Panel Decision for dispute CAC-ADREU-006199

Case number	CAC-ADREU-006199
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Domain names	remarkable.eu

Case administrator

Tereza Bartošková (Case admin)

Complainant

Organization

Respondent

Name	Markus Jank

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of other legal proceedings.

FACTUAL BACKGROUND

1.
The dispute relates to the domain name "remarkable.eu" ("the Domain Name")

2.
The Complainant trades under the name "Remarkable Europe NV". He registered the Domain Name on 10 March 2006 and has used the Domain Name since then to host his website and to create email addresses.

3.
With regard to rights in the Domain Name the Complainant asserts that he is the owner of the BENELUX word mark "REMARKABLE" applied for on 7 July 2002 and published on 1 April 2003. The mark is registered for services in classes 35, 41 and 42. An excerpt from the online register of the BENELUX Trademark Office is provided in Dutch only. The Complainant asserts further that he is the owner of a Community Trade Mark in form of a device mark "REMARKABLE ®!" No. 002769917 filed on 8 July 2002, registered on 1 July 2004 and published on 23 August 2004. The mark is registered for numerous services in classes 35, 41 and 42.

4.
The Complainant furthermore asserts that "due to technical issues" the Domain Name was "released" on 7 November 2011 and immediately registered by the Respondent through the Austrian registrar realtime.at Domain Services GmbH ("Realtime"). The Complainant describes Realtime as specialised in providing automated tools to register a domain name almost instantly upon the release by the previous holder, so called "catching" of domain names. Immediately after the registration the Respondent advertised the Domain Name for sale on the website accessible under the Domain Name. By clicking on a respective link the user was forwarded to the "sedo.com" website where the Domain Name was advertised for sale for a sales price of 19,400 EUR. These factual assertions by the Complainant are not denied or contested by the Respondent.

5.
It can be concluded from the Complainant's assertions that the Domain Name was registered without displaying the Respondent as the new owner. After the Complainant had contacted the new registrar Realtime and asked for a re-transfer of the Domain Name and offered to reimburse the new holder for his out of pocket costs for the registration the Domain Name was transferred to a new registrar and directed to the website www.remarkable.co.uk, which hosts the company website of Remarkable Pencils Ltd., a UK waste recycling undertaking trading under "Remarkable" but related neither to the Respondent nor the Complainant. These factual assertions of the

Complainant are, again, not denied or contested by the Respondent.

6.
The Complainant states in his Complaint that the Respondent could not reasonably claim that he did not know about the Complainant, in particular since a simple Google search would reveal the fact that the Complainant has rights in the name "Remarkable" and had been using the Domain Name for many years. The Respondent denies this and asserts in his Response that he was unaware of the Complainant's trademark rights and that the Complainant's assertion that the Respondent somehow must have been aware of the Respondent and his services is "unreasonable and factually untrue". The Parties submitted various Google searches in order to show what could and what could not have been found had the Respondent done a respective search prior to registering the Domain Name. The Complainant did, however, not provide any evidence which could establish that the Respondent had actual knowledge of the Complainant, his name and his trademark rights in "remarkable".

7.
In EURid's verification for the Domain Name the registrant and present Respondent's contact details consist inter alia of the email address "remarkable.te@aol.co.uk".

8.
The Complainant filed his Complaint on 21 December 2011 and asked for the dispute to be decided by a single Panelist. The Respondent was notified of the Complaint on 5 January 2012 and filed his Response on 15 February 2012 with a request to have the dispute decided by three Panelists.

9.
On 20 February 2012 the Complainant filed a non-standard communication as a response to the Response to the Complaint. On 2 March 2012, after the Panel had been constituted, the Respondent also filed a non-standard communication responding to the Complainant's non-standard communication.
Both communications were considered by the Panel.

A. COMPLAINANT

10.
The Complainant asserts that the Respondent has no legitimate interest in the Domain Name. He is neither known by the Domain Name nor is he using the Domain Name (other than redirecting it to Remarkable Pencils Limited's web page). The Complainant is of the opinion that the entire conduct of the Respondent, i.e. automatically registering or "catching" domain names previously held by third parties and putting them up for sale, amounts to bad faith.

