

Hot wheels: ECJ to rule on REIFEN.EU

Presentation given in Prague
on 17 April 2009

Agenda

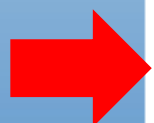
- Case history
- Questions referred to the ECJ

Internetportal und Marketing GmbH

- 10th August 2005:
Applied for a Swedish trademark “&R&E&I&F&E&N&” (for “seatbelts”) – together with 32 similar TM applications for generic words
- 7th December 2005:
Successfully applied for REIFEN.EU
- ~180 descriptive domain names

Applications for domain name reifen.eu

Position	Applied	Applicant	Details	Status	Documents received	Deadline for documents	Deadl ADR
1	07/12/2005 11:00:16.767	Internetportal und Marketing GmbH		Activated	23 December 2005	16 January 2006	13 April 2006
2	07/12/2005 11:01:22.947	Internetportal und Marketing GmbH		Expired	--	16 January 2006	--
3	07/12/2005 11:12:38.236	Reifen		Not considered	13 January 2006	16 January 2006	--
4	07/12/2005 11:15:20.343	Wolfgang Heilmann		Not considered	04 January 2006	16 January 2006	--
5	07/12/2005 11:21:59.348	Wolfgang Heilmann		Expired	--	16 January 2006	--
6	07/12/2005 11:24:44.148	Wolfgang Heilmann		Not considered	04 January 2006	16 January 2006	--
7	07/12/2005 11:28:41.696	Wolfgang Heilmann		Expired	--	16 January 2006	--
8	07/12/2005 11:31:07.164	Wolfgang Heilmann		Expired	--	16 January 2006	--





Suchbegriff eingeben

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Fertig

Richard Schlicht

- 10th November 2005:
Benelux trademark (and CTM) application for "REIFEN" for "*Preparations for cleaning window glass surfaces*" etc.
- „REInigungsmittel für FENsterglas-ähnliche Oberflächen“
- 31st March 2006:
German TM application (abandoned)

RICHARD SCHLICHT SOLARTECHNIK

- Unternehmen
- Hintergrund
- Kompetenz
- Leistungen** — Planung
- Kontakt — Bauleitung
- Glasreinigung**

Richard Schlicht Solartechnik bietet die Reinhaltung von Glasflächen in zweierlei Hinsicht:

Als Serviceleistung:
 Rekrutierung und Betrieb von Reinigungsteams vor Ort.
 Durch Technologie:
 Nanobeschichtungsverfahren der Gläser und Reinigungsmittel spezifischer Zusammensetzung.

Derzeit planen wir, unsere Reinigungs-Technologie REIFEN™ auch für Fenster in Architektur und Haushalt zu vermarkten.



ADR case no. 910 - REIFEN

- 24th April 2006:
Richard Schlicht v.
Internetportal und Marketing GmbH
- Panel assumed a speculative and abusive registration
 - “Registered without rights or legitimate interest” (-), but
 - “Registered in bad faith” (+)
- Transfer to Complainant

Court proceedings

- Internetportal und Marketing GmbH appealed
- 1st and 2nd instance confirmed the ADR decision
- Austrian Supreme Court (“OGH”) referred the case to the ECJ
 - OGH Case no. 17Ob17/08m,
decision of 18th November 2008
 - ECJ Case no. C-569/08

Questions referred (1a)

1. Is Article 21(1)(a) ... to be interpreted as meaning that a right within the meaning of that provision exists,
 - a) if, without any intention to use it for goods or services, a trade mark is acquired only for the purpose of being able to register in the first phase of phased registration a domain corresponding to a German-language generic term?

(OGH suggests an "effet utile" argument: The purpose of the phased registration was to prevent cybersquatting; this purpose is not affected if a generic domain name is registered because there are usually no exclusive rights on generic names)

Questions referred (1b)

1. Is Article 21(1)(a) ... to be interpreted as meaning that a right within the meaning of that provision exists,
b) if the trade mark underlying the domain registration and coinciding with a German-language generic term deviates from the domain in so far as the trade mark contains special characters which were eliminated from the domain name although the special characters were capable of being rewritten and their elimination has the effect that the domain differs from the trade mark in a way which excludes any likelihood of confusion?

(OGH: &R&E&I&F&E&N& ≠ REIFEN, trademark owner's interest in the domain name is not worth protecting)

Questions referred (2)

2. Is Article 21(1)(a) of Regulation (EC) No 874/2004 to be interpreted as meaning that a legitimate interest exists only in the cases mentioned in Article 21(2)(a) to (c)?

(OGH: We do not know whether Article 21(2) is a binding definition of "legitimate interest", or merely a non-exhaustive list of examples)

Why were the UDRP words "in particular but without limitation" omitted?

Questions referred (3)

If that question is answered in the negative:

3. Does a legitimate interest within the meaning of Article 21(1)(a) of Regulation (EC) No 874/2004 exist if the domain holder intends to use the domain – coinciding with a German-language generic term – for a thematic internet portal?

(OGH: We think no, because

- *unlike Article 21(2)(a)/(b) such interest is not “derived from a position held before the domain name was registered”*
 - *Correct? Cf. “demonstrable preparations” prior to “notice of an ADR procedure” in (a)*
- *unlike Article 21(2)(c) the domain name is not actually used)*

Questions referred (4)

If questions (1) and (3) are answered in the affirmative:

4. Is Article 21(3) ... to be interpreted as meaning that only the circumstances mentioned in subparagraphs (a) to (e) are capable of establishing bad faith within the meaning of Article 21(1)(b) ...?

(OGH: We do not know whether Article 21(3) is a binding definition of "bad faith", or merely a non-exhaustive list of examples)

Why were the UDRP words "in particular but without limitation" omitted?

Questions referred (5)

If that question is answered in the negative:

5. Does bad faith within the meaning of Article 21(1)(b) ... exist if a domain was registered in the first phase of phased registration on the basis of a trade mark, coinciding with a German-language generic term, which the domain holder acquired only for the purpose of being able to register the domain in the first phase of phased registration and thereby to pre-empt other interested parties, including the holders of rights to the mark?

(OGH: Possibly yes, the registrant accepted that he would prevent other – legitimate – right owners from registering "their" corresponding domain name)