



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Deutsche Bank Aktiengesellschaft v New York TV Tickets Inc.

Case No. D2001-1314

1. The Parties

The Complainant is Deutsche Bank Aktiengesellschaft, a German corporation with its principal place of business at Frankfurt am main, Germany. The Complainant is represented by Ms. Vivian Polak of Le Boeuf, Lamb, Greene & MacRae, LLP, of New York, NY, USA.

The Respondent is New York TV Tickets Inc, a New Jersey corporation of Edgewater, NJ, USA. The Respondent is represented by its President, Mr. Noel Turner.

2. The Domain Name and Registrar

The domain names at issue are <duetschebank.com> and <duetsche-bank.com> The domain names are registered with Verisign Inc's of Herndon, VA, U.S.A. ("the Registrar").

3. Procedural History

The Complaint submitted by the Complainant was received on October 30, 2001, (electronic version) and November 2, 2001, (hard copy) by the World Intellectual Property Organization and Mediation Center ("WIPO Center"). Some minor amendments were made to the Complaint before dispatch to the Respondent.

On November 8, 2001, a request for Registrar verification was transmitted by the WIPO Center to the Registrar, requesting it to:

Confirm that a copy of the Complaint had been sent to it by the Complainant as requested by WIPO Supplemental Rules for Uniform Dispute Resolution Policy ("Supplemental Rules"), paragraph 4(b).

Confirm that the domain names at issue are registered with the Registrar.

Confirm that the person identified as the Respondent is the current registrant of the domain names.

Provide full contact details, i.e., postal address(es), telephone number(s), facsimile number(s), email address(es), available in the Registrar's WHOIS database for the registrant of the disputed domain name, the technical contact, the administrative contact and the building contact for the domain names.

Confirm that the Uniform Domain Dispute Resolution Policy ("UDRP") was in effect.

Indicate the current status of the domain name.

By email dated November 9, 2001, the Registrar advised WIPO Center as follows:

It had received a copy of the Complaint from the Complainant.

It is the Registrar of the domain name registrations <duetschebank.com> and <duetsche-bank.com>

The Respondent is shown as the "current registrant" of the domain names and is also the administrative contact.

The UDRP applies to the domain names.

The domain name registrations are currently on "hold"

The Registrar has currently incorporated in its agreements the policy for Uniform Domain Name Dispute Resolution ("UDRP") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") (hereinafter simply the "Policy").

The Registrar advised that the domain names in question are on "hold". The Respondent has not sought to terminate the agreement with the Registrar. Accordingly, the Respondent is bound by the provisions of the Policy. The Respondent has not challenged the jurisdiction of the Panel.

Having verified that the Complaint satisfied the formal requirements of the Policy and the Rules for Uniform Domain Name Resolution Policy ("Rules"), the WIPO Center on November 12, 2001, transmitted by post-courier and by email a notification of the Complaint and Commencement of Administrative Proceedings to the Respondent. A copy of the Complaint was also emailed to the Registrar and ICANN.

The Complainant elected to have its Complaint resolved by a three-person panel. It has duly paid the amount required of it to the WIPO Center.

The Respondent was advised that a Response to the Complaint was required within 20 calendar days. The Respondent was also advised that any Response should be communicated, in accordance with the Rules, by four sets of hard copy and by email. The Respondent filed a Response by email on December 3, 2001, and by hard copy of December 21, 2001.

WIPO Center invited the Honorable Sir Ian Barker QC of Auckland, New Zealand to serve as Presiding Panelist in the case. It also invited Mr. M Scott Donahey of Palo Alto, CA, USA and Mr. Peter Michaelson of Red Bank, NJ, USA to be panelists. It transmitted to all Panelists a Statement of Acceptance and requested a Declaration of Impartiality and Independence.

All Panelists duly advised acceptance and forwarded to the WIPO Center an executed declaration of impartiality and independence. The Panel finds that the Administrative Panel was properly constituted in accordance with the Rules and the Supplemental Rules.