11.
The Complainant submits that the Respondent has been involved in ADR.eu proceedings previously and points out to the following decisions where the Panels found that Respondent had registered the following domain names without any rights or legitimate interest. ADR 05388 (no legitimate interest in "Witzenmann"); ADR 04729 (no legitimate interest in "Orencia"); ADR 04700 (no legitimate interest in "SHB"); ADR 03207 (no legitimate interest in "Allianz-online") and ADR 04484 (no legitimate interest in "Greenteam").

12.
The Complainant, furthermore, asserts that the Respondent's history of a pattern of conduct in registering domain names, the offering of the Domain Name for sale and that the Respondent could not have possibly unaware of the Complainant together and or independently amount to a registration or use in bad faith.

13.
Consequently, the Complainant requests the transfer of the Domain Name.

B. RESPONDENT

14.
The Respondent agrees with the Complainant's assertion that he is engaged in the business of buying and selling domain names. The Respondent admits that he had previously been engaged as a respondent in several proceedings under the ADR.eu policy but that he had since changed his business model and would now only register and resell what he calls "generic domain names". With regard to the redirection of the Domain Name to "www.remarkable.co.uk" the Respondent asserts that this was an attempt to demonstrate his good faith intentions and to demonstrate that his ownership of the Domain Name was in no way intended to trade on the Complainant's trademarks. The Respondent regards the UK company Remarkable Pencils Limited as representing a "neutral space".

15.
The Respondent asserts that he follows a legitimate business model in registering and reselling what he describes as "generic" domain names. Under generic domain names the Respondent understands second-level domains comprised of what the Respondent labels as "ordinary dictionary terms".

16.
Consequently, the Respondent requests for the Complaint to be denied.

DISCUSSION AND FINDINGS

17.
According to Article 1 thereof, Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain (OJ 2002 L 113, p. 1) sets out general rules for the implementation of the .eu Top Level Domain, including the designation of a Registry, and establishes the general policy framework within which that Registry is to function. In accordance with recital 16 in the preamble to that regulation, '[t]he adoption of a public policy addressing speculative and abusive registration of domain names should provide that holders of prior rights recognised or established by national and/or Community law and public bodies will benefit from a specific period of time (a "sunrise period") during which the registration of their domain names is exclusively reserved to [those] holders … and … public bodies'.

Article 5(1)(b) of Regulation No 733/2002 provides that 'the Commission shall adopt … rules concerning [inter alia] … public policy on speculative and abusive registration of domain names, including the possibility of registrations of domain names in a phased manner to ensure appropriate temporary opportunities for the holders of prior rights recognised or established by national and/or Community law and for public bodies to register their names'.

It was pursuant to that provision that the Commission adopted Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration ("Regulation 874/2004"). A claim for the transfer of the Domain Name to the Complainant requires according to Art. 21(1), 22(11) of the Regulation 874/2004 that the Panel finds that the Domain Name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and / or Community law, such as rights mentioned in Art. 10(1) of the Regulation 874/2004 and that the Respondent has registered the Domain Name without rights or legitimate interests in the domain or that the Respondent has registered or is using the Domains in bad faith.

18.
The Complainant asserted two registered trademarks, a Benelux wordmark and a Community logo trade mark, consisting of or comprising the word "remarkable" respectively. Neither the existence of the marks nor that they are identical or confusing similar to the Domain Name is in dispute between the parties and the Panel therefore does not see a need to elaborate further on this issue.

19.
The Panel follows the general rule that a party has to prove all facts which are favourable for and supportive of its own case. Therefore, the complainant of an ADR.eu proceeding has to establish evidence for the facts supporting a right which is identical or confusingly similar to the domain name as well as for the registration or the use of the domain name in bad faith (which is supported by the wording of Art. 21(3) of the Regulation 874/2004 stating that "bad faith […] may be demonstrated where […]).
The situation is different with "rights or legitimate interest" under Art. 21(1)(a) of the Regulation 874/2004. It is standing case law amongst panel decisions under the UDRP and Regulation 874/2004 that the complainant can technically not prove the absence of something, i.e. a "negative fact" and that therefore the onus shifts to the respondent to assert certain facts supporting a right/legitimate interest (which is supported by the wording of Art. 21(2) of the Regulation 874/2004 stating that "a legitimate interest […] may be demonstrated where […])". Once the respondent has done so the onus shifts back to the complainant and it is then on the complainant to provide proof that the facts asserted by the respondent are not true (cf. e.g. ADR.eu case no. 02035 – warema.eu with further references.)

