Panel Decision for dispute CAC-ADREU-005094

Case number	**CAC-ADREU-005094**
Time of filing	**2008-06-09 12:37:53**
Domain names	**ddr-museum.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**DDR Museum Berlin GmbH, Robert Rückel**

Respondent

Organization / Name	**Zheng Qingying**

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 which are pending or have been decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a limited liability company named “DDR Museum Berlin GmbH”, represented by Peter Kenzelmann and established 23th August 2005 in Berlin, Germany. The Complainant uses the domains www.ddr-museum.de and www.ddrmuseum.eu for commercial purposes.

The Complainant owns two trademarks, a coloured German Trademark DE-30564495.5 registered for goods and services in classes 16,25,28,41,42,43 on 15th March 2006) and a Community Trademark (004694774 registered for goods and services in classes 16, 42, 43 on May 30, 2007). The Complainant applied for a German Word Trademark on 9th November 2007 as well, (DE 30772928.1).

The Respondent is located in London, Great Britain and is Respondent in several ADR.eu cases (e.g. No. 02986, No. 04187, No. 04970). He registered the domain name “ddr-museum.eu” on September 12, 2006. He showed no use of the disputed domain neither commercial nor non profit. The disputed domain name was set on hold with a lot of other .eu domains previously.

On 3 June 2008, the Complainant initiated ADR proceedings. The Complainant, represented by no law office, submitted a complaint against the Respondent claiming that the Respondent registered the “ddr-museum.eu” domain name without rights or legitimate interest in this 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 not receive any Respondent’s communication confirming its consent with the termination of the ADR proceedings within the deadline and the Respondent was finally notified to submit its Response. The Respondent did not provide any communication in this regard.

According to the ADR Rules, Paragraph B3 f) the Respondent and Complainant were informed by the case administrator of the default. Even so the following five days after receiving this notification the respondent did not react (challenge the notice of Respondent Default according to Paragraph B3 (g) of the ADR Rules).

A. COMPLAINANT

The Complainant substantially claims that registration of the disputed domain name “DDR-Museum” is speculative and abusive pursuant to Art. 22 (1) (a) of the Regulation (EC) No. 874/2004.

The complainant declares that he owns rights as proprietor of trademarks, title- and company name rights and he is situated at Karl Liebknecht Straße 1, Berlin Mitte, a well respected museum about the former GDR (German Democratic Republic.) Further he declares that as one of the most interactive and visitor orientated museums in the world, it has been nominated for the Museum of the Year award. The complainant's premises constitute one of the most visited museums in Berlin.

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 failed to provide its Response within the required deadline and did not respond in any way.

Therefore, he has not produced any arguments or provided any evidence of any actual or contemplated right, legitimate interest or good faith use.

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 Registrant. Therefore, the only 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. Default

According to the ADR Rules, Paragraph B3 f) the Respondent and Complainant were informed by the case administrator of the default. Even so the following five days after receiving this notification the respondent did not react (challenge the notice of Respondent Default according to Paragraph B3 (g) of the ADR Rules).
Therefore the Panel shall decide according to Paragraph B10 (a) of the ADR Rules if the default comply as grounds or is a reason to accept the claims of the other party.
The Panel decides in this case yes, it is a reason to accept the claim of the other party.

3. identical or confusingly similar domain name

Regardless of the state of usage of the Complainant's marks, the complaint is in any case to be rejected if likelihood of confusion according to Article 8 (1) (b) of the Community Trademark Regulation cannot arise.

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, 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 status on hold.
The complainants marks do not have a strong or original power of distinction – indeed; the power of distinction of the marks is rather weak. “Museum” is a common word in the German Language, as well as in many European Countries. “DDR” is a common abbreviation and a former national emblem of the “German Democratic Republic”. It is protected under Art. 6ter (1) (a) Paris Convention with Art. 7 (1) (i) or (j) Community Trademark Regulation and Art. 8 (2) No. 6 MarkG (German Trademark Act) so far the German Government ruled it.

So decided the Federal Patent Court on 15th July 2008 (Az.26 W (pat) 4/05) in refusing a trademark application that the former German Democratic Republic (GDR) symbol “DDR” is no more a national emblem but a geographical indication of the new five States in Germany which formed the GDR.

