



WIPO Arbitration and Mediation Center

MLP Finanzdienstleistungen AG v. WhoisGuard Protected

vom 1. September 2008

Case No. D2008-0987

1. The Parties

The Complainant is MLP Finanzdienstleistungen AG, Wiesloch, Germany, represented by Schalast & Partner Rechtsanwälte, Germany.

The Respondent is ?WhoisGuard Protected?, Westchester, California, United States of America.

2. The Domain Name and Registrar

The disputed domain name <mlpwatchblog.com> is registered with eNom

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the ?Center?) on June 30, 2008, naming ?Unknown? as the respondent. This is because the respondent? whois information has been anonymised using the service provided by Whoisguard.com.

On July 1, 2008, the Center transmitted by email to eNom a request for registrar verification in connection with the domain name at issue. Later that day eNom replied, notifying the Center that the domain name is registered with it and confirming:

- (a) the domain name had been placed on ?lock? pending resolution of the dispute;
- (b) WhoisGuard Protected is shown in its records as the registrant; and
- (c) the administrative, technical and billing contacts information provided in the whois search.

Accordingly, the Center requested the Complainant to amend its Complaint to identify WhoisGuard Protected as the respondent. On July 10, 2008, the Complainant submitted an amended Complaint to comply with this request and modifying the remedies sought from cancellation to a request for transfer to the Complainant of the domain name.

The Center verified that the amended Complaint (hereinafter, the Complaint) satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (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?).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 15, 2008. In accordance with the Rules, paragraph 5(a), the due date for Response was August 4, 2008. The Response was filed with the Center on July 23, 2008.

Between July 24, 2008 and July 27, 2008, the parties submitted various other communications to the Center. On August 1, 2008, the Complainant formally submitted a Supplemental Filing. A Supplemental Filing was received from, or purporting to be from, the Respondent on August 4, 2008.

By email dated 5 August 2008, the Respondent confirmed that it withdrew its request for determination by a three member panel and wished to proceed with a single member panel.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on August 17, 2008. 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 the Rules, paragraph 7.

4. Factual Background

The Complainant states that it is a supplier of financial services to academics and other discerning clients in Europe, particularly in Germany. The Response contests this to some extent. However, what appears to be in dispute is more the nature of the Complainant's activities rather than that the Complainant engages in commercial activity (of some description) in at least several countries in Europe including, in particular, Germany.

The Complainant has an international trademark registration with WIPO for "mlp", No. 736939, dating from March 28, 2000, which is based on a German registration dating from February 25, 2000. The Complainant also has registered Community Trademark No. 000905406 for "MLP". While the Complaint states that the CTM is registered from April 4, 2002, the copy of the Certificate of Registration submitted with the Complaint states that the trademark is registered from May 22, 2001. Both registrations claim a range of goods and services in classes 9, 35, 36, 41 and 42.

As noted above, the identity of the persons (communications purporting to be from the domain name registration are signed "mlpwatchbloggers") operating the website is not known. In a decision dated March 31, 2007, however, the Oberlandesgericht Hamburg issued injunctions against the operation of a similar site in the German language at <mlpblog.de> as a violation of the Complainant's personal rights.

The domain name was registered on June 10, 2007. It resolves to a website which is highly critical of the Complainant and officers and representatives of the Complainant.

5. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proof in respect of the following three elements:

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

Before dealing with each of these elements in turn, it is necessary to deal with a procedural matter.

The Complainant's Supplemental Filing contends that the Response is inadmissible because it comes from a third party (not the named Respondent) and does not comply with the formalities prescribed by paragraph 5(ii) of the Rules. The thrust of the objection is that the Response has obviously been submitted by someone other

than WhoisGuard.com Protected.

As noted above, the registration of the domain name has been anonymised using the services of Whoisguard.com.

The Center has served the Complaint on the contact details provided in the whois search and confirmed by eNom as correct. The Response does in fact address the Complaint and states that those who have submitted the Response are in fact the owners of the domain name. In addition, the text of the Response and other bulletins about the dispute have been posted on the website to which the domain name resolves in circumstances clearly indicating that the person or persons operating the website have prepared and adopt the Response.

