

## DISPUTE RESOLUTION SERVICE

DRS 07666

### Decision of Independent Expert

Prelatura del Opus Dei Region de España

and

Dema Games Aps

#### 1. The Parties:

COMPLAINANT: Prelatura del Opus Dei Region de España  
Address: Diego de Leon 14  
MADRID  
Postcode: Madrid 28006  
Country: Spain

RESPONDENT: Dema Games Aps  
Address: Eskildsgade 18, 1.  
Copenhagen V  
Postcode: DK-1657  
Country: Denmark

#### 2. The Domain Name:

opus-dei.co.uk

#### 3. Procedural History:

On 26 August 2009 the Complainant filed the Complaint.

On 21 September 2009 the Response was filed by the Respondent.

On 20 October 2009 James Bridgeman was appointed as Expert.

On 6 November 2009, pursuant to paragraph 13 of the DRS Procedure the Expert issued an amended Procedural Order requesting additional information from the Parties. Additional Submissions were received from both Parties in response to the Expert's request.

#### **4. Factual Background**

The Complainant is a Roman-Catholic organization, founded in Spain in 1928. The Complainant first became established in Britain in December 1946.

The Complainant is the owner of CTM Registration No. 844.860 OPUS DEI (word), applied for on 8 June 1998 and registered on 13 December 1999 for classes 16, 38, 41 and 42.

The Respondent is the producer of a novelty card game named "Opus-Dei: Existence After Religion". The strategy based game is built around the world of philosophy, with absolutely no reference to the Complainant's organisation. The Complainant has sold approximately 2,000 "versions" of the game.

The Respondent relies on Danish registered trademark No. VR 2009 0158 OPUS DEI: EXISTENCE AFTER RELIGION (and device) registered in class 28 dated 15 January 2009, in the name of Mark Rees Andersen pursuant to Application No. VA 208 03896 filed on 2 October 2008.

The disputed domain name was registered on 4 January 2008.

On 25th March 2009 the Complainant filed Opposition to said Danish trademark application n° VR 2009 0158.

#### **5. Parties' Contentions**

##### **The Complainant's Submissions**

The Complainant submits that it has been active in Britain since 1946. It is presently involved in educational activities in Britain that provide assistance to the underprivileged and immigrants, while developing an awareness of the value of service among the participants. The Complainant submits that it has established a centre in Brixton, South London, where it carries on valuable social work with

women and girls of ethnic minorities. In Manchester, Glasgow and London, a programme called "ReachOut!" gathers together a number of volunteers, who work for a few hours every week with children from disadvantaged backgrounds. "GOAL" (Get-On-And-Learn) is another project that has run for a number of years in Hackney, London.

The Complainant states that in response to worldwide publicity about and interest in the Complainant, Channel 4 showed a television programme in December 2005 which featured many members of the Complainant, mainly from Britain and the US, going about their ordinary lives and talking about different aspects of their vocation.

The Complainant has registered OPUS DEI as a trade mark before the UK Trade Marks Registry and the Community Trade Mark Office (Office for Harmonization of the Internal Market). In order to protect its OPUS DEI trademark, the Complainant's parent company Scriptor, S.A. has registered Community Trade Mark OPUS DEI, registration numbers N E844860 and 1539036.

In order to further protect its various marks, such as "OPUS DEI", and to facilitate any users' ability to locate the sites on the worldwide web, the Complainant registered numerous domain names including <opusdei.co.uk>, <opusdei.org.uk>. The Complainant operates its business on the Internet through a number of websites including <www.opusdei.com>, all of which allow the Complainant to reach clientele across a wide geographic area.

The Complainant submits that the disputed domain name <opus-dei.co.uk> is identical, or confusingly similar, visually, phonetically and conceptually to the registered trademark in which the Complainant has rights as it is the same as the Complainant's OPUS DEI mark, save for the addition of the hyphen.

