory history of the Policy states that "excepting cases involving 'abusive registrations' made with bad faith intent to profit commercially from others' trademarks, (e g , cyber-squatting and cyber-piracy), the adopted policy leaves the resolution of disputes to the courts The adopted policy establishes a streamlined inexpensive administrative dispute- resolution procedure intended only for the relative narrow class of cases of 'abusive registrations' Thus, the fact that the Policy's administrative dispute-

resolution procedure does not extend to cases where a registered domain name is subject to a legitimate dispute (and may ultimately be found to violate the challenger's trademark) is a feature of the Policy" See ICANN Staff Report, <http://www.icann.org/udrp-second-staff-report-240ct99-htm>.

The Complainant's decision to activate the "Lauritz Knudsen" branding in the year 2003 is the principal reason why it has decided to file the Complaint. The Complainant's decision to activate this trademark and trade name at a date falling well after the Respondent's registration cannot be good grounds for it to ask for the transfer of the domain name, notwithstanding that Lauritz Knudsen was the name of the founder of the Complainant company in 1893. The Respondent's associated companies can also claim a heritage flowing from the Danish gentleman Lauritz Knudsen since the business in Asia-Pacific was indeed first established by the Complainant and its forebears, and the Respondent's companies owed its technological background in the past and continuing to today, with Danish technicians and engineers. At the very least, the Complainant cannot prevent the Respondent from claiming and referring to its association with Lauritz Knudsen since that is the truth.

Since 2002 the Respondent has protected its trademark "Lauritz Knudsen" by filing corresponding trademark applications in numerous Asian countries. None of these filings have ever been challenged by the Complainant.

C. Additional Submissions

Complainant's additional submission:

Respondent, while formally an individual, correctly refers to the group of companies he controls as the real party in interest. It is common ground that this Respondent's group of companies has its roots in the Complainant's former Singapore subsidiary. It is also common ground that Respondent took over this subsidiary and by agreement to change the name within two years. As such, the relationship is one of former related companies, akin to the relationship between a trademark owner and its former distributor. Here the UDRP practice is quite clear: a distributor may not register a domain name identical to the principal's trademark, unless the principal has given his explicit prior consent. See *Sociedad Española del Acumulador Tudor S.A. v. Asesoria Materiales Exportacion S.L.*, D2005-0621 (WIPO Sept. 13, 2005) (finding that the distributorship agreement did not allow a distributor to register a domain name comprising the principal's trademark).

Respondent relies on *Schneider Elec. v. Schneider UK Ltd.*, D2006-1039 (WIPO Oct. 21, 2006). There the domain name was registered in 1999 and the distributor relationship did not end until 2004. In other words where the domain name there was registered *while* the Respondent was a distributor. Here the situation is the opposite.

Further, Respondent has *undertaken* to refrain from using "LAURITZ KNUDSEN" and to confine itself to using "LKE." Respondent asserts that it first became owner of the Danish subsidiary at the time when the agreement had already been entered into. This statement seems to be incorrect because Respondent was very much involved in the

Danish subsidiary at the time when the said agreement was signed. Soh Kim Wat (Respondent's father) was one of the incorporators, and that Soh Wee Yong (Respondent) was on the Board of Directors on April 4, 2000. On March 17, 2003, Respondent was named Vice-Chairman of the Board of Directors:

Thus Respondent, as former distributor and contracting party, has no *legitimate* rights or interests in LAURITZ KNUDSEN.

RIGHTS OR LEGITIMATE INTEREST

It is well settled that once a UDRP complainant has made a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶ 4(a)(ii). *See Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000). Respondent has not lifted such burden, see:

Respondent's unclear and undated photographs do not provide any evidence of rights in the name LAURITZ KNUDSEN.

Respondent's undocumented Chinese company names do not give rights in the English equivalent.

Annex 6 was filed late and either most of the crucial language is not translated into English, or concerns other trademarks.

On the Internet, LAURITZ KNUDSEN = Complainant

The subject matter of this dispute is a domain name, which is inherently Internet-related, in that domain names are integral parts of Internet website sites and email. Respondent postulates that an Internet search on "Lauritz Knudsen" would reveal a majority of sites relating to the Complainant. A Google search shows that the *vast* majority of hits concern the Complainant, being either direct links to the Complainant's website, or to Complainant's distributors, current and former employees, mention in trade press, etc. Respondent is mentioned at the bottom of page 5 of the Google search results, and even there it due to mention of the Respondent's Danish roots.

