



## WIPO Arbitration and Mediation Center

### ENTSCHEIDUNG DES BESCHWERDEPANELS

#### 1. The Parties

The Complainant is Deutsche Telekom AG, ....

The Respondent is B. C., ... Oklahoma, United States of America.

#### 2. The Domain Name and Registrar

The disputed domain name <bild-t-online.info> is registered with Parava Networks, Inc. dba RegistrarteYa.com & nAAme.com.

#### 3. Procedural History

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint on July 1, 2004, (electronic version) and on July 5, 2004, (hard copy). On July 2, 2004, the Center transmitted by email to Parava Networks, Inc. dba RegistrarteYa.com & nAAme.com a request for registrar verification in connection with the domain name at issue. On July 2 and July 5, 2004, Parava Networks, Inc. dba RegistrarteYa.com & nAAme.com transmitted by email to the Center its verification response and confirmed that it was the Registrar for the disputed domain name and the Respondent is listed as the registrant of the disputed domain name. Further, the Registrar provided contact details for the administrative, billing, and technical contact and confirmed that the Uniform Domain Name Dispute Resolution Policy (the "Policy") applied to the domain name at issue. The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"). The Complainant made the required payment to the Center.

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 6, 2004. In accordance with paragraph 5(a) of the Rules, the due date for Response was July 26, 2004. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 3, 2004.

The Center appointed Markus S. Bonair as the Sole Panelist in this matter on August 13, 2004. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules.

On August 27, 2004, pursuant to paragraph 12 of the Rules, the Panel issued Administrative Panel Procedural Order No. 1 (Procedural Order No. 1) requesting the Complainant to provide the Panel with a signed letter of support from an authorized representative of the third party trademark holder, Axel Springer AG, who owns the rights to the trademark BILD, by September 6, 2004. Further, the Panel extended the due date for the decision to September 13, 2004. The Center transmitted Procedural Order No. 1 to the parties on August 27, 2004.

On September 6, 2004, the Complainant transmitted by e-mail to the Center a signed letter of support from an authorized representative of the third party trademark holder, Axel Springer AG. The Center received the hard copy of the original on September 8, 2004.

The language of the proceeding is English.

#### 4. Factual Background

The Complainant is a telecommunications company with representations in 65 countries worldwide. In 2003, the Complainant made revenue amounting to 55.8 billion euros. The Complainant's subsidiary T-Online International made revenue amounting to 493.0 million euros in the first quarter of 2004.

T-Online International provides Internet and related services, but also a broad range of multimedia-services, including web-hosting, e-mail services, online-banking and international roaming access. T-Online International launched a joint-venture, named Bild.T-Online.de AG & Co. KG, with the German Axel Springer Verlag publishing house in May 2002. T-Online International owns a 37 % stake in this joint-venture, the purpose of which is to provide contents and entertainment under the domain name <bild.t-online.de>. This joint venture has been reported by European and US-media companies.

This portal substitutes the former domain name <bild.de>, the online version of Germany's biggest-selling tabloid newspaper Bild-Zeitung. The daily print run of this newspaper amounts to 3.8 Million on an average.

According to the <www.bild.t-online.de> website, more than 8.0 million people are visiting this website daily.

The Complainant is the owner of a number of trademark registrations consisting of or incorporating the marks T-ONLINE or T ONLINE, e.g:

US Trademark Registration No. 75013884 T-ONLINE, registration date March 6, 2001.

US Trademark Registration No. 75013885 T ONLINE, registration date March 20, 2001.

Community Trademark Registration No. 214528 T-ONLINE, registration date April 11, 2001.

Community Trademark Registration No. 214478 T ONLINE, registration date November 10, 1998.

International Registration No. 650171 T-ONLINE, registration date January 11, 1996.

German Trademark Registration No. 39539437 T-ONLINE, registration date November 8, 1995.

The above trademark registrations cover - among others - goods and services in International Classes 9, 16, 36, 37, 38, 41 and 42.

