

## **ADMINISTRATIVE PANEL DECISION**

**WALA-Heilmittel GmbH v. Canada Jumeira / Contact Privacy Inc.**

**Case No. D2013-0782**

### **1. The Parties**

The Complainant is WALA-Heilmittel GmbH of Bad Boll, Germany, represented by Prinz & Partner, Germany.

The Respondent is Canada Jumeira of Dubai, United Arab Emirates (“UAE”); Contact Privacy Inc. of Toronto, Ontario, Canada, represented by The Muscovitch Law Firm, Canada.

### **2. The disputed domain name and Registrar**

The disputed domain name <wala.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 2, 2013. On May 2, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 6, 2013 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 10, 2013.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 13, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response June 2, 2013. The Response was filed with the Center June 2, 2013.

The Center appointed Adam Taylor, Stephanie Hartung and The Hon Neil Brown Q.C. as panelists in this matter on June 18, 2013. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the

Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is incorporated in Germany. Since the 1930s, it has developed, produced and marketed natural and homeopathic medicines under the name "Wala". In 1967, the Complainant extended the "Wala" product range by adding a skin care cosmetics line under the name "Dr. Hauschka".

The Complainant has branches in Australia, Belgium, Chile, Denmark, Finland, France, Greece, United Kingdom of Great Britain and Northern Ireland, Hong Kong, China, Ireland, Italy, Japan, Canada, Croatia, Malaysia, Mexico, New Zealand, The Netherlands, Norway, Austria, Poland, Portugal, the Russian Federation, Sweden, Switzerland, South Africa, Spain, Turkey, Hungary and the United States of America.

The Complainant owns a range of registered trade marks for the word WALA including:

- 1) German Trade Mark No. 39532706 for the word WALA registered on January 19, 1996, in classes 5, 29 and 32;
- 2) German Trade Mark No. 639317 for a figurative mark including the word WALA registered on June 3, 1953, in classes 5 and 32;
- 3) International Registration No. 665369 for the word WALA applying to Norway, Switzerland, Liechtenstein, Monaco, the Russian Federation, San Marino, Ukraine, Austria, Benelux, Czech Republic, Spain, France, Hungary, Italy, Poland, Portugal, Slovenia, Slovakia, Denmark, Finland, United Kingdom, Norway and Sweden registered on August 9, 1996, in classes 5 and 29;
- 4) International Registration No. 210130 for a figurative mark including the word WALA applying to, *inter alia*, Bahrain, Denmark, Finland, United Kingdom, Norway, Sultanate of Oman, Sweden, Austria, Benelux, Switzerland, Egypt, Spain, France, Hungary, Italy, Liechtenstein, Morocco, Monaco, Poland, Portugal, Romania, San Marino, Romania, Tunisia and Viet Nam registered on May 29, 1958, in classes 5 and 32; and
- 5) United States Trade Mark No. 73785021 for a figurative mark including the word WALA registered on May 14, 1991, in international class 5.

On November 23, 1999, the disputed domain name was registered by Iyad Aswad, a civil engineer and a Canadian citizen of Syrian origin. He moved from Syria to Canada in 1999. He then lived between Canada and Dubai before settling in Dubai in 2007. (There is no dispute that the Mr. Aswad controls the disputed domain name and references to the "Respondent" hereafter include Mr. Aswad.)

On or about September 14, 2000, the Respondent uploaded a web page at "<http://wala.com/lasik/>" to thank the doctor with whom he had had successful Lasik laser eye surgery.

On or about April 2, 2001, the Respondent forwarded the disputed domain name to a website consisting of an index to the Quran.

In 2003/2004, the Respondent used the disputed domain name for an information website about a new business he was starting, called "JOB General Transport".

On May 17, 2004, the Respondent incorporated a general trading company in Dubai by the name of "Canada FZE". (The acronym, FZE, stands for "Free Zone Establishment". A "Free Zone" enables foreign-owned businesses to be licensed in the UAE.)

For most or all of the period from about July 2004 to 2010 the home page of the website comprised different versions of a "not for sale" notice, one of which comprised a translation of the term "Not for Sale" into ten

languages.

An archive Whois record dated September 4, 2004, shows that the registrant and administrative contact name was "Iyad Aswad" and what appears to be a complete (Dubai) address is given for both contacts. There was also an "aswad@[...]" email address and a telephone/fax number.

