

ADMINISTRATIVE PANEL DECISION

RTL Group Markenverwaltungs GmbH v. Privacy Service Provided by Withheld for Privacy ehf / Name Redacted
Case No. D2022-0603

1. The Parties

The Complainant is RTL Group Markenverwaltungs GmbH, Germany, represented by BPM Legal, Germany.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <rtl.sbs> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2022. On February 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on March 2, 2022, providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 7, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for

¹ The Respondent has expressed privacy-related concerns. Accordingly, the Panel has decided to redact the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision instructions to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar, and has indicated Annex 1 to this decision shall not be published. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 March 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 29, 2022. Subsequently, the Respondent sent the Center three informal communications, on March 29, 2022, March 30, 2022, and April 1, 2022, respectively.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on April 4, 2022. 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.

The Complainant and the Respondent each sent additional communications to the Center, received on April 12, 2022, as discussed further below.

4. Factual Background

The Complainant is a private limited company established under German law and headquartered in Köln, Germany. It is the intellectual property holding company of the RTL media group based in Luxembourg, one of the leading European media companies dating from the 1920s with equity interests in 68 television channels, 10 digital streaming platforms, several global production companies, and a digital video network. The parent corporation is listed on the Frankfurt stock exchange. In fiscal year 2019, the group generated revenues of about EUR 6.7 billion.

The group has been known since 1954 as RTL (an acronym for Radio Télévision Luxembourg). It operates several websites with domain names based on the RTL name and mark, including <rtl.com>, <rtl.nl>, and <rtl.de>. Relevant RTL trademark registrations include the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
RTL	International Trademark (multiple jurisdictions including Benelux)	427678	January 11, 1977
RTL	International Trademark (multiple jurisdictions including Benelux)	592174	September 17, 1992
RTL	European Union Trademark	000108878	April 21, 1998

According to the Whois database, the Domain Name was created on January 20, 2022, in the “.sbs” top-level domain (“TLD”), a new TLD launched in mid-2021. According to its Registry, the TLD stands for “side by side” and is “perfect for philanthropic initiatives” but is an open registry for any lawful purpose.

The name of the registrant was withheld for privacy, but after receiving notice of this proceeding, the Registrar provided details that identified the Respondent (see footnote 1).

The Complaint attaches a screenshot showing that on February 17, 2022, the Domain Name redirected to a Dutch website, “www.mediacourant.nl”, which publishes news and commentary about Dutch television and entertainment. This site includes posts about the Complainant and its competitors and their respective programming, shows, stars, and writers. The site does not require subscriptions, nor does it appear to carry advertising or sponsored articles. According to the Dutch Wikipedia page about the Mediacourant website, the website has been operating as a somewhat sensationalist entertainment news site since 2004, with articles written by the editor or contributing authors (typically under pseudonyms) and enlivened by photos and fan polls.

The Respondent submitted information showing that the Complainant filed a Uniform Rapid Suspension (URS) claim on February 21, 2022, seeking temporary suspension of the Domain Name registration. The Examiner denied that claim on March 8, 2022, finding that the evidence presented as to the strength of the Complainant's Mark is insufficient to inescapably lead to the conclusion that Respondent targeted Complainant and the Mark, especially given Respondent's assertion (which is not itself obviously false) as to his good faith intent in registering the Disputed Domain Name.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is identical to its well-known RTL mark, which the Respondent is not licensed to use and in which it has no evident rights or legitimate interests.

The Complainant argues that the Respondent acted in bad faith by registering a domain name based on a "high-profile" mark and using it to redirect Internet traffic to "a commercial third party website", "in all likelihood, trying to divert traffic intended for the Complainant's website to its own for the purpose of earning revenues from Internet users searching for the Complainant's website." The Complainant adds that the "Respondent's registration of the disputed domain name also clearly prevents the Complainant from reflecting its trademarks in a corresponding domain name" and "disrupts the Complainant's business".

B. Respondent

The Respondent never submitted a substantive Response with a certification of completeness and accuracy as required by the Rules, paragraph 5(c)(viii). The Panel takes this into account in weighing the credibility of the Respondent's assertions and arguments in its emails to the Center after notification of default.

