

DECISION OF THE THIRD-PARTY DECIDER

Koninklijke Douwe Egberts B.V./ Philippe Delmas

Case no. 44370: actiesenseo.be

1. The parties

- 1.1. Complainant: Koninklijke Douwe Egberts B.V.
with registered office at The Netherlands, 1011 DK,
Amsterdam, Oosterdoksstraat, 80;
listed in the Belgian Central Enterprise Databank under
number 0500.758.837,

Represented by Mrs. Sabin Tigu, Attorney at law,

Ploum Lodder Princen's,
Blaak 28
3011 TA, Rotterdam
The Netherlands

- 1.2. The Domain Name holder:

Philippe Delmas,
Residing at France, 15500 Massiac, Avenue du general de
gaulle, 101

Not Represented

2. Domain name

Domain name: "actiesenseo.be"
Registered on: October 25, 2014

hereafter referred to as "the Domain Name".

3. Background to the case

On October 29, 2014, a cease and desist letter was sent by the Complainant to the domain name holder. He was invited to immediately cease and desist from any use of trademarks, including the SENSEO trademarks as used notably in the Domain Name. According to the record, he did not answer to the Complainant.

On January 15, 2015 the Complainant filed a complaint with the Belgian Centre for Arbitration and Mediation (CEPANI-CEPINA, hereafter referred to as the "Center") concerning the Domain Name, pursuant to the CEPANI Rules for Domain Name dispute resolution and the Dispute resolution policy of DNS BE (Article 10 of the Terms and conditions for Domain Name registrations under the ".be" domain operated by DNS BE).

On March 16, 2015, the domain name holder was notified of the Complaint and invited to submit a response by March 23, 2015. He did not submit his response to the Center.

The Complaint was filed in English pursuant to Article 11 of the CEPANI Rules for Domain Name dispute resolution.

On March 12, 2015, the Third-Party Decider sent the statement of independence to the Center.

Mr. Benjamin Docquir was appointed on March 16, 2015 by the Center as the Third-Party Decider to settle the dispute pursuant to Article 6.2 of the CEPANI Rules for Domain Name dispute resolution.

The Center also informed the Third-Party Decider that the deliberations would be closed by March 23, 2015. Both the Complainant and the domain name holder were informed of the aforementioned appointment and information.

The Third-Party Decider's decision is issued according to:

- The complaint dated 15 January 2015 and annexed documents;
- The Rules of the Belgian Center for Arbitration and Mediation for Domain Name dispute resolution (hereafter "Cepani Rules");
- The "Terms and conditions of Domain Name registrations under the ".be" domain operated by DNS", entitled "Dispute Resolution Policy" (hereafter "the Policy").

4. Factual information

The Complainant is a company under Dutch law named "Koninklijke Douwe Egberts B.V."

The Complainant is an international company making and marketing coffee and tea products. He owns a number of intellectual property rights. Especially, he owns several trademark registrations in relation to the sign SENSEO, including trademark registrations for the European Union and the Benelux (see Annex 4 to the Complaint)

covering coffee, automatic coffee marketing machines and coffee and tea percolators. The oldest registered Benelux trademark dates back to 1998.

The complainant has registered its own domain name "senseo.be" on 24 September 1999.

The Domain Name holder is Philippe Delmas. He is domiciled in France and his email address is deviousrupt@hotmail.com (see Annex 1 to the Complaint).

The domain name holder registered the Domain Name "actiesenseo" on 25 October 2014.

Currently the Domain Name holder, on the related website, advertises for and sells products of the brand MULBERRY, a maker of fashion bags (see Annex 7 to the Complaint).

On October 29, 2014, the Complainant's attorney at law sent a cease and desist letter to the domain name holder by email and registered mail and requested to transfer the authorization code of the Domain Name (see Annex 5 to the Complaint). These letter and mail apparently remained unanswered.

5. Position of the parties

5.1. Position of the Complainant

The Complainant requests the Third-Party Decider to order the transfer of the Domain Name since all conditions provided in the policy, contained in article 10, b), (1), are fulfilled.

The Complainant claims that the Domain Name is confusingly similar to the trademarks in which the Complainant has rights.

