



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Societe des Produits Nestle S.A. v. Pro Fiducia Treuhand AG

Case No. D2001-0916

1. The Parties

Complainant is Societe des Produits Nestle SA, a Swiss joint stock company incorporated and with its principal place of business in Vevey, Switzerland.

Respondent is Pro Fiducia Treuhand AG, a Swiss joint stock company incorporated and with its principle place of business in Hergiswil, Switzerland.

2. The Domain Name(s) and Registrar

The domain name at issue is: <maggi.com> ("the Domain Name").

The registrar is Network Solutions, Inc., Herndon, Virginia.

3. Procedural History

This action was brought in accordance with the ICANN Uniform Domain Name Dispute Resolution Policy, dated October 24, 1999 ("the Policy") and the ICANN Rules of Uniform Domain Name Dispute Resolution Policy, dated October 24, 1999 ("the Rules").

The Complaint was submitted on July 17, 2001, and amended on July 27, 2001. The Response was submitted on August 17, 2001. Respondent elected to have the matter decided by a three-member panel.

On September 27, 2001, the WIPO Arbitration and Mediation Center appointed Desmond James Ryan, M. Scott Donahey and Mark V. B. Partridge (presiding) as Panelists.

Complainant filed an additional submission on August 23, 2001, and Respondent filed an objection and rejoinder on October 2, 2001. Paragraph 12 of the Rules provides that additional submissions may be received at the sole discretion of the Panel. Because of the expedited nature of these proceedings, absent unusual

circumstances, it appears appropriate to exclude additional submissions that have not been requested by the Panel. See *J.P. Morgan v. Resource Marketing*, [Case No. D2000-0035](#) (WIPO 2000). We decline to accept the additional submissions here because it appears they merely provide additional argument on matters covered in the initial submissions and do not affect either party's opportunity to present its case. *Blue Sky Software Corp. v. Digital Sierra Inc. and Abdullah Khan*, [Case No. D2000-0165](#) (WIPO 2000).

4. Factual Background

Complainant is well-known as one of the largest multi-national food companies in the world. Among its many famous brands is MAGGI, which is the subject of numerous trademark registrations throughout the world. The MAGGI mark is used by Complainant's subsidiary company Maggi Enterprises Ltd. for various food products, including bouillon, soup, seasoning, sauce and prepared dishes.

Romeo Maggi is the Chairman and majority shareholder of Respondent, Pro Fiducia Treuhand AG. On June 12, 1996, Mr. Maggi registered the Domain Name [maggi.com](#). He provided the company name as the registrant and identified himself, Romeo Maggi, as the administrative and billing contact.

In 1999, Mr. Maggi submitted a Registrant Name Change Agreement dated November 9, 1999, to record himself as the Registrant of the Domain Name. For unknown reasons, the submission was not carried out.

At some point after registration, Mr. Maggi decided to create a web site for his family and for a foundation he intends to establish, The Maggi Foundation. In this regard, he worked with web designers to draft a possible web site. Respondent's submissions included a Web site Development Proposal for "Project Maggi," dated July 4, 2000. The proposal includes a detailed cost estimate for creation of the proposed site. As of June 26, 2001, the domain name led to a web page featuring a family photograph and the legend: "The Maggi Family . . . is coming soon!"

Complainant first contacted Respondent about this matter on July 23, 1999, asserting its trademark rights in MAGGI and requesting transfer of the Domain Name. Mr. Maggi responded on August 27, 1999, through his lawyer, explaining that the Domain Name corresponded to his family name and he had no reason to transfer it to Complainant. Correspondence continued between the parties for over a year, culminating in a meeting in Geneva in October, 2000.

5. Parties' Contentions

Complainant contends that Respondent lacks any legitimate interest in the Domain Name because the Registrant is a company that has no rights or interest in the name. Complainant further contends that the Domain Name is registered and used in bad faith because MAGGI is a world famous mark and because Respondent "has not properly used it up to now."

Mr. Maggi asserts that he is the real party in interest, that he has a legitimate interest in a Domain Name corresponding to his family name, and that he intends to use the Domain Name for a web site concerning the Maggi family. Respondent further seeks a finding of reverse domain name hijacking, on the grounds that Complainant is well aware of his legal right to have a domain name corresponding to his family name.

6. Discussion

A. Confusing Similarity

The material portion of the Domain Name is identical to a mark in which Complainant has prior trademark rights. Therefore, Complainant has met its burden on the first element of its claim.

B. Legitimate Interest

Paragraph 4(c)(ii) of the Policy indicates that the Panel may find a legitimate interest in the domain name if the circumstances show that the Respondent has been commonly known by the name.