From 2004 to 2006, the Respondent used the website to upload photos of various trips abroad, although not visible to the public from the front page of the website.

As of January 7, 2011, the home page of the Respondent's website carried a message stating: "DOMAIN FOR SALE: US\$= 5,000,000,00 ONLY. THIS DOMAIN IS FOR SALE. US\$ = 5,000,000.00 = ONLY."

According to an archive Whois record dated March 16, 2011, the registrant name for the disputed domain name was shown as "Canada", with "Iyad Aswad" still listed as administrative contract. Both were shown as located at the same Dubai address as previously (although the street/house number had been removed from the address). The email address had been changed to a Gmail one.

As of March 22, 2011, the disputed domain name was switched into the name of a proxy service.

At some point later in 2011, the Respondent switched the front page to a simple "under reconstruction" notice.

In around November/early December 2011, the Complainant sent a cease and desist email to the Respondent. The Respondent replied on December 7, 2011, stating: "You should know that our domain has never been exposed to your trade mark or to any equivalent related deals or businesses, and being registered for ages under our name. Please feel free to start any procedure you like and our New York lawyer will act accordingly. Regards, Wala.com."

When visited by the Panel in the course of preparing this decision, the website at the disputed domain name comprised a large family photograph labelled "Aswad family", with a notice at the bottom stating "personal website".

## **5. Parties' Contentions**

### **A. Complainant**

Identical or Confusingly Similar

The Complainant develops, produces and markets natural and homeopathic medicines and cosmetics. In both fields, the Complainant is extremely well-known in the trade circles concerned.

The Complainant enjoys an outstanding reputation as one of the pioneers and most important manufacturer of homeopathic pharmaceuticals. As a member of the American Association of Homeopathic Pharmacists (AAHP), and as one of the world's leaders in homeopathic medicines, the Complainant produces medicinal herb extracts using the methods developed by Rudolf Hauschka. Nowadays, the Complainant offers over 900 different pharmaceuticals in numerous countries worldwide.

The Complainant's "Dr. Hauschka' Skin Care" line includes more than 130 cosmetics. In 2010, this brand was included in the encyclopedia "GERMAN STANDARD Brands of the century", Langenscheidt 2010 as one of Germany's most known, reputed and important trade marks of the century. It is important that both on packaging and advertising for "Dr. Hauschka" products, the name "Dr. Hauschka" is always used in conjunction with the trade mark and company name "Wala". Use of this highly distinctive trade mark, clearly indicates that the products originate from the Complainant. The company name "Wala" is always printed on all promotional material.

Since the 1960s, the Complainant has used the sign "WALA" extensively in advertising, brochures, scientific publications and press releases worldwide.

For 65 years, consumers all over the world have been well aware that the "Dr. Hauschka" products are made and manufactured by the Complainant "WALA-Heilmittel GmbH". Therefore, both the trade mark and the company name "Wala" are extremely well-known worldwide. In particular, the "Dr. Hauschka" Skin Care" products and its manufacturer, the Complainant, enjoy an outstanding reputation internationally including in North America. The Complainant's "Dr. Hauschka" product range is frequently subject of high-profile media coverage in publications such as Elle, Conde Nast, Women's World and Marie Claire.

Various magazines and newspapers report that some of Hollywood's actors state that they are using the Complainant's "Dr. Hauschka" products.

The Complainant's pharmaceuticals and "Dr. Hauschka" cosmetics enjoy an outstanding reputation for providing high quality homeopathic products without synthetic preservatives, artificial fragrances or colourings. This established reputation especially includes Europe, Canada, the United States, Canada and the Middle East.

The disputed domain name is identical to the Complainant's trademarks.

#### Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name. The name "Wala" does not carry any generic meaning. Furthermore, the Respondent is neither a licensee of the Complainant nor is he affiliated with the Complainant or acting with the consent of the Complainant.

#### Registered and Used in Bad Faith

The disputed domain name was originally registered after some of the Complainant's WALA trade marks were registered and after intensive and long lasting use and international promotion.