On January 30, 2002, WIPO Center forwarded to the Panel by courier the relevant submissions and the record. In terms of Rule 5(b), in the absence of exceptional circumstances, the Panel was required to forward its decision by February 14, 2002.

The Panel has independently determined and agrees with the assessment of WIPO Center that the Complaint meets the formal requirements of the Rules and the Supplemental Rules.

4. Factual Background

The Complainant, founded in 1870 in Berlin, is Germany's largest bank and one of the world's leading financial institutions. It has used the company name and trademark "DEUTSCHE BANK" in connection with a wide variety of banking services since 1870 in Germany and since at least as early as 1978 in the United States.

Complainant currently owns the registration for the service mark "DEUTSCHE BANK" in the United States (Registration No. 1,782,926 (1993) and Germany (Registration No. 2,902,587 (1995) for use in connection with banking services ("Deutsche Bank Mark"). It has used the "DEUTSCHE BANK" mark worldwide since at least 1957, in Canada since 1971, in Mexico since 1955, as well as more than 180 variations on the mark "DEUTSCHE BANK", worldwide, for use in connection with a wide variety of banking and other financial services.

Complainant has invested substantial time and money over the years to publicize the DEUTSCHE BANK Mark. It has used this mark widely to establish the global fame and goodwill of the Deutsche Bank Mark in connection with its banking services.

The Complainant's mark has become well known in the banking industry after decades of use worldwide. It also has owned the registrations for the domain names <deutschebank.com> and <deutsche-bank.com> (collectively, the "Deutsche Bank domain names") since 1998 and actively promotes its banking services through these Domain Names. The home page located at each of these Deutsche Bank Domain Names automatically directs Internet users to the website "group.deutsche-bank.de/ghp_de/index_2.htm" (the "Deutsche Bank Website") at which site Complainant actively promotes its banking services.

Respondent registered the domain names <duetschebank.com> and <duetsche-bank.com> without authorization from the Complainant.

As of October 25, 2001, the websites located at each of the disputed Domain Names displayed the wording “[t]his site is coming very soon We are very excited to be bringing you quality products and services.” Accompanying this text is a photograph of a naked woman along with a flashing sexually-suggestive image and link to a website offering hard-core pornography. On the home pages of each of the disputed Domain Names appears a graphic box that alternates between displaying a sexually-suggestive image and the wording “Click Here!”

When the user clicks on the aforementioned graphic box, the user is automatically linked to a pornographic website located at www.eroticaempire.com where the user is exposed to hard-core pornographic images and links to other pornographic websites. When the user who had inadvertently or mistakenly reached www.eroticaempire.com attempts to close the web page, he or she is subject to “mouse-trapping”, an Internet technology employed by, e.g., linked pornographic sites that continues to stream pornographic images to the user, even after such user tries to close such websites.

According to Complainant, the link displayed on the disputed Domain Names’ websites to www.eroticaempire.com is accomplished by means of passage through an Internet counter located at <http://rdl.hitbox.com/rd?acct=CQ50100714BACXEN0> (“Hitbox”). The encoded text of the disputed Domain Names’ websites reveals that Respondent uses the term “DUETSCHEBANK” in the encoded text of its websites and identifies the “Hitbox” address as the proper destination for users clicking the “Click Here” button in the aforementioned graphic box.

On October 12, 2000, Complainant’s German counsel sent a “cease and desist” letter to Respondent. After subsequent communications with this counsel, including a telephone conversation on October 17, 2000, and subsequent letters dated October 22 and November 18, 2000, Respondent refused to voluntarily cancel the disputed Domain Names. On May 8, 2001, Deutsche Bank’s U.S. counsel sent a further “cease and desist” letter to Respondent.

On or around May 6, 2001, Noel Turner, President of Respondent, contacted Complainant’s US counsel by telephone and again refused to voluntarily transfer or cancel the disputed Domain Names.

Noel Turner then sent a letter dated July 24, 2001, to Complainant’s US counsel purporting to accept an alleged offer - \$10,000 for each of the two disputed Domain Names, for a total of \$20,000.

Respondent operates a show ticket business in the New York area. It owns a service mark for “Duetsche”.

