



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Musikhaus Thomann/ David Weir

Case n° 44334 : thomann.be

1. The Parties

1.1. Complainant: Musikhaus Thomann e.K.

with registered office at 30, Treppendorf, 96138 Burgebrach, Germany

Represented by Dominet AB, company with registered office at 8, Winstrupsgatan, 222 22 Lund in Sweden

1.2. Licensee: David Weir

83, Southbury Road, EN1 1PJ Enfield in United Kingdom

Not represented

2. Domain Name

Domain Name: "thomann.be"

Registered on: August 29, 2007

Hereafter referred to as " the Domain Name".

3. History of the procedure

On December 17, 2013 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).

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

On January 24, 2014, the Licensee was notified of the Complaint and was invited to submit a response by January 31, 2014. The Licensee did not submit his response to the Center.

Mr. Emmanuel Cornu was appointed on January 24, 2014 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 deliberation would be closed by January 31, 2014 and that its decision needed to be filed by February 14, 2014. Both the Complainant and the Licensee were informed of the aforementioned appointment and information.

On January 23, 2014, the Third-Party Decider sent the statement of independence to the Center. On January 31, 2014, pursuant to Article 12 of the CEPANI Rules for Domain Name dispute resolution, the deliberations were closed.

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

- the complaint dated 17 December 2013 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

1. The Complainant is a company under German law named "Musikhaus Thomann e.K. ".

The Complainant is active in the musical instruments industry.

2. The Complainant is the holder of the Community word trademark "Thomann" filed on July 29, 2005 and registered on August 11, 2006 for goods in classes 9, 11 and 15 (musical instruments and other related goods) as it results from the CTM registration nr. 004567401 (see annexes 2 and 3 to the complaint).

The name of the holder of the trade mark is described in the OHIM register as "Thomann Hans handelnd unter Musikhaus Thomann", that is to say, " Thomann Hans acting for Musikhaus Thomann" (see annexes 2 and 3 to the complaint).

3. The Complainant registered the domain name "thomann.de" in November 14, 1997 (see annex 1 to the complaint) .

4. The Licensee is David Weir. He is domiciled in the United Kingdom and his email address is solanetwork@hotmail.com.

The Licensee registered the Domain Name "thomann.be" on August, 29, 2007 (see annex 5 to the complaint).

The "thomann.be" website is currently inactive and contains indications explaining that the new website of Thomann UK "will be ready later this year".

5. Position of the parties

5.1. Position of the Complainant

5. 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 composed of the trademark "Thomann" in which the Complainant has rights.

The Complainant is of the opinion that the Licensee has no rights or legitimate interests in the Domain Name. In this respect, the Complainant argues that the Licensee does not hold any trademark similar to the domain name. The Complainant stresses that the Licensee registered the Domain Name with the sole aim of attracting internet users who wish to visit the Complainant's website. The Complainant asserts he received complaints from internet customers wishing to reach its website through the domain name "thomann.be".

Lastly, the Complainant argues that the Licensee's Domain Name has been registered and is being used in bad faith. The Complainant asserts the Domain Name has been registered in bad faith as the trademark of the Complainant is well-known in the music industry since 1954. The Complainant argues that the Licensee registered the Domain Name with the sole aim of attracting internet users and derive them on the competitive website "www.ukpianos.co.uk" where competitive trademarks of musical instruments are offered for sale. The Complainant also stresses that he called the Licensee who suggested the Complainant to send him an offer for the transfer of the domain name. Following this call, the Licensee asserts that his email and the following one remained unanswered and that the redirection towards the website www.ukpianos.co.uk was removed from the website www.thomann.be.

5.2. Position of the Licensee

6. The Licensee did not file a response in the course of the proceedings before the Third-Party Decider.

6. Discussion and findings

7. Pursuant to Article 15.1 of the CEPANI Rules for Domain Name dispute resolution, the Third-Party Decider shall decide in accordance with the Terms and conditions of Domain Name registrations under the ".be" domain operated by BNS BE and following the provisions of the CEPANI Rules for Domain Name dispute resolution.

Pursuant to Article 10, b), (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 of 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 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 confusingly similar

8. 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

9. The Complainant provides evidence that he is the owner of the Community word trade mark “Thomann”. As already noted above, the name of the trademark holder is described in the register as “Thomann Hans handelnd unter Musikhaus Thomann”, that is to say “ Thomann Hans acting for Musikhaus Thomann”. The Complainant has therefore to be considered as the owner of this Community trade mark registration (see annexes 2 and 3 the complaint).

The Complainant’s rights on its trade mark does not seem questionable, and the Third-Party Decider therefore regards it as valid.

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

10. According to established case law, the risk of confusion is established on the basis of a comparison *in abstracto* of the signs in presence (see example, Cepani, case 44106). The Third-Party Decider finds the Domain Name “thomann” to be identical to the trade mark “thomann”. The only differences between the Domain Name and the trade mark is the suffix “.be”.

According to the well established case law of Cepina, the suffix “ be” does not exclude the identity since the suffix refers only to the geographical extension and origin of the website.

The Licensee does not dispute this identity.

