Panel Decision for dispute CAC-ADREU-004340

Case number	**CAC-ADREU-004340**
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Domain names	**bundesliga.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**DFL Deutsche Fußball Liga GmbH, Legal Department**

Respondent

Organization / Name	**T.I.M. Spijkerman**

FACTUAL BACKGROUND

The Complainant is a limited liability company (GmbH) incorporated under German law having its place of business in Frankfurt am Main, Germany. The Complainant is wholly owned by and runs the operative business of “Die Liga - Fußballverband e.V.” – a registered association which is formed by the 36 football clubs of the two highest leagues in German professional football. The Complainant is the organizer of the Bundesliga and is responsible for all league operations, including the league matches and the worldwide marketing of the Bundesliga. The Complainant also runs the website www.bundesliga.de and is the owner of several German and CTM trademarks, among them German trademark No. 302 13 991.5 “BUNDES LIGA” and the equivalent CTM No. 002849065.
The Respondent is the owner of the company “Back-Online” which specializes in web designing and develops websites for other companies.
On January 2, 2006 the Respondent filed a Sunrise application for the domain bundesliga.eu.
The Respondent’s application was based on the Benelux trademark No. 0785636 “b&u&n&d&e&s&l&i&g&a” for Nice class 22 (ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags - not included in other classes; padding and stuffing materials - except of rubber or plastics; raw fibrous textile materials). The Respondent applied for the trademark on December 23, 2005 and applied for the domain name bundesliga.eu the same day. This first application was rejected by EURid because the trademark had not been registered yet. The second application dated January 2, 2006 was then accepted by EURid.
On February 2, 2006 the Complainant’s legal head filed an application for the domain bundesliga.eu. As the Respondent’s application was earlier in line, this application has not been considered by EURid.
In addition, the Respondent registered from December 2005 to January 2006 another 17 trademarks. All applications were made for Nice class 22. In all cases the Respondent followed the same approach as for “bundesliga” by entering an ampersand symbol (&) between each letter and applied for the domains without ampersands short time after the Benelux trademark registration.

A. COMPLAINANT

The Complainant asserts that the domain name bundesliga.eu is subject to revocation pursuant to section Art 21 (1) Commission Regulation (EC) No. 874/2004 as it is identical to the Complainant’s trademark being a prior right mentioned in

Art 10 (1) of said regulation and as the domain name has been registered by the Respondent without right or legitimate interest . Notwithstanding the foregoing, the Complainant argues that the revocation can be based also on the fact that the Respondent has registered and uses the domain in bad faith.

1. Trademark of the Complainant

The Complainant points out that he is the owner of a German word/figurative trademark ("Wort-Bildmarke" which is a composite mark of a word mark and a figurative mark) and the corresponding CTM (as a figurative mark) with the sole and predominant wording "BUNDES LIGA". The Complainant states that it is acknowledged by the Court that such a figurative or composite trademark qualifies as a prior right under Art 10 (1) of Commission Regulation (EC) No. 874/2004 and that the domain name shall be compared with the text elements for determination if the domain is identical or similar (see e.g. case 3170 "BUDAPEST", case 2791 "MESSE-STUTTGART", case 596 "RESTAURANTS"). The Complainant states that his trademark is therefore considered identical or at least confusingly similar to the disputed domain name.

2. No right or legitimate interest of the Respondent

According to the Complainant the Respondent cannot claim a right or a legitimate interest in the sense of Art 21 (1)(a) of Commission Regulation (EC) No. 874/2004.

a) The use of ampersands in the trademark
The Complainant asserts that the Registry mistakenly applied Art 11 of Commission Regulation (EC) No. 874/2004 to the Respondent's application.

Art 11 stipulates:

"Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten."

