

Decision for dispute CAC-UDRP-105411

Case number	CAC-UDRP-105411
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Time of filing	2023-05-03 10:22:41
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Domain names	Deutsche-Boerse.co
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Deutsche Börse AG
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Complainant representative

Organization	Grünecker Patent und Rechtsanwälte PartG mbB
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Respondent

Name	Marcus Aurelius
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of multiple trademark registrations in various jurisdictions, in particular (among others):

- International trademark registration No. 917734 "DEUTSCHE BÖRSE GROUP" (&device) with a priority of 18 August 2006 for international classes 9, 16, 35, 36, 41, 42, 45 with protection for CH, RU (However, this Panel finds that in provided excerpt related to the trademark registration No. 917734, a filing date of the trademark application is 15 February 2007 and there is no indication of protection area "CH, RU". If the Panel did not click on the link in this list, he would not have learnt further details regarding this trademark because in the list, only limited amount of information is apparent, especially trademark applicant, application No., application date, reproduction of the mark and classes.);
- German trademark registration No. 30648274 "DEUTSCHE BÖRSE" with a priority of 4 August 2006 for international classes 9, 16, 35, 36, 38, 41, 42, 45;
- German trademark registration No. 39404080 "Deutsche Börse" with a priority of 29 November 1994 for international classes 9, 16, 35, 36, 42 (however, this Panel finds that the correct number of this trademark registration is No. 394040805);
- EUTM No. 5276738 "DEUTSCHE BÖRSE" (&device) with a priority of 4 August 2006 for international classes 9, 16, 35, 36, 38, 41, 42;
- EUTM No. 000886481 "DEUTSCHE BÖRSE" with a priority of 24 July 1998 for international classes 9, 16, 35, 36, 42.

The Complainant proved its ownership of the aforementioned trademark registrations by the submitted excerpts and listings from the pertinent trademark registers and databases. With regard to international registrations, a more detailed excerpt should have been provided.

FACTUAL BACKGROUND

The Complainant owns company name rights for Deutsche Börse AG since 1992, which is regularly abbreviated as Deutsche Börse (excerpt from the Commercial Register).

The Complainant's authentic website is available at <https://www.deutsche-boerse.com/>.

According to the Registrar, the Respondent is 'Marcus Aurelius'. The Respondent's provided address as being at Berlin, Germany. The Respondent registered the disputed domain name <Deutsche-Boerse.co> on April 6, 2023 (hereinafter "disputed domain name").

PARTIES CONTENTIONS

COMPLAINANT:

1. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant states that the disputed domain name is confusingly similar to the Complainant's trademarks containing the wording "DEUTSCHE BÖRSE" because the disputed domain name includes it in its entirety.

The Complainant asserts that the disputed domain name <Deutsche-Boerse.co> contains the Complainant's mark, with the exception of the "Umlaut" "ö" that is transcribed as "oe". The common way to spell words with umlauts is to replace the "ö" by "oe" or simply replace it with an "o". Both ways to spell the letter are common and widely used and consequently, the transcription of the German "ö" in "oe" or "o" is irrelevant and does not avoid a finding of confusing similarity between the signs (See CAC Case No. 102877).

1. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant contends that the disputed domain name was created on April 6, 2023 without authorization by the Complainant. The disputed domain name is not connected to an active website, but is according to information received by the Complainant used by the Respondent for sending e-mails using the e-mail address "boerse-frankfurt@deutsche-boerse.co". The sender pretends in the e-mail to be an employee of the Complainant and requests the recipient to transfer funds.

The Complainant adds that the Respondent has never been authorized or otherwise been licensed or permitted by the Complainant to use any of its trademarks. The Respondent is also not affiliated in any way with the Complainant. The Respondent is not only using the trademark "Deutsche Börse" for the disputed domain name and "Boerse Frankfurt" for the email address but also alleges to be actually employed by the Complainant, to induce deceived users to transfer their funds.

