Panel Decision for dispute CAC-ADREU-008713

Case number	CAC-ADREU-008713
Time of filing	2025-04-09 14:05:21
Domain names	predpredaj.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	MADWIRE, s. r. o.

Complainant representative

Organization	VKS Legal advokátní kancelář, s.r.o.

Respondent

Organization	Marek Fischer - Germania Holding FF

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

Panel is not aware of any such proceedings.

FACTUAL BACKGROUND

Complainant:

The Complainant, MADWIR, s.r.o., is a Slovakian limited liability company. The Complainant's core business is arranging the sale of tickets to cultural events in Slovakia, mainly through internet websites owned or operated by the Complainant, in particular using its domain name <predpredaj.sk>.

The Complainant is a registered owner of the following trademark containing a word element "PREDPREDAJ":

(i) PREDPREDAJ SK (figurative), Slovak national trademark, filing and priority date 12 February 2019, registration date 16 December 2019, trademark no. 251330, registered for services in classes 35, 38 and 41 (referred to as "Complainant's Trademark").

The Complainant seeks transfer of the disputed domain name from the Respondent and maintains that the Respondent has registered the disputed domain name without rights or legitimate interest in the name and has acted in bad faith in registering and using it.

Respondent:

The Respondent is a physical person registered as an entrepreneur in the trade register of the Slovak Republic under the identification number 55808107 and business name "Marek Fischer - Germania Holding FF".

Disputed Domain Name:

The disputed domain name <predpredaj.eu> was registered by the Respondent on 17 October 2024 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is currently not used and has no content available to public (i.e. the disputed domain name is not currently associated with any active website).

Previous Communications of the Parties:

On 14 November 14, 2024, the Complainant contacted the Respondent, demanding that they stop infringing on their trademark rights and cease using the disputed domain name.

In his response, the Respondent stated that their organization is involved in the construction industry and was unaware of the Complainant's trademarks and business activities. The Respondent also proposed selling the disputed domain name to the Complainant for 40,000 EUR, mentioning that they are currently using the domain name for marketing activities.

A. COMPLAINANT

The Complainant contends as follows:

- The Complainant alleges that the Respondent improperly registered and used the disputed domain name <predpredaj.eu>, which is identical or confusingly similar to the Complainant's Trademark.
- The Complainant owns trademark rights to the term "predpredaj," and claims that by registering and using the disputed domain name for promoting and selling event tickets in Slovakia, the Respondent infringed on these rights and acted in bad faith.
- It is clear that the Respondent intended to run a business identical to the Complainant's, as seen on the Complainant's website "predpredaj.sk," and to take advantage of the Complainant's trademark and well-established brand.
- Despite stating the Respondent was unaware of the Complainant's brand and had intentions to manage his own concert ticketing business, the Respondent shortly thereafter registered a new domain, <epicstage.eu>, and duplicated the content from the disputed domain name website, keeping the same business model and contact details.
- The Complainant sees this behavior, including the Respondent's offer to sell the disputed domain name for EUR 40,000, as evidence of bad faith. The Complainant argues that if the Respondent had genuinely acted in good faith, there would be no reason to abandon "predpredaj.eu" and move the same content to a newly registered domain name.

Therefore, the Complainant is requesting the transfer of the disputed domain name to them. The Complainant meets the requirements for owning a .eu domain under Article 3(c) of Regulation (EU) 2019/517, as it is a business established in the European Union (supported by the enclosed extract from the Business Register).

B. RESPONDENT

The Respondent did not provide any response to the Complaint.

DISCUSSION AND FINDINGS

Applicable Regulations and Rules:

- Regulation (EU) 2019/517 of the European Parliament and of the Council of 19 March 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 („Regulation“);
- Commission Implementing Regulation (EU) 2020/857 of 17 June 2020 laying down the principles to be included in the contract between the European Commission and the .eu top-level domain Registry in accordance with Regulation (EU) 2019/517 of the European Parliament and of the Council („Implementing Regulation“);
- .eu Alternative Dispute Resolution Rules (”ADR Rules”) applicable to alternative dispute (ADR) resolution procedure under Article 11 of the Implementing Regulation;
- Supplemental ADR Rules of the Arbitration Court attached to the Czech Chamber of Commerce and the Agricultural Chamber of the Czech Republic applicable to alternative dispute (ADR) resolution procedure under Article 11 of the Implementing Regulation (“Supplemental ADR Rules”).