TRADEMARK / TRADE NAME

Under Danish trademark law, the use in itself of a sign can establish a trademark right and Danish law does not set as a condition that such a sign should be well-known as an identifier for the trademark holders goods and services offered in the relevant circle of trade. *See Sparbank Vest A/S v. Alexander Petrov*, FA 741638 (Nat. Arb. Forum Aug. 23, 2006) (where the Panel found that the complainant has established common law rights in the Danish Company name "SPARBANK VEST A/S" mark through continuous and extensive use of the mark in connection with its services since 1857); *see also Danish Camp Supply A/S v. Restore*, D2006-0214 (WIPO May 9, 2006) (where the Panel found

that Complainant had trademark rights to the name DANISH CAMP SUPPLY from use of its company name).

Complainant has been known as "LAURITZ KNUDSEN" for nearly 114 years. The registration of the trademarks in 2003 was merely confirmation of the trademark rights Complainant has established in the name.

REGISTRATION AND USE IN BAD FAITH

Because the Respondent, as former distributor, did not have permission to register the domain name with in 2001, well after the distribution relationship was terminated, it was in bad faith. Thus Respondent's reference to *Substance Abuse Mgmt., Inc. v. Screen Actors Modesi (sic) Int'l, Inc.*, D2001-0782 (WIPO Aug. 14, 2001) is inappropriate.

Respondent's additional submission:

Respondent received Complainant's Additional Submission in accordance with National Arbitration Forum Supplemental Rule 7(a) on 25th September 2007 (12.57 am local time in Singapore).

PROCEDURAL MATTERS

It is incorrect and misleading that the Response is 15 pages long. The substantive portion of the Response is 10½ pages long. It did exceed the limit marginally, but the contents of the 11th page contained mainly the certification and signature. Complainant has not been prejudiced by an excessively lengthy Response. The UDRP rule is meant only as a guide. The Respondent has tried to be as succinct as possible given the fact that the facts span a time period of 30 years. Paginated sheets 12 & 13 did not contain substantive portions of the Response but were instead, a Chronology of Events which we prepared only for the convenience of the Forum Panelists. Paginated sheets 14 & 15 comprise only a List of Annexures and Exhibits which is required in accordance with ICANN Rule 5(b)(ix). As such, paginated sheets 12 -15 should not be counted as part of the Response.

The Response together with Annexes and Exhibits ran into a total of 246 pages. It was not practicable to send hard copies of the Response to the Forum and the Complainant via facsimile transmission. The Respondent explains that due to time and logistical difficulties, hard copies could not be couriered to reach the Forum by 18th September 2007 as that would have meant shortening the Response period to an unreasonably short period for the Respondent to work within, thereby prejudicing the Respondent. The Respondent currently resides in Surrey, United Kingdom whereas his solicitor is in Singapore, and the voluminous documents for the annexes and exhibits had to be first searched for and then transmitted from China, Singapore, U.K. and Denmark. Company searches had to be undertaken in Singapore and Denmark. The search records of the Singapore company concerned were voluminous, as such records are placed on microfilm and went back to 1976. Due to the complex nature of the matter, numerous exchange of communication between the Respondent and his solicitor had to take place. The

Declaration of W Y Soh and the Response was finalized only just before 18th September 2007 and the original signed Declaration of W Y Soh could not be sent to Singapore for hard copy dissemination on a date sufficiently prior in time so as to allow for postal or courier delivery of hard copies of the Response from Singapore to Minnesota (location of National Arbitration Forum) and Copenhagen (location of Complainant's solicitor) by 18th September 2007. We contend that delivery of soft copies of the Response via email was sufficient to fully make known the Response to the Complainant without any prejudice being occasioned as all documents were printable.

The Complainant has protested that Annex 6 was not received until 24th September 2007. Annex 6 comprised copies of trademark registration certificates and trademark application documents. It is true that Annex 6 was not delivered initially through clerical mistake. However, even without receipt of Annex 6, the Complainant was already made aware in para 19 of the Declaration of W Y Soh, of steps taken by Respondent to register the trademark in numerous Asian countries. In addition, this was referred to at para 5.18 of the Response. Further, the Chronology of Events gave individual dates and details for steps taken by the Respondent to register "Lauritz Knudsen" trade mark in each of the Asian countries. The Complainant alerted the Respondent's solicitor as to the mistake only on 23rd September 2007 and Annex 6 was immediately emailed to the Complainant on 24th September 2007. Trademark registration documents are fairly standard in format. English translations of the documents relating to Taiwan, Thailand, Vietnam and Indonesia were provided. Only the documents relating to People's Republic of China were not translated, but the English word mark "LAURITZ KNUDSEN" and the dates (in Roman numeral) could clearly be seen.