5. Parties’ Contentions

Complainant:

Respondent’s domain names [<duetschebank.com>](http://duetschebank.com) and [<duetsche-bank.com>](http://duetsche-bank.com) are virtually identical to, and confusingly similar to, the registered mark “DEUTSCHE BANK” in which Complainant has exclusive rights.

The only distinction between the disputed Domain Names and Deutsche Bank's registered mark is a slight misspelling of the mark – namely, the transposition of the letters “U” and “E” in the word “DEUTSCHE”. This transposition of letters can be a common typographical and/or phonetic misspelling of the DEUTSCHE BANK Mark.

The fact that the disputed Domain Names take advantage of the common misspellings of the DEUTSCHE BANK Mark is illustrated by the common erroneous use of the wording “Duetsche Bank”. A sampling of articles from newspapers and other periodicals demonstrates that Respondent is relying upon a common misspelling of Complainant's famous mark. A search performed on a leading Internet search engine revealed that this misspelling of the famous mark led to 96 results, of which a significant sampling percentage referred to Deutsche Bank.

Respondent chose the disputed Domain Names based on a common misspelling of Complainant's well-known mark in an effort to attract Internet users who would erroneously or mistakenly key in the misspelled version of the Complainant's mark.

Given this confusing similarity, Internet users are likely to be misled or confused as to Complainant's relationship to, affiliation with, or endorsement of, the pornography-related websites which can be located through the disputed Domain Names. Under similar facts and circumstances, various WIPO Administrative Panels have found that domain names that consist of intentional misspellings or typographical errors of a trademark are “confusingly similar” to that trademark.

Respondent has no rights or legitimate interests with respect to the disputed Domain Names. In order to satisfy the requirement of paragraph 4(a)(ii) of the Policy, Complainant may show that Respondent has not: (a) used the disputed Domain Names in connection with any bona fide offering of goods or services; (b) been commonly known by the disputed Domain Names; or (c) made any legitimate noncommercial or fair use of the disputed Domain Names.

Respondent's Domain Names are used in connection with displaying sexually explicit images and offering links to hard-core pornographic websites. Consequently, Respondent's Domain Names bear no relationship to the actual or intended business of Respondent. Nothing on Respondent's websites would justify the use of a slight variation of the Deutsche Bank Mark or even the term ‘bank’ within the disputed Domain Names.

Respondent is not to use the word ‘bank’ in its name, unless it can establish that it is a properly-licensed banking institution. See New Jersey Statutes §17:9A-18 (an entity that is not a banking institution or banking holding company is not permitted to use the word ‘bank’ as part of its name. A violation of this requirement is a misdemeanor and may be enjoined by the state's banking commissioner). Accordingly, Respondent has no rights or legitimate interest in the disputed Domain Names.

Respondent's activities do not correspond to any of the circumstances set forth in paragraph 4(c) that would evidence any rights or legitimate interests with respect to the disputed Domain Names.

- (a) Respondent does not use the disputed Domain Names or a name corresponding thereto in connection with any *bona fide* offering of goods or services. Respondent's use of the Names in connection with sexually

explicit and pornographic images and pornographic links tarnishes and dilutes the Complainant's Mark by suggesting to users that Complainant endorsed, sponsored, or was otherwise affiliated with the disputed Domain Names.

- (b) Respondent has not commonly been known by the disputed Domain Names.
- (c) Respondent has not made any legitimate noncommercial or fair use of the disputed Domain Names. Each of the websites located at the disputed Domain Names offers a link that invites Internet users to access other pornographic sites. Upon clicking the link, the Internet user is transported to the pornographic site <eroticaempire.com> via a "Hitbox" web page which real-time statistics on the number of page views and unique visitors and how much traffic is sent to particular websites. Respondent is entitled to receive a stream of revenue from the advertising of third parties' pornographic goods and services via the link is provided on these websites located at the disputed Domain Names.

WIPO Administrative Panels have held that the use of domain names to offer pornography-related websites and/or links to pornographic images and services at other websites is not a legitimate use of the disputed Domain Names.