Using the "Wayback" search engines, the Complainant can verify that the Respondent offered the disputed domain name for sale at five million US dollars. This exorbitant amount clearly shows that the Respondent was fully aware of the outstanding reputation and value of the trade mark and company name WALA. All the more, since the Respondent sells its other domain names for prices ranging from 99 to 1,999 US dollars. This shows that the Respondent clearly knew about the value of the Complainant's very well-known trade marks and company names WALA. Otherwise, it cannot be explained why he would offer the disputed domain name <wala.com> for the very excessive sum of five million US dollars, whereas all of his other domain names are offered for less than 2,000 US dollars.

Against this background of the inactive use of the disputed domain name (the disputed domain name currently shows a mere "under construction" page), the sole and single purpose of the registration was to sell the disputed domain name for valuable consideration in excess of expenses.

The consensus view under the UDRP is that there can be use in bad faith even when the domain name is not actively used and the domain name holder has taken no active steps to sell the domain name by contacting the trade mark holder - but actively markets the domain name for sale. Mere passive holding with the apparent lack of any active attempt to contact the trade mark holder does not as such prevent a finding of bad faith. Here, the disputed domain name shows an "under construction" template and was actively marketed for sale at the exorbitant price of 5 million US dollars.

The Respondent "could have easily known" about the existence of the Complainant's trade mark. The Complainant's International Registration No. 210130 was registered on May 29, 1958. Beyond that, and keeping the Complainant's long-lasting history in mind, even a simple Google search (generating 120 million hits) using the term "wala" would have given the Respondent a comprehensive overview of the Complainant's field of business - especially the company name and trade mark WALA. All the more since

well before the registration of the disputed domain name, the name “Wala” was printed on all “Dr. Hauschka” products, packaging and brochures, which state that “‘Dr. Hauschka’ Skin Care” preparations are manufactured in Germany by “WALA-Heilmittel”.

The disputed domain name was originally registered by the registrant “Canada” on November 23, 1999 using Tucows Inc. as the registrar. The administrative contact of the disputed domain name in the historical Whois record displayed “Aswad Iyad” and an address in “Jumeira, Dubai, AE 16346 AE”. Bearing in mind the worldwide reputation of the Complainant’s “‘Dr. Hauschka’ Skin Care” brand, with the product being offered in numerous spas and beauty salons in Dubai and the continued intensive promotion in international fashion magazines also distributed in the Arab world, it was obvious even at the time of the first registration on November 23, 1999 that the term “wala” represented the Complainant, a world leader in homeopathic pharmaceuticals and cosmetics. Following the transfer of the disputed domain name in 2011 from the registrant “Canada” to “Contact Privacy Inc.”, the registrar and name servers have remained the same.

By the time of the first registration in 1999, the Complainant’s trade mark rights in WALA as well as the company name “Wala” were extremely well-known internationally and the Complainant’s submissions as to bad faith are partly based on the fact that the Respondent “could have easily known” about the existence of the Complainant’s trade mark.

The circumstances indicating evidence of registration and use in bad faith in paragraph 4(b) of the Policy are examples only. UDRP panels have stressed in numerous decisions that the use of a proxy registration service to avoid disclosing the name and coordinates of the real party constitute an additional indication of bad faith.

The only use of the pseudonym “Canada” was to hide the Registrant’s true identity. All the more so since, as a second step, the registrant “Canada” transferred the disputed domain name to “Contact Privacy Inc.”, a registration service seeking to conceal the identity of the true registrant.

There is a pattern of bad faith as the Respondent’s email address is shown as administrative and technical contact for 158 domain names, many of which are actively marketed for sale such as <800burger.com>, <cachef.com>, <canadadiary.com>, <emirati.org>, <mtl.mobi> and <mydarling.tv>.

## **B. Respondent**

### Identical or Confusingly Similar

The Complainant is the owner of several trade marks for WALA.

By the Complainant’s own admission, as of November 23, 1999, it only had two German trade marks, two International trade marks (which did not cover Syria, the UAE or Canada), as well as a United States trade mark.

Nevertheless, for the purpose of the Policy, this is sufficient since the disputed domain name is acknowledged to be identical to the Complainant’s trade marks, as understood by the Policy.

### Rights or Legitimate Interests

The initial registration of the disputed domain name openly reflected the Respondent’s personal name as well as his then current residential address in Dubai.

