



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

Decision of the Third-Party decider

S.A.R.L. Pneus Online Holding / DELTI.COM AG

Case No. 44238: pneus-online.be / pneusonline.be / pneu-online.be / pneuonline.be

1) The Parties

The Complainant in appeal is **S.A.R.L. PNEUS ONLINE HOLDING**, with its main office at Switzerland, 1227 Carouge, Rue Alexandre-Gavard 16, represented by Veerle RAUS, Attorney with offices at 1170 Brussels, Terhulpsessesteenweg 178.

The Respondent in appeal is **DELTI.COM AG c/o Mr Samusch Timon**, with its main office at Germany, 30169 Hannover, Bruehlstr. 11, represented by Christophe RONSE and S. CUBITT, Attorneys, with offices at 1000 Brussels, Havelaan 86C.

2) Domain Name

The domain names at issue are <pneusonline.be>, registered on 29 May 2002 and <pneus-online.be>, <pneu-online.be> and <pneuonline.be> registered on 6 January 2003, hereinafter referred to as the "Disputed Domain Names".

3) Procedural History

On 23 November 2011, the Complainant appealed the administrative decision of 3 November 2011, in which Complainant's request to have the Disputed Domain Names transferred was denied.

On 9 December 2011, the Respondent submitted a response to the Complainant's request for appeal.

On 21 December 2011, Cepina appointed a panel of three Third-Party Deciders.

On 28 December 2011, the Complainant informed Cepina that it did not request additional retort being convinced that its Request for Appeal sufficiently demonstrates its point of view and stated that it contested all new allegations of the Respondent regarding abusive proceedings and/or fabricated proof or forged documents.

The Third-Party Deciders shall render their decision based on the Request for Appeal, the Response, Article 10 of the "Terms and conditions of domain name registrations under the ".be" domain operated by DNS", entitled "Dispute resolution policy" (the "Policy"), and the Rules.

4) Elements of Fact

The Complainant is a Swiss company active in the business of selling tires online. Respondent is a German company, which is also active in the business of selling tires online. There is no relation between Respondent and Complainant, except that they are direct competitors.

In 2001, Complainant, active under the name ANS & Co SARL at the time, contacted the Respondent by email in view of a possible cooperation. Discussions between Complainant and Respondent did not result into an agreement.

Respondent registered the disputed domain name <pneusonline.be> on 29 May 2002. Respondent subsequently registered the disputed domain names <pneus-online.be>, <pneuonline.be> and <pneu-online.be> on 6 January 2003. Respondent started actively using the Disputed Domain Names since March 2003 at the latest.

Complainant is the holder of the following trademarks, which it uses in relation to the online sales of tires:

- French trademark registration number 3240756 for the figurative mark PNEUS-ONLINE.COM, filed on 7 August 2003 for classes 12 (pneumatic tires) and 38 (communication services);
- International trademark registration number 836271 for the figurative mark PNEUS-ONLINE.COM, registered on 28 July 2004 in classes 12 and 38 with designated countries UK, Austria, Benelux, Switzerland, Germany, Spain, Italy, Portugal and Romania;
- French trademark registration number 3502283 for the word mark PNEUS ONLINE , filed on 24 May 2007 for classes 35 (retail sale of tires and tire accessories for motor vehicles) and 36 (insurance); and
- International trademark registration number 962673 for the word mark PNEUS ONLINE, registered on 25 March 2008 in classes 35 and 36 with designated countries UK, Austria, Spain, Italy and Portugal.

On 12 June 2003, Complainant, through its Swiss counsel, summoned Respondent to stop using the domain names <pneu-online.com>, <pneuonline.com>, <pneusonline.com> and <pneusonline.com>, invoking a possible risk of confusion. Following this letter, Respondent temporarily blocked the abovementioned websites, but subsequently reactivated them in the autumn of 2003.

On 13 March 2008, Complainant sent a notice letter to Respondent with the request to stop all use of the Disputed Domain Names. Respondent replied to this letter on 28 March 2008 stating that it had legitimate rights in the Disputed Domain Names.

On 31 March 2011, Respondent sent a notice letter to Complainant with the request to confirm that it would refrain from hampering Respondent's legitimate use of the Disputed Domain Names. Complainant replied by letter of 19 May 2011, requesting the transfer of the Disputed Domain Names.

