

ADMINISTRATIVE PANEL DECISION

Süddeutscher Verlag GmbH, Süddeutsche Zeitung GmbH, and Süddeutsche Zeitung Digitale Medien GmbH v. Iakov Shultz
Case No. DME2022-0020

1. The Parties

The Complainants are Süddeutscher Verlag GmbH, Germany, Süddeutsche Zeitung GmbH, Germany, and Süddeutsche Zeitung Digitale Medien GmbH, Germany, internally represented.

The Respondent is Iakov Shultz, Poland.

2. The Domain Name and Registrar

The disputed domain name <sueddeutsche.me> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2022. On September 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 27, 2022, 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 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 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on October 28, 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.

4. Factual Background

The first Complainant, Süddeutscher Verlag GmbH, is the owner of German Registered Trademark no. 30131631 for the word mark SÜDDEUTSCHE ZEITUNG, registered on January 27, 2003 in Classes 9, 16, 35, 38, 41 and 42.

The second Complainant, Süddeutsche Zeitung GmbH, publishes the German daily newspaper “Süddeutsche Zeitung”, operates the website at “www.sueddeutsche.de”, and is the owner of German Registered Trademark no. 302020018574 for the word/figurative mark SZ, registered on March 2, 2021 in Classes 9, 16, 35, 38, 41, 42 and 45. It also claims rights in the unregistered trademark SUEDEUTSCHE.

The third Complainant, Süddeutsche Zeitung Digitale Medien GmbH, is the registrant of the domain names <sueddeutsche.de> and <sueddeutsche.com>, both used for the second Complainant’s said website.

The second and third Complainants are both wholly owned subsidiaries of the first Complainant and are licensees of the first Complainant’s SÜDDEUTSCHE ZEITUNG trademark.

According to Whois records, the disputed domain name was registered on August 18, 2022. The registrant appears to be an individual with an address in Poland. On September 5, 2022, readers of the “Süddeutsche Zeitung” informed the second Complainant that a video was being distributed on social media under a link relating to the disputed domain name. Said video was embedded in a copy of the second Complainant’s website, the official version of which is available at “www.sueddeutsche.de”. Said copy website reproduced the Complainants’ SÜDDEUTSCHE ZEITUNG trademark as a prominent heading. If links were clicked in said copy website, they redirected to the Complainant’s said official website. The second Complainant’s SZ word/figurative mark appears prominently as a watermark throughout said video.

5. Parties’ Contentions

A. Complainant

In summary, the Complainants contend as follows:

Consolidation of Complainants

The Complainants have a common grievance against the Respondent because they have a common legal interest as owner or licensees respectively of the trademark which conflicts with the disputed domain name. As publisher and as operator of the website “www.sueddeutsche.de”, the Complainants are the target of common conduct by the Respondent which has affected their legal interests.

Identical or confusingly similar

The disputed domain name is identical or confusingly similar to a trademark in which the Complainants have rights.

The Complainants have rights in the SÜDDEUTSCHE ZEITUNG registered trademark. The second Complainant has rights in the SUEDEUTSCHE unregistered trademark which has been acquired through longstanding use of the sign in trade, to the extent that it has acquired public recognition as a trademark within the affected trade circles, particularly for newspapers and electronic media. The Complainants’ trademarks have acquired distinctiveness for newspapers and electronic media, and constitute well-known marks.

The disputed domain name is confusingly similar to the SÜDDEUTSCHE ZEITUNG registered trademark and is identical to the SUEDEUTSCHE unregistered trademark as it creates a risk for confusion in the relevant trade circles, having regard to visual, aural, and semantic similarity, and their distinctive and

dominant elements. The element “.me” in the disputed domain name and the element “Zeitung” in the registered trademark are generic/descriptive elements ineligible for protection and should therefore be disregarded in the comparison process, whereby the consumer will focus on the distinctive element “sueddeutsche”.

The Complainants use their trademarks for newspapers and electronic media, while the Respondent uses the disputed domain name to disseminate harmful content which is embedded in a 1:1 copy of the Complainants’ website layout and uses the second Complainant’s SZ trademark to create the false impression that said content originates from the Complainants.

Rights or legitimate interests

The Respondent has no rights or legitimate interests in the disputed domain name. There is no evidence of the Respondent’s use of or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent has not been commonly known by the disputed domain name, and it does not make a legitimate noncommercial or fair use thereof, without intent for commercial gain misleadingly to divert consumers or tarnish the trademarks at issue.

Registered and used in bad faith

The disputed domain name was registered and is being used in bad faith.

