Panel Decision for dispute CAC-ADREU-004320

Case number	**CAC-ADREU-004320**
Time of filing	**2007-03-19 13:40:49**
Domain names	**nuernbergmesse.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**NürnbergMesse GmbH**

Respondent

Organization / Name	**Marnix Brands**

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 any other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

1 The Complainant is Nürnberg Messe GmbH, a German incorporated company.

2 The Complainant is the proprietor inter alia of the following trade mark registrations:

(a) Community Trade Mark 1 943 463 for the mark NÜRNBERG MESSE (registered 2002);
(b) International Registration IR 766 281 for the mark NÜRNBERG MESSE (registered 2001).

3 The Complainant also owns the domain name “NUERNBERGMESSE.de”.

4 The Respondent is Marnix Brands, an organisation based in the United Kingdom.

5 On 12 April 2006, a few days after the commencement of the Land Rush period, the Respondent applied for registration of the disputed domain name NUERNBERGMESSE, which registration was subsequently blocked by EURid.

6 On 10 May 2007, following a language trial which resulted in English being selected as the language of the proceedings, the Complainant issued the Complaint in the present ADR proceedings. The Respondent’s original Response was found to be defective and an amended Response was filed on 16 July 2007.

A. COMPLAINANT

7 The Complainant, Nürnberg Messe GmbH, seeks a decision transferring the registration of the disputed domain name to the Complainant. The Complainant’s submissions may be summarised as follows. The Complainant organises and promotes international trade fairs, mainly in Nürnberg, Germany, where over 50 trade fairs and congresses are held each year, attended by a large number of visitors. The Complainant’s commercial activities are conducted under the name NÜRNBERG MESSE. Furthermore, the Complainant is globally active through its subsidiary Nürnberg Global Fairs and the Complainant is now well known for its trade fairs throughout Europe and world-wide. As a result, consumers would associate the disputed domain name with the Complainant’s trade mark.

8 In addition to the trade mark use of the name NUERNBERGMESSE by the Complainant since at least 1988, the Complainant asserts that it has been using the trade name NUERNBERGMESSE since 1974. A major advertising device of the Complainant was the internet using the domain name “NUERNBERGMESSE.de”.

9 The Complainant asserts that registration of the disputed domain name by the Respondent is speculative and abusive within the meaning of Art 21 of Commission Regulation (EC) 874/2004 (the "Regulation"). The disputed domain name is identical with/ confusingly similar to the name NÜRNBERG MESSE, in respect of which the Complainant holds prior rights. Consumers would make a connection between the disputed domain name and the owner of the trade marks NÜRNBERG MESSE.

10 The Complainant also asserts that the domain name has been registered by the Respondent without rights or legitimate interest in the name since the Respondent has no rights to the disputed domain name, is not known by that name, has not used the domain name, or a name corresponding to the domain name, in connection with the offering of goods or services, and has not made legitimate non-commercial or fair use of the name, even though the domain name was registered more than one year ago at the time when the Complaint was filed.

11 The Complainant further submits that the disputed domain name has been registered in bad faith. The Complainant relies on a letter said to be from the Respondent to the Complainant dated 3 May 2006 as evidence of the fact that the domain name was registered primarily for the purpose of selling it to the Complainant. The letter shows the Respondent's intention of selling the domain name to the Complainant, and the Complainant construes this letter as threatening to sell the disputed domain name to a competitor of the Complainant if there was no response "in a short time". The letter further showed that the Respondent was aware of the Complainant's prior rights to and the reputation of the name NÜRNBERG MESSE.

12 Furthermore, the Complainant points out that the Respondent acted in bad faith when registering the disputed domain name because the disputed domain name could be used intentionally to divert traffic away from the Complainant's web-site for commercial gain by reason of the identity/confusing similarity of the domain name with the Complainant's trade mark.

13 Finally, the Complainant confirms that it satisfies the general eligibility criteria for transfer of the disputed domain name.

B. RESPONDENT

14 The Respondent's submissions may be paraphrased as follows. The Respondent points out that the Complainant failed to register the disputed domain name during the phased period of registration known as the Sunrise phase and asserts that, once the phased period of registration had expired, the Respondent was free to apply for and register the disputed domain name on a "first come first served" basis in accordance with Commission Regulation (EC) 733/2002 and the Regulation.