The ampersand sign "&" is such a special character. The Complainant argues that the Respondent is not entitled to the domain name bundesliga.eu because Art 11 cannot be interpreted literally but must be seen with regard to the intention of the legislator.
According to the Complainant, the treatment of special characters in Art 11 must be seen as an exemption to the demand of strict identity pursuant to Art 10 (2): As for technical reasons such special characters cannot be used in a domain name, a trademark including a special character should, within the restrictions of Art 11, nevertheless qualify for a prior right in order to avoid a discrimination of an owner of such a trademark. However, it is not the intention of Art 11 to privilege an owner of such a trademark in any way, either. If the domain name resulting of an elimination of the special characters does not reflect the recognition of the trademark any more (and vice versa) the applicant is barred from claiming a prior right based on the exemption of Art 11 (see e.g. case 265 "LIVE", case 394 "FRANKFURT", case 1523 "COLOGNE" and case 3043 "KENDO"). Adopting this approach to the present case, the Respondent should be barred from claiming for a prior right based on the exemption of the rule of identity in Art 11 because the unreadable and meaningless trademark b&u&n&d&e&s&l&i&g&a has no link to the readable and meaningful word "bundesliga" (see case 3043 for "K&E&N&D&O" and "KENDO").

Furthermore, it is argued that the idea to reduce the test of the "prior right" to a formal procedure and to refer all discretionary aspects to a complaint based on "bad faith" according to Art 21 (1)(b) is violating a general principle of "abuse of law" which forms a part of European Union Law. Independently from and with priority over the conditions laid down in Art 21 (1)(b) and (3) allowing the Complainant to invoke bad faith of the Respondent, the doctrine of abuse of law must be applied to Art 11 of Commission Regulation (EC) No. 874/2004.

Secondly, in the intention to obtain an advantage from the Community rules by creating artificially the conditions laid down for obtaining it, the Respondent registered the Benelux-Trademark b&u&n&d&e&s&l&i&g&a in an accelerated procedure in class 22 for the sole reason to benefit from Art 11 of the Regulation and to register the domain bundesliga.eu on this basis

directly after the registration of said trademark.

Therefore it is argued that even a literal interpretation of Art 11 might not lead to a recognition of a prior right for the Respondent as his conduct constituted an “abuse of law”. He should consequently be excluded from invoking Art 11 of Commission Regulation (EC) No. 874/2004 as basis for his prior right.

b) Legitimate interest
The Complainant asserts furthermore that for the aforementioned reasons a legitimate interest of the Respondent according to Art. 21 (2) (EC) No. 874/2004 has to be denied.
Despite, the conditions of Art 21 (2) would not be fulfilled anyway. Art 21 (2)(a) and (2)(c) would require a usage in connection with the offering of goods and services for the class the trademark has been registered for. In the present case the Respondent does not use the website for class 22 (ropes etc.).

In addition, the Respondent does not provide any meaningful content on the website but merely copied and pasted, without authorization, some fragments of the official FIFA and UEFA website and photos of third parties to his page.
Art 21 (2)(b) is therefore not fulfilled according to the Complainant.

3) Bad faith

Notwithstanding the foregoing, the Complainant considers the domain to be subject to revocation also because the Respondent has registered the domain and is using it in bad faith pursuant to Art 21 (1)(b), (3) of Commission Regulation (EC) No. 874/2004.

a) Art 21 (3)(a) – intention to sell

The Complainant argues that the domain name was registered primarily for the purpose of selling the domain name to the Complainant. Evidence for this assertion is seen in the letter of the Respondent dated May 12, 2006 (see Annex 7). In this letter the Respondent made an implied request for proposal to buy the domain name when he stated: ”Since the Deutsche Fussball Liga GmbH has interest in the domain “bundesliga.eu”, they probably have also thought about conditions. We may expect your answer via letter until May 17, 2006”.

b) Art 21 (3)(b)(i) – preventing the Complainant to register the domain name

The Complainant also brings forward that the domain name has been registered in order to prevent the Complainant from registering the corresponding domain name because the Respondent

- included ampersands in his trademark application and filed for class 22 to avoid conflicts with the existing trademark of the Complainant and to artificially benefit from Art 11 of Commission Regulation (EC) No. 874/2004

- filed 17 Benelux trademarks, including the trademark b&u&n&d&e&s&l&i&g&a, shortly before he applied for the corresponding .eu domain names during first phase of the Sunrise period and used the expedite trademark as prior rights which would entitle him to the corresponding domain names

- and does not use the website in the class the trademark has been applied for, but with content concerning football, the business of the Complainant.

c) Art. 21 (3)(d) – attracting Internet users for commercial gain by creating confusion

Finally, the conditions of Art 21(3)(d) were also considered fulfilled. The Respondent used the domain name bundesliga.eu intentionally to attract Internet users, for commercial gain, by creating a likelihood of confusion with the trademark of the Complainant.
This argument was supported by the fact that the Respondent does not use the website in the class the trademark has been

applied for, but with content concerning football, the business of the Complainant and that he promotes on bundesliga.eu links to a huge list of domains offered by him under the business identifier “back-online.nl”, under that he further offers IT services on the website "back-online.nl" (see Annex 11 and 12).