THE PARTIES

The Respondent disagrees with the Complainant's submission that the relationship between the former Singapore subsidiary and the Complainant is akin to the relationship between a trademark owner and its former distributor. The former Singapore subsidiary engaged in full-scale manufacturing and installation and did not merely import goods manufactured by an overseas principal. Furthermore, the Singapore company was a fully owned subsidiary and was originally founded by the Complainant rather than being an unrelated company. In such a scenario the decision in *Sociedad Espanola del Acumulador Tudor SA v. Asesoria Materiales Exportacion S.L*, D2005-0621 (WIPO Sept. 19, 2005) has no relevance or application. There was certainly no distributionship agreement in existence governing the relationship, rights and obligations of the former Singapore subsidiary and the Complainant.

The decision in *Schneider Electronics GmbH v. Schneider UK Ltd*, D2006-1039 (WIPO Oct. 21, 2006) further illustrates that a even a former distributor can show a legitimate interest in registering a domain name containing a trademark based on the fact that a company with a certain name would find it desirable for commercial practicalities, to own a domain name containing the same name as well as to use an email address similar in name to the company name. That said, the Respondent's companies which are named "Lauritz Knudsen" has a legitimate interest in registering and retaining a domain name

containing the said corporate name, as well as for email purposes. The Schneider decision also showed that a relevant factor for the Panel to consider would be to avoid disruption to business interests of the Respondent. Since the Respondent has owned companies with the name "Lauritz Knudsen" for several years prior to the registration of the domain name it would surely be disruptive and against their business interests if **<lauritzknudsen.com>** were to be transferred to the Complainant.

We further make reference to *Tomatis Developpement SA v. Gerritsen*, D2006-0708 (WIPO Aug. 1, 2006). This case demonstrates that in the case of a terminated license agreement where the Respondent had no surviving connection with the former licensor, the Respondent was not ordered to transfer the domain name because there was no bad faith shown at the time of registration. This case states the principle that for the purposes of showing bad faith, the motives of the registrant at the time of registration are of crucial importance. The Policy was designed to deal with cybersquatters i.e. people who register domain names knowing them to be the trade marks of others and with the intention of causing damage or disruption to the trade mark owners and/or unfairly exploiting the trade marks to their own advantage. The preponderance of panelists construe this as calling for a bad faith intent at the time of registration. To do otherwise would open up the Policy to a far wider category of cases than it was ever intended to cover. The Panel should be under no doubt that when the Respondent registered the domain name **<lauritzknudsen.com>** he justifiably thought that what he was doing was something that he was entitled to do. In a case where the situation has changed such as in *Tomatis* where a license agreement has been terminated and a respondent has no surviving connection with the former licensee, and if, as the complainant claimed that the respondent's use of the domain name since termination infringes the complainant's rights, the proper forum for that dispute is the court and not an administrative proceeding under the UDRP.

THE NAME "LAURITZ KNUDSEN"

The Complainant has failed to discharge the burden of proof on them to show that "Lauritz Knudsen" was their trademark as at the material time. Instead, it was a 'secondary name' or 'supplementary name' on the Danish company register, as well as being the name of the original inventor/founder of Complainant. It is important to note that it was not even a 'secondary' or 'supplemental' name on the Danish company register until 23rd February 2004 (see Annex 3 of W Y Soh's Declaration). At this current time, the Complainant has no less than 20 supplemental names! It cannot be the case that all the supplemental names constitute trademarks. Prior to 2004, the supplemental names listing did not include "Lauritz Knudsen A/S." Instead, as from the very beginning in 1986, the corporate records show the entry as "LAUR. KNUDSEN" only, whether as supplemental name or official name. Further, under Danish law, the inclusion of supplementary names in the companies register only means that no other company may register an identical name. However, a mere registration of a secondary name does not give the holder any trademark rights. This would require either use as a trademark or registration as a trademark as defined in the Danish Trademarks Act.