Further, the Complainant is ? among others ? the registrant of the following domain names: <bild-tonline.de>, <bild-tonline.com>, and <tonline.com/ .net/ .org/ .info/ .biz/ .de> as well as <t-online.com/ .net/ .org/ .info/ .biz/ .de>. Furthermore, the Complainant has arranged for the subdomain <bild.t-online.de>. The gTLD <bild-t-online.com/ .net/ .org> as well as the ccTLD <bild-t-online.de> are registered for Axel Springer.

The holder of the trademark and service mark BILD, Axel Springer AG, has consented to the transfer of the disputed domain name to the Complainant.

On June 15, 2004, 8,802,865 Internet users had visited the websites ?www.bild.t-online.deâ?? and ?www.bild-t-online.deâ?? until 6.30 p.m. On June 16, 2004, 9,406,450 Internet users had visited the websites until 8.00 p.m. and on June 17, 2004, 6,367,924 visitors until 2.05 p.m..

The domain name <bild-tonline.com> is routed to the Complainantâ??s homepage ?www.telekom3.deâ??.

The Complainant sent the Respondent a ?cease and desistâ?? letter on March 17, 2004. The Complainant then sent a copy of this letter by e-mail on April 08, 2004. The Complainant sent a further e-mail to the Respondent on May 3, 2004.

## 5. Partiesâ?? Contentions

### A. Complainant

#### Identical or Confusingly Similar

The Complainant contends that the domain name <bild-t-online.info> is confusingly similar to the trademarks T-ONLINE and T ONLINE in which the Complainant has rights. The Complainant argues that the addition of the designation ?bildâ?? in the beginning does not hinder the similarity, since it is the German translation of the English word ?pictureâ?? and therefore descriptive. In this respect, the Complainant refers to *Reuters Limited v. Global Net 2000, Inc*, WIPO Case No. D2000-0441, *Louis Vuitton Malletier v. Enrico Villa*, WIPO Case No. D2000-0721 and *Heineken Brouwerijen B.V. v. Mark Lott*, WIPO Case No. D2000-1487.

Further, the Complainant contends that it enjoys unregistered trademark rights in the designation BILD.T-ONLINE. The Complainant argues that the domain name <bild-t-online.info> is confusingly similar to its unregistered trademark BILD.T-ONLINE. The Complainant further argues that the registration of the domain name <bild-t-online.info> is to be considered as ?typo-squattingâ?? and refers to *The Toronto-Dominion Bank v. Boris Karpachev*, WIPO Case No. D2000-1571.

#### Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the domain name <bild-t-online.info>. The Respondent is not, and never has been, representative or licensee of the Complainant, nor is the Respondent otherwise authorized to use the Complainantâ??s marks.

The Respondent does not use the domain name <bild-t-online.info> for a *bona fide* offering of goods or services and does not make a legitimate noncommercial or fair use of it. After Internet users insert the respective domain name as a URL-address, the web browser displays permanently a page which reads ?Unable to determine URL address from host name ?www.bild-t-online.infoâ?? and ?The name server was unable to process this queryâ??. The Respondent does not offer and never has offered any goods or services nor even information on the domain.

The Complainant refers to *Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Distribution Purchasing & Logistics Corp*, WIPO Case No. D2000-0464.

## Registration and Use in Bad Faith

The Complainant contends that the domain name at issue was registered and is being used in bad faith.

The Complainant argues that due to the fame and reputation of the Complainant's registered marks T-ONLINE and the immense reputation of the domain name <bild.t-online.de> and its contents, it is evident that the disputed domain name was registered with these trademarks in mind. Furthermore, given the fact that the designation 'Bild' is not an English word, and that the designations 'Bild' and 'T-Online' are placed together to form a domain name which is sufficiently unique, the Respondent was unlikely ever to have created such a domain name without having knowledge of the Complainant's domains.

Since the registration of the disputed domain name in March 2004 it has not been used in any legitimate way. This prevents the Complainant from registering the disputed domain name.