The Complainant submits that the Respondent has no rights or legitimate interest in respect of the domain name. The disputed domain name <opus-dei.co.uk> resolves to a website containing games and links to all sorts of other websites providing Respondent's goods and services

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's OPUS DEI mark as the two are almost identical. It is obvious that the Respondent has registered the domain name identical or confusingly similar to the Complainant's mark, name and domain names, for the sole purpose of trading on the goodwill associated with these and misleading the public into believing that the Respondent is the Complainant.

The Complainant submits that the particular combination of the words "opus" and "Dei" appears to have been first used by Respondent in registration of this domain name.

The Complainant submits that when a domain name incorporates a distinctive mark in its entirety, this creates sufficient similarity between the mark and the domain name to render it confusingly similar.

The Complainant submits that its OPUS DEI mark and its services are famous. Persons familiar with the Complainant's products and services are likely to conclude that the disputed domain name is simply an extension of the Complainant's activities. In view of the fame of the Complainant's marks and the lack of distinctiveness afforded by the simple addition of non-distinctive or descriptive material, the domain names are misleading.

Due to the Complainant's reputation, the unauthorised use by the Respondent of the OPUS DEI mark in conjunction with the website constitutes representations that:

- the Respondent and its services are somehow connected to the Complainant or its members;
- the Respondent has the authority of the Complainant to use the OPUS DEI trademark and to conduct the services that it is providing on the website under that trademark;
- the Respondent has the approval of, or an affiliation with, the Complainant;
- the services provided by the Respondent are of a particular standard and quality that the Complainant's customers have come to expect as services provided by the Complainant's members.

By adopting the contested domain name, the Respondent is seeking to benefit from the goodwill of the Complainant and pass itself off as a business of the Complainant or its licensees or affiliated with the Complainant.

The Complainant submits that the disputed domain name is an Abusive Registration because:

- the registration of the disputed domain name and its subsequent use, continues to take unfair advantage of, and was and continues to be unfairly detrimental to the Complainant's rights;
- the Respondent has no connection with the Complainant and no legitimate reason for registering the domain name;
- the Respondent's registration of the domain name can only have been in order unfairly to disrupt the Complainant's business;
- the Respondent's use of the domain name will inevitably have confused Internet users into believing that the domain name is in some way connected with the Complainant;
- the Respondent is not entitled to legitimately trade under the OPUS DEI trade name.

The Complainant submits that it can be therefore assumed that the Respondent acquired the contested domain name:

- to prevent the Complainant from reflecting its trademarks in a corresponding domain name;
- to disrupt the business of the Complainant;
- to establish a website and attract for commercial gain, Internet users to the website or other on-line location by creating a confusion with the Complainant's mark;
- to sell the contested domain name to a competitor of the Complainant;  
or
- to sell the domain name to the Complainant for valuable consideration in excess of the costs incurred in acquiring the contested domain name.

The Complainant submits that the difference between the disputed domain name, and the Complainant's website address <www.opusdei.co.uk> is so minor that a consumer seeking the Complainant's website could easily misspell or simply incorrectly remember the Complainant's name and mark.

The Complainant submits that confusion is inevitable as a result of such similarity. The Respondent's registration and use of the disputed domain name is so inherently likely to cause confusion among Internet users searching for the Complainant that it cannot constitute a *bona fide* offering of goods or services nor can it constitute a legitimate non-commercial or fair use of the disputed domain name.

The common experience of mis-typing any entry using a keyboard, especially when trying to type a word from memory, leads to the conclusion that it would be an easy and very likely mistake for users of browser software to type in opus-dei.co.uk when seeking opusdei.co.uk, adding an extra "hyphen".

The Complainant submits that the Respondent's activities:

- (a) risk misleading/offending Complainant's customers to the Complainant's detriment; and
- (b) may risk diverting business from the Complainant by the unlawful use of the Complainant's trade marks to link to third party sites.

The Complainant submits that the Respondent must have had the Complainant in mind when registering the disputed domain name. The Complainant submits that although the Respondent has no rights or legitimate interests in the disputed domain name, the Respondent obviously knows about the Complainant's activities, services and products and it is as a consequence obvious that the Respondent is familiar with the Complainant's trademark.