The Complainant relied on *Sparbank Vest A/S v. Petrov*, FA 741638 (Nat. Arb. Forum Aug. 23, 2006) to say that under Danish law the use in itself of a sign can establish a

trademark right and Danish law does not set as a condition that such a sign should be well-known as an identifier for the trademark holders goods and services. However, this case can be distinguished from the present case where the Complainant at the material times were using the company name LK A/S or LK-NES A/S and as such, require to show specifically that "Lauritz Knudsen" was used as a sign to identify the goods. In the Sparbank decision, the complainant used "Sparbank" and it was found that they had established common law rights in "Sparbank Vest A/S" as a trademark and accordingly, had proven substantial goodwill and recognition of the mark in connection with the goods and services to establish secondary meaning and common law rights in the mark for the purposes of the UDRP Policy para 4(a)(i).

AGREEMENT OF 20th DECEMBER 2004

The Complainant's reliance on the above Agreement to place an obligation on the Respondent to transfer the domain name is misplaced. First, it has been held many times that disputes which turn on contractual interpretations will fall outside the scope of the Policy. *E.g., Private Media Group v. Anton Enterprises Inc.*, D2002-0693 (WIPO Sept. 30, 2002).

The reliance on the Agreement is further misplaced in that the Forum is not the correct decision-maker that the Agreement now places an obligation on the part of the Respondent to transfer the domain name as the Forum has simply no power to make such a decision. The Agreement was concluded several years after the registration of the domain name and never mentioned said domain name. The UDRP Policy cannot be used as a means to litigate broader disputes involving domain names.

The Agreement does not place any personal obligation on the Respondent in respect of the domain name and neither does it mention the domain name. As such, this Agreement is completely irrelevant.

Although the Respondent may have been a director of LK-NES Europe, he did not acquire any shareholding in this company until 2005.

PANEL MUST FIND THREE ELEMENTS TO EXIST CONJUNCTIVELY

The Panel is reminded that in order to succeed, the Complainant must establish of the following three elements:

- (i) the domain name registrant's domain name is identical, or confusingly similar, to a trademark in which the complainant has rights; and
- (ii) the registrant has no rights or legitimate interests in the domain name, and
- (iii) the domain was registered and is being used in bad faith.

A complaint cannot succeed on the basis of only one or two of the elements being found in favor of the Complainant.

In numerous decisions it has been shown that the Panel may decide that it is unnecessary to make any finding say, with reference to rights or legitimate interests if it is otherwise satisfied that the Complainant fails to establish one or two of the remaining elements e.g. the issue of bad faith. *See, e.g., Gerhardt v. Jones*, D2007-0033 (WIPO March 23, 2007). Complainant fully bears the burden of proof for each element. *See Golding v. Campbell*, D2007-0103 (WIPO Apr. 16, 2007). Importantly, the Complainant has failed at the very outset to show that "Lauritz Knudsen" was their trademark at the time when the domain name was first registered in 2001, and not just a secondary company name or personal name of their founder. Although the name "Lauritz Knudsen A/S" may have been recorded as a secondary company name, this was not until 23rd February 2004. The Complainant offers no proof that that was the name which they projected to the trade and public apart from a product catalogue bearing a 2004 date.

In light of the conclusion that Complainant failed even to prove their first element, the Panel need not go on to consider whether the Respondent has any right or legitimate interest in the domain name. It is important to note that universally, the definition of a trademark is that it is a sign which is used specifically for the purpose of indicating the source or origin of products to the consumer. Lauritz Knudsen the Danish gentleman may have been known in Denmark to be a famous inventor, but unless concise evidence is given that his name has acquired a secondary meaning to be equated in law with that of an unregistered trademark i.e. a recognition that the name should be associated with activities beyond the primary activity of Mr. Lauritz Knudsen as an inventor, the Complainant would not have discharged the burden under the first element. It is certainly not the policy under the UDRP to protect proper names. *See, e.g., Springsteen v. Burgar*, D2000-1532 (WIPO Feb. 7, 2001).