Respondent responded to the cease and desist letter dated May 8, 2001, by refusing voluntarily to transfer or cancel the disputed Domain Names unless Deutsche Bank agreed to pay \$20,000 for the transfer of the disputed Domain Names.

Complainant Deutsche Bank conducted an internal investigation to determine whether the alleged offer was made to Respondent which confirmed that no offer of any kind was ever made to Respondent with respect to the Infringing Domain Names or otherwise.

Respondent must have been fully aware of Complainant's exclusive rights in and to the registered mark 'DEUTSCHE BANK' at the time Respondent disingenuously offered (by means of Noel Turner's acceptance of a purported \$20,000 offer that was never made) to sell the disputed Domain Names. Respondent must have been aware that Complainant would seek to protect its registered and famous mark from the dilution and tarnishment that results from the use of confusingly similar versions of its mark in domain names used to operate pornography-related websites.

The only plausible purpose for Respondent's registration and use of the disputed Domain Names is to attract, for commercial gain, Internet users to its sexually explicit websites or other on-line pornographic locations, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of Respondent's websites, advertising and services offered on those sites. Respondent's registration of the disputed Domain Names that are simply typographical errors and/or misspellings of Complainant's famous mark is itself evidence of Respondent's bad faith.

Respondent's registration and use of domain names that consist of a common misspelling of Complainant's registered mark are inherently deceptive and serve no purpose other than to draw users who mistakenly or inadvertently enter an incorrectly

spelled version of the Deutsche Bank Mark when he or she is attempting to access Complainant's websites.

Respondent

Respondent has used the brand name and service mark 'DUETSCHÉ' in connection with its new product line that is still yet to be publicly launched on the Internet. The site, however, has been available for private users i.e. banks, venture capitalists and other financial institutions perusal. Additionally, members of the press and media groups have been invited to the "Private" site. The Complainant only cites the "Public" web page in their complaint. It was not a "Private" user nor was it invited to see the private section of the site, which will indicate its true nature when publicly launched.

This new service "Duetsche" will provide web-based tickets to coming new shows and will be launched on NBC in the spring of 2002. This service which is in line with Respondent's main business stream of marketing and producing TV Shows in New York has been operating the service mark "DUETSCHÉ" in the United States since 1999 for its new development use. It now intends to apply for a trademark for 'DUETSCHÉ'. Respondent has invested substantial time and money over the last two years to develop product on the "DUETSCHÉ" mark and has used this mark widely in a manner to gain first and second round funding from a variety of venture capitalist companies.

Respondent specifically registered the domain names <duetsche.com>, <duetschebank.com> and <duetsche-bank.com> to protect its service mark "DUETSCHÉ". It has also registered a number of other domain names that utilize the service mark 'DUETSCHÉ'.

Respondent's primary site is <duetsche.com>. It began work on its content in late 1999. All the purchased domain names that were purchased (including the disputed names) have been directed to the primary <duetsche.com> home page.

The home page that comes up for public users is essentially a placeholder establishing the presence on the web before the product launch. The home page for private users (Users who have been authenticated) is the full <Duetsche.com> product.

The contents of the single "Public" web page were some text, one photograph and a hit counter. The text used on this public page was "We are very excited to be bringing you quality products and services. If you would like to contact us please click below: <Webmaster@Duetsche.com>". A single stock photograph was placed on this page as a background image. This is a photograph of a woman. Although this picture is attractive it is not, as alleged by the Complainant, pornographic. At the bottom of the page was a free web hit counter service named 'WEBTRENDS LIVE'. This records web page visitor information at no cost and no benefit to the owner other than information on how many people visit the site.

