

Kluwer Trademark Blog

Top Level Judges on Top Level Domains

Kai Schmidt-Hern (Lubberger Lehment) · Wednesday, June 22nd, 2016

Weapon of Choice: Protection of Names under Civil Law

Before German courts, the best weapon against bothersome domain name registrations is not trademark law, but civil law. [Sec. 12 of the German Civil Code \(BGB\)](#) states quite broadly that the bearer of a name can keep others from using that name if such use compromised the bearer's interests. Sec. 12 applies to personal names and company names. The BGH (*Bundesgerichtshof* = German Federal Supreme Court) has held in a number of cases, that a person or a company has a legitimate interest, protected by Sec. 12 BGB, in using their name as a domain name. If a third party registers such a name as a domain name, the mere fact that the bearer of the name is barred from registering it could constitute a violation of Sec. 12 BGB. In the case of a violation, the bearer of the name can request the third party to cancel the domain name registration.

Trademarks No Good in the Absence of Goods (or Services)

Trademark law does not deliver in such cases. Trademark infringement can only occur when a mark is used for its protected goods and services. Merely registering a name as a domain name, however, does not constitute trademark use, i.e. one for goods or services. And even if there is a trademark use, because the website under the domain name deals commercially with the protected goods or services, the trademark owner cannot request the other party to cancel the domain name registration, but only to cease use with regard to the protected goods or services.

“Profitbricks” Case

In the recent “Profitbricks” case, the BGH confirmed its jurisprudence. At the same time, it has drawn its limits:

Profitbricks GmbH owns domain name registrations for profitbricks.de and profitbricks.com. The German defendant registered profitbricks.us, .es, .org as well as profitbrick.de and profitbrick.com. Profitbricks GmbH sued for having these registrations cancelled and disconnected, relying on Sec. 12 BGB. With regard to the .es and .us domains, the plaintiff argued that it had a subsidiary in the US and that Spain was an important market.

The Court of Appeals, relying on the BGH's jurisprudence, granted the plaintiff's motions. The plaintiff had a legitimate interest in disseminating content under the TLDs .us and .es, which were commonly used in Spain and the US. The plaintiff also had a legitimate interest in being found under profitbrick.de and profitbrick.com, because internet users were likely to omit the “s”

inadvertently.

With a judgement of 28 April 2016, the BGH remitted the matter to the Court of Appeals. The BGH affirmed its jurisprudence whereby the plaintiff needed to show under Sec. 12 BGB (i) use of its name, (ii) confusion, (iii) impairment of plaintiff's interests. The BGH was satisfied with (i) and (ii), but found insufficient evidence of an impairment of plaintiff's interests. Such an impairment could be assumed if a company established in Germany was barred from using the .de-TLD. However, no such assumption was justified regarding the use of foreign TLDs like .es and .us. The plaintiff needed to – and failed to – show its activities in the US and in Spain and why these activities would necessitate a website under the .es and .us TLDs. Further, the plaintiff failed to provide any evidence of an impairment of its interests regarding the .org domain, for which there was no assumption either. Finally, the plaintiff did not have a legitimate interest to register misspellings like profitbrick.de and .com, because the plaintiff owned the correctly spelled domains [profitbricks.de](https://www.profitbricks.de) and .com. With ICANN's TLD frenzy being in full swing, the restrictive stance by BGH is not exactly good news for name owners.

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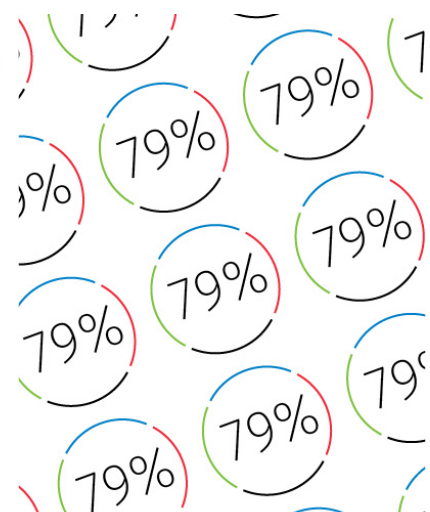
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