

Case C-569/08

Internetportal und Marketing GmbH

v

Richard Schlicht

(Reference for a preliminary
ruling from the Oberster Gerichtshof)

(Internet — .eu Top Level Domain — Regulation (EC) No 874/2004 — Domain
names — Phased registration — Special characters — Speculative and abusive
registrations — Concept of “bad faith”)

Opinion of Advocate General Trstenjak delivered on 10 February 2010 I - 4875

Judgment of the Court (Second Chamber), 3 June 2010 I - 4908

Summary of the Judgment

1. *European Union law — Interpretation — Texts in several languages — Uniform interpretation*
(Commission Regulation No 874/2004, Art. 21(3)(a) to (e))
2. *Trans-European networks — Telecommunications sector — Internet — Implementation and functions of a top level domain — Speculative or abusive registrations*
(Commission Regulation No 874/2004, Art. 21(1)(b) and (3))

1. Article 21(3) of Regulation No 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration must be interpreted as meaning that bad faith can be established by circumstances other than those listed in Article 21(3)(a) to (e) of that regulation.
2. In order to assess whether there is conduct in bad faith within the meaning of Article 21(1)(b) of Regulation No 874/2004, read in conjunction with Article 21(3) thereof, the national court must take into consideration all the relevant factors specific to the particular case and, in particular, the conditions in which registration of the trade mark was obtained and those in which the .eu top level domain name was registered.

The necessity of uniform application and, accordingly, of uniform interpretation makes it impossible to consider one version of the text in isolation but requires it to be interpreted on the basis of both the real intention of its author and the aim he seeks to achieve, in the light in particular of the versions in all languages.

The objective of frustrating the registration of speculative or abusive domain names, which, by their very nature, may be marked by a variety of circumstances of fact and law, would be compromised if bad faith, within the meaning of Article 21(1)(b) of Regulation No 874/2004, could be established only in the circumstances exhaustively set out in Article 21(3)(a) to (e).

(see paras 35, 37, 39, operative part 1)

With regard to the conditions in which registration of the trade mark was obtained, the national court must take into consideration, in particular:

- the intention not to use the trade mark in the market for which protection was sought;
- the presentation of the trade mark;
- the fact of having registered a large number of other trade marks corresponding to generic terms; and
- the fact of having registered the trade mark shortly before the beginning of phased registration of .eu top level domain names.

With regard to the conditions in which the .eu top level domain name was registered, the national court must take into consideration, in particular:

- the abusive use of special characters or punctuation marks, within the meaning of Article 11 of Regulation No 874/2004, for the purposes of applying the transcription rules laid down in that article;

- registration during the first part of the phased registration provided for in that regulation on the basis of a mark acquired in circumstances such as those in the main proceedings; and

- the fact of having applied for registration of a large number of domain names corresponding to generic terms.

There is nothing in the wording of the second paragraph of Article 11 of Regulation No 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration to suggest any form of

hierarchy as between the three transcription rules. It follows from Article 10(2) of Regulation No 874/2004 that the registration of a .eu top level domain name on the basis of a prior right consists of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists. However, since certain special characters which may appear in a name in respect of which a prior right is held cannot appear in a domain name by reason of technical constraints, the legislature has laid down transcription rules for such special characters in the second paragraph of Article 11 of Regulation No 874/2004.

It thus follows from a joint reading of Articles 10(2) and 11 of Regulation No 874/2004 that application of the transcription rules set out in the second paragraph of Article 11 is subordinate to the objective of ensuring that the domain name which it is sought to register and the name in respect of which a prior right is invoked are identical or as close as possible to each other.

Both the presence of special characters in the name in respect of which a prior right is invoked and an applicant's choice in regard to the three rules for the transcription of such characters laid down in the second paragraph of Article 11 of that regulation, namely: elimination, replacement by a hyphen or rewriting, may thus point to the existence of conduct in bad faith within the meaning of Article 21(1)(b) of that regulation, particularly in

the case where the domain name which it is sought to register does not concord with the name in respect of which a prior right is invoked.

By contrast, no relevance attaches to the fact that the proprietor under national or European Union law was unaware of the applicant at the time of registration of the domain name. Since the existence of prior rights in respect of a name corresponding to a generic term cannot therefore be excluded, conduct which is manifestly intended to circumvent the procedure for phased registration established by

Regulation No 874/2004 could adversely affect holders of such rights. In addition, the adoption of a course of conduct of that kind is tantamount to seeking to obtain an unfair advantage to the detriment of any other person interested in the same domain name who cannot rely on a prior right and must therefore await the general opening of registration for .eu top level domain names in order to be able to apply for registration.

(see paras 57, 60-63, 72, 75-77, operative part 2)