Panel Decision for dispute CAC-ADREU-006901

Case number	CAC-ADREU-006901
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Domain names	fc-bayern-munchen.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	FC Bayern München AG

Respondent

Organization	Duncan Asset Management

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

none

FACTUAL BACKGROUND

The Complainant is a stock corporation since 2001 named “FC BAYERN MÜNCHEN AG”, represented by Dr. Michael Gerlinger in Munich, Germany. The Complainants business is to support and manage the FC Bayern München football (soccer) association. The Complainant uses the domains www.fc-bayern-muenchen.de and similar ones for commercial purposes.

The Complainant owns various trademarks, e.g. a coloured word&device Community Trademark re. no. 002808145 “FC BAYERN MÜNCHEN”.

The Respondent is located in Nottinghamshire, Great Britain and leads his Duncan Asset Management business. He registered the domain name “fc-bayern-munchen” on September 28, 2014. He showed no use of the disputed domain but intended to deal with it. The disputed domain name was set on hold previously.

On December 29th, 2014, the Complainant initiated ADR proceedings. The Complainant submitted a complaint against the Respondent claiming that the Respondent registered the disputed domain name without rights or legitimate interest in the disputed domain name and in bad faith and that, therefore the registration should be declared speculative and abusive within the meaning of Article 21 of EC Regulation No. 874/2004 (hereinafter “Public Policy Rules”).

The ADR Court did receive Respondent’s communication dated January 7th confirming its consent with the transfer of the disputed domain.

A. COMPLAINANT

The Complainant substantially claims that registration of the disputed domain name “fc-bayern-munchen” is speculative and abusive pursuant to Art. 22 (1) (a) of the Regulation (EC) No. 874/2004. Some unnecessary information and evidence consumed time for checking and analysing.

The Complainant declares that he owns rights as proprietor of trademarks, company and trade name rights as well as domain name rights. He is situated in Munich, Bavaria. Further he declares that the FC Bayern is one of the most successful and very well known soccer clubs in the world.

The Complainant insists that the Respondent registered the domain name without rights and legitimate interest and in bad faith and that,

therefore, such registration is speculative and abusive within the meaning of Article 21 of the Public Policy Rules. Intention of the Respondent to sell the domain is obvious.
Accordingly, the Complainant requests the transfer of the domain name from the Respondent to the Complainant.

B. RESPONDENT

The Respondent gave little but clear response within the required deadline and declared that he is willing to accept a transfer of the disputed domain name to the Complainant.

Therefore, he has not produced any arguments or provided any evidence of any actual or contemplated right or legitimate interest in the disputed domain name.

DISCUSSION AND FINDINGS

1. According to Article 22 (11) of the Regulation (EC) No 874/2004 an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21 of the aforementioned or the decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No. 733/2002.

In the present case, the Complaint has been brought against the Respondent. He declared clearly in his email dated January 7th, that he is willing to transfer the disputed domain name to the Complainant.

Therefore, the question is whether the registration is speculative or abusive within the meaning of Article 21 the Regulation (EC) No 874/2004. According to this disposition and Paragraph B 11 (d) (1) of the ADR.eu Alternative Dispute Resolution Rules (the “ADR Rules”) the Complainant bears the burden of proving the following:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith.

2. identical or confusingly similar domain name

Regardless of the state of usage of wares or services of the Complainant’s marks, the complaint is in any case to be granted if likelihood of confusion according to Article 8 (1) (b) of the Community Trademark Regulation can arise from an identical trade name or domain name.

The European Court of Justice has held that the likelihood of confusion must be appreciated globally taking into account all factors relevant to the circumstances of the case. Those factors may include, inter alia, the similarity of the goods, the similarity of the trademarks (signs), the distinctive (or non-distinctive) character of the opposing sign, the relevant public and consumer behaviour.

Thereby, the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components (see to that effect the judgment of the Court of Justice of 11 November 1997 in Case C-251/95 Sabèl v Puma AG, paragraphs 22 to 25, [1997] ECR I-1691, OJ OHIM 1/98, p. 79).

Here is no similarity of goods because the Respondent had none, only a domain name.

However, the Complainant has his prior right of the trade name which is granted under §§ 5, 15 Markengesetz (German Trade Mark Act). The evidence was provided accordingly. Moreover, he is the owner of various domain names, which incorporates terms FC Bayern or FC Bayern Muenchen. Therefore, the Panel finds that the disputed domain name is identical or confusingly similar to a name in respect of which the Complainant has a right.

3. Alleged Registration of Domain Name without Rights and Legitimate Interest

With respect to the alleged registration of the Domain Name without rights or legitimate interest, the Panel holds as follows:

The Respondent did not prove any formal or other positive right to a FC BAYERN MÜNCHEN denomination. The registration itself creates

no legitimate right or interest within the meaning of Article 21 of the Regulation (EC) No 874/2004 without perceptible use or preparing measures, especially no prior right.