11. As a result of the above, the Domain Name can be considered as identical to the trade mark of the Complainant.

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

6.2. Rights and legitimate interests

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

It is settled case-law that the Complainant must not be imposed the burden of proving a negative assumption (i.e. the absence of rights and of legitimate interest). This burden of proof is considered to be satisfied when, taking into account all the facts of the case, the Complainant could credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (examples, Cepani, cases nr. 4038, 4064, 4030, 4013). Furthermore, a licensee is expected to cooperate and produce evidence of the existence of a right or a legitimate interest.

The Licensee 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 Licensee used the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services, or that the Licensee made demonstrable preparations for such use.

The Licensee 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 Licensee's name and the Domain Name.

13. The Domain Name was registered with the Registrar on August 29, 2007. At this time, the Complainant had already registered its trademark.

14. The Complainant states that the Licensee has no rights or legitimate interests in the Domain Name. In this respect, the Complainant argues that the Licensee does not hold any trademark similar to the domain name. The Complainant also stresses that the Licensee registered the Domain Name with the sole aim of attracting internet users on competitive website who wish to visit the Complainant 's website.

Since the Licensee did not submit any response, the content of its website is the main element to consider on this point.

However, the content of the "thomann.be" website cannot convince the Third-Party Decider of the existence of any of Licensee's legitimate interests in the Domain Name.

According to the Complainant, the domain name contains a link redirecting towards the competitor website "www.ukpianos.co.uk". However, the evidence provided by the Complainant does not show the existence of such a link (see annex 4 to the complaint). The evidence only shows that the "thomann.be" website is currently inactive. On the website, one may read "*Welcome to Thomann UK! You are on the Thomann UK website. For other countries, please click on you flag above. Our new website will be ready later this year... Thanks you for your patience...*" (see annex 4 to the complaint).

The allegation of the Complainant regarding his call with the Licensee or a change of the Licensee's website content is not established.

However, the use of a website must be effective. Such a use is not effective when a website has not been used for a long period or only contains rudimentary information, moreover when the content of the website was removed short after the first contact between the Complainant and the Licensee (see similar case, CEPANI, 44085, casas.be).

In the present case, the Licensee is not using the domain name "thomann.be". Apart from the name "Thomann" and the indication of "UK" as a country, there is no information concerning the commercial or non-commercial use of the website. One could thus question the purpose and use of the information on this webpage. It therefore is obvious to deduct from this content that Licensee does not use the domain name in connection with bona fide offering of goods or services, nor does he make a legitimate and non-commercial use of the domain name.

15. The Third-Party Decider therefore considers that the Licensee use of Domain Name did not show any legitimate interest thereon.

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

6.3. Registration or use in bad faith

16. Bad faith may never be presumed but must be reasonably proven. This principle was settled by Cepina case law (see Cepani, cases nr. 4049, 4067, 44150).

Case law also reiterated the principle that one may not deduct bad faith from the mere fact that a Licensee does not file a response (see Cepani, cases nr. 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 licensee's bad faith. Bad faith can be proven by any means, including presumptions and circumstances that indicate, with a reasonable degree of certainty, that the Licensee 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.

As to the registration, the trademark of the Complainant was registered before the date of registration of the Domain Name. The use of the word "thomann" is identical to the trade mark of the Complainant "thomann". The Complainant declares having some reputation and being known throughout Europe including in Belgium for decades in relation with musical instruments. This affirmation is not contested by the Licensee.

It is extremely unlikely that a third party would choose this word as a Domain Name. The Licensee must have been aware of the trademark rights when it registered the Domain Name so that it can

reasonably be assumed that Licensee intentionally chose the Domain Name in order to misleadingly divert Internet users (see Cepani, case 4014).

Beside the above-mentioned bad faith at the time of the registration of the Domain Name, the Third-Party Decider is of the opinion that the Domain Name is currently being used in bad faith.

According to the Complainant, the Licensee changed the content of the domain name after the Complainant contacted him for the first time. According to the Complainant, the content of the website "thomann.be" was exclusively made of links redirecting towards the competitor website "www.ukpianos.be". However, the Complainant does not provide a clear evidence of this fact. Actually, the domain name is nearly empty and seems inactive.

Besides, according to the declaration of the Complainant, when the Complainant contacted the Licensee, the latter offered to transfer the domain name "for a right price". This assertion is not contested by the Licensee. The intention of the Licensee in registering and in using the disputed domain seems thus to monetize it by offering it for sale. Such an offer addressed directly to the Complainant constitutes a case of the bad faith.

Finally, according to the Complainant, his following emails remained unanswered and the email address of the Licensee was modified from "david@ukpianos.co.uk" into "solanetwork@hotmail.com". The Complainant asserts that he sent a letter to this new email address and a certain Mr Abdi Ismail, which seems to be linked to Mr. David Weir and the company "ukpianos" (see annex 6 to the Complaint), rejected his demand very rudely.

The absence of response of the Licensee and the change of email address after a first contact between the Complainant and the Licensee are circumstances that also brings into question the Licensee's good faith.

Therefore, the Third-Party Decider finds that these circumstances show that the Licensee 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 "thomann.be " Domain Name is to be transferred to the complainant.

Brussels, February 12, 2014



Emmanuel Cornu
The Third-Party Decider