

BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

## DECISION OF THE THIRD-PARTY DECIDER

**BELFIUS BANK / PiratePoint Ltd**

**Case no. 44431 : privatebanking-belfius.be**

### 1. The parties

#### 1.1. Complainant:

**BELFIUS BANK NV**  
Pachecolaan, 44  
1000 Brussels  
Belgium

*Represented by*

Mrs. Nathalie Delaere  
Head of Tax & Legal

E-mail: [eva.joosten@belfius.be](mailto:eva.joosten@belfius.be)

#### 1.2. Licensee:

**PIRATEPOINT Ltd**  
Jeremiah Haselberg  
Oliaji Trade Centre – 1<sup>st</sup> floor, 12345 Victoria  
Cyprus

E-mail [domains@opiratepoint.net](mailto:domains@opiratepoint.net)

### 2. Domain name

Domain name: privatebanking-belfius.be  
Registered on: 13 April 2017

hereafter referred to as "the Domain Name".

### **3. Background to the case**

On 14 July 2017, Complainant filed a complaint concerning the Domain Name.

The Licensee did not submit any response.

On 18 August 2017, Cepani appointed the Third-Party Decider to settle the dispute.

### **4. Factual information**

Complainant is a well-known Belgian company active in the field of financial services.

Complainant proved being owner of several Benelux and Community trademarks containing the word element "BELFIUS" (see Complaint exhibits).

In particular, Complainant registered

- a Benelux word mark "BELFIUS", on 23-01-2012 (complaint, Exhibit 1),
- a Community word trademark "BELFIUS", on 23-01-2012 (complaint, Exhibit 2).

Complainant is also tradenames and domain names containing the word "BELFIUS".

Complainant discovered the registration, on 13 April 2017, by the Licensee, of the Domain Name which contains the word "belfius" combined with the terms "private banking" which explicitly refer to one of the core activities of the Complainant.

Complainant addressed a formal notice on 28 April 2017 (+ reminder on 2 May 2017) to the Licensee, to request the transfer of the Domain Name to the Complainant.

The Licensee did not answer to the Complainant.

The Complainant filed a complaint to the Cepani to seek the transfer of the Domain Name.

### **5. Position of the parties**

#### **5.1. Position of the Complainant**

Complainant is owner of reputed trademarks and tradenames.

Licensee registered the Domain Name which contains the "Belfius" trademark and is confusingly similar thereto.

Likelihood of confusion is even greater than the "Belfius" is combined with "privatebanking" while private banking is one of the core activities of the Complainant.

Licensee does not use the Domain Name and is not known under any similar tradename (no trademark registered) on the Belgian market. Furthermore, Licensee does not provide financial services, which proves the lack of legitimate interest in the Domain Name.

Considering the reputation of the Complainant, the use of Complainant's trademark in combination with terms describing core activities of the Complainant, there is an obvious attempt to exploit Complainant's reputation to attract consumers through the generated confusion.

The use of the Domain Name by the Licensee might damage the Complainant's trademark and cause dilution of the trademark. The bad faith of the Licensee is confirmed by the lack of answer to the formal notice addressed by the Complainant.

## 5.2. Position of the Licensee

Licensee did not submit any response to the complaint.

## 6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, the Complainant must provide evidence of the following:

- *" the licensee's domain name is identical or confusingly similar to a trademark, a tradename, a social name or corporation 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*
- *the licensee has no rights or legitimate interests in the domain name; and*
- *the licensee's domain name has been registered or is being used in bad faith."*

### 6.1. Domain Name is identical or similar to Complainant's trademarks, tradename and corporate name

Complainant proved prior rights on "Belfius" trademark and trade name, and in particular :



Complainant is owner of

- a Benelux word mark "BELFIUS", on 23-01-2012 (complaint, Exhibit 1),
- a Community word mark "BELFIUS", on 23-01-2012 (complaint, Exhibit 2).

Domain Name is confusingly similar to these trade name and trademarks.