Previously, another free web counter had been used from the "HITBOX" company (which also records web hits at no cost and no benefit to the owner other than information on how many people visit the site). But this was discontinued due to the very rare occasion where questionable content would be placed on the very small banner window over which Respondent has no control. As the window generated is random and the "questionable content" was very rare, the Complainant must have tried

many times before an "Adult" advertisement came up. It was not a representative visit. This evidence is not a realistic interpretation of how this website appeared to the average user and is misleading. Respondent could not be responsible for any link after a user clicked on the HITBOX connection. This would sometimes be to an advertiser that may (albeit in very rare cases) have offered adult material or possible "Mousetrapping" as it is known. Respondent cannot condone this behavior which is why it moved the tracking service out of HITBOX and into WEBTRENDS LIVE. Respondent has never benefited in any way other than to use a free web counter service. Any traffic that was passed to the "HITBOX" service from persons who would click on this very small icon gave no financial (or otherwise) gain in any way to it.

Respondent has never contacted or solicited anyone to purchase the discussed domain names in any form. Its actions are protective of its service mark.

It has never offered, sold or transferred a domain name in any shape or form to any party. It was first contacted on October 12, 2000, by Complainant's German counsel, to discuss the registration of the domain names. In subsequent communications including a telephone conversation on October 17, 2000, and subsequent letters dated October 22 and November 18, 2000, Respondent identified that it had taken the domain names to protect its service mark and therefore refused to pass over its service mark.

On May 16, 2001, Noel Turner, on behalf of the Respondent, contacted Complainant's US counsel by telephone. Mr. Turner felt that he should not pass the domain names to Complainant. In the discussion, Mr. Turner suggested that an arrangement be made that would allow both parties to protect, and stop dilution, of their relevant service marks. Complainant's US counsel stated that she would get back to Noel Turner on this matter.

On July 11, 2001, Noel Turner was contacted to discuss a final solution which dealt with the previously discussed matter. US counsel for Complainant required an amendment to the agreement that allowed Deutschebank full "Registrant" control of the domain names. The agreement would state that although Complainant would now be the registrant of record, neither party would offer data on those domains. For this "Registrant" privilege Complainant agreed to pay \$10,000 for each of the domain names discussed which Respondent accepted. Respondent's "acceptance of their offer" letter was not some kind of solicitation.

"Deutsche" is not confusingly similar to, the registered mark "DEUTSCHE BANK" in which Deutsche Bank has exclusive rights.

The Respondent recognizes that the domain names at issue could be construed as confusingly similar to its own service mark "DUETSCH". Specifically, <Duetschebank.com> could be construed as being part of the Duetsche operation and business of which Respondent owns the service mark. Its actions in purchasing these domain names have been taken to protect its service mark from dilution. It has tried repeatedly to find a resolution with Complainant which has acted in a "hasty" manner and has resorted to "litigious" tactics instead of a mutual and objective agreement.

Respondent chose the disputed Domain Names based on its ownership of its established service mark "Duetsche" and retains its rights towards its own service mark. Respondent has been in negotiations with other entities that own domain names that include its service mark "Duetsch" including, but limited to: <duetschemark.com>.

<duetschetv.com>, <duetschetickets.com>, <duetscher.net>, <duetscher.org>, and <duetschetelecom.com>. Respondent has been commonly known as <Duetsche.com> and therefore has rights to any domain name that contains its service mark; in the process of its launch of its new site, it is offering bona fide goods and services at this location.

The domain names were not registered or used by the Respondent in bad faith. Respondent has never contacted or solicited anyone to purchase the discussed domain names in any form.

Respondent did not attract Internet users with a likelihood of confusion with a trademark or service mark holder. The Respondent is not a “Porn master” as alleged by Complainant. Any connection with porn was created by the Complainant in a bid to smear the Respondent. In a bid to add credibility to the smear, much focus has been on the HITBOX situation in a bid to “Mud sling” as much as possible. The HITBOX situation was unfortunate, but absolutely not representative of the average users visit to any of the site domain names at issue. Those changes have been rectified over six months ago.

The Respondent registered the domain names purely for the purposes of protecting its service mark and for no other reason. Its “Placeholder” page contained no pornography as alleged by the Complainant.

Respondent receives no revenue from the links to websites offering pornographic goods and services via the link that is provided on the websites located at the disputed Domain Names.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to:

“decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable”.