In these circumstances, the Panel finds that, not only has the registrant of the domain name been given proper notice of the dispute, but also it is clear that the Response has been submitted by, or on behalf of, the people who have in fact registered the domain name.

The object of the rules prescribed by paragraph 5(ii) of the Rules is obviously partly to ensure that the person submitting the document is in fact the respondent or representing the respondent and partly to ensure that communications in the dispute are properly notified. The Response was submitted by email. Further communications to the email address submitting the Response have been responded to in a timely fashion. In the circumstances, the Panel finds that the requirements of paragraph 5(ii) of the Rules have been sufficiently complied with.

Accordingly, the Response is admitted.

The Panel also acknowledges that both Supplemental Filings will formally form part of the record in the dispute.

A. Identical or Confusingly Similar

There are two parts to this inquiry: does the Complainant have trademark rights in a mark and, if so, is the disputed domain name identical or confusingly similar to that mark?

The Complainant has proved ownership of the trademarks ?mlp? and ?MLP? referred to above. Thus the issue is whether or not the domain name is confusingly similar to those marks.

The Complainant contends that it is, relying on the cases holding that the addition of a descriptive term to a trademark can never be anything other than confusingly similar to the trademark. The Respondent contends that the term ?watchblog? is well known to signify a criticism or gripe site like the so-called ?-sucks? domain names. Anticipating this, the Complainant argues that the website is mainly directed to the public in Germany and most Germans will not appreciate this significance of the term. The Respondent claims that its website is in English and directed to the American public. The Complainant claims this is purely a pretext and points to the website?s tags which are in German. The Respondent claims this is to continue the tradition of the ?www.mlpblog.de? site. Perhaps on firmer ground, the Respondent identifies a significant number of popular ?watch? or gripe sites targeted to the German public, including eleven based on ?watchblog? such as ?www.googlewatchblog.de?.

The question whether such a domain name is confusingly similar to trademark rights has provoked a degree of controversy among Panels. As fairly summarized in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions at paragraph 1.3, the majority view is that:

A domain name consisting of a trademark and a negative term is confusingly similar to the complainant?s mark. Confusing similarity has been found because the domain name contains a trademark and a dictionary word; or because the disputed domain name is highly similar to the trademark; or because the domain name

may not be recognized as negative; or because the domain name may be viewed by non-fluent English language speakers, who may not recognize the negative connotations of the word that is attached to the trademark.

In contrast, the minority view is that:

A domain name consisting of a trademark and a negative term is not confusingly similar because Internet users are not likely to associate the trademark holder with a domain name consisting of the trademark and a negative term.

See also David Lindsay, *International Domain Name Law: ICANN and the UDRP*, (Hart Publishing, 2007), 262 ? 75.

Having regard to the prevalence of ?watch? or gripe sites identified by the Respondent (a number of which are based on or use the term ?watchblog?), one may have considerable sympathy for the Respondent?s contention that there will be no confusion as to source from the domain name at least amongst those, whether German, American or otherwise, who are regular or frequent browsers of the web.

That is not a complete answer, however. It does not take into account the potential for confusion amongst those who may be less familiar with the Internet. Also, it assumes that the only relevant confusion is confusion as to source. The concern underlying much of the majority view referred to in the WIPO Overview is that such domain names can be used precisely for the abusive or extortionate purposes the Policy was designed and intended to stop. Examples of such registrations can be found in *Standard Chartered PLC v. Purge I.T.*, WIPO Case No. D2000-0681 and *Wachovia Corporation v. Alton Flanders*, WIPO Case No. D2003-0596. In these types of cases, the domain name has been adopted precisely because of the association that will be made with the trademark and clearly for the purposes struck at by the Policy.

The comparison at this stage is between the proved trademark rights and the domain name, not how the domain name is being used but, as another panel has noted, it is necessary nonetheless to take into account the potential uses of the domain name: *Koninklijke Philips Electronics N.V. v. In Seo Kim*, WIPO Case No. D2001-1195. On that basis, it can be argued that it is the making of the association between the domain name and the trademark which is sufficient to supply the confusing similarity.