Pursuant to ECJ case law, a likelihood of confusion exists between a prior trademark and another sign as far as *"the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically"* (ECJ, C-120/04, nr. 31).

*"The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details"* (ECJ, C-120/04, nr. 28)

In present case, the Domain Name is composed of three elements

- Belfius
- privatebanking
- ".be"

Belfius is the dominant and distinctive element of the Domain Name, since the ".be" is the code of the Belgian CcTLD's extension (see CEPANI case 44141 and mentioned references) and since "privatebanking" element comprises terms describing a type of bank activities.

The distinctive character has to be assessed according to the perception of the average consumer of the category of products concerned (ECJ, 16 September 2004, case C-329/02, paragraph 24 ; ECJ, 22 June 1999, case C-324/97, paragraph 26).

Used in connection with financial services related activities, "private banking" is generally understood as referring to " banking, investment and other financial services provided by banks to high-net-worth individuals (HNWIs) with high levels of income or sizable assets. The term "private" refers to customer service rendered on a more personal basis than in mass-market retail banking, usually via dedicated bank advisers. It does not refer to a private bank, which is a non-incorporated banking institution" (Wikipedia definition of "private banking").

Being used in combination with Belfius well-known name/mark, the "privatebanking" terms shall obviously be associated in their meaning to the private banker activities.

*"The public will not generally regard a descriptive element forming part of a compound mark as the distinctive and dominant element of the overall impression conveyed by that mark"* (ECFI, T-425/03, nr. 82).

Domain Name dominant element is therefore “belfius”, which is identical to Complainant’s trade name and word marks.

First condition is therefore met.

## 6.2. Rights and legitimate interests

Licensee did not provide any explanation to justify the registration of the Domain Name.

In these circumstances, a prima facie evidence of a lack of legitimate interest may be sufficient to meet the second requirement of DNS BE terms and conditions (CEPANI, cases nr. 44094 and 44217).

Furthermore, the existence of a possible legitimate interest is even more doubtful that the Licensee registered a domain name made of three elements directly referring to Complainant and its activities:

- the “belfius” sign corresponding to the well-known trade name and trademarks of Complainant;
- the “privatebanking” terms which refer to one of the core activities (also well-known) of the Complainant;
- the “be” suffix which refers to the Belgian market where the Complainant is established and has acquired its reputation in the provision of financial services.

Registering that kind of domain name without providing any justification of a possible legitimate use constitutes a prima facie sufficient evidence of a lack of legitimate interest of the Licensee.

Indeed, these elements indicate a speculative domain name registration.

Second condition is therefore met.

## 6.3. Registration or use in bad faith

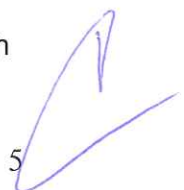
Licensee did not make any use of the Domain Name.

Licensee did not reply to Complainant letters and to the complaint (complaint, exhibits 3 and 4).

The well-known character of Belfius trademark within the Belgian market requires a more severe assessment of bona fide use of the Domain Name (CEPANI cases nr. 44030 and 44051).

Based on the above-mentioned elements (in partic. those developed in 6.2), one can reasonably conclude that registration of Domain Name constitutes an attempt to disrupt Complainant’s business or to attract internet users by creating confusion with Complainant’s trade name or trademarks.

5



The registration and/or use of the Domain Name are made in bad faith.


Third condition is therefore met.

Furthermore, even if unnecessary to justify decision, bad faith determination might be reinforced by an additional element. As referred in the complaint, the Whois database mentions a contact email address for Licensee based on piratepoint.net URL. This URL points to a web site offering "off-shore domain registration" services, i.e. services enabling to anonymously register and manage domain names (see <https://www.goip.com/offshore-domain-registration.php>).

## 7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-party decider hereby rules that the domain name registration for the "**privatebanking-belfius.be**" domain name is to be transferred to the Complainant.

Namur, 07/09/2017.



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Alexandre Cruquenaire,  
The Third-party decider