As has already been established by previous panels, such use of the disputed domain names cannot amount to a bona fide offering of goods and services and cannot confer to the Respondents any rights or legitimate interests in the disputed domain names (See section 2.5.1. of the WIPO Jurisprudential Overview 3.0). Moreover, at least some of the disputed domain names have been used in connection with fraudulent activities (See below) and this use can never confer rights or legitimate interests to the Respondent (See section 2.13. of the WIPO Jurisprudential Overview 3.0). Moreover, already the mere fact of having registered a domain name that includes the Complainant's well-known trademarks, as such, is misleading the Internet users as to the origin of these domain names and cannot confer to the Respondent right or legitimate interests (See CAC Case No. 104278).

1. The Complainant contends that the domain name has been registered and is being used in bad faith.

The Complainant adds that the disputed domain name was registered on April 6, 2023. On April 21, the Respondent allegedly "Marcus Aurelius", used the domain name to impersonate the Complainant in an email to a third party to request the "Transfer amount of 154,440.00 USD to your Binance account."

Therefore, the Respondent "solely registered the disputed domain name for fraudulent purposes." (See WIPO Case No. DCO2017-0021; WIPO Case No. D2018-2442).

The Complainant asserts that the use of a confusingly similar, deceptive domain name for an e-mail scam has previously been found by panels to be sufficient to establish that a domain name has been registered and is being used in bad faith (See CAC Case No. 104229; WIPO Case No. D2010-1367; WIPO Case No. D2013-0117). Moreover, in finding a domain name used only for an e-mail scam was bad faith, the panel in WIPO Case No. D2016-0387 pointed out that numerous UDRP panels have found such impersonation to constitute bad faith, even if the relevant domain names are used only for email. See, e.g., WIPO Case No. D2014-1742 ("Respondent was using the disputed domain name in conjunction with [...] an email address for sending scam invitations of employment with Complainant"); and WIPO Case No. D2011-0128 ("although the disputed domain names have not been used in connection with active

websites, they have been used in email addresses to send scam emails and to solicit a reply to an 'online location'").

Finally, the Complainant asserts, that the Whois data for the Respondent "*Marcus Aurelius*" is fake. The address provided Friedrichstrasse 103 refers to the hotel Melia in Berlin (<https://www.melia.com/de/hotels/deutschland/berlin/melia-berlin>), even assuming this might be adequate for a Roman emperor, the phone number "+49 546 984564" contains the area code "0546 " for "Bramsche Hase" and not the area code for Berlin (030).

RESPONDENT:

No administratively Complaint Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the UDRP).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

Columbia has adopted the UDRP for .co ccTLD. Therefore, this Policy is applicable in this case.

PRINCIPAL REASONS FOR THE DECISION

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "DEUTSCHE BÖRSE".

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the Panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the Panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose

of determining whether it is identical or confusingly similar”.

In the CAC Case No. 104278, Grünecker Patent und Rechtsanwälte PartG mbB v. multiple respondents, the Panel stated that: “The Panel agrees with the Complainant that all the disputed domain names are confusingly similar to the Complainant’s trademarks. In particular, the disputed domain names contain the trademark EUREX, or the trademark BÖRSE FRANKFURT, where the letter “Ö” has been replaced by the letters “oe”, which is the letter combination usually adopted to replace the o-Umlaut.”

The Complainant has established that owns numerous trademark registrations containing verbal elements “DEUTSCHE BÖRSE”, in various jurisdictions protecting goods and services in connection with online financial products (evidenced by excerpts and listings from the pertinent trademark registers and databases).

The Complainant’s trademark “DEUTSCHE BÖRSE” is incorporated in its entirety and clearly recognizable in the disputed domain name <Deutsche-Boerse.co>. Part of the Complainant’s trademark “BÖRSE” is transcribed as “boerse”. The “umlaut” diacritical mark used here for “ö” is replaced with the letters “oe”, which is common and widely used in transcription. Therefore, this transcription does not change the overall impression of the disputed domain name.

The addition of the gTLD <.co> does not change the overall impression of the disputed domain name either.

The disputed domain name <Deutsche-Boerse.co>, as it reproduces the “DEUTSCHE BÖRSE” trademark in its entirety, is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

1. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

The WIPO Overview 3.0 in Paragraph 2.5.1. states that: “[...] Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [...]”

The WIPO Overview 3.0 in Paragraph 2.13.1 states that: “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are “replicas” or “reproductions” or indeed the use of such term in the domain name itself.”