Further, there has been no use of the domain name by the Respondent. According to previous administrative panel decisions of the Center such a use is not necessary. In this respect, the Complainant refers to *Atlantic Recording Corporation v. Paele International*, WIPO Case No. D2001-0065.

According to various administrative panel decisions of the Center an indication for the bad faith of the Respondent is his lack of use of the domain name. The Complainant refers to *CBS Broadcasting v. LA-Twilight-Zone* WIPO Case No. D2000-0397, *Toyota Motor Sales USA v. Rafi Hamid dba ABC Automobile Buyer*, WIPO Case No. D2001-0032 and *Muggles Magical Toys, Inc. v. Muggles.org*, Nat. Arb. Forum Case No FA-94798.

Furthermore, the Complaint argues that its marks T-ONLINE and T ONLINE are considered as well-known marks in many markets, including the USA. According to previous administrative panel decisions of the Center this is an indication for bad faith at registration of the domain, *Red Bull GmbH v. Harold Gutch*, WIPO Case No. D2000-0766 and *eBay, Inc. v. Sungho Hong*, WIPO Case No. D2000-1633.

This is even more true in view of the combination of the designations 'T-Online' and 'Bild', which is sufficiently unique that Respondent was unlikely ever to have coined such a domain name without already knowing about Complainant's, *Neuberger Berman Inc. v. Alfred Jacobsen*, WIPO Case No. D2000-0323.

Before this administrative proceeding, the Complainant sent the Respondent a 'cease and desist' letter. This letter was returned to the Complainant with the notice 'insufficient address'.

According to paragraph 4(b)(ii) of the Policy, another strong indication for the bad faith of the Respondent with regard to the registration of the domain name by the Respondent are circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain registration to the Complainant who is the owner of the trademark or to a competitor of the Complainant, for valuable consideration in excess of his documented out-of-pocket costs directly related to the domain name.

There is no evidence that the disputed domain name bears a relationship to any business or other activity of the Respondent. This indicates that the Respondent has registered the domain name primarily for the purpose of disrupting the business of the Complainant and therefore in a lack of good faith.

The Complainant refers to a statement in *Sony Kabushiki Kaisha v. Inja, Kil*, WIPO Case No. D2000-1409, namely 'It is inconceivable that the Respondent could make any active use of the disputed domain name without creating a false impression of association with the Complainant. The Respondent was not authorized by the Complainant to use its mark nor the disputed domain name'.

## B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

The Panel is satisfied that the Center took all steps reasonably necessary to notify the Respondent of the filing of the Complaint and commencement of this administrative proceeding.

According to paragraph 4(a) of the Policy, the Complainant must assert and prove each of the following:

- (i) that Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant contends that the public has come to associate the name BILD.T-ONLINE exclusively with the Complainant and that the Complainant has rights in the designation BILD.T-ONLINE. The Panel finds that the Complainant has failed to provide evidence that the public associates the name BILD.T-ONLINE exclusively with the Complainant and that it has rights in the designation BILD.T-ONLINE.

However, the Complainant has provided sufficient evidence of its rights to the marks T-ONLINE and T ONLINE.

In this case, the domain name <bild-t-online.info> contains not only the Complainant's trademark and service mark T-ONLINE but also the trademark and service mark BILD, which is held by a third party. A number of WIPO Panels have considered domain names that consist of a Complainant's trademark and a third party trademark and have concluded that such domain names are confusingly similar to either trademark, see e.g. *Chevron Corporation v. Young Wook Kim*, [WIPO Case No. D2001-1142](#) and *Pfizer, Inc. v. Martin Marketing*, [WIPO Case No. D2002-0793](#).

Further, in light of the fact that the Complainant's subsidiary and the third party trademark holder own a joint venture named Bild.T-Online.de AG & Co. KG, Internet users would presumably assume that the disputed domain name was authorized by the entities holding the trademarks and service marks T-ONLINE and BILD or by the joint venture.

The Panel finds that the disputed domain name is confusingly similar to the trademarks and service marks T-ONLINE and T ONLINE in which the Complainant has rights even if the disputed domain name also contains the third party mark BILD.