20.
Applied to the case at hand, this means the following: the Complainant asserted a lack of right and legitimate interest and in his Response to the Complaint the Respondent explained his business model (of "buying and selling generic domain names") and expressed his opinion that (in the legal assessment) this creates a legitimate interest. While the Complainant also asserts that the Respondent must have been aware of the Complainant and his trademarks the Respondent denies this and since the Complainant could not raise substantiated doubts with regard to this denial the Panel treats the Respondent as if he had no such knowledge at the relevant time, i.e. the time of the registration of the Domain Name. For the further legal assessment the Panel works under the assumption that the

Respondent registered the Domain Name – with the help of Realtime's automated system – without being aware of the Complainant and his trademarks (if one reads the Respondent's assertions very carefully one will not find a denial that the Respondent has not been aware of the Complainant but only of his trademarks. However, if one applies the same care to the Complainant's assertion one will find no explicit allegation that the Respondent actually knew of the existence of the Complainant. There was, therefore, no need for the Respondent to deny this explicitly).

21.
As stated above, the registration or the use of the domain name in bad faith on the one hand and the registration of the domain name without a right or legitimate interest on the other hand are alternative requirements rather than cumulative ones. Consequently, the complainant succeeds with his complaint by showing either bad faith or the lack of a right or legitimate interest. The Panel is of the opinion that it might be helpful to explain why the Panel does not follow the Complainant in its assertion that the Domain Name was registered in bad faith before the Panel turns to the pivotal question of the case whether the Domain Name was registered with or without legitimate interest.

22.
Art. 21(3) of the Regulation 874/2004 stipulates:
"3. Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where:
(a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or
(b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:
(i) a pattern of such conduct by the registrant can be demonstrated; or
(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or
(iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;
(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or
(d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name; or
(e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered.

Out of this non-exhaustive list (cf. ECJ "reifen.eu" at 31-39) the Complaint asserts two of the examples: (1) the offering for sale of the domain name to the holder of the right and (2) a pattern of conduct.

23.
Art. 21(3)(a) of the Regulation 874/2004 requires that the domain name was registered primarily for the purpose to sell it to the holder of a name in respect to which is recognised. In other words the Complainant would have had to show not only that the Domain Name was offered for sale to the general public but specifically to the Complainant. Such an offer or such intent has not been established by the Complainant.

24.
With regard to the Respondent's history of involvement in ADR.eu proceedings the Complainant would not only have to show a pattern of conduct as such. Art. 21 (3)(b)(i) requires that the pattern must show that the Respondent's registration including the Domain Name were made to prevent the Complainant from the use. While such pattern might have been established for past registrations it does not include the Domain Name.

25.
Beyond the examples discussed above, the Panel sees no circumstances which would justify finding bad faith in the conduct of the Respondent outside the non-exhaustive list of examples in Art. 21(3) of the Regulation 874/2004.

26.

Since the Panel did not find an element of bad faith in the registration and use of the domain name according to Art. 21(1)(b) of the Regulation 874/2004 the Complainant can only succeed with his Complaint if the Domain Name was registered without a right or legitimate interest according to Art. 21(1)(a) of the Regulation 874/2004.

27.
The Respondent does not claim to have a right in the Domain Name. The following reasoning therefore only concerns the question of whether the Domain Name had been registered without legitimate interest.
The list of examples of legitimate interest given in Art. 21(2) of the Regulation 874/2004 comprises three alternatives:

28.
Under lit. (a) legitimate interest can be demonstrated where prior to any notice of an alternative dispute resolution procedure the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so. These requirements are in the view of the Panel not fulfilled in the present case. This would only be the case if one would regard the offering for sale of the Domain Name as qualifying to be in connection with the offering of goods or services. In the opinion of the majority of the Panel this is not what is intended by this provision. Rather there should be a genuine use in form of content being available under the Domain Name.

29.
Under lit. (b) the holder of a domain name being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law. These requirements are in the view of the Panel also not fulfilled in the present case and such requirements are not even alleged by the Respondent. In particular, using the term "remarkable" as third-level domain within an email-address remarkable.te@aol.co.uk cannot qualify as such and the Panel understands that even the Respondent does not make this part of his arguments.

30.
Lit. (c) suggests legitimate interest where the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name (…). The requirement of non-commercial is in the view of the Panel not fulfilled since offering the Domain Name for sale (here for 19.400 EUR) is a commercial undertaking.