Shortly after he registered the business entity, “Canada FZE”, the Respondent updated the registration data for the disputed domain name to reflect his new entity’s name, *i.e.* “Canada”, but kept all of his personal data intact in his capacity as administrator, including full name, address, telephone and fax number.

There is no truth whatsoever to the Complainant’s express allegation that “Canada” was a mere “pseudonym” used by the Respondent to conceal his true identity from the Complainant. To the contrary, the

Respondent's identity and contact details were openly disclosed for 12 years, until on or about March 21, 2011, when the Respondent simply engaged the registrar's standard privacy service.

The Respondent resided in both Canada and the UAE at the time that he registered the disputed domain name. He speaks Arabic as his mother tongue.

The reason that the Respondent registered the disputed domain name was that he was very familiar with the term, "wala", because it was a common Arabic slang term, for a naughty "boy", derived from the formal word for "boy", "walad". Then the Respondent was known by the nickname, "Wala" by his friends, who considered him something of a "playboy", since he was very late to marry and because he "carried on quite a bit" during his extended youth.

The Respondent was also familiar with the word, "wala", as it referred to a kind of oath in Arabic, and is also commonly used in conversation and in lyrics, to loosely mean the phrase, "not even", as in "wala wahed" ("not even one"). There are many references to the word "wala" in Arabic music, referencing all of the aforementioned various meanings. However, in many Arabic songs, the term, "wala" is used in the sense that the Respondent was most familiar with, as in a naughty boy or playboy.

Accordingly, the Respondent reserved the disputed domain name for himself by registering it, and thought nothing of it. He was busy in his personal life and as a professional civil engineer and was not involved in the Internet to any significant extent.

The Respondent has declared under penalty of perjury that, when he registered the disputed domain name, he had never heard of the Complainant or its brand WALA.

This is hardly surprising as the Complainant has submitted no evidence that in the UAE, Syria, or in Canada, back in 1999, there would have been any likely reason that the Respondent would have known of the Complainant's mark. For example, the Complainant has failed to submit any Syrian, Canadian, or UAE sales data or distribution figures.

A search for the word "wala" using "www.google.ae" does not reference the Complainant once on the first page of results. In all likelihood, the absence of any references to the Complainant would have been even more pronounced had this search been conducted nearly 14 years ago when the disputed domain name was registered by the Respondent.

Similarly, a search today, using "www.google.com" (from Toronto), for "wala", shows that the Complainant is barely referenced, with only the fourth listing out of numerous others people and companies that use the term "wala" for all manner of things, including a Fox News affiliate in Alabama called WALA-TV, the Western Australia Little Athletics, the Wisconsin Assisted Living Association, the goddess called Wala, the Spanish sportswear manufacturer called Wala, the Western Amateur Linking Association, and the musical artist, Wala.

It was the WALA-TV Alabama Fox News affiliate TV station that was the first to demand that the disputed domain name be transferred to it, back in 2000. The Respondent had never heard of this TV station in Alabama, and refused to hand over the disputed domain name to it.

Upon registering the disputed domain name, the Respondent started using it for email and has done so to date.

By 2004, the Respondent was receiving a lot of spam and solicitations to purchase the disputed domain name from all kinds of people, including emails with large attachments that were affecting his email services. Accordingly, from July 2004, he posted various "not for sale" notices on the home page of the website at the disputed domain name.

Inquiries kept coming in to buy the disputed domain name over the years, and all such inquiries were ignored or refused by the Respondent. Finally, in an exasperated effort to "get the point across", in January 2011,

the Respondent put up another notice saying, "DOMAIN FOR SALE: US\$=5,000,000.00 ONLY", with the intention being that this should surely discourage further unwanted solicitations. But further email solicitations continued to come in despite Respondent's efforts to discourage them. The Respondent had this notice up for about 10 months but, since it was not having its desired effect, he went to an "under reconstruction" notice in 2011.

For the Complaint to succeed, the Panel must find that the Respondent has "a total lack of any right or legitimate interest"; not merely that the Complainant has a purported "better" right or legitimate interest.

The Complainant erroneously claims that the name "Wala" does not carry any generic meaning. Maybe not in German, but in Arabic the disputed domain name corresponds to a common colloquial, or slang expression related to the word, "boy". It has been long held that where a domain name is generic, the first person to register it in good faith is entitled to the domain name. This is considered a "legitimate interest".