A geographical indication (GI) is a sign used on goods or services that have a specific geographical origin and possess qualities, reputation or characteristics that are essentially attributable to that origin. GIs are protected in accordance with international treaties and national laws under a wide range of concepts, including laws specifically for the protection of GIs or AOs, trademark laws in the form of collective marks or certification marks, laws against unfair competition, consumer protection laws, or specific laws or decrees that recognize individual GIs.

After that the combination of a generic term (museum) and a geographic term (DDR) let the German judicature refuse intellectual property rights (eg. OLG Hamm decision of 18th March 2003, Az.: 4 U 14/03 – tauchschule-dortmund.de).

The Complainant ’s German Trademark is opposed what is comprehensible to the reasons mentioned above. Therefore the Panel venture to doubt that the trademarks give the Complainant an eligibility right because of Art. 8 (2) No. 1 and No. 2 German Trademark Act.

Besides the Complainant may claim his prior right of the trade name which is granted under §§ 5, 15 Markengesetz (German Trade Mark Act). So far an confusing similarity is obvious.

4. 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 DDR-Museum denomination. The registration itself is no right and creates none without perceptible use or preparing measures.

Article 10 (1) provides that holders of prior rights recognised 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.

The Respondent registered the disputed domain name after the sunrise period.

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, 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 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 recognised 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 "DDR-Museum” cannot be concluded from the Respondent’s 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 ddr-museum.eu domain name without rights or legitimate interest, within the meaning of Article 21, paragraph 1, letter a) of the Public Policy Rules.

5. 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 ddr-museum.eu domain name was registered by the Respondent who's name is in relevant databases including EURid and Adr.eu cases . But in fact in this case is no evidence shown that the Respondent offered the disputed domain.

6. Conclusion

The present complaint is based on the fact that the domain name "DDR-museum" is identical to the name "DDR Museum" which is protected under German and Community law. Even if the full name "DDR Museum Berlin GMBH" would have to be considered, the domain name would still be confusingly similar to the name "DDR Museum Berlin GmbH". The use of identical or similar terms cause a substantial danger of confusion between the parties in question.

The disputed name is part of the Complainant's name of firm and is also used as a trade name. Hence, "DDR-Museum" is a name for which the following rights are recognised 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).

As per the excerpt from the commercial register, the Complainant's company firm name "DDR-Museum Berlin GMBH" has been registered in August 2005 and it still exists. A title trademark right for the foregoing sign, called from the Complainant "copyright" is claimed since 19th of July 2005. The Complainant attached to its Complaint relevant documentation supporting and proving its arguments.

The Complainant has demonstrated priority in using the name "DDR-Museum" because the Respondent is only able to claim rights since 12th of September 2006.

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.
Nevertheless, the Complainant provided the Panel not with full evidence proving that the Complainant is the only person who has legitimate interest to use the disputed domain name. Until the final decision of the German Patent- and Trademark Office in the DE 30564495 opposition proceedings is missing, a final transfer is not appropriate and the domain name should only be revoked. Although the Complainant might not have rights arising from the registered trademark here he has other rights, the company name itself. On this basis the panel had to order the domain name to be transferred.

DECISION

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

the domain name DDR-MUSEUM be transferred to the Complainant

PANELISTS

Name	**Harald von Herget**

DATE OF PANEL DECISION 2008-09-04

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed a Complaint against the Respondent claiming that the Respondent registered for the “ddr-museum.eu” without rights or legitimate interest in the name. The Respondent failed to provide its Response.

The registration of several domain names that are similar to existing trademarks without using these domains is sufficient to establish a pattern of conduct according to Article 21 (3) (b) (i) of the Regulation (EC) No. 874/2004 (eg. ADR.eu No. 03588 – XIRONA, ADR.eu No. 04187 - DEGINVEST).

Given the foregoing, the Panel holds that indications and evidence exist that the disputed domain name was registered without rights or legitimate interest in the name and without regarding in this case probably in bad faith. The Panel orders that the domain name be transferred to the Complainant.