In this case, the disputed domain name consists of the trademark ? ?MLP? ? and the term ?watchblog?. Many people no doubt will recognize that term as signaling a ?watch? or ?gripe? site. It could plausibly identify, however, a website operated by the trademark owner.

In these circumstances, therefore, whether one were to apply the majority or the minority view, the Panel finds that the domain name is confusingly similar to the Complainant?s trademark rights.

B. Rights or Legitimate Interests

The second factor that the Complainant is required to establish is that the Respondent has no rights or legitimate interests in respect of the domain name.

Paragraph 4(c) sets out three non-exhaustive examples of rights or legitimate interests for the purposes of the Policy. They are:

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.?

In view of the difficulty in disproving a negative, the Complainant must adduce sufficient material to raise a prima facie case under this factor and then an evidential burden shifts to the Respondent to rebut that prima facie case. For convenience, the Panel refers only to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions paragraph 2.1.

It is common ground between the parties that the Respondent is not associated with the Complainant or authorised by it to use "MLP" in its domain name.

The content of the website to which the domain name resolves is highly critical of the Complainant and its activities. There is no suggestion by the Complainant, however, that the Respondent is engaging in its activities for commercial gain. It is not contended, for example, that the website offers products or services in competition to the Complainant.

The Complainant concedes that the Respondent may be free to comment publicly about the quality of the Complainant's services, but contends this gives the Respondent no right or legitimate interest in a domain name which is identical or confusingly similar to the Complainant's trademark, citing Bett Homes Limited and Bett Brothers plc v Bill McFadyen WIPO Case No. D2001-1018.

The approach taken in the cited case has often been applied. But it has not attracted universal acceptance, as the learned panel in Bett Homes acknowledged and as is reflected in the WIPO Overview at paragraph 2.4. As that paragraph suggests and perusal of the many cases confirms, it has not yet proved possible to reconcile the differing approaches taken by different panels.

Paragraph 2.4 of the WIPO Overview and many of the cases suggest that the resolution of this issue may depend on whether the panelist is American or the dispute concerns parties both located in the United States of America. That does not by any means explain all the cases.

Nor in this Panel's view is it an appropriate resolution under a Policy which operates internationally. In this context, it is important to recognize that paragraph 4(c)(iii) was incorporated in the Policy to implement the principle in all disputes under the Policy that:

"Domain name registrations that are justified by legitimate free speech rights or by legitimate non-commercial considerations would likewise not be considered to be abusive."

Many (but by no means all) of the cases denying that the registrant of a "gripe" site has rights or legitimate interests in a domain name concern a domain name which was identical or virtually identical to the complainant's trademark. Examples of this include Kirkland & Ellis LLP v. DefaultData.com, American Distribution Systems, Inc., WIPO Case No. D2004-0136; Triodos Bank NV v. Ashley Dobbs, WIPO Case No. D2002-0776.

An early panelist explained the rationale for this approach quite succinctly in Monty & Pat Roberts, Inc., v. J. Bartell, WIPO Case No. D2000-0300:

"[T]he right to express one's views is not the same as the right to use another's name to identify one's self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the New York Times or Time Magazine. That does not, however, translate into a right to identify one's self as the New York Times or Time Magazine."

Some panels have been willing to extend that principle to domain names which are confusingly similar, not just identical (indeed the Bartell case itself concerned the domain name <montyroberts.org>. The problem with such an approach particularly when put in the way invoked by the Complainant in this case, however, is

that it can have the effect of reading the "defence" provided by paragraph 4(c)(iii) out of the Policy. In this connection, this Panel agrees with the learned Panelist in *Standard Chartered PLC v. Purge I.T.*, WIPO Case No. D2000-0681 who said:

"Complaints sites are only likely to be set up against businesses with considerable reputations. Those who have genuine grievances against others or wish to express criticisms of them – whether the objections are against commercial or financial institutions, against governments, against charitable, sporting or cultural institutions, or whatever – must be at liberty, within the confines set by the laws of relevant jurisdictions, to express their views. If today they use a website or an email address for the purpose, they are entitled to select a Domain Name which leads others easily to them, if the name is still available."