In accordance with paragraph 4(c)(ii) of the Policy, the Respondent has been known as a "wala" to his friends.

The Respondent has actually used the disputed domain name in connection with email, and also for a personal, noncommercial website that enabled him to upload material and photos of interest to him and his friends and family, in accordance with paragraphs 4(c)(i) and (iii) of the Policy. Use of a domain name for rather benign noncommercial personal websites in connection with hosting family photographs and other personal material over the course of many years is within the ambit of paragraph 4(c)(iii) of the Policy.

#### Registered and Used in Bad Faith

The Complainant states that "it is extremely well-known to the trade circles concerned", but outside of these "trade circles", it is questionable whether the Complainant's WALA mark is genuinely widely and well-known.

Neither the Respondent nor anybody that the Respondent has talked to about this matter has ever heard of the Complainant or its "Wala" brand.

The extensive list of trade-related articles, newsletters and brochures exhibited by the Complainant are mainly targeted towards doctors who are involved in the homeopathic and skin-care industries, and not the much broader, general public, let alone the public all over the world. In fact, several of these publications are expressly addressed with the salutation, "Dear Dr.". Furthermore, many of these publications are expressly addressed to trade professionals, and include the express description: "Price List for Wholesalers/Importers".

Most of the publications which the Complainant has ostensibly proffered to establish its "outstanding reputation", do not relate to, nor publicise, the WALA mark at all. Many publicise the "Dr. Hauschka" trade mark, not the WALA mark. The Complainant even expressly states that its "exemplary product brochures" all carry the "extremely distinctive WALA logo". Whereas every single one of these documents prominently features "Dr. Hauschka"-branded skin care products only, and the logo that appears does not include the word "wala" at all.

All the extensive and lengthy exhibits provided by the Complainant in order to demonstrate that "the Complainant uses the sign "WALA" extensively in advertising, brochures, scientific publications, and press releases" really are not about "Wala" at all, but rather about the Complainant's other brand, "Dr. Hauschka".

The fact that "Dr. Hauschka" is apparently the Complainant's primary brand is further corroborated by the Complainant's list of nearly 100 trade marks registered in various countries, of which only about 10 are for WALA alone, or with a design. In contrast "Dr. Hauschka" marks comprise nearly 40 of the Complainant's marks.

The Complainant has represented to the Panel that its WALA brand is the one that is well-known these days, but, in actuality, it is really the "Dr. Hauschka" skin care products that the Complainant has been referencing in the Complaint. Accordingly, there is real reason to doubt whether even today the mark WALA is as well-

known as the Complainant has contended.

Moreover, the vast majority of the Complainant's submitted evidence is, in any event, in connection with an immaterial time period; namely, after the disputed domain name was registered on November 23, 1999 – nearly 14 years ago. Aside from some industry-related articles and brochures from pre-November 23, 1999, the Complainant has failed to provide any evidence that WALA was well-known, let alone famous, prior to November 23, 1999, anywhere in the world, let alone in the UAE or Canada.

The Complainant has seized upon this 10-month period wherein Respondent notified visitors of the "US\$5,000,000.00" price tag, in order to attempt to cast the Respondent as a "cybersquatter". But this "US\$5,000,000.00" supposed price tag only appeared after nearly 12 years of registration, and after nearly six years of display of a notice expressly stating the exact opposite; *i.e.* that the disputed domain name was not for sale. Accordingly, the Complainant's theory that the Respondent registered the disputed domain name to extort money from the Complainant is extravagant and ridiculous. The Respondent's conduct is totally inconsistent with an attempt to sell the disputed domain name to anyone, let alone the Complainant.

The Complainant has unfairly attempted to case Respondent as a cybersquatter because he owns some other clearly non-trademark infringing domain names, and has recently listed some of them for sale. All of these domain names are of minimal, if any, value and none correspond to any known trade marks.

The disputed domain name has never genuinely been for sale, and the Respondent has no interest in selling the disputed domain name to anyone, let alone the Complainant.

The Respondent is not a competitor of the Complainant and has no ties to the homeopathic or skin care industries whatsoever. The Respondent has never used the disputed domain name in a trade mark infringing manner whatsoever, solicited the Complainant or otherwise interfered with the Complainant's business in any way.