31.
Consequently, the Panel finds that none of the examples listed in Art. 21(2) of the Regulation 874/2004 are supported by the facts asserted by the Respondent. However, the Panel is of the opinion that the Art. 21(2) is non-exhaustive. The European Court of Justice ("ECJ") decided in its decision C-569/08 "Internetportal und Marketing GmbH / Schlicht" ("the reifen.eu case") that the list of examples of bad faith in Art. 21(3) is non-exhaustive but did not decide whether the same is true for Art. 21(2). The Panel is of the view that, considering the similarities in the structure and wording of both paragraphs, there is no reason why Art. 21(2) should be exhaustive when Art. 21(3) is not. The question for the Panel to be answered is then what consequences follow from the fact that the Respondent's course of action fulfils neither of the requirements of Art. 21(2).

32.
The difficulty in answering this question is that there is little guidance to the meaning of "legitimate interest". The Regulation 874/2004 is silent on the issue and there seem to be no relevant published travaux preparatoires giving an indication of the concept of legitimate interest. The "ordinary meaning" of the words "legitimate interest" seems not to provide much guidance either since "legitimate" is an abstract concept that has to be filled with meaning.

33.
Attempts have been made to evade determining the meaning of "legitimate interest" by reverting to the term "speculative registration" (ct. e.g. ADR.eu case no. 05578 noonan.eu). The Recital 16, the title of Art. 21 and Art. 22(11) of the Regulation 874/2004 mention "abusive and speculative registrations". If one understands "abusive" as a reference to bad faith then it stands to reason to understand "speculative" as a reference to the lack of a right or legitimate interest under Art. 21(1) of the Regulation 874/2004. However, the Regulation 874/2004 and the Regulation 733/2002, mentioning "abusive and speculative registrations" in Art. 5(1)(b), give even less guidance on the concept (if there is one) of a speculative registration than on a registration without legitimate interest. Again, the ordinary meaning of the word does not provide much insight and as far as e.g. the "noonan.eu" decision argues with such ordinary meaning it is not clear to the majority of the Panel where such meaning shall come from, always bearing in mind that Regulation 874/2004 is EU legislation where the English language version is not necessarily the decisive one. If one defines the English term "speculative" as "(1) based on theory or guesswork rather than on knowledge or (2) investment with a high risk of loss" (cf. Oxford Dictionary of Current English, Third Edition, 2001) the meaning of the concept becomes not much clearer. If one considers the registration of the domain name as the investment then the risk of loss would depend on what would amount to bad faith or lack of

right/legitimate interest in order to determine how high the risk of losing the domain name in ADR proceedings would be. Hence, reverting to the "ordinary meaning" of the word seems to lead to a circular argument and the Panel is convinced that looking into the other language versions of Regulation 874/2004 would not lead to materially different conclusions.

34.
In the view of the Panel the next step would be to enquire whether the facts of the present case create a situation of which the Panel is convinced the lawmaker would have added to the list of examples if had he been aware of this at the time of the drafting of the Regulation 874/2004. For this exercise the majority of the Panel reverts to the three examples given in Art. 21(2) and try to extract a common denominator on which all examples are based. In doing so the majority of the Panel comes to the conclusion that such common denominator can be identified in the use of term in question, be it as domain name or otherwise. Art. 21(2) (a) and (c) of the Regulation 874/2004 expressly require that the domain name is used in a specific way. Art. 21(2) (b) requires that the holder of the domain name has commonly been known by the domain name. This requires a use of some form, be it by the holder of the domain name himself or by third parties; where else should the general knowledge come from? That Regulation 874/2004 puts a great emphasis on the use of the domain name can be seen that the requirement is continued Art. 21(3) where (b) (ii) and (iii) also require actual use of the domain name within certain time limits. The majority of the Panel does not consider the registration of a domain name for the sole purpose of offering it for sale as a genuine use as required by the Regulation 874/2004. The majority of the Panel therefore is of the opinion that no legitimate interest in the Domain Name has been demonstrated. This approach is also followed in ADR.eu case no. 05578 "noonan.eu" where the Panelist states at 35 "There appears to be no separate business use by the Respondent of the Domain Name beyond use in connection with a pay-per-click website. There are also offers to dispose of the Domain Name. This in the absence of any argument or evidence on the part of the Respondent to the contrary, is sufficient to justify a finding of a lack of a legitimate interest". The majority view within the Panel agrees with this conclusion.

