

DECISION OF THE THIRD-PARTY DECIDER

Case 44421: glashuette-original.be

1. Parties

- 1.1. The complainant: **Glashütter Uhrenbetrieb GmbH**, having its principal place of business at Altenberger Platz, 1, 01768 Glashutte, Germany,

Hereafter “*the Complainant*”,

Represented by Mr. Steven M. Levy, Esq., attorney at law, 301 Fulton Street, Philadelphia, Pennsylvania 19147, US,
- 1.2. Domain name holder: Mr. **Zhao Ke**, Weihai Rd. 655, 200041 Shanghai, China,

Hereafter “*the Domain name holder*”,

2. Domain Name

The disputed domain name is: glashuette-original.be (hereafter “*the Domain name*”), registered 26 November 2014.

3. The procedure

On 1 February 2017 the Complainant filed its complaint in the present procedure, requesting that the Domain name be transferred to the Complainant.

The Domain name holder did not file a rebuttal.

The Complainant offered the possibility to the Domain name holder to voluntarily transfer the Domain name within 7 calendar days as from the filing of the Complaint. The file does not show any reaction from the Domain name holder to such offer.

The Third-Party Decider was appointed on 14 March 2017. The deliberations were closed on 21 March 2017.

The Complainant declared that no other legal proceedings have been commenced or terminated in connection with or relating to the Domain name.

4. Facts

4.1. The Complainant designs, manufactures and commercializes luxury wristwatches.

The Complainant is the owner of the known “*Glashütte Original*” watch brand and trademark. The Complainant promotes the watches on its website “*Glashuette-Original.com*”, and uses the trademark on social media and on the internet in general. The Complainant regularly promotes its watches with the “*Glashütte Original*” mark at conferences, festivals and other events. The Complainant has obtained several trademark registrations in protection of “*Glashütte Original*”, and files in the present litigation the related certificates.

Although “*Glashütte*” refers to a town in Germany, where fine watchmaking has a long history, the trademark “*Glashütte Original*” is highly distinctive of the Complainant and the watches that it designs, manufactures and commercializes.

4.2. The Domain name is used by the Domain name holder on a pay-per-click website containing references to several watch marks used by competitors of the Complainant.

5. Elements of evidence

According to Article 10, b, (1) of the Terms and conditions for .be domain name registrations, the Complainant has to assert and to prove that:

- i) the Domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and
- ii) the Domain name holder has no rights or legitimate interests in the Domain Name; and
- iii) the Domain name holder’s Domain name has been registered or is being used in bad faith.

6. Position of the parties

6.1. Position of the Complainant

The Complainant considers that all conditions provided for in Article 10, b) (1) of the Terms and conditions for .be domain name registrations are fulfilled.

6.1.1. The Domain name is identical or confusingly similar to the Complainant’s trademark

The Complainant considers that the Domain name is identical or confusingly similar to its trademark and corresponding logo.

The omission of the *umlaut* in the word “*Glashütte*” with addition of an “*e*”, according to the Complainant, is irrelevant in this case: the “*ü*” (with the *umlaut*) as shown in

the mark is difficult if not impossible to use for domain names and the replacement in such a case of the “ü” by “ue” is common in the German language. The Complainant itself uses the “ue” for its domain name “*Glashuette-Original.com*”.

The Complainant refers to other decisions whereby the concerned domain names have been found confusingly similar to the Complainant’s trademark. It concerns the following domain names: “*glashuette-original.watch*”, “*glashuette-original.kaufen*” and “*glashuette-original.nl*”.

Furthermore, the Complainant considers that the addition of the suffix “.be” is not relevant for establishing the similarity between the Domain name and the Complainant’s trademark. The reference to the country code does not exclude the similarity since this only refers to the geographical extension and origin of the website. The Complainant refers to other decisions on this subject matter. Finally, the Complainant considers that also the addition of a hyphen between words is irrelevant, again with reference to other decisions on the same issue.

6.1.2. The Domain name holder has no rights or legitimate interests in the Domain name

The Complainant considers that the Domain name holder has no rights or legitimate interests in the Domain name: the Domain name holder would not be using the Domain name *bona fide*, since the Domain name would be used for a website which diverts customers of the Complainant to its competitors. Again, the Complainant is referring to past decisions, including decisions that would show that the Domain name holder has a pattern of abusing trademarks in domain names.

The Domain name holder is not commonly known by the Domain name or the name “*Glashütte Original*”, and does not operate any business under this name. The Domain name holder’s use of the Domain name is not a fair use; consumers think that they are visiting a site of the Complainant and instead this site links to competitors of the Complainant, for similar products.

The Complainant considers that the use made by the Domain name holder of the Domain name tarnishes and dilutes the Complainant’s trademark, since such use would diminish the consumers’ capacity to associate the Complainant’s mark with its quality products and services, and would associate the Complainant with other products and services over which it does not have control.

6.1.3. The Domain name has been registered or is being used in bad faith

The Domain name, according to the Complainant, has been registered by the Domain name holder for the purpose of preventing the Complainant from using the related domain and to create confusion with the Complainant’s trademark.

The Domain name holder according to the Complainant obtains click-through fees and other revenue from visitors who click on the links.

Finally, the Complainant files correspondence showing an attempt from the Domain name holder to sell the Domain name to the Complainant, from which the Complainant also deduces that the Domain name holder uses the Domain name in bad faith.