The Complainant must not only prove that the disputed domain name was being "used" in bad faith, but also that the Respondent originally registered the disputed domain name in bad faith as well.

The Complainant implies that in 1999, when the disputed domain name was registered, the Respondent ought to have been aware of its German, United States, and International Trade Marks, none of which cover Syria, the UAE, or Canada. Nevertheless, it is well established that a respondent is not obliged to search the records of foreign trade mark offices, and that foreign trade mark registrations do not put domestic domain name registrants on constructive notice of foreign trade marks.

The Complainant also suggests that when the Respondent registered the disputed domain name in 1999, he "could have easily known" about the existence of the Complainant and its trade marks, since the Complainant's marks were "extremely well known internationally". However, the Complainant has failed to establish that WALA was in fact "well known internationally" in 1999, since the vast majority of its submitted evidence is for "Dr. Hauschka" only, and is mainly from recent years, post-1999. Accordingly, there is absolutely no basis whatsoever to impute that the Respondent "must have heard" of the Complainant.

Moreover, the fact is that the Respondent had in fact never heard of the Complainant or its marks, when he first registered the disputed domain name.

The fact that the disputed domain name is composed solely of a common colloquial word in Arabic weighs heavily against a finding of bad faith registration. Absent direct proof that such a word was registered solely for the purpose of profiting from a complainant's trade mark rights, there can be no finding of bad faith registration.

No explanation for the 14-year delay in bringing this proceeding has been provided by the Complainant. This long delay raises the inference that the Complainant was not confident in the merits of its claim for entitlement to the disputed domain name.

## **6. Discussion and Findings**

### **A. Supplemental Filings**

The Complainant made an unsolicited supplemental filing on June 19, 2013. The following day, the Respondent filed an objection to admission of this supplemental filing as well as an alternative supplemental filing responding to the Complainant's supplemental filing. This was followed by a second supplemental filing by the Complainant together with an objection thereto by the Respondent both submitted on June 21, 2013.

Paragraphs 10 and 12 of the Rules in effect grant the Panel sole discretion to determine the admissibility of supplemental filings. Paragraph 10(d) states: "The Panel shall determine the admissibility, relevance, materiality and weight of the evidence". Paragraph 12 states: "In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties".

The principles which the Panel should apply in deciding whether or not to admit supplemental filings have been considered in many cases under the Policy. See, e.g., *The E.W. Scripps Company v. Sinologic Industries*, WIPO Case No. D2003-0447. The principles include: that additional evidence or submissions should only be admitted in exceptional circumstances, such as where the party could not reasonably have known the existence or relevance of the further material when it made its primary submission; that if further material is admitted, it should be limited so as to minimize prejudice to the other party or the procedure; and that the reasons why the Panel is invited to consider the further material should, so far as practicable, be set out separately from the material itself.

The Complainant did not attempt to establish any exceptional circumstances justifying its first supplemental filing. Instead, the filing was submitted as if there were an automatic right of reply to the Response. Accordingly, the Panel declines to admit either the Complainant's first supplemental filing or any of the later filings (which all flowed from the first one).

The Panel would add, however, that even if it had admitted the Complainant's supplemental submissions, they would have made no difference to the outcome of this case.

In the view of the Panel it is unhelpful for parties to file supplemental submissions without any attempt to justify them – as the Complainant has done here. This practice can result in the addition of unnecessary complication and cost to what is intended to be a relatively quick and inexpensive procedure.

### **B. Identical or Confusingly Similar**

The Complainant has rights in the mark WALA by virtue of its registered trade marks as well as unregistered trade mark rights deriving from its use of that term since the 1930s.

The Panel concludes that the disputed domain name is identical to the Complainant's trade mark, disregarding the domain name suffix.

The Panel therefore finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

### **C. Rights or Legitimate Interests**

The Panel does not propose to address this aspect in view of its findings in relation to "bad faith" below.