The Schneider decision shows that in situations where parties have entered into and maintained a long-standing commercial relationship, Panels tend to impose on the Complainant a heavier burden of proof for bad faith. Allegations of bad faith aimed at a former distributor or licensee can only be properly understood in the full context of their prior history. The Respondent respectfully points out that the contents of their website at <lauritzknudsen.com> bore no resemblance to the contents of the website of the Complainant in Denmark in either its design, product range or any other textual or visual respects. Indeed, it is clear that the domain name and website was required and utilized fully in connection with a very substantial business undertaking established by the Respondent in Asia first as a successor in title to the Complainant's own abandoned business in Asia and thence greatly expanded, and, most importantly, to which expansion and operation the Complainant has never at any time objected.

Other cases such as *The Thread com, LLC v. Poploff*, D2000- 1470 (WIPO Jan. 11, 2001) are instructive to show that the complaint ought to be dismissed. The factual situation in *The Thread* results in a decision stating that it was not a garden-variety cybersquatting case, and in fact, not a cybersquatting case at all. Rather, it was a breach of contract and breach of fiduciary duty dispute between former partners. The only arguable reason that the complainant was seeking relief in the forum is that the property at issue is a domain name. The Panel is not a general domain name court, and the Policy is not designed to

adjudicate all disputes of any kind that relate in any way to domain names. To attempt to shoehorn what is essentially a business dispute between former partners into a proceeding to adjudicate cybersquatting is, at its core, misguided, if not a misuse of the Policy. For example, in *Latent Technology Group, Inc. v. Fitchie*, FA 95285 (Nat. Arb. Forum Sept 1, 2000) it was a dispute concerning employee's registration of a domain name in his own name and subsequent refusal to transfer it to employer. This raised issues of breach of contract and breach of fiduciary duty, which the Panel decided were more appropriate to be decided in court, not before a UDRP panel.

It must be noted for the record that the arguments the Respondent has made are not to be read as an assertion that there is in existence any dispute between the parties as regards the interpretation of the Settlement Agreement dated 20th December 2004 or as regards the use of the trademark and domain name "Lauritz Knudsen." As Respondent has earlier stated, he did not have any idea that Complainant objected to his domain name.

INTERNET ISSUES

The Complainant includes as support for their contention, that on the Internet, LAURITZ KNUDSEN = Complainant. In response thereto, the Respondent points out that it would be perfectly apparent to any Internet user that one needs to browse from one search result to another to find the information and material that he or she is looking for in relation to a search item. The name Lauritz Knudsen is a proper name and it is conceivable that there may be numerous hits generated from search results due to this. In any case, it is not part of UDRP caselaw that a domain name dispute case should be determined on the basis of the results of a Google Internet search for the majority of references.

COMPLAINANT FAILED TO RESPOND TO IMPORTANT POINTS IN RESPONSE

It is pertinent to note that the Complainant has failed specifically to answer numerous important points raised by the Respondent in the Response:-

Non-exhaustively, the Complainant has for example:-

[a.] failed to explain why there was a delay of nearly 6 years before Complainant formally objected to the registration of the domain name.

[b.] failed to produce any proof that "Lauritz Knudsen" was their trademark and used on or in relation to products to designate their source or origin. The only document they relied on was dated in 2004, which was after the registration of the domain name.

[c.] failed to explain why, although they took action to protect their trademark "LK", they did not do so for "Lauritz Knudsen."

FINDINGS

Both parties claim rights to the "Lauritz Knudsen" mark. Respondent is an individual whose father was (at one time) employed by a subsidiary of Complainant in Singapore. A company now controlled by Respondent was a wholly owned subsidiary of Complainant, but was completely divested a number of years ago. Based upon the extensive material recited above, the Panel finds:

- (1) the domain name registered by the Respondent is identical to the "Lauritz Knudsen" mark, but Complainant has not established rights to that mark;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name because he does not conduct business under this "Lauritz Knudsen" mark (although he is a shareholder in companies that do); and
- (3) the domain name was not registered and is not being used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The domain name is identical to Complainant's tradename, with the addition of the gTLD ".com" and omitting a space. *See Roberts v. Boyd*, D2000-0210 (WIPO May 29, 2000); *Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2002) (finding <hannoverre.com> to be identical to HANNOVER RE, "as spaces are impermissible in domain names and a generic top-level domain such as '.com' or '.net' is required in domain names"); *see also Wembley Nat'l Stadium Ltd. v. Thomson*, D2000-1233 (WIPO Nov. 16, 2000) (finding that the domain name <wembleystadium.net> is identical to the WEMBLEY STADIUM mark); *see also Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar).