The Complainant has not consented to the Respondent's use of the disputed domain name. The Respondent has no connection or affiliation with the Complainant and has not received any license or consent to use the OPUS DEI

mark in a domain name or in any other manner. The Respondent is not commonly known, as an individual, business, or other organization, by any product or service related with the term "OPUS DEI" alone or combined with the denomination of the products or services that it could eventually offer in the market. The Respondent is not known in the market with the name OPUS DEI. The Respondent has no relationship with, license from or specific permission from the Complainant for the use of the OPUS DEI mark. The Respondent's bad faith registration and use of the disputed domain name is evident from the diversion of Internet traffic intended for the Complainant's websites.

The Complainant cites the decision of the Court of Appeal, in its leading judgment in the "One In A Million" case (British Telecommunications plc & Others v. One In A Million Limited & Others, [1999] FSR 1), which it submits condemned the practice of misappropriating trade marks and names in which other parties have rights and registering them as domain names. Such practices have consistently been confirmed as unacceptable in many, many subsequent cases, and in many DRS Decisions.

The Complainant submits that in the case of distinctive household names, the Court of Appeal considered that making an unauthorised registration of a domain name corresponding to such distinctive names could amount to a misrepresentation in itself. In such cases, the use of such domain names would inevitably mislead and amount to passing-off.

The Complainant submits that the disputed domain name was registered and has been used in bad faith. Because of the international notoriety of the Complainant's trademark OPUS DEI and the Complainant's OPUS DEI sites, the Respondent would have been fully aware of the Complainant's rights and reputation prior to the registration of the disputed domain name and was in any event on constructive notice of the trademark registrations and other domain name registrations.

In its additional submissions requested by the Expert, the Complainant submits that it became aware of the disputed domain name registration and the following Danish trademark registrations at the same time:

Community Trademark application No. 7.284.953 OPUS DEI: EXISTENCE AFTER RELIGION (and device), in class 28, in the name of Mark Rees Andersen which became abandoned due the lack of payment of the filling fees;

Trademark application in Denmark No. VR015809 OPUS DEI: EXISTENCE AFTER RELIGION (and device), in class 28, in the name of Mark Rees Andersen.

In view of the above, on 25th March 2009 the Complainant filed Opposition to the Danish trademark application n<sup>o</sup> VR015809. After having requested an extension of term to provide arguments and evidences, the Opposition was

fulfilled on 15 September 2009. The opposition is based on CTM Registration No. 844.860 OPUS DEI (word), applied for on 8 June 1998 and registered on 13 December 1999 for classes 16, 38, 41 and 42. This registration claims seniority in Denmark, Benelux, Germany, Spain, France, United Kingdom, Greece, Ireland, Italy and Portugal. In order to extend the protection to class 28, the opposition is based on the notoriety of CTM nº 844860 OPUS DEI for religious services.

In its grounds for opposition, the rejection of trademark application VR 2009 00158 is requested due to the existence of the mentioned CTM registration in the name of the PRELATURA DEL OPUS DEI, REGION DE ESPAÑA.

### **The Respondent's Submissions**

The Respondent refutes the Complainant's claim and states that it duly registered the disputed domain name <opus-dei.co.uk> in the autumn of 2008, filing valid contact details and otherwise in accordance with Nominet UK rules and regulations.

The Respondent's web site established at the <www.opus-dei.co.uk> address includes explanations of the game's rules and the philosophy behind the game, as well as how to acquire the game directly from the web site. The disputed domain name has been in use to this effect prior to the Complaint and is thus used in connection with a genuine offering of goods. The card game is commonly known by the domain name registered.

The Respondent is the owner of the Danish Trademark Registration, VR 2009 00158, "Opus-Dei: Existence After Religion" (figurative mark) for class 28, which covers novelty card games. The Complainant is thus legitimately connected with a mark similar to the disputed domain name, i.e. hyphenated "Opus-Dei".