### **D. Registered and Used in Bad Faith**

The Complainant bases its case in part on the contention that the Respondent "could easily have known" about the existence of the Complainant's trade mark. In support, the Complainant cites a number of

previous UDRP cases, all of which are cited as relevant decisions in conjunction with the following paragraph within paragraph 3.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) which addresses the question as to whether constructive notice, or a finding that a respondent “knew or should have known” about a trade mark, or willful blindness, can form a basis for finding bad faith:

**“Knew or Should Have Known:** Some panels have in certain circumstances found bad faith registration based in part on proof that the respondent “knew or should have known” about the existence of the complainant’s trademark (other than through the above-mentioned US concept of constructive notice). This may be seen as an instance of the panel attributing readily obtainable knowledge to a respondent even if the respondent avers that it did not have the knowledge. Circumstances in which panels have made such finding have included those in which the complainant’s trademark was shown to be well-known or in wide use on the Internet or otherwise at the time the domain name was registered, or when a respondent’s denial of knowledge is otherwise highly improbable [...]”

The preceding paragraph in WIPO Overview 2.0 observes that UDRP panels have mostly declined to introduce the US concept of constructive notice *per se* into the UDRP - although some UDRP panels have done so in certain circumstances involving US-located respondents.

In the Panel’s view, the question for the Panel in this case is not whether the Respondent “could” or “should” have known of the Complainant’s trade mark but rather whether, on the balance of probabilities, it is likely that the Respondent was in fact aware of the Complainant’s trade mark on registration of the disputed domain name taking account of all of the circumstances including the fame or otherwise of the Complainant’s mark, the plausibility or otherwise of the Respondent’s denial of knowledge of the Complainant and of the Respondent’s rationale for selecting the disputed domain name, and the manner in which the Respondent has in fact used the disputed domain name.

As to the fame of the Complainant’s trade mark, the Complainant has produced a vast amount of evidence of trade mark use. A mixed picture emerges. Some examples relate solely to use of the DR. HAUSCHKA mark (and can be disregarded). Others principally demonstrate use of “Dr. Hauschka” but also include subsidiary reference to WALA, usually as part of the manufacturer name shown on product labels and at the end/back of marketing literature: “aus dem Hause WALA Heilmittel GmbH”. There are yet further instances of documents which are indeed primarily branded WALA but many of these are directed to the relevant trade, not “public-facing” documents. A batch of product brochures, which are said to carry the distinctive WALA logo, in fact either replace the word WALA with “Dr. Hauschka” or simply contain only the design part of the logo, omitting any words at all.

Further, there is no information, such as turnover figures or marketing spend, indicating the scale of the Complainant’s activities by reference to the WALA brand as at the date of registration of the disputed domain name in 1999 (or indeed thereafter). Nor is there any evidence at all of pre-registration use specifically referable to the UAE or any of the other countries in which the Respondent has been located - Canada or Syria.

Accordingly, while the Complainant has clearly used the mark WALA in Germany and elsewhere, both as a primary brand and as a subsidiary one to DR HAUSCHKA, the Panel is not convinced from the evidence before it that the Complainant’s WALA brand has achieved such a level of fame as to render the Respondent’s denial of knowledge implausible.

The Respondent has provided a declaration “under penalty of perjury” setting out, amongst other things, the reason why he registered the disputed domain name. The Panel does not of course automatically accept that the facts stated in the declaration are true, but simply notes that the declaration is said to be made under penalty of perjury; this declaration is just one factor to be considered in weighing the evidence as a whole.

The Respondent’s explanation is that he would frequently be referred to as “wala” by his friends and family because he was married later in life in comparison to his friends and because he had lived “a quite full social

life” as a single man. He says that “wala” is a common colloquial, or slang, Arabic term referring to a “naughty boy” or, in certain contexts, to someone who is a “playboy”. He says he believes that this slang term comes from the word, “walad”, which means “boy” in Arabic. The Respondent adds that to his knowledge “wala” is a very common word in Arabic referring amongst other things to a “kind of oath”.

The Panel notes that the Respondent has not produced any document in which he is actually referred to as “wala” although perhaps one it is unreasonable to expect a nickname to feature in written, as opposed to face-to-face, communications. The Response exhibits a translation/transliteration of the lyrics of an Arabic song entitled “Elzam 7doudak Ya Wala” / “Know Your Limits, Boy!” in support the Respondent’s assertion as to the “naughty boy”/“playboy” meaning, but no other supporting evidence.

The Panel has taken some trouble to set out in section 4 above its detailed factual findings as to the Respondent’s use of the disputed domain name for an assortment of private and business purposes over the years, based of course on the evidence before it. It is striking that none of these uses relate in any way to the Complainant or to the Complainant’s area of business - despite the Respondent having held the disputed domain name for some 14 years.