The Respondent has used the disputed domain name to distribute a video on social media which was embedded in a copy of the Complainants’ website and linked to it upon clicking on any content. The Complainants have not produced said video and they do not wish to be associated with it. The disputed domain name was registered primarily to misappropriate the Complainants’ media coverage in order to disrupt and influence public discourse by damaging the Complainants’ reliability and destroying the public’s confidence in the media.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (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 in bad faith.

A. Preliminary issue - Consolidation of Complainants

The Complaint has been brought in the name of the first, second and third Complainants together with a request for consolidation of their respective complaints.

The topic of multiple complainants filing a single complaint against a respondent is discussed in section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)). In examining the issue, panels typically consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that

has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

In the present case, the Panel is content to consolidate the complaints of all of the Complainants against the Respondent. The Complaint affirms that the first Complainant is the owner of the SÜDDEUTSCHE ZEITUNG registered trademark while the second and third Complainants are wholly owned subsidiaries of the first Complainant and are licensees of said mark. The registration and use of the disputed domain name containing a substantial portion of such trademark therefore gives rise to a specific common grievance against the Respondent on the part of all three Complainants, each of whose rights are affected thereby.

In terms of common conduct, the Respondent's use of the disputed domain name in a way that suggests it is reporting the news on behalf of the second Complainant's German daily newspaper "Süddeutsche Zeitung" (or as part of its website "www.sueddeutsche.de"), the Respondent's use of the second Complainant's SZ mark, the Respondent's use of the third Complainant's domain name <sueddeutsche.de>, and the Respondent's partial reproduction of the first Complainant's SÜDDEUTSCHE ZEITUNG registered trademark in the disputed domain name demonstrate conduct that has affected each of the Complainants in a similar fashion. Furthermore, the Respondent has not responded to the Complainants' request for consolidation by opposing or otherwise commenting upon it, and it may therefore be deemed to have no particular objection thereto. Finally, the Panel considers that it would be equitable and procedurally efficient to permit the consolidation.

The Panel therefore allows the consolidation of the Complainants' respective complaints against the Respondent relating to the disputed domain name in the present administrative proceeding. The Complainants sought transfer of the disputed domain name by way of remedy but did not specify to which of the three Complainants the disputed domain name should be transferred in the event of their success. In the absence of any specification on this subject, the Panel will order transfer to the Complainants.

B. Identical or Confusingly Similar

The first element of the Policy is usually assessed in two parts. First, the Complainants must demonstrate that they have UDRP-relevant rights in a trademark. Secondly, said trademark is compared to the disputed domain name, typically on a straightforward side-by-side basis, usually excluding the country code Top-Level Domain as this is required for technical reasons only. In such comparison, if the trademark is held to be recognizable in the disputed domain name, confusing similarity will usually be found, whereas if it is held to be identical thereto, identity will generally be found.

In the present case, the first Complainant has UDRP-relevant rights in its SÜDDEUTSCHE ZEITUNG registered trademark as described in the factual background section above. The second and third Complainants are also licensees of such mark. Turning to the comparison process, it must first be noted that non-internationalized domain names such as the disputed domain name are composed of standard ASCII characters only, which do not include accents such as the umlaut over the letter "u" in the first Complainant's trademark. Although the Complainants did not discuss the matter directly, as the Panel understands it, there is a typing convention in the German language whereby an umlaut over a letter may be substituted by the letter concerned without an umlaut together with, and followed by, a letter "e". This substitution typically occurs in circumstances where it is not possible to render an umlaut in the typography concerned, which would therefore apply in the case of a non-internationalized domain name consisting of ASCII characters such as the disputed domain name.

Armed with this knowledge, and comparing the first Complainant's trademark to the disputed domain name, the Panel notes that the disputed domain name reproduces 12 letters (inclusive of the necessary umlaut substitution) of the first Complainant's 18 letter trademark. This must be taken as a substantial proportion, albeit not an entire reproduction of said mark. The Complainants state that the dominant feature of said mark is the SÜDDEUTSCHE portion, being the element reproduced in its entirety in the disputed domain name, allowing for the umlaut substitution. The Respondent has not taken issue with that submission. Where at least a dominant feature of the relevant mark is recognizable in a domain name, the domain name

will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the [WIPO Overview 3.0](#)).

In addition, the Complainants effectively submit that the disputed domain name is a variant of the third Complainant's <sueddeutschland.de> domain name, as used by the second Complainant in the website address or URL for the online component of the "Süddeutsche Zeitung" newspaper. The Panel is satisfied that the manner of use of the disputed domain name to publish an alleged news item with an apparently intentional (false) attribution to the Complainants' newspaper affirms the confusing similarity in this case because it appears *prima facie* that the respondent seeks to target the first Complainant's SÜDDEUTSCHE ZEITUNG trademark, particularly by way of its abbreviated form as found in the third Complainant's <sueddeutschland.de> domain name and by reproducing the Complainants' SÜDDEUTSCHE ZEITUNG trademark on the associated website (see section 1.15 of the [WIPO Overview 3.0](#)).