Legal Grounds for Decision:

Under Article 4(4) of the Regulation and the Article B11(d)(1) of the ADR Rules, the disputed domain name may be revoked, and where necessary subsequently transferred to another party, if it is identical or confusingly similar to a name in respect of which a right is established by Union or national law (first element), and where:

(a) it has been registered by its holder without rights or legitimate interest in the name (second element);

or

(b) it has been registered or is being used in bad faith (third element).

- Complainant's Rights to the Name

Article 4 (4) of the Regulation and Paragraph B11(d)(1)(i) of the ADR Rules requires that the disputed domain name be “identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or European Union law”.

Such rights are listed in Article 9(2) of the Implementing Regulation and Article B1(b)(9) of the ADR Rules and include copyright, trademarks, and geographical indications provided in Union or national law, and, in as far as they are protected under national law in the Member States where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

The Complainant presented evidence that it is a registered owner of the Complainant’s Trademark, which is a national registered trademark under the laws of Slovakia.

The Panel therefore concluded that the Complainant has established that the Complainant Trademark satisfies criteria for protected right within the meaning of the Article 9(2) of the Implementing Regulation and Article B1(b)(9) of the ADR Rules.

- Identity and/or Confusing Similarity to the Name

The Complainant’s trademark is not a word mark, but a figurative one. While it contains the term “predpredaj.sk”, this appears in stylized letters and a graphical form.

As a matter of principle, domain names cannot be identical to figurative (or combined) trademarks, since such trademarks—by their nature—cannot be reproduced in a domain name. However, domain names can be confusingly similar to figurative trademarks. On this basis, the Panel finds that the disputed domain name is not identical to the Complainant’s Trademark.

Given the lack of identity, the central issue examined by the Panel is whether the disputed domain name, <preredpredaj.eu>, is confusingly similar to the Complainant’s figurative trademark, which includes the term “predpredaj.sk” in stylized characters along with graphical elements.

There are two possible interpretations of the concept of “confusing similarity” in domain name and similar disputes.

The first is a narrow interpretation, which involves a straightforward comparison of the visual and aural elements of the domain name and the trademark (or a name in which the Complainant has rights) to assess the likelihood of Internet user confusion. Under this approach, the trademark must generally be recognizable within the domain name. The mere addition of common, dictionary, descriptive, or other non-distinctive terms is usually insufficient to avoid initial user confusion.

The second, broader interpretation expands this analysis to include the general “likelihood of confusion” test. In addition to comparing visual and aural similarities, this approach considers whether Internet users are likely to be confused as to the source or affiliation of the domain name. This includes the likelihood of association, where users might believe that the goods or services offered under the domain name originate from the trademark holder or from an economically linked entity.

In applying the broader test, the relevant user is the average consumer of the goods or services in question—someone who is reasonably well-informed, observant, and circumspect. The perception of this average consumer is critical in determining whether there is a likelihood of confusion and, consequently, confusing similarity.

In the present proceeding, the only significant element of the Complainant’s trademark for the purpose of this analysis is the word “predpredaj.” The graphical design of the trademark is not relevant to assessing confusing similarity in the context of domain name disputes. Furthermore, the country-code suffixes “.sk” (Slovakia) and “.eu” (European Union) are considered non-distinctive and are therefore excluded from the comparison.

In Panel’s view, the concept of "confusing similarity" must be interpreted and applied with rigor, in accordance with its broader interpretation—that is, by also applying the "likelihood of confusion" test. This stricter standard is essential to prevent the undue monopolization of generic or commonly used terms in the realm of commercial activity on the Internet.

This consideration is particularly important in .eu ADR proceedings, as the applicable ADR Rules require the Complainant to establish only one of the two additional elements—either lack of legitimate interest or bad faith—for the complaint to succeed.