The Complainant lays particular weight on the message on the Respondent’s website in 2011 which stated that the disputed domain name was for sale for US dollars 5 million. Out of context, such a notice might indeed raise suspicions about the *bona fides* of the Respondent. The Respondent, however, asserts that the message was an “exasperated effort” to get the point across to the world at large that the disputed domain name was not for sale - in response to a constant stream of purchase enquiries. The Respondent’s explanation is corroborated by evidence of a dozen or so purchase enquiries from 2010 to date. Only one of those pre-dates the Respondent’s notice – the Respondent says that previous enquiries are no longer available due to his switching computers and email services over the years – but the volume of more recent enquiries is at least an indicator of what is likely to have occurred previously. Further, the evidence shows that, for some six years or so before the sale notice appeared, the home page of the Respondent’s website comprised a “not for sale” notice in differing formats. In view of this, and although it was a somewhat unusual route for the Respondent to take, in the particular circumstances of this case the Panel accepts the Respondent’s assertion that, by proposing an extraordinarily high price which was bound to deter prospective purchasers, the sale notice was intended to convey the message that the disputed domain name was not in fact for sale rather than it being an offer of sale directed at the Complainant or indeed anyone else.

The position might have been different if there had been evidence linking the sale notice with the Complainant in some way, but there is none. In any case, the sale notice was displayed some 12 years after the Respondent’s acquisition of the disputed domain name and so, even if it had been intended as a genuine offer for sale, and even if it had been directed at the Complainant, that of itself would not necessarily signify that the disputed domain name was originally acquired for that purpose, which the Complainant would have to establish in order to succeed under paragraph 4b(i) of the Policy.

The Complainant contrasts the price of US dollars 5 million with the prices of under US dollars 2,000 which the Respondent has sought for a number of other domain names which he has offered for sale. However, the Panel has accepted the Respondent’s explanation for the US dollars 5 million price tag in the particular circumstances relating to the disputed domain name, as explained above, and so nothing turns on the distinction between this and the prices he has sought for his other domain names.

The Complainant also claims that of itself the Respondent’s ownership of 158 domain names, many of which are actively marketed for sale, is indicative of a pattern of bad faith. However, in the absence of any suggestion, let alone evidence, that any of those domain names reflect third party trademarks, this assertion must fail.

Finally, the Complainant relies on the alleged attempt by the Respondent to conceal his identity, particularly on the basis of use of the registrant name “Canada” and thereafter by transfer into a privacy service.

In the Panel’s view, the evidence does not show that the Respondent set out to conceal his identity. As

mentioned in section 4 above, before the registrant switch to "Canada", Mr. Aswad was shown as the registrant and administrative contact for the disputed domain name. There is no reason to think that the address or other contact information shown for Mr. Aswad was false. And while, on the face of it, the change of registrant to "Canada" may seem questionable, it is now clearly explicable given the Respondent's evidence that he had incorporated a trading company called "Canada FZE" in the UAE in 2004.

As to the further switch to a proxy service, paragraph 3.9 of WIPO Overview 2.0 states as follows:

"Consensus view: Although use of a privacy or proxy registration service is not in and of itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. For example, registrant use of a privacy service in combination with provision of incomplete contact information to such service or a continued concealment of the "true" or "underlying" registrant (possibly including that registrant's actual date of acquisition) upon the institution of a UDRP proceeding may be evidence of bad faith."

The Panel sees nothing untoward in the manner in which the Respondent has used the proxy service which might be indicative of bad faith.

Accordingly, having carefully weighed up all of the above matters, including the long period for which the disputed domain name has been registered and its use for multifarious personal and business purposes all unconnected with the Complainant, the Panel concludes that on the balance of probabilities the Respondent's explanation of his purpose in registering the disputed domain name and his denial of knowledge of the Complainant at the time of registration of the disputed domain name are credible.

The Panel therefore finds that the Complainant has failed to establish the third element of paragraph 4(a) of the Policy.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

**Adam Taylor**  
Presiding Panelist

**Stephanie Hartung**  
Panelist

**The Hon Neil Brown Q.C.**  
Panelist  
Date: July 9, 3013