Respondent disputes Complainant's assertion of rights in the LAURITZ KNUDSEN mark prior to its registration as a trademark in 2005 (which is AFTER Respondent registered his domain name). Based upon the information provided, Complainant did not use LAURITZ KNUDSEN as an alternative tradename until February 23, 2004 (which is AFTER Respondent registered his domain name). The pamphlet provided to demonstrate the use of the name is dated June 2004 (which is AFTER Respondent registered his domain name). Based upon the information provided, there is no substantial evidence Complainant LAURITZ KNUDSEN used the mark immediately before Respondent registered the domain name.

The Panel further finds Policy ¶ 4(a)(i) requires Complainant's rights to predate Respondent's domain name registration and these rights do not necessarily have to be trademark rights. Rights in a name are sufficient to satisfy the requirements of the Policy. *See Phoenix Mortgage Corp. v. Toggas*, D2001-0101 (WIPO Mar. 30, 2001) (“[Policy ¶ 4(a)(i)] necessarily implies that the Complainant's [trademark] rights predate the Respondent's registration and use of the Domain Name. Any other interpretation would allow a junior trademark user to challenge a prior domain name registration, a possibility that is obviously contrary to the intent of the Policy and to trademark law generally”); *see also EU Prop. Portfolio Ltd. v. Salvia Corp.*, FA 873726 (Nat. Arb. Forum Feb. 7, 2007) (finding that the complainant could not establish rights in the <eupp.com> domain name where its use of the EUPP mark did not predate the respondent's registration of the domain name).

Complainant's claims to the LAURITZ KNUDSEN mark which predate 1968 (when Complainant changed its name to LK-NES A/S) are simply too distant in time to support a finding of present rights at the time the domain name was registered.

The Panel finds Policy ¶ 4(a)(i) not satisfied.

Rights or Legitimate Interests

Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to show that it does have rights or legitimate interests pursuant to Policy ¶ 4(a)(ii). *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is “uniquely within the knowledge and control of the respondent”); *see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent has no right or legitimate interest is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist).

Respondent is not licensed to register names featuring LAURITZ KNUDSEN mark or any derivation thereof. Respondent has failed to establish that he is commonly known by the <lauritzknudsen.com> domain name pursuant to Policy ¶ 4(c)(ii). *See IndyMac*

Bank F.S.B. v. Eshback, FA 830934 (Nat. Arb. Forum Dec. 7, 2006) (finding that the respondent failed to establish rights and legitimate interests in the <emitmortgage.com> domain name as the respondent was not authorized to register domain names featuring the complainant's mark and failed to submit evidence of that it is commonly known by the disputed domain name); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

Respondent claims rights to the LAURITZ KNUDSEN mark due to his shareholdings (unspecified in amount or percentage for all of the relevant times) in various companies which use the mark. A respondent may only assert the respondent's rights and not the rights of a third party, *Mattel, Inc. v. RanComp Ltd.* FA0510000579563 (6/14/2004) and *YUM! Brands Inc. and KFC Corporation v. Ether Graphics a/k/a Andrew Gruner*, FA 212651 (Nat. Arb. Forum Jan. 2, 2004). These companies do not have an interest in the domain name because their interest does not appear in the WHOIS information. It does not appear from the WHOIS information Respondent is acting as a trustee.

If any one of Respondent's companies were the owners of the <lauritzknudsen.com> domain name, the Panel's finding on this element might well have been to the contrary.

The Panel finds Policy ¶ 4(a)(ii) satisfied.

Registration and Use in Bad Faith

Complainant failed to meet the burden of proof of bad faith registration and use under Policy ¶ 4(a)(iii). *See Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (finding that the complainant failed to establish that respondent registered and used the disputed domain name in bad faith because mere assertions of bad faith are insufficient for a complainant to establish Policy ¶4(a)(iii)); *see also Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

It should be noted the settlement agreement Complainant refers to is not with Respondent. While Respondent subsequently acquired some undisclosed stock holding in this company, this was done AFTER Respondent registered the <lauritzknudsen.com> domain name.

The Panel finds Policy ¶ 4(a)(ii) not satisfied.

Based upon the past relationships between the parties and entities associated with them, the Panel does not believe this is a case of reverse domain name hijacking.

DECISION

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.



Honorable Daniel Banks
Arbitrator

Daniel Banks, Chair and Panelist

Dated: October 26, 2007

Houston Putnam Lowry, Chartered Arbitrator and Panelist

David Tatham, Panelist

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