

(iii) Prae Artiëstenverloning was established in 2011. The website on which Prae Artiëstenverloning offers its services, is accessible via the domain name "www.artiëstenverloning.nl".

(iv) In a verdict in interlocutory proceedings of 15 September 2011 on a claim of Artiëstenverloningen, Prae Artiëstenverloning was ordered by the District Court to cease and desist every further use of the domain name "artiëstenverloning.nl". This judgment was overturned by the Court of Appeal.

3.2 In these proceedings on the merits, Artiëstenverloningen again seeks an order against Prae Artiëstenverloning to cease and desist every use of the domain name "artiëstenverloning.nl". The basis for this claim of Artiëstenverloningen is, insofar as relevant on further appeal, that Prae Artiëstenverloning is acting unlawfully by using the term "artiëstenverloning.nl" as a domain name as this domain name can be confused with the older trade and domain name of Artiëstenverloningen.

3.3 The District Court initially granted the claim, but the Court of Appeal then denied it. The higher Court substantiated its decision as follows:

The terms "artiëstenverloning(en)" are merely descriptive of the services offered by Artiëstenverloningen and Prae Artiëstenverloning. The use of a merely descriptive domain name, as a result of which there is confusion or a likelihood of confusion with the (older) trade name and/or domain name of someone else, is in principle not unlawful, even when that use is detrimental to the other user. Additional, sufficiently compelling circumstances could mean that that principle would not apply. According to the statements made by both parties, however, none of those circumstances are evident in this case. The fact that Prae Artiëstenverloning has deliberately chosen this merely descriptive domain name does not constitute such a circumstance.

3.4.2 The use of a trade name is regulated by the Dutch Trade Names Act (*Handelsnaamwet* ("Hnw")). Insofar as users of a trade name are not protected by this Act, in particular as a result of the fact that this Act only protects the user of a trade name against the use of the same or a similar denomination as a trade name (Art. 5 Hnw), they can benefit from the additional protection granted by the legal provisions of Art. 6:162 BW [Dutch Civil Code] in tort against the later use of the same or a similar denomination that is confusing, such as a domain name ...

3.4.3 The right to a domain name is not legally regulated. Rightholders are protected against the use, by someone else, of the same or a similar domain name of a later date if that use is unlawful with respect to the rightholder or if there is a contractual basis for protection. The use of a denomination similar to a domain name may be unlawful as well if there is the possibility of confusing the two.

3.4.4 According to the uncontested decision of the Court of Appeal the terms 'artiëstenverloning(en)' are merely descriptive of the services that both Artiëstenverloningen and Prae Artiëstenverloning provide. As, in principle, it should be possible for anyone to use a term that is descriptive of their goods or services, in a domain name too (regarding Art. 5 Hnw: compare the judgment of the Dutch Supreme Court of 8 May 1987, ECLI:NL:HR:1987:AG5592, NJ 1988/36 – Bouwcentrum), the use of a merely descriptive term in a case such as this, even when confusing, is only unlawful if there are additional circumstances which render it so.

3.4.5 Following the considerations referred to in recitals 3.4.2-3.4.4, the Court of Appeal did not make any error of law, nor are its findings incomprehensible or inadequately substantiated.

...

4 Ruling

The Supreme Court dismisses the action.

Anmerkung von Dirk Visser*

On 11 December 2015 the Dutch Supreme Court issued an interesting judgment on trade and domain names (Supreme Court 11 December 2015, ECLI:NL:HR:2015:3554). The owner of the Dutch domain name *www.artiëstenverloningen.nl* had sued the owner of the very similar domain name *www.artiëstenverloning.nl*. The domain names had been registered by two different companies, both of which pursue a business in payroll administration for and on behalf of performers (the term 'artiëstenverloning (en)' literally translates to 'performers' payroll administration(s)').

The District Court had granted the application for an order to cease and desist the use of the newer domain name. The Court of Appeal, however, overturned that ruling. According to the higher Court, the domain names *www.artiëstenverloning(en).nl* are merely descriptive of the services offered by both companies. The use of a merely descriptive domain name, as a result of which there is confusion or a likelihood of confusion with the (older) trade name and/or domain name of someone else, is in principle not unlawful, even when that use is detrimental to the other user. Additional – sufficiently compelling – circumstances could mean that that principle would not apply, but apparently none of those circumstances were evident in this case.

The Supreme Court reaffirmed the view that the terms 'artiëstenverloning(en)' are merely descriptive of the services that both parties provide, stating that "in principle, it should be possible for anyone to use a term that is descriptive of their goods or services, in a domain name too". Nothing new so far, but what makes this case interesting is that in its ruling the Supreme Court referred to another Supreme Court decision regarding trade names (Supreme Court, 8 May 1987, ECLI:NL:HR:1987:AG5592 – Bouwcentrum), continuing that "the use of a merely descriptive term in a case such as this – even when confusing – is only unlawful if there are additional circumstances which render it so".

By referring to the Supreme Court's trade name decision of 1987, it inferred that it had already decided, in 1987, that the use of a merely descriptive trade name, even when confusing, is not unlawful. However, according to D.W.F. Verkade in his annotation on the current Supreme Court judgment, a close reading of the judgment of 1987 points to the fact that in that ruling confusion was not an issue. But by referring to that decision, the Supreme Court is apparently now of the opinion that confusion or the risk of confusion is not enough in the case of highly similar, yet merely descriptive, domain names and trade names. As a result of this judgment it is quite likely that additional circumstances are required in both situations.

In his Opinion, Advocate General Van Peursem concluded that the legal assessment criterion should be whether confusion is caused needlessly. Although the Supreme Court did not adopt this in its final judgment, it is possible that this 'needlessly caused confusion-criterion' will be regarded as one of the additional circumstance(s) when dealing with merely descriptive trade names.

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