35.
For the majority within the Panel the lack of legitimate interest combined with the absence of a right therefore renders the registration of the Domain Name by the Respondent speculative and gives rise to a claim for the transfer of the Domain Name to the Complainant.

36.
The minority view within the Panel does not stop at this point but requires some element of bad faith in the conduct of a respondent in order to find a lack of legitimate interest. In the case of the registration of a domain name for the purpose of offering it for sale, the minority view within the Panel is of the opinion that under the "first come first served" principle anybody must have the right to register as common dictionary word (in the present case a common English adjective) and offer it for sale unless it can be shown that the holder of the domain name does not trade on the value as a dictionary word but on the value of the Complainant's rights. This would require that the Respondent had at least knowledge of the Complainant's right in the domain name at the time of registration of the domain name by the Complainant.

The minority view within the Panel can in for this interpretation of the requirement rely on discussions under ICANN's Uniform Domain Name Dispute Resolution Policy ("UDRP") which stood model for parts of the Regulation 874/2004 and the body of case law that emerged from panel decisions applying the UDRP, foremost but by no means exclusively, the decisions held under auspices of and published by the World Intellectual Property Organisation ("WIPO"). It is within the case law under the UDRP that a defence forwarded by respondents emerged that it cannot be forbidden to register "generic domain names" or "ordinary dictionary words" as domain names as long as this has not been done in bad faith towards the complainant.

The "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")" provides for an own category "Does a respondent automatically have rights or legitimate interests in a domain name comprised of a dictionary word(s)?" where the following summary can be found:

"Consensus view: If the complainant makes a prima facie case that the respondent has no rights or legitimate interests, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the UDRP, or any other basis for rights or legitimate interests, then the respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a dictionary word or phrase. Factors a panel tends to look for when assessing whether there may be rights or legitimate interests would include the status and fame of the trademark, whether the respondent has registered other domain names containing dictionary words or phrases, and whether the domain name is used in connection with a purpose relating to its generic or descriptive meaning (e.g., a respondent may well have a right to a domain name "apple" if it uses it for a genuine site for apples but not if the site is aimed at selling computers or MP3 players, for example, or an inappropriate other purpose). Panels have recognized that mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services), may not of itself confer rights or legitimate interests in the domain name. Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely

used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase)."

Turning to the last sentence of the citation, it appears that the facts established for the present case show that there was neither genuine use of the Domain Name or even intent for such use nor could the Complainant establish that the Respondent did trade of the Complainant's trademark rights in the term "remarkable", effectively leaving it open how the "consensus view" would decide the present case under the UDRP.

Some of the decisions made under the UDRP take the issue even further, e.g. case D2004-0230 regarding various domains containing "match", a case which is not concerned with the "buying and selling of generic domain names" but where the sole panelist makes the following statement:
"By registering the service mark MATCH.COM, Complainant cannot thereby preclude anyone else from ever registering the common term "match" in combination with other common words in the .com gTLD. So long as those domain names are used in their generic sense, rather than seeking to profit from the good will associated with Respondent's trademark, their registration and use would not violate the Policy. Therefore, the Panel finds that if Respondent has not used the domain names in bad faith, then Respondent has rights and legitimate interests in respect of the domain names at issue."

The majority within the Panel cannot agree with the view taken by numerous panels deciding cases under the UDRP. It is not for this Panel to decide whether such an interpretation of the requirement of "legitimate interest" is correct under the UDRP. For cases decided under the Regulation 874/2004 the majority within the Panel cannot subscribe to adding bad faith elements to the requirement of "legitimate interest". If one looks at the UDRP one can see today more than ever how carefully it was drafted. In combining the requirements of lack of right / legitimate interest and bad faith it was meant to cover clear cut cases only which justify deciding the matter in cheap and quick cross border / cross culture proceedings. It turned out that with the limitations of taking evidence in the domain name arbitral proceedings many panelists felt that they had to lower the threshold for the bad faith requirement in order to help complainants to prove their case. When the Regulation 874/2004 was discussed a body of UDRP case law existed that applied the very low threshold for the bad faith requirement. However, this was not enough for the draftsmen of the Regulation 874/2004 and they decided that lack of rights/legitimate interests on the one hand and bad faith on the other hand should be alternative requirements rather cumulative ones; all that without raising the threshold for establishing bad faith. To the contrary: whereas the UDRP requires that the registration AND the use must have been in bad faith, Regulation 874/2004 lets it suffice that registration OR use were made in bad faith. With regard to the rights on which a complaint against a domain name holder can be based on there is a significant extension compared to the UDRP because it was felt that the UDRP in this respect too did not provide sufficient protection for the right owners. Unlike under the UDRP the rights in question must, however, be able to claim protection within the territory of the EU. All this leads to a situation that puts the right holder into a significantly stronger position compared to the UDRP.

