

ADMINISTRATIVE PANEL DECISION

Dagbladet Børsen A/S v. Laurent Mermet
Case No. D2016-1814

1. The Parties

The Complainant is Dagbladet Børsen A/S of Copenhagen, Denmark, represented by Plesner Law Firm, Denmark.

The Respondent is Laurent Mermet of Miami, Florida, United States of America, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <børsen.com> ("Disputed Domain Name") is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 7, 2016. On September 7, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 7, 2016, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint [together with the amendment to the Complaint/amended Complaint] satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 14, 2016. In accordance with the Rules, paragraph 5, the due date for filing the Response was October 4, 2016. The Respondent submitted a first request for a four calendar day extension for response under paragraph 5(b) of the Rules on September 28, 2016, which was granted by the Center on September 29, 2016, and a second request for extension on October 8, 2016, which was granted by the Center on October 10, 2016. The new deadline for filing the Response was October 12, 2016. The Response was filed with the Center on October 12, 2016.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on October 24, 2016. 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 was founded in 1896 in Denmark. In 1899 it began operating a Danish newspaper with a focus on business and stock exchange content. The Complainant has been conducting its business under the BØRSEN trade mark, and holds registered rights in the BØRSEN trade mark in the EU and Denmark.

The Respondent acquired the Disputed Domain Name in July 2013. The Disputed Domain Name resolves to a parking page.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows:

- (a) The Complainant has been using the BØRSEN trade mark in relation to its newspaper. "Børsen" means stock exchange in Danish. The Complainant's newspaper provides content on the stock market and the financial market. The Complainant owns EU and Danish trade mark registrations for the BØRSEN trade mark (applied for on September 21, 2015 and August 16, 1982, respectively).
- (b) The Disputed Domain Name is identical to the Complainant's BØRSEN trade mark.
- (c) The Respondent has no rights or legitimate interests in the Disputed Domain Name. There is no evidence that the Respondent is commonly known by the Disputed Domain Name, and the Respondent is not a licensee of or otherwise affiliated with the Complainant. The Disputed Domain Name resolves to a parking page that provides links to various websites relating to the stock market, including links to the Complainant's website and other newspapers or magazine. The Respondent's use of the Disputed Domain Name for a parking site does not amount to a legitimate interest, as the Disputed Domain Name incorporates the Complainant's trade mark.
- (d) The Respondent chose to register the Disputed Domain Name for the purpose of confusing users into believing that it is associated with the Complainant, and redirecting traffic to the Respondent's parking page in order to obtain pay-per-click revenue, which amounts to bad faith registration and use. The Respondent has also registered and is using the Disputed Domain Name in bad faith for the purposes of selling it to the Complainant in excess of its out-of-pocket expenses directly related to the Disputed Domain Name (as the parking page states that the Disputed Domain Name is for sale).

B. Respondent

The Respondent's contentions can be summarised as follows:

- (a) As admitted by the Complainant in its Complaint, the word "børsen" is a generic Danish word meaning "exchange" or "stock exchange".
- (b) The Respondent is in the business of registering and acquiring domain names that reflect generic words in different languages. The Respondent owns a large portfolio of domain names that solely contain generic or descriptive words in a foreign language.

- (c) The Respondent acquired the Disputed Domain Name based on its generic meaning. The Respondent acquired the Disputed Domain Name in July 2013 and had been using it in relation to pay-per-click advertisements in relation to its generic meaning of “exchange” and “stock exchange”. Trading in generic or descriptive domain names can constitute a legitimate interest and right.
- (d) There was only one link to the Complainant’s website on the parking page to which the Disputed Domain Name resolved, which was automatically generated by the advertising algorithm that presents ads based on the generic term. Such reference only first appeared on the parking page three and a half years after the Respondent acquired the Disputed Domain Name.
- (e) There is no evidence that the Respondent registered the Disputed Domain Name in bad faith, *i.e.*, for the purpose of targeting the Complainant. The Respondent’s registration and use of the Disputed Domain Name as a parking page in connection with its generic meaning was in good faith.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

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

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the BØRSEN trade mark, based on its EU and Danish trade mark registrations (the earliest of which was filed in 1982).