The Complainant refers to the Domain name holder as “*a serial cybersquatter*”, showing a pattern of bad faith registration of domain names that are confusingly similar to trademarks in which the Domain name holder has no rights. The Complainant thereby refers to 23 other cases brought against the Domain name holder.

6.2. Position of the Domain name holder

An excerpt of a search within the DNS BE WHOIS database conducted by the Complainant shows that the Domain name was registered on 26 November 2014 with reference to the Domain name holder as onsite contact and the email address “ruochang@gmail.com” for the registrant.

The Domain name holder has not replied to the Complainant’s complaint.

7. Discussion and conclusions

7.1. The Domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Complainant files certificates of registration of its trademark “*Glashütte Original*” (certificates of registrations of EU trademarks of 16 February 1999, 7 November 2000, 27 November 2006, all clearly dating from before the registration of the Domain name).

The Complainant also files a number of documents that evidence the regular use by the Complainant of such trademark, for luxury watches designed by the Complainant, manufactured and /or commercialized by the Complainant. The Complainant refers to the website of its group companies, the Swatch Group, its own website www.glashuette-original.com, the use of its trademark in its local shop in Dresden, Google images of the watches that it designs, the Wikipedia entry for “*Glashütte Original*”, the use of its trademark on Youtube, the use of its trademark on Facebook, the use of its trademark at the occasion of festival sponsorships and other partnerships. The Complainant thus evidences that it has rights, in the EU and hence in Belgium, in the trademark “*Glashütte Original*”.

The Domain name is confusingly similar to the Complainant’s trademark.

As invoked by the Complainant, it is indeed common in the German language to replace the *umlaut* on the “*u*” by the letter “*e*” for online communication. The letters “*ü*” and “*ue*” therefore in those circumstances can be considered “*identical*”, and in any case “*confusingly similar*”, as referred to in Article 10 b) (1), i) of the Terms and conditions for .be domain name registrations.

Furthermore, the suffix “.be” can indeed be considered as irrelevant for determining the similarity between the Domain name and the trademark of the Complainant (cf. a.o. CEPANI case n° 44202, Ryanair Ltd./ Lilli Karizama; CEPANI case n° 44018, JT international Company Netherlands B.V. / Amstel Meer Land B.V.), such as is the case for the addition of a hyphen.

7.2. The Domain name holder has no rights or legitimate interests in the Domain name

Pursuant to Article 10, b) (3) of the Terms and conditions for .be domain name registrations, the Domain name holders' rights or legitimate interests in the Domain name can be demonstrated by the following circumstances:

- *Prior to any notice of the dispute, the Domain name holder used the Domain name or a name corresponding to the Domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or*
- *The domain name holder has been commonly known by the Domain name, even if he has no trademark; or*
- *The Domain name holder is making a legitimate and non-commercial or fair use of the Domain name, without intent to misleadingly divert consumers or to tarnish the trademark (...) at issue.*

In the absence of a reply or of the filing of any evidence of the existence of rights or legitimate interests, the Domain name holder does not show neither explain that it has such rights or interests.

The contrary can be deduced from the file as submitted by the Complainant.

The file shows that the Domain name holder does not use the Domain name in connection with a bona fide offering of goods or services: the file shows the history of cybersquatting of the Domain name holder, a similar use of the Domain name on the concerned website where, as indicated by the Complainant, the consumers are diverted to websites of competitors of the Complainant, and shows that the Domain name holder wanted to sell the Domain name to the Complainant thereby itself taking the initiative.

There is no evidence whatsoever that the Domain name holder would be commonly known by the Domain name. It has not been established that the Domain name holder is making a legitimate non-commercial use of the Domain name, on the contrary, given the use on a pay-per-click website diverting consumers and the offer to sell.

It can thus sufficiently be deduced from the file submitted by the Complainant that the Domain name holder has no rights or legitimate interests in the Domain name.

7.3. The Domain name has been registered or is being used in bad faith

Article 10, b), (2) of the Terms and conditions for .be domain name registrations enumerates in a non-exhaustive way a number of circumstances by which the Complainant can demonstrate that the Domain name holder registered or uses the domain name in bad faith.

Bad faith can be evidenced by any means including presumptions and other evidence showing, with a reasonable degree of certainty, the existence thereof (cf. e.g. CEPANI case n° 44202, Ryanair Ltd./ Lilli Karizama; CEPANI case n° 44019, Verfaillie Bauwens BVBA/ Stichting Juridisch Eigendom Domeinen).

Given the notoriety of the Complainant's trademark in the concerned sector, it is improbable that the Domain name holder at the moment of registration of the

Domain name was unaware of the Complainant's rights. It appears from the file that it is likely that the Domain name holder registered the Domain name, and is using the Domain name, to obtain a commercial advantage, namely by attracting, for commercial gain, visitors that are diverted to other websites. This is further confirmed by the offer to sell that the Domain name holder made to the Complainant, as well as by the Domain name holder's history of cybersquatting.

By registering the Domain name, the Domain name holder furthermore had to know that the Complainant would be prevented from registering the same, whereas consumers that would be looking for the Complainant's products and services would be diverted to websites of competitors of the Complainant.

From the above, it can be concluded that the Domain name was registered and is being used in bad faith as referred to in Article Article 10, b), (1), iii) of the Terms and conditions for .be domain name registrations.

8. Decision

In accordance with Article 10, e) of the Terms and conditions for .be domain name registrations, the Third Party Decider decides to order the transfer to the Complainant of the Domain name "glashuette-original.be".

Brussels, 4 April 2017.

Catherine ERKELENS

The Third-Party Decider