The Complainant is of the opinion that the domain name holder has no rights or legitimate interests in the Domain Name, especially because the dominant element of the Domain Name is the SENSEO trademark.

The Complainant argues that, prior to any notice of the dispute, the domain name holder did not have rights or legitimate interests in respect of the Domain Name, more in particular because the domain name holder has not 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. The Complainant emphasizes the fact that the domain name holder is now using the Domain Name to offer most likely counterfeiting products of a different well-known brand. Then, he claims the domain name holder has not been commonly known under the Domain Name, let alone that the same owns a relevant trademark registration in that respect. In addition, the Complainant asserts that the domain name holder is not making a legitimate or non-commercial or fair use of the Domain Name, especially because no license or authorization has been given by him to the domain name holder to use the SENSEO trademark.

Lastly, the Complainant asserts that the domain name holder has been registered and is being used in bad faith. The Complainant argues the Domain Name has been registered in bad faith as the trademarks of the Complainant are earlier and well-known. Moreover, he argues that the domain name holder registered the Domain

Name with the sole aim of attracting internet users and derive profit from the use of the trademarks of the Complainant. Besides, the Complainant asserts, the registration is also disrupting the business of Complainant, as Complainant cannot use the Domain Name for its activities. Finally, the Complainant claims that the absence of a response is a strong indication of bad faith.

5.2. Position of the domain name holder

The domain name holder did not file a response in the course of the proceedings before the Third-Party Decider.

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. Identical or similar to

According to article 10, b), (1), (i) of the Policy, the Complainant has to prove that he has rights in a trademark and that the Domain Name is identical or confusingly similar to such trademark.

(a) As to the existence of prior rights

The Complainant provides evidence that he is the owner of the trademark SENSEO which the Third-Party Decider regards as a well-known brand in the Benelux as well in many other countries in the world. Actually, he furnishes evidence that can be found in the Annex 4 to the Complaint and which are linked to trademark registrations, used for goods and services in various classes, for the European Union and the Benelux. More exactly, he is the proprietor of the Benelux and Community word mark and figurative mark SENSEO.

Therefore, the Complainant's rights on its trademarks do not seem questionable *prima facie*, so much that the Third-Party Decider regards them as valid.

(b) As to the identity and the likelihood of confusion

Pursuant to ECJ case law, *"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 and 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, 6 October 2005, *Medion AG v. Thomson multimedia Sales Germany & Austria GmbH*, paragraph 28 and CEPINA case, 30 September 2013, *belagcomcloud.be*).

According to established case law, the risk of confusion is established on the basis of a comparison *in abstracto* of the signs in presence (CEPANI, Case No. 44106).

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

- Actie
- Senseo
- “.be”

Senseo 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 No. 44141 and mentioned references) and since the “Actie” element is a descriptive sign in Dutch.

In the present case, the disputed Domain Name is confusingly similar to the Registered Trademarks for the following reasons:

- (1) SENSEO is an invented word with a high degree of inherent distinctiveness reinforced by longstanding international recognition so as now to amount to a well-known mark (see *supra*);
- (2) “Actie” is an ordinary descriptive word. However, in the case at hand, a descriptive word connected with the earlier trademark (SENSEO) do not suffice to avoid the creation of a likelihood of confusion (See *Dell Inc. v. None*, WIPO Case No. D2004-0511 (August 27, 2004) in which the Panel said: *“This argument [that clones refers to a generic equivalent and not the trademarked product] merits attention, but ultimately is not persuasive here. The dominant element of the Domain Name is the strong (and in all likelihood famous) mark DELL, which is followed immediately by the noun (“computers”) that best describes the goods and services provided by Complainant under that mark (...) Given the strength and renown of Complainant’s mark and the initial interest engendered by the combination “dellcomputers,” the word “clone” (placed, it is worth noting, at the end of the second-level domain) is not sufficient to overcome the overall - and confusing - similarity between the mark and the Domain Name”*.
- (3) On the contrary, the word “actie” exploits the SENSEO’s reputation in order to attract Internet users, giving the impression that the website under the disputed Domain Name sells Complainant’s products at special prices. Therefore, the prefix “actie” does nothing to dispel and serves only to reinforce the connection in the public’s mind between the word SENSEO and Complainant: see *Philip Morris Incorporated v. Alex Tsytkin*, WIPO Case No. D2002-0946 (February 13, 2003), *Philip Morris USA Inc. v. n/a*, WIPO Case No. D2004-0462 (August 5, 2004) and *Belfius Bank S.A. v. Dioen Kend*, CEPANI Case No. 44301 (June 7, 2013)).