In these circumstances, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights. It is therefore unnecessary for the Panel to go on to consider the Complainants' submissions regarding their alleged unregistered rights in the term SUEDEUTSCHE.

Accordingly, the Complainants have carried their burden with regard to paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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".

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. Where the panel finds that a complainant has made out such a *prima facie* case, the burden of production shifts to the respondent to bring forward evidence of such rights or legitimate interests.

In the present case, the Complainants effectively assert that the Respondent cannot avail itself of any of the circumstances described in paragraph 4(c) of the Policy. The Complainants also show that the Respondent has used the disputed domain name as part of a deceptive scheme to persuade Internet users that a video published in connection with the disputed domain name is a genuine news item that has been reported by the online component of the Complainants' newspaper. The Panel is satisfied that this is sufficient to establish a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the burden of production shifts to the Respondent to bring forward submissions and any corresponding evidence of any such rights and legitimate interests. The Respondent has not participated in the administrative proceeding and has not made any claim to have rights or legitimate interests in the

disputed domain name. In the absence of any account from the Respondent, the Panel notes that the evidence presented by the Complainants demonstrates that the Respondent is using the disputed domain name to falsely attribute a news video to the Complainants' newspaper. In order to give credibility to the said video, the Respondent appears to have selected the disputed domain name primarily because it reproduces a substantial portion of the first Complainant's SÜDDEUTSCHE ZEITUNG trademark, reflecting the title of the Complainants' newspaper, and because this matches the abbreviated version of such trademark and newspaper title in its online version, namely "sueddeutsche". Indeed, the disputed domain name appears to have been selected because it is a deliberate typographical variant of the third Complainant's <sueddeutsche.de> domain name as used in the second Complainant's website, and it differs from this by only a single letter within the country code Top-Level Domain. To enhance the confusion, the Respondent goes on to watermark the video with the second Complainant's SZ registered trademark and to embed it in a copy of the Complainant's website usually found at "www.sueddeutsche.de", which copy website reproduces the Complainants' SÜDDEUTSCHE ZEITUNG trademark as a prominent heading.

The Panel notes that for completeness it has considered whether the disputed domain name is being used for the purposes of fair use criticism of the Complainants. That possibility has to be discounted because the facts and circumstances of the case strongly suggest that the Respondent is not seeking to criticize the Complainants *per se* but rather to cloak itself in the Complainants' identity in order to disseminate the video described above with a false attribution. This may be a noncommercial use but it is not a legitimate noncommercial use, nor is it a fair use of the disputed domain name. On the contrary, the Respondent's actions concerning the disputed domain name suggest that it has engaged in a deliberate scheme to deceive the public by misappropriating the Complainants' identity. Such a scheme cannot confer rights or legitimate interests upon the Respondent in the opinion of the Panel.

The Panel finds that the Complainants have carried their burden with regard to paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- "(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or
- (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 online 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."

In the present case, it is clear that the Respondent knew of and was intending to target the Complainants' rights in the SÜDDEUTSCHE ZEITUNG trademark. The disputed domain name contains a substantial proportion of the Complainants' mark and the Panel has found that it is confusingly similar thereto. Furthermore, the Second-Level Domain of the disputed domain name is alphanumerically identical to the abbreviation of said mark which is used to represent the online component of the Complainants' newspaper, as indicated by the third Complainant's domain name <sueddeutsche.de>. The disputed domain name is

only one letter different from such domain name when the country code Top-Level Domain is taken into account.

As noted in the preceding section, the disputed domain name has been used to provide a false attribution to alleged video news footage, which is presented as if it emanated from the Complainants, including reproducing the Complainants' SÜDDEUTSCHE ZEITUNG trademark prominently on the associated website. This activity does not necessarily fit squarely into any of the circumstances listed in paragraph 4(b) of the Policy, albeit that, if the Respondent is itself regarded as a distributor of news content, paragraph 4(b)(iii) might be relevant because it would be a competitor of the Complainants. Nevertheless, the categories of bad faith conduct are expressed by the Policy to be non-exclusive, and the Panel considers that the deliberate deception of the public by the adoption of the first Complainant's trademark and an abbreviated identifier therefor within the disputed domain name and the website to which it points could not be regarded as a good faith activity in the circumstances of this case. It is conduct that calls for an explanation from the Respondent which has not been tendered. In the absence of any such explanation or any possible good faith motivation that might be apparent from the facts and circumstances, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainants have therefore carried their burden with regard to paragraph 4(a)(iii) of the Policy.

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 disputed domain name <sueddeutsche.me> be transferred to the Complainants.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: November 11, 2022