For all the foregoing reasons, pursuant to Art. 22 (1) of Commission Regulation (EC) No. 874/2004, the Complainant asks the Panel to revoke the domain name and transfer it to the Complainant.

B. RESPONDENT

The Respondent claims that he is the legal owner of the domain name bundesliga.eu. According to the Respondent’s interpretation of Art. 11 (EC) No. 874/2004 he was free to delete the & sign when filing the registration request for the domain name.

1. Options
He points out that Art. 11 leaves three options for the applicant to comply with the Regulation and apply for a domain name on the basis of a name containing a special character. The applicant may:
- either eliminate the special character entirely from the corresponding domain name,
- replace it with hyphens,
- or, if possible, rewrite it.
In the Respondent’s view, when it is not possible to rewrite special characters, the applicant looses the third possibility (“Names containing such special characters can thus only be used to claim a prior right on a domain name without the special character or with a hyphen instead of the special character”). When it is possible to rewrite it, the domain name holder still benefits of the above named three possibilities and is free to choose between them.

2) Legitimate interest
The Respondent also claims to have a legitimate interest as he considers it to be his core business to purchase domain names and develop websites for other companies. He thereby refers to other websites owned by him such as “spijkernet.nl” (Annex 18 and 19).

3) Bad faith
a) Art. 21 (3) (a)- intention to sell
It is emphasized by the Respondent that his core business is web design and not the trade with domain names. He claims that he has been induced by the Complainant to make an offer for sale on their request. He had never offered the domain bundesliga.eu for sale or rent before.

b) Art. 21 (3) (b) (i)- preventing the Complainant to register the domain name
The Respondent asserts that the Complainant is not the only rightful owner of the domain in question. To emphasize this point he refers to other domains such as bundesliga.ch, .info, .nl etc. which all refer to different subjects.

c) Art. 21 (3) (d)- attracting internet users for commercial gain by creating confusion
It is argued by the Respondent that the domain bundesliga.xx is used for a variety of services by a whole range of companies and can therefore not be considered confusing in his case.

DISCUSSION AND FINDINGS

According to Art. 21 (1) EC 874/2004 a registered domain name shall be subject to revocation when it has been registered without rights or legitimate interests, Art. 21 (1) (a) (EC) 874/2004 or when it has been registered in bad faith, Art. 21 (1) (b) (EC) 874/2004.

I. Right or legitimate interest
The Complainant argues that the Respondent cannot base his domain name registration on a prior right because it was registered in bad faith. The Complainant suggests to apply the doctrine of “abuse of law” to Art. 11 (EC) 874/2004. The domain could only be registered because the registry misinterpreted Art. 11 (2).

By now, there is a long case history on the interpretation of Art. 11 (EC) 874/2004 (see eg. case 398 “BARCELONA”, case 2185 “ANTWERP”, case 394 “FRANKFURT”, case 3043 “KENDO”). The controversy focuses on the question whether Art. 11 (2) should be interpreted as allowing every applicant to freely choose between three options when his name for which prior rights are claimed contains special characters. He could either eliminate it entirely, replace it with a hyphen or if possible rewrite it (see case 1867 “OXFORD”).
The majority of Panel decisions disagreed with this interpretation. The wording of Art. 11 (2) “if possible rewrite it” should be understood in the sense that within the three alternatives provided for in Article 11 Par. 2, rewriting the symbols would be the preferred option. In other words, eliminating the symbol or replacing it with hyphens would be secondary options, only available when the symbol cannot be rewritten (see case 394 “FRANKFURT”). This textual argument is supported by the systematic of Art. 11. Art.11 (2) should be seen as an exemption to the rule of strict identity pursuant to Art. 10 (2). As the present case illustrates, the sequence of signs “b&u&n&d&e&s&l&i&g&a” is not identical to the word “bundesliga”.
To interpret Art. 11 (2) in the sense that it leaves an unfettered choice to the applicant to eliminate any special character contained in the name for which the prior right is claimed comes close to an open invitation to domain grabbing. Of all the signs mentioned in this Article, “&” and “+” are the ones for which a transcription is not only possible but, according to their meaning, is also the only logical way forward (see case 394 “FRANKFURT”). As it is easily possible to transcribe “&” to “and”, EURid should, according to Art. 11, have done so.
Consequently, the Respondent cannot claim the domain “bundesliga.eu” based on the prior right to a trademark “b&u&n&d&e&s&l&i&g&a”.
Whether the question of a “bad faith” registration should be raised under Art. 11 as suggested by the Complainant is irrelevant, when “bad faith” of the applicant can already be established under Art. 21 (3) (EC) 874/2004. The issue of abusive registration is addressed sufficiently when the line of interpretation of Art. 11, as pointed out above, is followed.