Article 10 (1) provides that holders of prior rights recognized or established by national and/or Community law and public bodies shall be eligible to apply to register domain names during a period of phased registration before general registration of. eu domain starts.

According to Article 21, paragraph 2 of the Public Policy Rules a legitimate interest may be demonstrated where (a) prior to any notice of the ADR proceedings, the Respondent 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; (b) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law; (c) the Respondent is making a legitimate and non-commercial, or fair, use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognized or established by national and/or Community law.

With regard to letter (b) in the preceding paragraph above, as far as the Panel is aware, the Respondent is not commonly known under the disputed domain name.
Legitimate interests just to the name "fc-bayern-munchen" cannot be concluded neither from the Respondent's name nor from the Respondent's company name. It is also not apparent that the Respondent has used the domain name in connection with the offering of goods or services or has made demonstrable preparations to do so prior to any notice of this dispute.

Therefore, the Panel holds that the Respondent registered the disputed domain name without rights or legitimate interest, within the meaning of Article 21, paragraph 1, letter a) of the Public Policy Rules.

4. Alleged Registration and Use of Domain Name in Bad Faith

The Complainant also argues that the Respondent registered the disputed domain name in bad faith, namely, in order to sell the domain name.

The Panel would like to point out that the dispute domain name was registered by the Respondent who's name and was offered to the complainant on September 28th, 2014 to make a deal with the Complainant. However, this it is not of further importance because the Panel is of the opinion that the Respondent registered the disputed domain name without any rights or legitimate interest and was willing to agree into the transfer of the disputed domain to the Complainant.

5. Conclusion

The present complaint is based on the fact that the domain name "fc-bayern-munchen" is confusingly similar to the name "FC BAYERN MÜNCHEN" which is protected under German and EU law. The hyphen, the lack of diacritical signs in the English language concerning the "Ü" and the abbreviation of the legal form of the German stock corporation "AG" are not relevant. The use of identical or similar terms cause a substantial likelihood of confusion.

The disputed name is part of the Complainant's name and is also used as a trade name. Hence, "FC BAYERN MÜNCHEN" is a name for which the following rights are recognized within the German legal system. The protection of trade names is granted under §§ 5, 15 German Trade Marks Act whereas the registered name of a company is protected by §§ 17 et seqq. of the Handelsgesetzbuch (German Commercial Code). Furthermore, the disputed name is nearly identical with some Complainants trademarks, namely CTM reg. no. 002808145.

As per the excerpt from the commercial register, the Complainant's company firm name "FC BAYERN MÜNCHEN AG" has been registered in the year 2001 and it still exists. The Complainant owns an identical trademark right for the foregoing sign and several identical or nearly identical domains, e.g. fc-bayern-muenchen.de, fcbayernmuenchen.de. The top-level domain will be neglected. The Complainant attached to its Complaint relevant documentation supporting and proving its arguments.

The Complainant has demonstrated priority rights in using the name "fc-bayern-muenchen" because the Respondent is only able to claim rights since September 28, 2014.

In this case the Complainant requests that the contested domain name would not only be revoked but also transferred to it. In such a case the Complainant must meet the general eligibility criteria to be a registrant of a domain name set out in Article 4(2)(b) of 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.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community;

2. an organisation established within the European Community without prejudice to the application of national law; or

3. a natural person resident within the European Community.

The Complainant, being a company registered under German law, satisfies the eligibility requirement for .eu domain name registrations pursuant to Article 4(2)(b)(ii) of Regulation (EC) No. 733/2002.
Therefore the disputed domain name has according to the ADR Rules to be transferred as claimed.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name FC-BAYERN-MUNCHEN be transferred to the Complainant

PANELISTS

Name	**REIMER VON HERGET, Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2015-02-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: [fc-bayern-munchen]

II. Country of the Complainant: [Germany], country of the Respondent: [United Kingdom]

III. Date of registration of the domain name: [28 September 2014]

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. [combined] trademark registered in [EU], reg. No. [002808145], for the term [FC BAYERN MÜNCHEN], filed on [08 August 2002] in respect of goods and services in classes [3,6, 8, 9, 11,12, 14-18, 20-22, 24-34, 38, 39, 41, 44]
2. company name: FC BAYERN MÜNCHEN
3. domain name: fc-bayern-muenchen.de

V. Response submitted: [Yes]

VI. Domain name is [confusingly similar] to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. [No]
2. Why: registration only for dealing purpose

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. [Probably Yes]
2. Why: not necessary to decide

IX. Other substantial facts the Panel considers relevant: Respondent agreed to transfer of the disputed domain

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

XI. Procedural factors the Panel considers relevant: none

XII. [If transfer to Complainant] Is Complainant eligible? [Yes]