In the present case, the Complainant claims that the Respondent has never been authorized or otherwise been licensed or permitted by the Complainant to use any of Its trademarks. The Respondent is also not affiliated in any way with the Complainant.

Furthermore, the Complainant contends that the Respondent is not only using the trademark “DEUTSCHE BÖRSE” for the disputed domain name and “BOERSE FRANKFURT” for the e-mail address but also alleges to be actually employed by the Complainant, to induce deceived users to transfer their funds. This Complainant’s statement is evidenced by e-mail message, which proves that the Respondent is using the disputed domain name for sending e-mails from boerse-frankfurt@deutsche-boerse.co address. The sender “James Klosterman” in the e-mail requests recipients to transfer funds and pretends to be the Complainant’s employee. It can be presumed that this e-mail is used for illegal activity. Since it was sent under the disputed domain name, it cannot confer rights or legitimate interests on the Respondent.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the UDRP.

1. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the WIPO Case No. DCO2017-0021, L'Oréal v. Cimpress Schweiz GmbH, the Panel stated: "From the above it is apparent to the Panel that the Respondent was not only familiar with the Complainant's trademarks, but also its company, when registering the disputed domain name. It can be inferred that the Respondent solely registered the disputed domain name for fraudulent purposes. It is established case law that the use of a disputed domain name for the purpose of defrauding Internet users by the operation of a 'phishing scheme' is perhaps the clearest evidence of registration and use of a domain name in bad faith (see *OLX, Inc. v. J D Mason Singh*, [WIPO Case No. D2014-1037](#) and *The Royal Bank of Scotland Group plc v. Secret Registration Customer ID 232883 / Lauren Terrado*, [WIPO Case No. D2012-2093](#))."

In the WIPO Case No. D2016-0387, Kramer Law Firm, P.A. Attorneys and Counselors at Law v. BOA Online, Mark Heuvel, the Panel stated: „In this case, Complainant appears to argue that bad faith exists pursuant to paragraph 4(b)(iv), given that the Disputed domain names have been used in connection with what Complainant has described as a scam 'to improperly and illegally solicit money from unsuspecting people located in the UK' – something that Respondent has not denied. While this scam is not, as Complainant has noted, a "typical" case of phishing, it is nevertheless clearly a way in which 'Internet fraudsters impersonate a business' – something that the U.S. Federal Trade Commission associates with phishing activities.² Numerous UDRP panels have found such impersonation to constitute bad faith, even if the relevant domain names are used only for email. See, e.g., *Terex Corporation v. Williams Sid, Partners Associate*, [WIPO Case No. D2014-1742](#) ('Respondent was using the disputed domain name in conjunction with [...] an email address for sending scam invitations of employment with Complainant'); and *Olayan Investments Company v. Anthono Maka, Alahaji, Koko, Direct investment future company, ofer bahar*, [WIPO Case No. D2011-0128](#) ('although the disputed domain names have not been used in connection with active web)sites, they have been used in email addresses to send scam emails and to solicit a reply to an 'online location')."

In the present case, The Complainant has established that owns numerous trademark registrations in various jurisdictions for "DEUTSCHE BÖRSE", protected for the classes in connection with online financial products. Past panels have decided that the Complainant's mark "DEUTSCHE BÖRSE" is well-known and has distinctive nature (See the CAC Case No. 104278). Furthermore, the Complainant already proved that he owns company name rights in Germany for Deutsche Börse AG since 1992, which is regularly abbreviated as Deutsche Börse.

Therefore, this Panel states that the Respondent (whose provided address is in Berlin, Germany) must have been aware of the Complainant's trademark and its reputation before the registration of the disputed domain name on April 6, 2023.

As mentioned above, the Respondent used the disputed domain name to impersonate the Complainant in an e-mail to a third party requesting financial transactions (evidenced by the e-mail message). This Panel agrees with the Complainant concerning the registration of the disputed domain name solely for the purpose of cyber fraud via e-mail. Past panels found that such use of the disputed domain name is considered bad faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **Deutsche-Boerse.co**: Transferred

PANELLISTS

Name	Radim Charvát
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DATE OF PANEL DECISION	2023-06-13
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Publish the Decision