The domain name in the present case is not identical to the Complainant's trademarks. While the Panel has been prepared to find it confusingly similar to the Complainant's trademarks, having regard to the objects of the Policy, it is nonetheless at the lower end of confusing similarity. See e.g. *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign* WIPO Case No. D2004-0206.

Many decisions (but once again by no means all) concern, or also concern, situations where the registrant's bona fides are plainly in doubt or lacking. *Standard Chartered PLC v. Purge I.T.* WIPO Case No. D2000-0681 and *Wachovia Corporation v. Alton Flanders* WIPO Case No. D2003-0596, already referred to, exemplify such situations. *Kirkland & Ellis LLP v. DefaultData.com*, *American Distribution Systems, Inc.*, WIPO Case No. D2004-0136 illustrates another kind.

There has been no suggestion in this case, however, that the Respondent is using the domain name for commercial ends.

Some panels have found paragraph 4(c)(iii) inapplicable because the criticism of the Complainant's goods or services, particularly if expressed intemperately, tarnishes the trademark. This does not seem to provide a sound discrimen, however, since the, or an, object of the criticism will often be to warn potential customers from dealing with the trademark owner just as the, or an, object of parody is to lampoon. If (as WIPO's Final Report appears to acknowledge) the Policy contemplates criticism of the trademark owner as a valid defence to some extent, characterising any effect of lost sales or negative opinion of potential customers as tarnishment would render paragraph 4(c)(iii) nugatory.

After preparing the draft of this decision, the decision in *Aspis Liv Försäkrings AB v. Neon Network, LLC*, WIPO Case No. D2008-0387 has come to the Panel's attention. The learned dissenting panelist in that case pointed out that the Staff Report underlying the adoption of the Policy specifically limited tarnishment "to acts done with intent to commercially gain".

The Complainant criticizes the Respondent's website as consisting of bare assertion unsubstantiated by supporting facts – the Complainant of course contends that the criticisms are false. Neither party has tendered evidence in support of their respective positions.

The Complainant (albeit under the third limb of the Policy) invokes the decision of the Oberlandesgericht Hamburg against <mlpblog.de> to demonstrate that the Respondent can have no rights to the domain name under German law. Assuming in the Complainant's favour that the Respondent is in fact the same person as the defendant in that case, however, there are a number of reasons why that decision does not assist the Complainant here. In fact, the Respondent expressly denies that it is located in Germany, claiming to be American or based in the United States of America. Nonetheless, the Policy operates in an international sphere and is not necessarily to be governed by the laws of one particular jurisdiction. Secondly, the Oberlandesgericht Hamburg was concerned with a different, albeit similar, domain name. Thirdly, the Respondent contends that the decision of the Oberlandsgericht Hamburg concerned a right of personality, not a trademark right. It is clear, however, that the Policy is limited to abusive registrations in violation of trademark rights and is not directed to rights of personality.²

In all of the circumstances, therefore, the Panel finds that the Respondent has demonstrated rights or legitimate interests in the domain name.

C. Registered and Used in Bad Faith

In view of the conclusion under the second limb of the Policy, it is not necessary to address this limb. Given the nature and use of the domain name evidenced in this record, however, the Panel would have found that the domain name had not been registered and is not being used in bad faith.

The Panel can readily accept that the Complainant must find the content of the Respondent's website galling, particularly as the Complainant contends that the allegations are untrue. Correspondingly, the Respondent appears to have very strong views about the Complainant. This Panel is not in a position on the record in this proceeding and, in any event, these proceedings are not a suitable vehicle to resolve the rights and wrongs of the parties' grievances with each other about these matters. Proceedings under the Policy are concerned with abusive registration and use of domain names as defined under the Policy, leaving other disputes to be resolved in venues more suited to investigating the evidence and issues.

7. Decision

For all the foregoing reasons, the Complaint is denied.