15 Furthermore, the Respondent was making legitimate non-commercial use of the domain name without the intention to mislead consumers or to harm the reputation of a name for which a prior right was recognised or established. The name NUERNBERG MESSE had in fact become a generic term used by millions of people. The Complainant should not have exclusive rights to that name and should not be allowed to monopolize language.

16 Also, the Complainant's trade mark did not correspond to the domain name. In particular, the trade mark used the German spelling "Ü" and consisted of two words with capitalised first letters and separated by a stylised slash. By contrast, the domain name used the spelling "UE" and consisted of one word. This spelling was not protected. In case there were any similarities, the Complainant failed to show that consumers were in fact being misled, or that the Complainant's reputation was being harmed. Rather, the Complainant was itself confusing consumers by using two different spellings for its name. The domain name should therefore not be revoked arbitrarily.

17 The Respondent further invokes the right of freedom of expression guaranteed by the UN Universal Declaration of Human Rights and the European Convention of Human Rights.

18 The Respondent rejects the Complainant's submission that the disputed domain name had been registered without rights or legitimate interest in the name, or that it had been registered in bad faith, and takes the position that the Complainant failed to adduce any evidence to support these accusations. The letter relied upon by the Complainant to establish bad faith did not mention the sale of the disputed domain name. The Respondent therefore asks the Panel to reject the Complaint.

DISCUSSION AND FINDINGS

19 The Panel has reviewed and considered the parties' submissions and annexed documents, as well as the other documents constituting the record, in detail before arriving at a decision.

20 While the Complainant refers in one place to the disputed domain name as NUERNBREGMESSE, it is clear from the proceedings as a whole, and from the remainder of the Complainant's submissions, that this is a typographical error on the part of the Complainant and

that the proceedings are concerned with the domain name NUERNBERGMESSE. Indeed, the Respondent's response likewise proceeds on this basis.

21 In accordance with Article 21(1) of the Regulation and Paragraph B.11(d)(1) of the ADR Rules, in order to succeed, the Complainant must establish that:

(a) the disputed domain name is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognised or established by national and/or Community law; and either
(b) the domain name has been registered by the Respondent without rights or legitimate interest in the domain name; or
(c) the domain name has been registered or is being used in bad faith.

22 The Complainant has adduced evidence to show that it is the registered proprietor of figurative trade mark registrations for the mark NÜRNBERG MESSE, including a CTM, and of a domain name comprising the name NUERNBERGMESSE. Absent any evidence to that effect, the Panel does not accept the Complainant's submission that it made use of the trade name NUERNBERGMESSE since 1974 and of a trade mark NUERNBERGMESSE since at least 1988.

23 The question therefore arises whether the domain name NUERNBERGMESSE is identical or confusingly similar to the trade mark NÜRNBERG MESSE. The Panel takes the answer to this question from Article 11 of the Regulation, which deals with special characters. Article 11 paragraph 1 of the Regulation provides that, as far as the registration of complete names is concerned, where such names comprise a space between the textual or word elements (as is the case with the Complainant's trade mark) identicality shall be deemed to exist between such complete names and the same names written with a hyphen between the word elements or combined in one word in the domain name applied for.

24 Article 11 paragraph 2 of the Regulation further provides that, where the name for which prior rights are claimed contains special characters, spaces, or punctuation, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

25 Insofar as the slash between the word elements NÜRNBERG and MESSE of the Complainant's trade mark is concerned, the slash is considered by Article 11 paragraph 3 of the Regulation to be a special character and must therefore be disregarded to arrive at the corresponding domain name. Finally, Article 11 paragraph 4 addresses the question how the German spelling "Ü" is to be dealt with and requires such letters which contain additional elements that cannot be reproduced in ASCII code either to be reproduced without these elements (i.e., as "U"), or to be replaced by conventionally accepted spellings (such as "UE").

26 If the Complainant had applied for a domain name based on its prior trade mark rights, it would have had to do so in the form NUERNBERG-MESSE/ NURNBERG-MESSE, in the form NURNBERGMESSE, or in the form of the disputed domain name NUERNBERGMESSE. Indeed, the Complainant's .de domain name uses the form NUERNBERGMESSE. The Panel therefore holds that the disputed domain name is identical to the name in respect of which a right (of the Complainant) is recognised within the meaning of Article 21(1) of the Regulation and Paragraph B.11(d)(1) of the ADR Rules.