The burden for the Complainant, under paragraph 4(a) of the Policy, is to show:

- That the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- That the Respondent has no legitimate rights or interests in respect of the domain name; and
- The domain name has been registered and used in bad faith.

The Panel considers that the disputed domain names are confusingly similar to the Complainant’s registered marks.

A disputed domain name which consists of the Complainant’s mark plus the addition of a descriptive word linked to the services that the Complainant markets can be

confusingly similar to a mark. See *Harrods Ltd v AB Kohler & Co* – (WIPO Case No. D2001 0544) decision July 31, 2001, over the names <harrodswatch.com> and <harrodsjewellery.com>. *PBS Bank Schwetz A.G. v Tuzen* (WIPO Case No. D2001-1311) is a case where the word ‘bank’ was added in the disputed domain name to the registered mark PBS. The Complainant was a well-known supplier of banking services. The Panel held that it was the juxtaposition of the word ‘bank’ with the letters of the mark which changed the whole complexion of the domain name from being one depicting anything at all to one connected with a banking institution.

There is a further reason for finding confusing similarity. In the Panel’s view, this is a case of ‘typosquatting’ where the domain name is a slight alphabetical variation from a famous mark. WIPO jurisprudence offers many examples of confusing similarity brought about through easily made typing errors by an Internet user – particularly when the mark is another language from that of the user’s mother tongue.

See for example, *DaimlerChrysler Corporation v. Worshipping, Chrisler, and Chr, aka Dream Media and aka Peter Conover*, WIPO Case No. D2000-1272 (mark: Chrysler; domain names: crysler, chrisler, chrystier or christler) and *Telstra Corporation Ltd v. Warren Bolton Consulting Pty Ltd.*, WIPO Case No. D2000-1293 (mark: bigpond; domain name: big pons).

Nor has the Respondent demonstrated any legitimate rights or interests in respect of the domain name. Complainant gave him none. In that regard, the Complainant has never licensed, authorized or permitted the Respondent to use the Deutsche Bank Mark in any manner. Consequently, given the notoriety of the Complainant's Deutsche Bank Mark, any use which the Respondent would make of any domain name, as here, that incorporated the Complainant's Deutsche Bank Mark, or one confusingly similar thereto, would likely violate the exclusive trademark rights which the Complainant has long held in its mark.

The websites are not developed. It is clear that they could, at some stage have resolved into a pornographic site. Respondent says such a result was unintended and that the Respondent made nothing out of any visits by Internet users to a pornographic site. The Panel is in no position to decide whether that contention is correct. However, the situation is clear that Respondent has not demonstrated any bona fide offering of goods and services using the disputed domain names. Nor has Respondent shown that it has been known by the disputed domain names, whatever the situation with regard to the name “duetsche”.

In the circumstances, it is not difficult for the Panel to infer bad faith registration and use of the disputed domain names by the Respondent. The inference of bad faith at the time of registration is shown by the blatant attempt to replicate the name of a world famous financial institution simply by the transposition of two letters of its name. The use of the word “bank” in the registration can have no good faith explanation and none was offered by the Respondent.

The Panel cannot resolve the questions of fact relating to the negotiations between Mr. Turner and Ms. Polak. It does not need to found a bad faith conclusion on these because of the force of the initial inferences of bad faith registration.

Clearly, too, the possible resolution of the Respondent's website with a pornographic site, whatever the circumstances under which this occurred is a tarnishment of the Complainant's mark and ongoing evidence of bad faith.

Accordingly, the Panel finds the Complaint proved.

7. Decision

For the foregoing reasons, the Panel decides:

- (a) That the domain names registered by the Respondent are confusingly similar to the trademarks to which the Complainant has rights;
- (b) That the Respondent has no rights or legitimate interests in respect of the domain names; and
- (c) The Respondent's domain names have been registered and are being used in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy, the Panel requires that the registration of the domain names <duetschebank.com> and <duetsche-bank.com> be transferred to the Complainant.

Hon. Sir Ian Barker QC
Presiding Panelist

Mr. M. Scott Donahey
Panelist

Mr. Peter Michaelson
Panelist

Dated: February 12, 2002