The Respondent submits that the disputed domain name opus-dei.co.uk must be considered as generic or descriptive in the context in which it is used. As a well known fact, the two Latin words in the phrase "*opus dei*" mean "work of god." These two words and the concept of "*opus dei*" are commonly known, without relation to the Complainant. The Respondent has included the words "*Opus-Dei*" in the name of the card game only in its limited meaning in the Latin language.

Furthermore the Respondent states that "the word 'Opus' is also commonly used to describe works of art (traditional works of art, games and software) to imply the significant artistic effort used for the creation hereof. (*sic*)"

The Respondent claims to have a legitimate interest in the disputed domain name. The Respondent's rights in the Danish Trademark "Opus-Dei: Existence after Religion" do not conflict with any rights held by the Complainant.

The Respondent submits that it is making fair use of the disputed domain name. The disputed domain name has not been registered for the purpose of selling the disputed domain name to the Complainant or otherwise for the purpose of disrupting the business of the Complainant, but has been registered in connection with a genuine offering of goods to which the Respondent has trademark rights; namely a strategic card game.

Addressing the rights relied upon by the Complainant, the Respondent submits that the trademark rights registered by the Respondent are limited to Class 28, which includes games and toys, and explicitly also novelty card games ("Specialkortspil"). The Complainant does not have rights in said class and none of the trademark classes covered by the Complainant's registrations concern a product identical to that of the Respondent.

The Respondent submits that Section 3, Article 15, of the Community Trademark Council Regulation (EC) no. 40/94, states that if an owner of a Trademark wishes to call for protection rights with regard to a product type, that specific legal person must have produced and/or sold that type of product within the last 5 years. Thus, even if the Complainant had protection rights within Class 28, infringement would require that the Complainant had produced or sold a novelty card game within the last 5 years to the date of registration. The Complainant had once had a legitimate trade mark in Denmark, but this expired without renewal in 1996.

The Respondent submits that the Complainant's mark cannot be considered distinctive or famous. Only marks of undisputed distinctiveness are considered to fall within that category. It has in no way been substantiated by the Complainant that their mark is of such character. On the contrary the mark is a religious term used widely in various contexts, e.g. a priest's sermon is commonly referred to as "Opus Dei", to mention just one example.

The Respondent denies that the disputed domain name is confusingly similar to the Complainant's trademark registrations.

The Respondent refers to its website to which the disputed domain name opus-dei.co.uk resolves and states that in the first line of the description of the game it is clearly stated that "Opus-Dei: Existence After Religion™ is an atheist-themed game (with no affiliation with the Catholic organisation, "Prelatura del Opus Dei") [...]", effectively eliminating any risk of confusion.

It is obvious from the Respondent's web-site that products sold are not in any way connected to the Complainant's organisation. On the contrary it transpires from the web site that the product sold is a card game with a theme relating to philosophy and science. It is unlikely that any consumers seeking the Complainant's religious services would acquire the Respondent's product and thus the Respondent will have no advantage of any users related with the Complainant entering its web site.



The Complainant's name has an introductory element "Prelatura del" which cannot be considered to be commonly known, and further distinguishes the Complainant from the disputed domain name.

The Respondent submits furthermore that the inclusion of a hyphen in the disputed domain name is relevant in this context: The very meaning of "*opus dei*" changes with the addition of the hyphen, from "work of god" to "god-work", the first conveying the meaning of an actual labour of god (implying one god; the context of the action itself in past tense), the latter conveying the meaning of a work fit for or requiring a god for its labour.

The Respondent submits that the decision of the Court of Appeal in the "One in a Million" case is not instructive in this case. The holder of the domain name in "One in a Million" was a dealer in domain names - registering and selling them. Unlike the circumstances in the "One in a Million" case the disputed domain name held by the Respondent is not identical to a distinct and well known name, and the Respondent has not been engaged in a pattern of abusive registration of domain names. In this case the disputed domain name is not intended for use in a fraudulent way.