27 However, if the Panel had not found the domain name to be identical with the name for which a prior right exists, as it did, the Panel would have regarded the disputed domain name as confusingly similar to the name for which the prior right exists because the German letter "Ü" is commonly rewritten as "UE" where special symbols are not available or cannot be used. The Complainant's .de webname provides a typical example for such rewriting. The Panel does not regard the disputed domain name as a geographical name within the meaning of the Regulation, as the Respondent appears to suggest in a passage of his Response.

28 There is no suggestion on the record that the Respondent had a right in the name NUERNBERGMESSE. The Panel must therefore next consider the question whether the disputed domain name has been registered by the Respondent without rights or legitimate interest in the domain name. The Panel does not accept the Respondent's suggestion that the Complaint should be rejected on the ground that the Complainant failed to adduce evidence showing that the Respondent did not have a right or legitimate interest in the domain name. The Panel construes Article 21(2) of the Regulation as placing the burden on the Respondent to demonstrate the existence of a legitimate interest in the name.

29 Pursuant to Article 21(2), a legitimate interest could have been demonstrated where:

(a) prior to any notice of an alternative dispute resolution (ADR) 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;

(b) the holder of a domain name, being an undertaking, organisation 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;

(c) the holder of a domain name 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 recognised or established by national and/or Community law.

30 The Respondent has not suggested, nor is there otherwise any indication, that any of the above circumstances may apply and the Panel therefore concludes that the Respondent does not have any legitimate interest in the name NUERNBERGMESSE.

31 The Complainant is therefore not required to show, nor is the Panel required to consider, whether the Respondent applied for the disputed domain name in bad faith. However, the Panel notes that in the letter dated 3 May 2006 from an entity named Brands Registration Ltd, which shares the Respondent's postal and e-mail address, to the Complainant, it is stated that "BRANDS Registration has established nuernbergmesse.eu and made this available for your acquisition." While it is not necessary in light of the Panel's findings to clarify the relationship between Brands Registration Ltd and the Respondent, the Panel regards this letter as evidence of the existence of bad faith within the meaning of Article 21(3)(a) of the Regulation, in that it indicates that the domain name was registered or acquired primarily for the purpose of selling the domain name to the holder of a name in which a prior right is recognised or established, specifically, the Respondent, as the letter makes clear.

32 Finally, it follows from Article 22(11) that the Panel's jurisdiction is limited to reviewing the registration of the disputed domain name against the provisions of the Regulation and of Regulation (EC) No 733/2002, and that the Panel does not have jurisdiction, even if it was inclined to entertain such an argument, to consider whether the Respondent's freedom of expression or other fundamental rights may be in play and may have been infringed. However, were it to address the argument, the Panel would not conclude that the Respondent's freedom of expression could be considered to be or have been infringed by measures which prevent speculative and abusive registrations, having regard to the legitimate rights of others, including those of the Complainant; in particular, where the case concerns essentially a bare domain name registration, where the website accessed via the disputed domain name is not used as some form of protest website, and where it carries no substantive content and simply links and automatically forwards to the registrar's website, which in turn carries the statement that "This domain name is registered for a client of Networking4all B.V" (in addition to generic information about the Registrar's services).

33 In light of these findings, the Panel concludes that the Complainant has satisfied the requirements of Article 21(1) of the Regulation and of Paragraph B.11(d)(1) of the ADR Rules.

34 The Panel finds that the Complainant satisfies the general eligibility criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002 and referred to in Article 22(11) of the Regulation. The Complainant is therefore entitled to the transfer of the disputed domain name to itself.

DECISION

For all the foregoing reasons, and in accordance with Paragraph B.12(b) and (c) of the ADR Rules, the Panel orders that the disputed domain name NUERNBERGMESSE.eu be transferred to the Complainant.

PANELISTS

Name	**Gregor Kleinknecht, LLM MCIArb**

DATE OF PANEL DECISION 2007-08-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant seeks the transfer of the disputed domain name NUERNBERGMESSE.eu to the Complainant. The Respondent states that there is no evidence that the registration was speculative and abusive and asserts that, in fact, the disputed domain name was registered in accordance with the applicable provisions of the Commission Regulations after the Complainant failed to avail itself of the opportunity to apply for and register the disputed domain name during the Sunrise phase. The Complainant has established that the disputed domain name is identical to the mark in respect of which the Complainant has a right which is recognised or established by national and/or Community law, having regard to the appropriate treatment of spaces and special characters in the domain name. The Panel found that the Respondent had no rights or legitimate interest in the disputed domain name. Since the Complainant also fulfils the general eligibility criteria, it was entitled to the transfer of the disputed domain name.