

ADMINISTRATIVE PANEL DECISION

Süddeutscher Verlag GmbH, Süddeutsche Zeitung GmbH, and Süddeutsche Zeitung Digitale Medien GmbH v. Kaspar Ullrich
Case No. D2022-3506

1. The Parties

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

The Respondent is Kaspar Ullrich, Germany.

2. The Domain Name and Registrar

The disputed domain name <sueddeutsche.online> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint (See PrivacyGuardian.org). The Center sent an email communication to the Complainants on September 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on September 27, 2022.

The Center verified that the Complaint together with the amendment to 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 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 26, 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 Complainants are part of a group of companies which publish the newspaper Süddeutsche Zeitung in print and digital version and operate the corresponding website under the domain name < sueddeutsche.de >. The newspaper Süddeutsche Zeitung is one of the largest daily newspapers in German language.

The Complainant Süddeutscher Verlag GmbH holds the national German trademark registration DE 30131631 for the word mark SÜDDEUTSCHE ZEITUNG, registered on January 27, 2003 amongst others for printed matter, including in electronic form, namely newspapers, publication and editing of print media and electronic media. It results from the official extract on this trademark provided by the Complainants, which has not been contested by the Respondent, that this trademark enjoys acquired distinctiveness (“*Verkehrsdurchsetzung*”) for the afore mentioned goods and services. Finally, the Complainants claim that their trademarks are well-known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property.

It further results from the Complainants’ documented and undisputed allegations that the Complainant Süddeutsche Zeitung GmbH operates the website under the domain name < sueddeutsche.de > (which is owned by the Complainant Süddeutsche Zeitung Digitale Medien GmbH). Under this domain name the electronic version of newspaper Süddeutsche Zeitung is available. The website to which this domain name leads shows the logo SZ, which is protected as a separate national German trademark (DE 302020018574) for the Complainant Süddeutsche Zeitung GmbH.

The disputed domain name has been registered by the current Respondent on August 20, 2022. The language of the registration agreement is English.

Finally, the Complainants’ documented allegations, which remained undisputed, evidence that the disputed domain name resolves to a website that is highly similar to the Complainants’ website and disseminates false information together with a corresponding video. Said website use the identical layout and font of the Complainants’ official news-page under the domain name < sueddeutsche.de > and the video including the trademarks SÜDDEUTSCHE ZEITUNG and SZ without any authorization and therefore creates the wrong impression that this false information and video originates from the Complainants.

5. Parties’ Contentions

A. Complainant

Firstly, the Complainants point out that the disputed domain name is visually, aurally and semantically identical or confusingly similar to the Complainants’ trademarks. The element “zeitung” is merely descriptive and therefore to be disregarded for the comparison of the signs and the disputed domain name. In this context, the Complainants bring further forward that the Complainant Süddeutsche Zeitung GmbH owns an unregistered German trademark in the term “sueddeutsche” pursuant to Section 4 of German Trademark Act acquired through longstanding use of that sign in trade which led to public recognition as a trademark.

Secondly, the Complainants contend that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainants content that there is no evidence that the Respondent uses or is making demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services. Furthermore, the Respondent is not commonly known under the disputed domain name. Finally, the Respondent is not making any legitimate noncommercial or fair use of the

disputed domain name.

Thirdly, the Complainants contend that the disputed domain name was registered and is being used in bad faith. In fact, the disputed domain name is used to spread highly harmful content, namely a video creating the false impression that it has been produced and distributed by the Complainants. However, the Complainants did not produce or distribute said video and do not want to be associated with this content. In the Complainants' view, it is therefore obvious that the disputed domain name has been registered primarily in order to misappropriate the Complainants' media coverage in order to disrupt and influence the public discourse through damaging the Complainants' reliability and destroying the public's confidence in media.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "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".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

Pursuant to paragraph 14(b) of the UDRP Rules the Panel shall draw such inferences from the Respondent's default to submit a Response as it considers appropriate. In the absence of any Response, the Panel is, therefore, prepared to draw certain inferences in light of the particular facts and circumstances of the case *e.g.*, where a particular conclusion is *prima facie* obvious or where no other plausible conclusion is apparent.