37.
Turning to Art. 21(2) and Art. 21(3) of the Regulation 874/2004 one can see a clear distinction in the wording of both paragraphs that leads the majority view within the Panel to the conclusion that Art. 21(3) deals with a subjective requirement where knowledge and intent of the respondent play a role (cf. lit(a) "for the purpose of it", lit.(d) "intentionally used to") whereas the wording of Art. 21(2) suggest no such subjective element. The majority within the Panel therefore understands Art. 21(2) as purely objective: either there is a right or legitimate interest or not, notwithstanding the inner motivation of the respondent. It is conceded, however, that the last part of Art. 21(2)(c) "without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law" is in fact a reference to a subjective element, "intent". This is the only subjective reference to be found in Art. 21(2) and the Regulation 874/2004 in that respect differs from the UDRP which in addition in para 4(c)(i) refers to a "bona fide offering of goods". And if one translates bona fide with good faith then we have the opposite of bad faith and another entry for "faith considerations" but that one is absent in the Regulation under which a "connection" with the offering of goods and services suffices. Nonetheless, the majority within the Panel would not go so far and regard Art. 21(2)(c) of the Regulation 874/2004 as a door opener for general bad faith considerations. The structure of the norm should rather be understood in a way that a "legitimate and non-commercial or fair use" as such creates legitimate interest in the meaning of Art. 21(1)(a) but that the bad intentions can revoke the otherwise given legitimate interest. This means that the creation of legitimate interest has, in the view of the majority within the Panel, to be assessed on an objective basis. This distinction leads to a situation where a respondent might have a right or legitimate interest but because of his "bad intentions" the registration might still be considered abusive under Art. 21(3) the Regulation 874/2004 and this was in fact the underlying situation of the ECJ "reifen.eu" case where the ECJ could take a "shortcut" and immediately address bad faith without dealing with Art. 21(2) first.

38.
As a consequence, what might be common under the UDRP causes in fact problems with Art. 21 of the Regulation 874/2004. Since under the UDRP objective and subjective requirements have to be fulfilled it might not be accurate to mix them or discuss them at the

wrong place but it does not affect the outcome of the decision. Since under Art. 21(1) of the Regulation 874/2004 lit. (a) and lit. (b) are alternative requirements mixing the two appears to improperly influencing the outcome of the decision if one understands lit. (a) as an objective requirement and lit. (b) as a subjective one. One might find such conduct correct under the UDRP. If not, no damage is done since it does not affect the outcome of the decision because without bad faith there is not a success for the complainant no matter how one decides on the interest issue. Under the Regulation 874/2004 the majority view within the Panel finds the statement unacceptable because it would undermine and completely negate the intended deviation of Regulation 874/2004 from the UDRP in that lack of legitimate interest and bad faith should be alternative requirements rather than cumulative ones.

39.
Apart from the considerations above the reference to "generic domain names" and "ordinary dictionary terms" might, in the view of the majority of the Panel, not be the appropriate approach in order to implement the "first come first served" principle. Not only has the WIPO Overview, as cited above, recognised this problem. The ECJ in its "reifen.eu" ruling too addresses the issue. And while the ECJ in that ruling did not discuss Art. 21(1)(a) and Art. 21(2) of the Regulation 874/2004 but Art. 21(1)(b) and Art. 21(3) the following considerations at 74 et. seq. also apply to the discussion about the meaning of legitimate interest:

"The appellant contends in that regard that the main proceedings concern the registration of a domain name consisting of a generic term, which cannot, under any circumstances adversely affect the rights of third parties since nobody has exclusive rights over generic terms […]. That argument is misplaced on two grounds. […] Second, it fails to take account of the fact that prior rights can legitimately exist in respect of generic terms. As the Court has already held European Union Law and, in particular, Art. 3 (1) (b) and (c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) does not preclude the registration in a Member State, as a national trademark of a term borrowed from the language of another Member State in which it is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is thought, unless the relevant parties in the Member States in which registration is thought a capable of identifying the meaning of the term […]. Since the existence of prior rights in respect of a name corresponding to generic term cannot therefore be excluded, conduct such as that engaged in by the appellant in the main proceedings could adversely affect holders of such rights."