The Disputed Domain Name incorporates the Complainant’s BØRSEN trade mark in its entirety. It is a well-established rule that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the generic Top-Level Domain (“gTLD”), in this case “.com”, may be disregarded (see *Rohde & Schwarz GmbH & Co. KG v. Pertshire Marketing, Ltd*, WIPO Case No. D2006-0762).

Accordingly, the Panel finds paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) states that once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel accepts that the Complainant has not authorised the Respondent to use the BØRSEN trade mark, and there is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the BØRSEN trade mark. Accordingly, the Panel is of the view that a *prima facie* case has been established and it is for the Respondent to prove it has rights or legitimate interests in the Disputed Domain Name.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name was in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if it has acquired no trade mark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Disputed Domain Name currently resolves to a parking page which contains links. Pursuant to paragraph 2.6 of the WIPO Overview 2.0, use of a domain name to post parking pages or pay-per-click links "may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a '*bona fide* offering of goods or services'...or from 'legitimate noncommercial or fair use' of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder." A common example of where use of a domain name to resolve to a parking page may amount to a right or legitimate interest, is where the pay-per-click links genuinely relate to the generic meaning of the domain name and the respondent had no intention of targeting the complainant (see *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424).

The Panel accepts that the word "børsen" is a generic Danish word meaning "exchange" or "stock exchange" in English. The Complainant even acknowledged in its Complaint that its BØRSEN trade mark means "exchange" or "stock exchange". The Disputed Domain Name resolves to a parking page which contains pay-per-click links related to its generic meaning (*i.e.*, links relating to stock exchanges). Even though some of the pay-per-click links refer to newspapers (including the Complainant's website and potential competitors of the Complainant), such newspapers provide content and information regarding stock exchanges and reflect the generic meaning of "børsen". The Panel is of the view that the Respondent likely registered the Disputed Domain Name due to the generic meaning of "børsen", and without specifically targeting the Complainant or its BØRSEN trade mark. This is based on the fact that the Complainant has failed to provide any evidence, regarding its fame and well-known status outside of Denmark, and the Respondent appears to have no ties to Denmark and insufficient evidence has been adduced by the Complainant to suggest that the Respondent had knowledge of the Complainant's mark and its activities in Denmark when it registered the Disputed Domain Name.

The Respondent appears to regularly register domain names that include generic words in foreign languages for the purpose of using them in relation to pay-per-click advertising. Such business activities can be legitimate and are not in themselves a breach of the Policy, so long as they do not encroach on a third party's trade mark rights.

The Panel notes that whilst the Respondent has provided an extensive list of domain names allegedly owned by the Respondent, which correspond to generic words in various foreign languages, no evidence has been provided to establish that the Respondent is the registered owner of such domain names. Therefore, the Panel found it necessary to exercise its powers under paragraph 10(a) of the Rules to determine whether or not the Respondent is the registered owner of at least some of these domain names. Based on a "Whols" search conducted by the Panel on a few of the domain names claimed to be owned by the Respondent, the Panel found that many of them are held under a proxy service provider (*e.g.*, Super Privacy Service, Dynadot), and therefore the Panel could not verify whether the Respondent was the underlying owner of them. However, the Panel's "Whols" search did reveal several domain names that are held in the name of the Respondent. As such, the Panel accepts that the Respondent is in the business of registering domain names that reflect generic words, rather than specifically targeting third party trade marks. For example, according to the Panel's Whols search, the domain names <savegarde.com> (meaning "backup" in French), <télécharge.com> (meaning "downloaded" in French), <água.com> (meaning "water" in Portuguese), <negócios.com> (meaning "business" in Portuguese), <huis.net> (meaning "house" in Dutch), <тариф.com> (meaning "rate" in Cyrillic), are owned by the Respondent.

Taking all of the above into account, the Panel concludes that the Respondent is using the Disputed Domain Name in a descriptive manner, rather than in order to target the Complainant's BØRSEN trade mark. Such use can confer rights and legitimate interests on the Respondent in the Disputed Domain Name.

The Panel finds that the Complainant has failed to satisfy paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As the Complainant has failed to satisfy paragraph 4(a)(ii) of the Policy, the Panel does not need to consider whether the requirements of paragraph 4(a)(iii) are met.

7. Decision

For the foregoing reasons, the Complaint is denied.

Gabriela Kennedy

Sole Panelist

Date: November 7, 2016