The Respondent cites the decisions in DRS 03022, where the Respondent submits there was not found to be an abusive registration; DRS 03294, where the Respondent submits the parties operated in different fields and where trademark infringement was alleged; and DRS 02802, where the Respondent submits the registered name was found to be generic. The Respondent additionally submits, without expansion or giving any explanation for its submission, that the decisions in DRS 06286, DRS 06567, DRS 06788, DRS 06832 and DRS 06985 support its case.

The Respondent submits that its card game "Opus-Dei: Existence After Religion" is dubbed "The World's FIRST atheist card game!" on the very first (index) page of the site, which also furthermore clearly expresses that there is "no affiliation with the catholic organisation, 'Prelatura del Opus Dei'" in the very first paragraph. To confuse the very fundamental religiosity of the Complainant with an atheist card game is not only unlikely, but impossible due to the latter disclaimer quoted above, which has been present on the site from its very beginning.

Furthermore, it must be stressed that the Respondent's trademark was legally registered and approved by the correct and official governmental trademark authority (that also adheres to EU community trademark law) and thus should be enough to uphold the rights to a .co.uk domain. Any dispute regarding the trademark will of course have significance if it should result in favour of the Complainant, but only in that circumstance. Since the Latin concept "*opus dei*" (lat. "Work of God") is very likely a public domain phrase (used on a daily basis by scholars and priests, also other than catholic priests), it is unlikely that the

Complainant will win its case. This is furthermore underlined by the fact that the two trademarks are registered in two distinctly different trade mark classes.

The Respondent concludes (i) it has legitimate interest in the disputed domain name, (ii) it is using the disputed domain name in connection with a genuine offering of goods, (iii) it is the owner of a trademark including the words of the disputed domain name, (iv) the disputed domain name must be considered generic and indistinctive, (v) the disputed domain name is not covered by any rights registered by the Complainant, (vi) the disputed domain name has not been registered in order to confusingly attract consumers, (vii) and there is no risk of confusion. The Respondent submits that therefore, the registration of the disputed domain name cannot be considered an infringement of the Complainant's rights.

At the request of the Expert, the Respondent furnished a copy of the game to the Expert and to the Complainant.

In Additional Submissions requested by the Expert the Respondent denied that it had prior knowledge of the Complainant and their trademark before applying to register the OPUS-DEI: EXISTENCE AFTER RELIGION trademark. The Respondent claims that it first came across the Latin concept "Opus Dei" (Work of God, also translated as such) in reading Dan Brown's The Da Vinci Code and believed it to be a fictitious organisation, as the book was clearly a work of fiction. The Complainant is not established in Denmark. The best testament to the fact that the Respondent had no knowledge of the Complainant's existence and is not trying to infringe upon or take advantage of the Complainant's reputation, is the fact that there is not even a hint of any mention of the Complainant organisation within the game. Catholicism as a concept in itself is not mentioned at all, and thus in no way being made fun of. The game, in one aspect, only wishes to display the exploitative activities of cult-like religious movements.

The Respondent submits that the Complainant does not have any trademark registration for a novelty card game. There is a specific legal difference of categories between normal "Playing Cards" and a novelty card game. Novelty card games belong to the general class of toys and games (Class 28), and normal/generic "Playing Cards" belong to the general class of paper products (Class 16). The Respondent submits that its trademark application is definitively not in conflict with any of the Prelature's classes, namely: Class 16, 38, 41 or 42.

## **6. Discussions and Findings**

Paragraph 2.a of the DRS Policy provides that a Respondent must submit to proceeding if a Complainant asserts to us, according to the Procedure, that:

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Paragraph 2.b of the DRS Policy provides that the Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

An Abusive Registration as defined in paragraph 1 of the DRS Policy means a domain name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

Paragraph 4 of the DRS Policy sets out how a Respondent may establish that a registration is not abusive and provides a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration including at paragraph 4.a.i,A: "Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has...used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services..."

## **Identical or Similar**

The disputed domain name <opus-dei.co.uk> is clearly very similar to the Complainant's OPUS DEI trademark.