A. Preliminary issue: Consolidation of Complainants

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.

Therefore, 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.

B. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainants must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainants have rights.

It is well accepted amongst WIPO UDRP panels that the first element of the UDRP functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, 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 (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant Süddeutscher Verlag GmbH is the registered owner of verbal trademark SÜDDEUTSCHE ZEITUNG (registered on January 27, 2003) which enjoys acquired distinctiveness in Germany for printed matter, including in electronic form, namely newspapers, publication and editing of print media and electronic media. 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. The Panel notes that the element ZEITUNG of said trademark is not reflected in the disputed domain name. In addition, the mutated vowel "ü" of the trademark's element SÜDDEUTSCHE is replaced by the letters "ue" in the disputed domain name. 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](#)).

The TLD ".online" is a technical requirement as all TLDs and is therefore generally disregarded for the purpose of the analysis of confusing similarity.

In this case, the Panel has also taken note of the content of the website associated with the disputed domain name to confirm confusing similarity whereby it appears *prima facie* that the Respondent seeks to target a trademark through the disputed domain name.

In the light of the above, there is no need for the Panel to establish whether the Complainants' trademarks are actually well-known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property and if the Complainants owns unregistered trademark rights in the term "sueddeutsche" for purposes of the UDRP (see section 1.3 of the [WIPO Overview 3.0](#)).

As a result, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainants must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to a disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainants have made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, the Panel notes that the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In addition, it results from the Complainants' documented allegations, which remained undisputed, that the disputed domain name resolves to a website that is highly similar to the Complainants' website and disseminates false information together with a corresponding video. Said website and the video use the trademarks SÜDDEUTSCHE ZEITUNG and SZ as well as the identical layout and font of the Complainants' official news-page under the domain name <sueddeutsche.de> and the

official videos without any authorization. They therefore create the wrong impression that this false information and the video published on that website under the disputed domain name originate from the Complainants. In the Panel's view, such use cannot be qualified as *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. Such use rather capitalizes on and is highly detrimental to the reputation and goodwill of the Complainants' trademarks and newspaper.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondent wanted to mimic the Complainants' original website and videos under the disputed domain name by taking over the same layout, font and trademarks. In the Panel's view, this excludes any fair use of the disputed domain name from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainants have therefore satisfied paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainants must thirdly establish that the disputed domain name has been registered and is being used in bad faith.

The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances that the Panel finds applicable to the present dispute is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

In fact, the Complainants' documented allegations, which remained undisputed, evidence that the disputed domain name resolves to a website that is highly similar to the Complainants' website and disseminates false information together with a corresponding video. As mentioned above under Section 6.B, said website and the video use the trademarks SÜDDEUTSCHE ZEITUNG and SZ as well as the identical layout and font of the Complainants' official news-page under the domain name < sueddeutsche.de > and the official videos. They therefore create the wrong impression that this false information and the video published on that website under the disputed domain name originate from the Complainants. However, the Complainants have not given any authorisation for such use and are neither linked to the Respondent or this website nor want they to be associated with such propaganda content. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent positively knew the Complainants' trademark, website and newspaper when it registered the disputed domain name.

This finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand (see sections 3.1 and 3.2 of the [WIPO Overview 3.0](#)):

- (i) the nature of the domain name, picking up the exact second level domain under which the Complainants publish the online version of their newspaper;
- (ii) the content of the website to which the disputed domain name directs, which disseminates false information, in particular a video, creating the wrong impression that the Complainants are responsible for this content, which is susceptible to damage the public's confidence in serious media and the Complainants' reliability, reputation and goodwill;
- (iii) website content using and targeting the Complainants' trademarks SZ and SÜDDEUTSCHE ZEITUNG;
- (iv) the clear absence of any rights or legitimate interests in the disputed domain name;
- (v) the Respondent's failure to submit a response with a credible evidence-backed rationale for registering the disputed domain name;
- (vi) the Respondent's failure to provide any evidence of actual or contemplated good-faith use; and
- (vii) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant 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.online> be transferred to the Complainants.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: November 9, 2022