

New developments in domain name case law

A large number of domain name cases have been heard in Germany. Dietrich Beier, of Bardehle, Pagenberg, Dost, Altenburg, Geissler, analyzes the significance of the most recent judgments

Germany has had, for several years now, a vital case law development in domain name matters. Almost 100 decisions are published every year. Others remain unpublished and are known only to the parties. Although many of the published decisions are finally decided by the first instance courts, some of them have reached the Federal Supreme Court which took the chance to provide guidance. In the past, the Federal Supreme Court allowed generic domain names under certain requirements in view of unfair competition law (for example *mitwohonzentrale.de* = *housing-cooperative.de*) and ruled on domain name constellations where identical names were in question (*shell.de*).

In three new decisions, the highest German civil court clarified an important detail in German name law (*maxem.de*), denied certain claims against the German domain name authorities Denic (*kurtbiedenkopf.de*) and did not object to the prohibition of the generic domain name with an indication of a city as in *tauschschule-dortmund.de* (= *diving-school-dortmund.de*). These decisions will be discussed below.

Name rights and domain names

The plaintiff with the family name *Maxem* sued the proprietor of the domain name *maxem.de* based on his name right according to section 12 of the German Civil Code. The domain name owner argued that he

is using *maxem* as a pseudonym based and built on the first names of his grandfather, his father and himself (*Max*, *Erhardt*, *Matthias*). The defendant was active with this “pseudonym” in role-playing games in the internet.

The Court of Appeal decided against the plaintiff and founded its decision on the fact that there are many persons in Germany with the last name *Maxem* and that, therefore, a confusion with the plaintiff is not likely, adding that a civil name has no natural priority towards a pseudonym which can also enjoy name protection.

The Federal Supreme Court lifted this decision and granted the request of the plaintiff. First of all, a name right does not require that a concrete confusion actually occurred. The fact that a name owner cannot use a respective domain name with a .de TLD is considered as a violation of its name rights, if the domain name owner has no better right or at least a peer right to use the domain name. Furthermore, it was decisive in the case that a pseudonym requires not only use of a name as a pseudonym, but also a secondary meaning, comparable to an author or an artist publishing under this pseudonym or performing in public in order to enjoy name protection for the pseudonym. Since the established use of *maxem* on the internet by the domain name owner was not of this kind, the name was not considered as a protected pseudonym. Otherwise, the court explained, the established name

protection would be significantly impaired, in particular in view of the common use on the internet to act under a nickname or an alias. The Federal Supreme Court further confirmed that this injunction only covered the use of the domain name *maxem.de* including related e-mail addresses, but not necessarily the use of maxem in another form outside the internet.

Interestingly enough, the plaintiff still has no access to the domain name *maxem.de*, since this domain name was transferred during the proceedings through three instances to another person with the civil name *Detlef Maxem*. The plaintiff had failed to block the transfer of the challenged domain name with the German domain name authorities Denic by requesting a so called “dispute entry” with which the plaintiff declares to resolve the domain name issue with the current owner out of court, or in court based on better rights which must be briefly substantiated in the request. After the grant of such a dispute entry, the domain name owner can fully use the domain name for his web site or email traffic, but is prohibited from transferring the domain name until the dispute entry is valid. The dispute entry is valid for one year and can be extended if the plaintiff substantiates that the initiated proceedings or discussions with the current owner will last longer (which is usually the case). The practical lesson from this case is to never initiate court proceedings without having a granted and valid dispute entry concerning the domain name in question.

Generic domain names

The Federal Supreme Court has now granted its second decision in the field of unfair competition law after the milestone decision *mitwohonzentrale.de* (*housing-cooperative.de*). This decision allowed generic domain names in Germany, even if only one competitor can use such a domain name with a broad content, provided the circumstances of the case do not lead to deception of the consumer or if not (almost) all equivalents under other TLDs are blocked.

This recent decision was not issued with a substantiation, since the Federal Supreme Court denied a further appeal against a decision of the Court of Appeal Hamm concerning the domain name *diving-school-dortmund.de*, which is possible without a detailed

substantiation. By rejecting this further appeal, the Federal Supreme Court has nevertheless given an indication that it agreed with the decision of the lower instance.

The Court of Appeal had granted an injunction against the use of the domain name *diving-school-dortmund.de* on the basis of the Unfair Competition Law, since it was of the opinion that the course of trade will get the wrong impression considering this domain name as an indication for an extraordinary and very specific diving school in the German town Dortmund. The diving school in question was one of three diving schools in Dortmund without being bigger or better or more experienced.

The distinction between the decisions concerning *divingschool-dortmund.de* and the decision *housing-cooperative.de* must be seen in the further specification of the city by adding “-Dortmund”. This may cause a more specific consumer understanding than only the generic domain name “*diving-school.de*”. The decision is of general importance, since it clarifies that a concrete use of a domain name can be inadmissible only for the reason that it bears an inherent character of deception. Another reason for being considered as deceptive is the combination of the domain name with the related content on the website. The question whether the domain name alone or only the domain name seen in context with the website can be considered as deceptive is being heavily discussed in Germany. Many lawyers were of the opinion that the pure combination of a generic term with a geographical indication as the name of a city must be allowed in view of the prior case law of the Federal Supreme Court. There were, however, also other voices and decisions such as (in translation) attorney-hannover.de for a single law firm in Hanover, which was held inadmissible since the consumer supposedly expects an overview of lawyers admitted in Hanover (Court of Appeal Celle). Also the domain name “attorneys-dachau.de” for another single law firm in the little town of Dachau in Bavaria was prohibited (Court of Appeal Munich) for the same reason.

Despite the general message of this decision that only the domain name as such can be considered as deceptive in certain cases, the concrete finding in the present case can be disputed, since the singular of diving school in connection with the geographical indication *Dortmund* for one of the bigger cities in

Germany does not necessarily lead to an understanding that this diving school using the domain name is unique in comparison with other diving schools in this city.

Role of domain name authorities

A further, very recent decision of the Federal Supreme Court of February 2004 deals with the obligations of the German domain name authorities Denic. Although the substantiation of this decision is still not published, it is interesting enough to explain the main issues of this dispute.

The former president of the German state of Saxony, Kurt Biedenkopf, filed a complaint against Denic to obtain a judgement that Denic shall not be allowed to assign "his" domain name *kurt-biedenkopf.de* to another person than himself, whilst Mr. Biedenkopf himself was not interested in using this domain name for his own website. His request against Denic to block this domain name for all time was, however, denied in all three instances. The Dresden Court of Appeal held that this claim was, at least in the present case, not justified since it could not be excluded that another person with the name Kurt Biedenkopf can have a justified interest as good or even better than the interest of the former president Kurt Biedenkopf to use this domain name for his own purposes. It can be assumed that the Federal Supreme Court will confirm this reasonable argumentation in its substantiation to follow.

This decision relates to the fact that in the entire field of intellectual property in Germany the plaintiff is not obliged to get successfully attacked IP rights registered for himself, and nor do the patent offices have an obligation to consider prior court decisions granting injunctions against colliding trade marks of certain defendants, at least as long as the offices do not examine prior relative rights during the examina-

tion of the trade mark application.

The above decisions and several hundreds of other published decisions concerning domain name disputes in Germany show the very good working practice of German courts in line with traditional and, where necessary, adapted argumentation patterns known from trade mark/name law and Unfair Competition Law as well as the economic importance domain names still have. In particular the case *divingschool-dortmund.de* shows, however, that future case law must draw many more boundaries between admissible and non-admissible domain names in the field of unfair competition law.

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