There is no distinction between the disputed domain name and the Complainant's trademark except for the addition of the hyphen and the .co.uk ccTLD extension. It is well accepted that the ccTLD extension may be ignored for the purposes of making the comparison. The additional hyphen element does not serve to distinguish the disputed domain name from the Complainant's trademark in any way.

The Complainant has therefore succeeded in the first element of the test in paragraph 2.a of the DRS Policy.

## **Abusive Registration**

The question of whether the disputed domain name was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, must in this case, turn on the question as to whether the Respondent had the right to adapt and use the words OPUS DEI as the dominant element of a trademark for a novelty card game.

This issue is in dispute in another forum namely the Danish Trademarks Registry.

In applying the DRS Policy to this Complaint, in the view of this Expert, two issues are particularly pertinent, namely whether a Respondent can rely on rights that appear to be exclusively outside of the United Kingdom and secondly whether the Respondent intentionally targeted the Complainant's goodwill and reputation.

In DRS 02802 RuggedCom.Inc. v Lanstore Inc. 1 February 2006, the Appeal Panel appears to have accepted that the Complainant satisfied the first limb of the test notwithstanding that its rights and reputation seem to have existed only in Canada and the USA. On that basis it would appear that a Respondent should be able to equally rely on non-United Kingdom rights.

As to the Respondent's intention, the Appeal Panel in DRS 04149, Playboy Enterprises International Inc -v- Trevor Hughes, 29 March 2007 stated at paragraph 8.17 of the decision that "[w]hile the Panel is prepared to accept that the Respondent did not intend to trade off the Complainant's goodwill in any way, his intention is not a determinative issue. In the Panel's view, the Expert placed too much emphasis on the Respondent's lack of intention to target the Complainant in the first instance decision. Although evidence of what can conveniently be referred to as "abusive intent" can be helpful to demonstrate that a Domain Name is an Abusive Registration, it is not a necessary ingredient. The test is more objective than that, and can be summarised as follows: in the light of the strength of the Complainant's Rights and the similarity of the Domain Name to the name in respect of which those Rights exist, has the registration and/or use of the Domain Name by the Respondent taken unfair advantage of or been unfairly detrimental to those Rights? Since the burden of proof is "on the balance of probabilities", it is not necessary to find actual unfair advantage or unfair detriment; the likelihood that either or both of these ingredients will arise is sufficient."

In the view of this Expert, while in many cases a respondent's state of knowledge can be an indicator of an Abusive Registration, in the present case the Respondent's claim not to have been aware of the existence of the Complainant is not central to the issue. The central issue is whether the Respondent is entitled to adapt and use the words "*opus*" and "*Dei*" as a trademark for a novelty card game.

On the evidence before this Expert, the Danish registered trademark No. VR 2009 0158 OPUS DEI: EXISTENCE AFTER RELIGION (and device) registered in class 28 dated 15 January 2009, has been registered in the name of Mark Rees Andersen pursuant

to Application No. VA 208 03896 filed on 2 October 2008. The Respondent claims to have the right to use this mark. At the request of this Expert, the Respondent has furnished this Expert with evidence of its card game and has provided evidence of its sales. While those sales are quite limited in number, they appear to be genuine.

In the circumstances the Respondent has raised a credible defence that it has rights in the domain name based on its ownership of the Danish trademark registration and furthermore based on paragraph 4.a.i,A of the DRS Policy that “[b]efore being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has...used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services...”

In the view of this Expert the Complainant has failed to meet the burden of proof required by paragraph 2 b of the DRS Policy.

It may be possible for the Complainant to succeed in a future application in the event that it is successful in its proceedings before the Danish Trademark Registry but on the evidence before this Expert in the present proceedings, given the limited nature of the jurisdiction of the DRS Policy, this Complaint must fail.

## **7. Decision**

The Complainant has failed to prove that the Respondent’s registration of the disputed domain name is an Abusive Registration and the Complainant’s application is refused.

**Signed: James Bridgeman**

**Dated: 17 December 2009**