The majority within the Panel agrees with this and follows the understanding that the legitimacy of an interest in a domain name can only be evaluated in looking into how it is used. If it is used in a "generic" way, which means descriptive with regard to goods / services offered in the first place, then it is legitimate. In the view of the majority within the Panel this is reflected by the examples given in Art. 21(2). The provisions made in Art. 21(2)(a) do not lead to different conclusions: even where only preparations for a use of the domain name can be shown it can determined whether the preparations were made with regard to a generic use or no. In other cases the use of the same domain name may not be legitimate. The same must apply no matter whether the domain name consists of "ordinary dictionary words" or not.

40.
The above considerations persuaded the majority of the Panel that the Respondent lacks a legitimate interest in the Domain Name and therefore to accept the Complaint.

41.
In the minority view, the Complainant has shown neither bad faith registration or use nor that the Domain Name has been registered by the Respondent without rights or legitimate interest in the name.
This case raises the issue whether and, if so, under what circumstances, a person is entitled to register as a .eu domain name for the purpose of sale on the open market an ordinary dictionary word, where that word is identical or confusingly similar to a trademark or other prior right.

Cases under the UDRP must be treated with caution, since the language of Regulation 874/2004 differs significantly. Some features are common to both Policies, however, such as the onus of proof of absence of rights or legitimate interest being on the complainant, who must make out a prima facie case of such absence before the onus shifts to the respondent to demonstrate by concrete evidence that it does have rights or a legitimate interest. As stated in the UDRP case Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (omitting citations):

“The Panel notes that Complainant bears the “general burden of proof” under paragraph 4(a)(ii) of the Policy, which burden shifts to the Respondent once Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. [...]
Since it is difficult to prove a negative (i.e. that Respondent lacks any rights or legitimate interests in the mark [sic]) – especially where the Respondent, rather than the Complainant, would be best placed to have specific knowledge of such rights or interests – and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant’s burden of proof on this element is light.[...] Hence, Complainant must make at least a prima facie showing that Respondent has no rights or legitimate interests

in the mark [sic]. After Complainant has met its initial burden of proof, if Respondent fails to submit a response Complainant will be deemed to have satisfied Paragraph 4 (a) ii of the Policy."

See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 2.1 and Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000-0624.
This formulation of the onus of proof is important in cases such as the present because, as stated in an early UDRP case involving a respondent engaged (as here) in "the development and marketing of valuable Internet domain names":

“Where the domain name and trademark in question are generic—and in particular where they comprise no more than a single, short, common word—the rights/interests inquiry is more likely to favor the domain name owner”: Shirmax Retail Ltd./Détaillants Shirmax Ltée v. CES Marketing Group Inc. eResolution Case No. AF 0104 (20 March, 2000), http://www.disputes.org/decisions/0104.htm

Hence under the UDRP, “normally”, to use the word in the WIPO Overview 2.0, anyone is entitled to register a dictionary word as a domain name and to use it in connection with its dictionary meaning:
“...mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services), may not of itself confer rights or legitimate interests in the domain name. Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase). WIPO Overview 2.0, paragraph 2.2.

It is unfortunate, as explained in ADR .eu Case No. 05578, noonan.eu, at paragraphs 26 and 27, that the term “speculative” is not defined in any of the regulations and does not appear in the text of Article 21 itself, so that the fundamental question was left hanging, namely whether that term is intended to render illegitimate the registration and trading in .eu domain names unconnected with any other business activity.

The learned panelist in that case pointed (in paragraph 32) to the natural meaning of the word “speculative” as suggesting someone who has no real interest in using the domain name in connection with any separate and independent business activity and who registered the domain name because it may have value in and of itself, the most obvious example being someone who registered a domain name primarily because he believes he may be able to sell it to some other entity at a profit. In the absence of a response in that case (a factor not present here), the complainant was held to have established absence of rights or legitimate interest.