Respondent subsequently initiated administrative proceedings with Cepina. A decision was rendered on 3 November 2011, in which Complainant's request to have the Disputed Domain Names transferred was denied. It was held that i) the Disputed Domain Names were confusingly similar to trademarks in which the Complainant has rights, ii) the Respondent has a legitimate interest in the Disputed Domain Names and iii) the Disputed Domain Names were not registered or used in bad faith.

On 23 November 2011, Complainant appealed the abovementioned administrative decision with the request to transfer the Disputed Domain Names to Complainant.

5) Parties Contentions

- a) Complainant

In summary, Complainant argues that the transfer of the Disputed Domain Names should have been ordered by the appealed Administrative Decision of 3 November 2011. According to the Complainant:

- The Disputed Domain Names are essentially identical and confusingly similar to a trademark, a trade name and a corporation name in which the Complainant has rights;
- Respondent has no rights or legitimate interests in the Disputed Domain Names; and
- The Disputed Domain Names have been registered or are being used in bad faith.

b) Respondent

Respondent argues that the transfer of the Disputed Domain Names was rightfully denied in the appealed Administrative Decision of 3 November 2011. According to the Respondent, it was wrongfully decided that the Disputed Domain Names were confusingly similar to the word marks "Pneus Online" in which the Complainant had rights. According to Complainant, the trademarks, the trade name and corporation name cannot be taken into account, since i) the trademarks were registered subsequent to the registration of the Disputed Domain Names, ii) Complainant has no trade name protection in Belgium and iii) Complainant cannot enjoy protection as a corporation name in Belgium.

Respondent argues to have rights and legitimate interests in the Disputed Domain Names, given the descriptive character of the domain names, which relates to Respondent's business.

Finally, Respondent contends not to have registered or used the Disputed Domain Names in bad faith.

6) Discussion and Findings

a) Analysis of the Complaint

Article 15.1 of the Rules instructs the Third-Party Decider as to the principles the Third-Party Decider is to use in determining the dispute: "*The Third-Party Decider shall decide following the parties views and in accordance with dispute resolution policy, the registration agreement and following the provisions of the present Rules.*"

By virtue of Article 10, b, 1, of the Policy the Complainant must prove each of the following:

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

i) Identity

The Administrative Panel is of the opinion that, since article 10, b, 1 of the Cepani Rules refers to "a trademark" without any further specification, all trademarks irrespective of the territory for

which they are registered or their anteriority compared to the registration date of the disputed domain names may be considered.

Moreover, the fact that these trademarks may be invalid due to a lack of distinctive character is irrelevant in assessing whether these trademarks are identical or similar to the disputed domain names (Cepina Case No. 44050, *Startpagina b.v. vs. Take b.v.b.a.*, 17 November 2004 (startpagina.be); Cepina Case No. 4054, *The European Omnibus Survey s.c.r.l. vs. Magyar Gallup Intezet*, 25 January 2005 (gallup-europe.be); Cepina Case No. 4084, *Belgisch Instituut voor Normalisatie v.z.w. vs. Willy De Belder*, 9 August 2006 (benor.be); Cepina Case No. 4085, *Media Office NV vs. María Eguirón*, 31 juli 2006 (casas.be)).

Accordingly, the Complainant's four trademarks can be relied upon when assessing the identity or confusing similarity of the disputed domain names.

The Administrative Panel is of the opinion that the French and international word trademarks PNEUS ONLINE are, at the very least, confusingly similar to the disputed domain names (pneus-online.be, pneusonline.be, pneu-online.be and pneuonline.be).

Indeed, the two words used in both trademarks are used in the same order in the four disputed domain names. The omission of the final "s" in "pneus", the addition of a hyphen between both words as well as the presence of the suffix ".be" makes no relevant difference in this respect.

For the above reasons, the Administrative Panel believes that the disputed domain names are, at the very least, confusingly similar to the Complainant's word trademarks PNEUS ONLINE.

As this confusing similarity has been established with regard to the Complainant's French and international trademarks PNEUS ONLINE, there is no need to examine the other trademark and trade name rights invoked by the Complainant.

ii) Rights or legitimate interests

Pursuant to article 10.3 of the Cepani Rules, the Respondent can demonstrate rights or legitimate interests in the Disputed Domain Names notably if "*prior to any notice of the dispute, the licensee used the domain name[s] or a name corresponding to the domain name[s] in connection with a bona fide offering of goods or services or made demonstrable preparations for such use*".

The Respondent, who is active in the tire business, activated all four disputed domain names in March 2003. The first purchases through these websites occurred in April 2003. It is thus established that the Respondent has been using the Disputed Domain Names for online sales of tires since April 2003.