A legitimate interest pursuant to Art. 21 (2) (EC) 874/2004 cannot be established because it would require a use of the domain in the class the prior right has been registered for. The Respondent registered the trademark for class 22 but never used it to offer goods and services related to that class of products.

II. Bad faith
The Respondent registered a Benelux-Trademark shortly before applying for a TLD.eu together with 17 other trademarks containing the same special character “&”.
Whether the Respondent only registered the domain names to sell or rent it to the holder of an identical name, Art. 21 (3) (a) (EC) 874/2004 does not become clear from the evidence of the parties. The Respondent does use the website for his own business purposes and did not contact the Complainant on his own initiative.
However from the fact, that the Respondent registered the domain name “bundesliga.eu” for a class (Nice class 22) unrelated to football or sports and that he used the domain to advertise links to his other websites, it is established that he registered the domain to attract Internet users by creating a likelihood of confusion, Art. 21 (3)(d) (EC) 874/2004. The Respondent uses the well-known trademark of the Complainant to attract attention to his website. While the expectation of the Internet user would be to be referred to content linked to the actual German Bundesliga- which probably results in a high number of visitors every day- he will only find links to other commercial websites of the Respondent. The fact that the Respondent presents a few text fragments and pictures about football does not change the real commercial intention of the website.
The Respondent therefore registered the domain in bad faith according to Art. 21 (3)(EC) 874/2004.

III. Conclusion
The Respondent did not present a prior right eligible for registering the domain in question. Art. 11 (EC) 874/2004 is a technical provision and the priority of the three options included therein should be assessed by comparing the domain name applied for and the prior right on which it is based. In the present case, deleting the “&” symbol would grant rights to the applicant in a domain name for which it does not have prior rights according to Article 10.1 of Regulation 874/2004. The other options i.e. a hyphen or, if possible, rewriting, should have been followed.

In addition, the Respondent registered the domain in bad faith by intentionally creating a likelihood of confusion for commercial gain, Art. 21 (3)(EC) 874/2004.

DECISION

For all the foregoing reasons, in accordance with Art. 22 (11) of the Regulation (EC) 874/2004, being satisfied that Complainant is eligible for the registration of the Domain Name <bundesliga.eu>, the Panel unanimously orders that the Domain Name <bundesliga.eu> is transferred to Complainant.

It was proven by the Complainant and from public sources that the Complainant satisfied the general criteria for registration set out in § 4 (2) (b) of Regulation (EC) No. 733/2002.

The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction.

PANELISTS

Name	**Dinant Oosterbaan**

DATE OF PANEL DECISION 2007-05-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Respondent filed a Sunrise application for the domain bundesliga.eu. The Respondent's application was based on the Benelux trademark "b&u&n&d&e&s&l&i&g&a". The Panel held that the Respondent did not present a prior right eligible for registering the domain in question. Art. 11 (EC) 874/2004 is a technical provision. In the present case, deleting the "&" symbol would grant rights to the applicant in a domain name for which it does not have prior rights according to Article 10.1 of Regulation 874/2004. The other options mentioned in the Regulation i.e. a hyphen or, if possible, rewriting, should have been followed.

In addition, the Respondent registered the domain in bad faith by intentionally creating a likelihood of confusion for commercial gain, Art. 21 (3)(EC) 874/2004.