In its emails to the Center, the Respondent, which is not represented by counsel, appeared to be confused by the parallel URS and UDRP proceedings initiated by the Complainant. The Respondent objected that the URS Examiner had "closed" the case with the dismissal of the URS claim and seemed to be under the impression that the Center had access to whatever material the Respondent had submitted in the URS proceeding. Despite further explanation from the Center, the Respondent did not furnish information or substantive arguments on the template Response.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

- (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.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

6.1 Supplemental Filings

The Center received additional communications from the Complainant and the Respondent on April 12, 2022. Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the panel to conduct the proceeding “with due expedition”. Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. See [WIPO Overview 3.0](#), section 4.6.

The Respondent’s communication relates to concerns about the Complaint intruding on his privacy. It also details his registration and use of several other domain names for personal purposes involving “domain hacks” –meaningful combinations of the domain name string with the top-level domain name or “TLD”. The Respondent also comments on the rejection of the Complainant’s URS claim and states that if the Complainant had not blocked the Domain Name, the Respondent could have proceeded to build the corresponding website.

The Complainant’s reply communication points out that the UDRP and URS procedures are distinct and that the URS procedure, which concerns only a temporary suspension of registration, operates under different standards and briefing limits. The Complainant concedes that the Respondent may have registered and used other domain names for legitimate personal purposes but disputes the relevance of this fact for the Domain Name at issue.

The Panel does not find either communication particularly material to the resolution of the present UDRP complaint, but has noted their contents. The private information of concern to the Respondent is not included in this published Decision.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a straightforward comparison between the complainant’s trademark and the domain name”. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. The Domain Name incorporates in its entirety the Complainant’s registered RTL word mark, which is also the predominant element of its logos that are registered as figurative marks. As usual, the top-level domain “.sbs” is disregarded as a standard registration requirement. See *id.* section 1.11.2.

The Panel finds, therefore, that the Domain Name is identical to the Complainant’s registered marks for purposes of the Policy, paragraph 4(a)(i) and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a 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 domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondents' use of the Domain Name to redirect Internet users to a third-party (arguably competing) website. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent. The Respondent has not submitted a formal Response but has suggested that it has plans ultimately to develop a website relevant to the initials "rtlsbs". This claim is not conclusive for purposes of the second element without some evidence of "demonstrable preparations", which are wholly lacking on this record. Meanwhile, redirection to a media news site could be considered relevant and even if it appears to be noncommercial in this instance, the site – using an identical second level domain name as the Complainant's mark – is devoted to news and commentary on television media which is the Complainant's area of activity. See [WIPO Overview 3.0](#), sections 2.5.1.

Thus, the Panel concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following to which the Complainant alludes (in which "you" refers to the registrant of the domain name):

"(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The first example cited by the Complainant is not entirely apt, because there is no evidence of a "pattern" of abusive conduct. The second also is unpersuasive, because it does not appear that the Respondent is a competitor or seeks to "disrupt" the Complainant's business – though the Panel can see why the Complainant may argue this, especially where the site content is in the same area of commerce and does not seem to support the Respondent's claimed intentions. The Complainant relies heavily on the notion that the Respondent is steering Internet users to a competing "commercial" website. The problem with that argument is that the website to which the Domain Name redirects is populated with news and commentary, and it is not evident if and how the site is monetized (albeit there could be some form of indirect gain inuring to the Respondent in indirect, e.g., reputational, ways).

But the illustrative list of bad faith in paragraph 4(b) is not exclusive. The following facts matter for purposes of the third element:

(1) the Respondent does not deny prior awareness of the Complainant's well-known trademark (this would seem to be an untenable assertion, if it were made, given the content of the related site),

(2) the Respondent failed to submit a Response offering a plausible, legitimate reason for registering a Domain Name identical to that mark, and

(3) whatever legitimate purpose the Respondent might conceive for the Domain Name, the Respondent has been directing it to a third-party website that is in the same (media) commercial area of the Complainant.

Exploiting the Complainant's trademark to promote another party's website must be considered bad faith under the Policy (whether or not the Respondent directly makes money from it).

The Panel concludes that the Complainant has established the third element of the Complaint.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <rtl.sbs> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: April 18, 2022.