### B. Rights or Legitimate Interests

According to paragraph 4(c) of the Policy, a Respondent may demonstrate its rights to or legitimate interests in the domain name by proving any of the following circumstances:

(i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence before the Panel that any of the situations in paragraph 4(c) of the Policy apply in the case of the Respondent.

The Complainant contends that the Respondent is not, and never has been, a representative or licensee of the Complainant, nor is the Respondent authorized to use the Complainant's mark.

The Complainant has shown that the disputed domain name does not resolve to a website. The Complainant contends that the Respondent does not use the disputed domain name for a *bona fide* offering of goods or services and does not make a legitimate noncommercial or fair use of it.

Further, the Complainant has filed a letter of support from the holder of the trademark and service mark BILD, in which the third party trademark and service mark holder states that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has made a *prima facie* showing that Respondent has no rights to or legitimate interests in the disputed domain name.

A number of WIPO cases have established that, by virtue of paragraph 4(c) of the Policy, once a Complainant establishes a *prima facie* case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. See e.g. *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#), and *Six Continents Hotels, Inc. v. Seweryn Nowak*, [WIPO Case No. D2003-0022](#).

In this case, the Respondent has failed to file a Response and to meet that burden.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the domain name at issue.

### **C. Registered and used in Bad Faith**

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of a domain name:

(i) circumstances indicating that the respondent has registered or the respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

In addition to these criteria, other factors alone or in combination can support a finding of bad faith.

In the light of the Complainant's numerous trademark registrations for, and its wide reputation in, the mark T-ONLINE, it is most likely that the Respondent was aware of the Complainant's mark T-ONLINE when registering the disputed domain name. Further, it is obvious that the Respondent was aware of the joint venture Bild.T-Online.de AG & Co. KG, which is owned by the Complainant's subsidiary and the holder of the mark BILD, when registering the disputed domain name. It is most unlikely that the Respondent would have combined the marks BILD and T-ONLINE in a domain name without knowledge of the joint venture.

The knowledge of the marks at the time of registration of the domain name suggests bad faith, see e.g. *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#) and *Reuters Limited v. Global Net 2000, Inc.*, [WIPO Case No. D2000-0441](#). Accordingly, the Panel finds that the domain name was registered in bad faith.

It appears from the information available to this Panel that the Respondent engages in passive holding of the disputed domain name. The fact that a Respondent engages in passive holding of a domain name can in certain circumstances be evidence of use in bad faith. In *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#), the Panel concluded that "The question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."

In this case, the Respondent has not submitted a response to deny the contentions of the Complainant. The Respondent has registered a domain name that is a combination of the two widely known marks BILD and T-ONLINE. The Respondent was most likely aware of the joint venture named Bild.T-Online.de AG & Co. KG, which is owned by the Complainant's subsidiary and the holder of the mark BILD, when registering the disputed domain name. The Respondent has made no use of the disputed domain name and has submitted no evidence of any good faith use of the disputed domain name.

Further, before this administrative proceeding, the Complainant sent a "cease and desist" letter to the Respondent's contact details but received the letter in return with the notice "insufficient address", which indicates that the Respondent has provided incorrect contact details to the Registrar. The use of false contact details constitutes bad faith, see e.g. *Oxygen Media, LLC v. Primary Source*, [WIPO Case No. D2000-0362](#) and *Home Director, Inc. v. Home Director*, [WIPO Case No. D2000-0111](#).

In light of the above, the Panel finds that the domain name <bild-t-online.info> is being used in bad faith. Accordingly, the Panel finds that the Complainant has entirely satisfied its burden under paragraph 4(a)(iii) of

the Policy.

The Complainant has submitted a letter of support from the holder of the trademark and service mark BILD and the Panel therefore has no concern that a transfer of the disputed domain name to the Complainant would interfere with the rights of the third party trademark holder.

## **7. Decision**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <bild-t-online.info>, be transferred to the Complainant.

(Panelist)