The concept of “likelihood of confusion,” as discussed above, involves a comprehensive analysis that includes factors such as the distinctiveness of the trademark. The more distinctive a trademark is, the greater the likelihood that similar domain names will be perceived as confusingly similar under this broader standard. Conversely, trademarks that are weak, generic, or descriptive face greater difficulty in satisfying this test, especially where the domain name incorporates common or descriptive language.

The term “predpredaj” (which translates to “pre-sale” in English) is generic and descriptive by nature, and therefore lacks inherent distinctiveness. It is likely for this very reason that the Complainant registered a figurative mark rather than a word mark; an application for a word mark such as “predpredaj.sk” would likely have been refused on the grounds of descriptiveness.

Against this background, the Panel finds that, due to the generic nature of the term “predpredaj,” average Internet users (i.e., reasonably well-informed and observant consumers) would not associate the disputed domain name <predpredaj.eu> with the Complainant, its trademark, or its business.

That conclusion, however, might have been different had the Complainant provided evidence that the otherwise generic and descriptive term “predpredaj” had acquired distinctiveness (or secondary meaning) through extensive use and promotion to the extent that consumers uniquely associate it with the Complainant and its services. However, the Complainant has submitted no such evidence.

Applying the broader interpretation of the "confusing similarity" concept, the Panel concludes that the disputed domain name and the Complainant’s trademark do not meet the “likelihood of confusion” test. Consequently, there is no confusing similarity between the disputed domain name and the Complainant’s trademark.

This position is supported by a consistent body of panel decisions, including: CAC-ADREU-005309 < euroairport.eu>, CAC-ADREU-004261 <motorshowbolognafiere.eu>, CAC-ADREU-004687 <booking.eu>. These cases illustrate that a domain name is not confusingly similar to a

trademark if the shared word element is purely descriptive or a combination of descriptive terms.

The Panel also invokes prevailing WIPO UDRP case law, which may be analogously applied in .eu ADR proceedings. Per these precedents, descriptive words or phrases in a trademark do not create confusing similarity with a corresponding domain name. See, for instance, WIPO Case No. D2003-0645 <britishmeat.com>; WIPO Case No. D2006-0778 <brabant-wallon.org>, or WIPO Case No. D2004-0717 <aberdeenairport.com>.

Accordingly, the Panel concludes that the disputed domain name is neither identical to, nor confusingly similar with, any name in respect of which a right is established under Union or national law (within the meaning of Article 4(4) of the Regulation and Paragraph B11(d)(1)(i) of the ADR Rules).

This outcome can be seen as the natural consequence of the Complainant's business decision to operate under a descriptive and easily memorable name. While nothing prevented the Complainant from adopting a wholly fictitious and more distinctive trademark, it chose a generic one. It cannot, therefore, claim exclusive rights to the generic term "predpredaj" or its variations.

The Panel wishes to emphasize that this .eu ADR proceeding does not—and cannot—determine whether the Respondent's use of the disputed domain name, including any content hosted on the associated disputed domain name website, infringes the Complainant's trademark or other rights, or constitutes acts of unfair competition. Such matters fall outside the scope of these proceedings.

Since the Complainant has failed to establish the first element of the test under Article 4(4) of the Regulation and Paragraph B11(d)(1) of the ADR Rules—namely, identity or confusing similarity—the Panel need not consider whether the Respondent has rights or legitimate interests in the domain name, or whether the domain name has been registered or used in bad faith.

DECISION

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

PANELISTS

Name	**Jiří Čermák**

DATE OF PANEL DECISION 2025-04-09

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: PREDPREDAJ.EU

II. Country of the Complainant: Slovak Republic, country of the Respondent: Slovak Republic

III. Date of registration of the domain name: 17 October 2024

IV. Rights relied on by the Complainant (B(11)(f) ADR Rules) on which the Panel based its decision:

1. PREDPREDAJ SK, figurative trademark registered in the Slovak Republic, reg. No. 251330, for the term predppredaj.sk filed on 12 February 2019, registered on 16 December 2019, in respect of services in classes 35, 38 and 41

V. Response submitted: No

VI. Domain name/s is neither identical nor confusingly similar to the protected right/s of the Complainant.

VII. Dispute Result: Complaint denied