The Complainant sent the Respondent a formal notice regarding the disputed domain names on 13 March 2008, which is five years after the Respondent's activation of the disputed domain names. This means that the Respondent used the Disputed Domain Names about five years prior to the Complainant issuing any notice or claim in relation to the domain names.

The Respondent has also shown that it has, and has had since 2000, many domain names comprising the words 'tires' (in several languages) and 'online' (E.g., <autoreifenonline.de>, <dackonline.net>, <daekonline.dk>). According to the Administrative Panel, the registration of the Disputed Domain Names, comprising the words 'pneu(s)' and 'online' fit with the business strategy of the Respondent, who is selling tires online on different markets. Given the descriptive character of the Disputed Domain Names and the business of Respondent, the Administrative Panel finds that Respondent could legitimately register the Disputed Domain Names, even if it was aware of the Complainant's activities under <pneus-online.com>. In any event, Complainant

had no trademark rights when Respondent registered the Disputed Domain Names and was not active on the Belgian market at the time.

iii) Registration or use in bad faith

Pursuant to article 10, b, 2 of the Cepani Rules, registration or use in bad faith can be demonstrated by, amongst others, the following circumstances:

*"- the domain name was registered in order to prevent the owner of 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 a name of a geographical entity to use the domain name and that the registrant has engaged in a pattern of such conduct;
- the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- the domain name was intentionally used to attract, for commercial gain, Internet users to the registrant's web site or other on-line location, by creating confusion with the complainant's trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of a geographical entity as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or location or of a product or service on his web site or location".*

-) Registration

At the time the Respondent registered the disputed domain names, the Complainant had not yet registered any of its "pneu(s)(-)online" trademarks and the Complainant's corporate name was ANS & CO SARL. In discussions between the Complainant and the Respondent prior to the registration of the Disputed Domain Names, no mention is made of the sign 'Pneus Online'. Complainant failed to demonstrate that, at the time of registration, there were any other circumstances that would have caused Respondent to gain knowledge of Complainant's use of or intention to use the sign 'pneus online' in or in relation to Belgium. Moreover, the Administrative Panel is of the view that the Complainant has not established that, at the time of the registration, the Complainant used "pneus online" as a trade name, as more than a domain name, or that it presented itself by that name to the Respondent or its customers.

As a result, there is no evidence of bad faith at the time of registration of the Disputed Domain Names

-) Use

The Respondent has continually used the Disputed Domain Names for eight years for its own business in online sales of tires. According to the Panel, this sufficiently shows that the Respondent did not register or use the Disputed Domain Names primarily for the purpose of disrupting the Complainant's business.

Furthermore, the Administrative Panel is of the opinion that the Complainant has failed to demonstrate its presence, let alone established reputation, on the Belgian market at the time of registration and subsequent use of the disputed domain names. The press articles presented were either directed at French readers or dated subsequent to the registration of the domain names. The invoices were also dated subsequent to the registration of the domain names. Before the registration of the Disputed Domain Names, the Complainant's web site www.pneus-online.com was hardly visited by Belgian Internet users (two visits in January 2002 and 31 visits in August 2002). Therefore, the Disputed Domain Names could not have been intentionally used to profit from the Complainant's reputation or to attract, for commercial gain, Internet users by creating confusion with the Complainant. Finally, the fact that Complainant's reputation in Belgium may have grown over time does not prevent Respondent to continue using domain names in which Respondent has a legitimate interest.

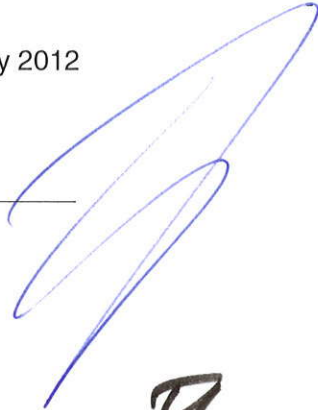
For the above reasons, the Administrative Panel is of the view that the Complainant has not proved that the Respondent registered or has been using the Disputed Domain Names in bad faith.

7) Decision

Pursuant to Article 10, e, of the Policy, the Third-Party Deciders deny the request of Complainant that the registration of the Domain Name <pneus-online.be>, <pneusonline.be>, <pneu-online.be> and <pneuonline.be> be transferred to Complainant.

Brussels, 31 January 2012

Yves Van Couter
Third-Party Decider



Geert Glas
Third-Party Decider



Flip Petillion
Third-Party Decider