Given that the registration for sale of domain names (“speculation”) is not per se unlawful and is indeed a common business practice, the minority would add to the definition of “speculative” adopted in the noonan.eu case the requirement in ADR .eu cases that, to be illegitimate, the speculation must be referable to or likely to impinge upon the trademark or other name on which the complainant relies. In considering cases falling outside the non-exclusive examples set out in Article 21(2), all the circumstances of each case will need to be considered before it may properly be found that a legitimate interest has been demonstrated. Where the question is whether to revoke, under Article 21, the registration for sale of a domain name that happens to be identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, those circumstances will include whether the domain name is a common dictionary word or a distinctive, well-known or famous, fanciful or arbitrary word and the use, if any, to which the domain name has been put. As under Article 21(2)(c), absence of innocent intent on the part of the registrant will negate any right or legitimate interest the registrant might otherwise establish.

The minority would find that, following the sunrise period, any person has the right, on the principle “first come, first served”, to register as a domain name in the .eu domain space a common dictionary word and has a legitimate interest in using it by offering it for sale on the open market (i.e. otherwise than to the complainant), unless there be established either:
(a) intent on the part of the registrant to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or community law; or
(b) that it is objectively unlikely that the Domain Name would mislead consumers or harm the reputation of that name.
This combines in paragraph (a) the concept of subjective intent in Article 21(2)(c) and in paragraph (b) the objective approach of the learned panelist in Shirmax Retail: “as long as this use is not misleading to consumers and does not tarnish a trademark”.
The requisite intent may be inferred, for example, where the prior right is inherently distinctive, such as KODAK or, being descriptive, has become distinctive and well-known through use or where the price at which the domain name is offered for sale reflects its value as a distinctive word.

In the present case the Domain Name is an ordinary English adjective; the Complainant’s Benelux and European Community trademarks are not fanciful or arbitrary and the Complainant has submitted no evidence to establish either fame or strong secondary meaning in its marks such that consumers are likely to associate <remarkable.eu> only with the Complainant; there is no reason to believe that the

Respondent was aware of the Complainant or its trademarks prior to notice of this dispute; and the Respondent has shown by concrete evidence that the price sought on the open market for the Domain Name was well within the range of prices paid in that market in 2012 for dictionary word domain names. Accordingly, there is no evidence from which it may be inferred in this case that the Respondent had any intent to mislead consumers or harm the reputation of the Complainant's trademarks, nor that the Domain Name would be likely to do so.

In all the circumstances the minority would find that the Respondent has established a legitimate interest within the meaning of Article 21(1)(a).

Even if the view of the majority be accepted that intent ("bad faith") has no place in the consideration of rights or legitimate interest under Articles 21(1) and (2), the minority would find in this case that, having regard to the prices obtained in 2012 on the open market for other dictionary word domain names, it is objectively unlikely that the conduct of the Respondent in registering the Domain Name and offering it for sale on the open market for 19,400 EUR would mislead consumers or harm the reputation of the Complainant's trademarks. Hence for this reason alone the minority would find that Complainant has failed to establish circumstances within Article 21(1). For these reasons the minority would dismiss this Complaint.

42.
Since the Complainant established at least prima facie evidence for the fulfilment of the requirements of Art. 4 (2) (b) of the Regulation 733/2002 the Complainant can claim the transfer of the Domain Names according to Art. 22(11) of the Regulation 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name REMARKABLE be transferred to the Complainant:

PANELISTS

Name	**Mr Alan Lawrence Limbury**

DATE OF PANEL DECISION 2012-03-07

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: remarkable.eu

II. Country of the Complainant: Belgium, country of the Respondent: Austria

III. Date of registration of the domain name: 7 November 2011

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: combined CTM, reg. No. 002769917, for the term "REMARKABLE ®!", registered on 1 July 2004

V. Domain name is confusingly similar to the protected right/s of the Complainant

VI. Response submitted: Yes

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Why the Complainant considers the Respondent to lack the rights and legitimate interests: Because the Respondent registered the domain name for the sole purpose of reselling it.
2. Rights or legitimate interests the Respondent claims to have: The Respondent contends that its business of registering and selling "generic" domain names is legitimate.
3. Does the Panel consider the Respondent to have no rights or legitimate interests: No rights/legitimate interest since the registration of a domain name for the sole purpose of selling it does not amount to legitimate interest.

X. Dispute Result:Transfer of the disputed domain name.