The domain name holder does not dispute this similarity.

As a result of the above, the Domain Name must be regarded as confusingly similar to the trademark of the Complainant.

The Third-Party Decider therefore concludes that the first condition is met.

6.2. Rights and legitimate interests

According to article 10, b), (1), (ii) of the Policy, the Complainant has to prove that the domain name holder has no rights or legitimate interests in the disputed Domain Name.

The domain name holder is expected to cooperate and produce evidence of the existence of a right or a legitimate interest. On the contrary, the domain name holder does not collaborate to the administration of evidence in the case at hand, since he did not reply to the Complainant's emails nor to the complaint. The Third-Party Decider has not been informed of any evidence proving that, prior to any notice of the dispute, the domain name holder used the Domain Name with a *bona fide* offering of goods or services, or that the domain name holder made demonstrable preparations for such use.

The domain name holder has not produced evidence that he has been commonly known by the Domain Name, and there appears at first sight to be no connection between the domain name holder's name and the Domain Name.

The Domain Name was registered with the Registrar on October 25, 2014. At this time, the Complainant had already registered its trademarks.

The Complainant states that the domain name holder had no license or permission from him to use the trademark or to apply for use any Domain Name incorporating that mark. Therefore, *"in absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent"* (see *Guerlain S.A. v. Peikang*, WIPO Case No. D2000-0055 (March 27, 2000)).

The content of the "actiesenseo.be" website cannot convince the Third-Party Decider of the existence of any of the domain name holder's legitimate interests in the Domain Name, especially as today the domain name holder is using the Domain Name to advertise for and sell counterfeit products of another well-known brand, named MULBERRY (see Annex 7 to the Complaint).

The Third-Party Decider therefore considers that the domain name holder did not show any legitimate interest in the Domain Name.

The second requirement of article 10, b), of the Policy is therefore met.

6.3. Registration in bad faith

Bad faith can never be presumed but must be reasonably proven by the Complainant. This principle rests on a settled CEPINA case law (see CEPANI, Cases No. 4049, 4067, 44150).

Case law also reiterated the principle that one may not deduct bad faith from the mere fact that a domain name holder does not file a response (see CEPANI, Cases No. 4045 and 4053). However, although not being in itself a sufficient evidence for bad faith, the absence of a response, in combination with other elements, may nevertheless serve as a circumstantial evidence for establishing a domain name holder's bad faith.

Moreover, bad faith can be proven by any means, including presumptions and circumstances (including the fact that the Complainant's trademarks were registered since 1999) that indicate, with a reasonable degree of certainty, that the domain name holder knew, or ought to know, the Complainant's trademarks and nevertheless registered the Domain Name.

It must also be stressed that under DNS.be terms and conditions, bad faith may be established at the registration or during the use of the Domain Name.

In the case at hand, the SENSEO trademark is quite a famous brand in the world and in the Benelux and was undoubtedly adopted by the Respondent in conjunction with the word "actie" by reason of its potential capacity to attract the maximum number of purchasers to its website, albeit it being clear from the record that the domain name holder's website does not sell such products. However, the Third-Party Decider is convinced that the domain name holder had no other reason to choose the Domain Name than to take advantage of the reputation of the Complainant's trademarks, which he knew or ought to know.

Therefore, together with the absence of any response from the domain name holder, the Third-Party Decider finds that these circumstances show that he has registered and used the Domain Name in bad faith.

As a result, the Third-Party Decider considers that the third condition is met.

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 "actiesenseo.be" Domain Name is to be transferred to the complainant.

Brussels, April 1, 2015



Benjamin Docquir
The Third-party Decider