Complainant contends Respondent lacks any legitimate interest in the Domain Name because MAGGI is not the name of the named Respondent. In making this claim, Complainant ignores facts known to it prior to the filing of the Complaint. It is undisputed that the chairman and majority shareholder of the named Respondent is Romeo Maggi. In fact, it appears representatives of Complainant personally met with Mr. Maggi about this matter months before the Complaint was filed.

Prior decisions have recognized that an individual has a legitimate interest in a domain name that corresponds to that person's name. See e.g., *Valazquez Jimenez v. Velazquez-Perez*, [Case No. D2001-0342](#) (WIPO 2001); and *G.A. Modefine SA v. A.R. Mani*, [Case No. D2001-0537](#) (WIPO 2001).

Here, the circumstances similarly indicate Respondent has a legitimate interest in the name, despite the fact that the Domain Name was originally registered by Mr. Maggi using his company name, rather than his personal name. It appears that the name was registered by Mr. Maggi for personal rather than business use. Indeed, he designated himself as the administrative contact and later submitted documentation to identify himself as the registrant. There is no reason to believe that the company was merely using the name of an officer or employee as a pretext to trade on the rights of another. And there is no reason to suspect that Mr. Maggi's claim to the Maggi name is a sham. Records long predating this dispute show it to be his true name. Accordingly, we find that Respondent has a legitimate interest in the Domain Name, and Complainant can has failed to establish the second necessary element of its claim.

C. Bad Faith

We also find that Complainant has failed to demonstrate bad faith use and registration. Although failure to make bona fide use of a domain name has been cited in some cases as a factor to consider in determining bad faith, lack of bona fide use on its own is insufficient to establish bad faith. Here, Respondent has not attempted to sell the Domain Name for profit, has not engaged in a pattern of conduct depriving others of the ability to obtain domain names corresponding to their trademarks, is not a competitor of Complainant seeking to disrupt its business, and is not using the Domain Name to divert Internet users for commercial gain. In short, none of the circumstances listed in the Policy are present here, and we find no additional circumstances to justify a finding of bad faith. Instead, the evidence as a whole is consistent with Respondent's claim that Mr. Maggi intends to use the Domain Name in good faith for a web site concerning the Maggi family.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides:

If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Respondent urges that we make a finding of Reverse Domain Name Hijacking on the grounds that Complainant, a sophisticated Swiss company, knew of Respondent's rights under Swiss law to use his name as a domain name. Respondent asserts that Complainant has instead engaged in a campaign of intimidation to dispossess Respondent of the Domain Name.

A similar case of alleged abuse occurred in *G. A. Modefine S.A. v. A.R. Mani*, [Case No. D2001-0537](#). In that case, Mr. A.R. Mani was the registrant of the domain name <armani.com>. The Panel found that the complainant had been brought in bad faith, stating:

The Panel finds the failure of the Complainant in its Complaint to set out any of the clearly lengthy background to this dispute is surprising. The Complainant or entities associated with it have been pursuing the Respondent

since 1995, through various representatives. The Panel is left with a strong sense that the reason these actions have led nowhere is because they come up against the same issue as has been identified in these proceedings, namely, the Respondent's legitimate use of a variant of his own name. The Complainant states . . . in accordance with the Policy, that "the Complainant certifies that the information contained in the Complaint is to the best of the Complainant's knowledge complete and accurate." The Panel does not see how that could properly have been said. In the circumstances, the Panel concludes, pursuant of paragraph 15(e) of the Rules, that this Complaint has been brought in bad faith, and that it constitutes an abuse of the administrative proceeding.

Complainant here has similarly avoided the full story. As a result of its rather lengthy dealings with Mr. Maggi, Complainant was aware that Mr. Maggi intended to use the Domain Name for personal use, yet Complainant ignores these negotiations in the Complaint and fails to even mention Respondent's alleged personal interest in the Domain Name. In fact, the initial complaint misstated the registration record by failing to name Mr. Maggi as the administrative contact, an error later corrected when noted by the WIPO staff. Had Mr. Maggi failed to defend his position, perhaps Complainant's lack of candor might have resulted in a decision in its favor. Having instead been exposed, that lack of candor concerning material facts, tied with the lack of legal merit to Complainant's position, leads us to the conclusion that this Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Conclusion

Complainant has failed to show that Respondent lacks a legitimate interest in the Domain Name <maggi.com> or that the Domain Name was registered and used in bad faith. Therefore, Complainant's request for relief is denied. In addition, the Panel finds that the Complainant was brought in bad faith and constitutes an abuse of the administrative proceeding.

Mark V. B. Partridge
Presiding Panelist

Desmond James Ryan
Panelist

M.Scott Donahey
Panelist

Dated: October 12, 2001