



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Retail Royalty Company/ Avice Doucet

Case n° 44278 : americaneagleoutfitters.be

1. The Parties

1.1. Complainant: Retail Royalty Company
with registered office at 89109 Las Vegas, Nevada, United States of
America, Convention Center Drive, 101

*Represented by Mr. N.A. Winthagen, Attorney at law
with registered office at 1017 SG Amsterdam, The Netherlands,
Weteringschans, 24*

1.2. Licensee: Avice Doucet,
37100 Tours, France, Quai Saint-Nicolas, 66

Not represented

2. Domain Name

Domain Name: " americaneagleoutfitters.be"

Registered on: June 27, 2012

Hereafter referred to as " the Domain Name".

3. History of the procedure

On August 3, 2012 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).

CEPANI – NON-PROFIT ASSOCIATION

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

On August 10, 2012, the Licensee was notified of the complaint and was invited to submit a response by August 31, 2012. The Licensee did not submit his response to the Center.

Mr. Emmanuel Cornu was appointed on September 5, 2012 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 September 11, 2012 and that its decision needed to be filed by September 25, 2012. Both the Complainant and the Licensee were informed of the aforementioned appointment and information.

On September 4, 2012, the Third-Party Decider sent the statement of independence to the Center.

On September 11, 2012, 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 3 August 2012 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 American law named "Retail Royalty Company" and is wholly owned subsidiary of American Eagle Outfitters, Inc. ("AEO") as stated in annex 2 to the complaint). AEO is internationally active and operates under the trade name American Eagle Outfitters for clothing targeting youth (see annexes 3, 4 and 6 to the complaint).

The Complainant designs, markets and sells casual clothing and accessories targeting youth under the trade mark "American Eagle Outfitters" at its own retail stores and on the website www.ae.com. Some research on the Internet confirms that via this website, the merchandise is available for purchase and can be shipped to most EU member States including Belgium.

The Complainant holds title to the intellectual property of AEO. He is the holder of the registered trademark "American Eagle Outfitters".

This trade mark was registered, among others, as:

- Community Trade Mark "American Eagle Outfitters" filed 31 August 2006 and registered 29 June 2011 for goods and services in classes 3, 14, 25 and 35, as it results from the CTM registration nr. 528.7875.
- Community Trade Mark " American Eagle Outfitters" filed 8 June 2011 and registered 19 October 2011 for goods in class 18, as it results from the CTM registration nr. 100.29891.

- International Trade Mark covering, among others, the Benelux, " American Eagle Outfitters" registered 26 February 2009 for goods and services in classes 3, 14, 25 and 35, as it results from the International registration nr. 998.853. The trade mark is reproduced as follows:

AMERICAN EAGLE
OUTFITTERS

Excerpts of the official databases proving the ownership of these trademarks are added as annex 7 to the complaint.

The Complainant exploits these trademarks on the Belgian market and therefore wishes to register the Domain Name americaneagleoutfitters.be. However, it does not seem possible since the Domain Name was registered by the Licensee.

Some research on the internet reveals that the website www.ae.com was registered by AE Direct Co. LLC, another subsidiary of "AEO" the parent of the Complainant (see annex 2 to the complaint). This website has been active on the Internet for more than 13 years (ae.com Domain Name was registered on March 17, 1999).

The Licensee is Avice Doucet. He is domiciled in France and his email address is ruochangmail.com.

The Licensee registered the Domain Name americaneagleoutfitters.be on June 27, 2012.

The "americaneagleoutfitters.be" website exclusively contains sponsored links to sellers of unrelated products and of competing fashion brands (complainant competitors).

The email address "ruochangmail.com" of the Licensee is associated with 1106 currently registered domain and 745 previously registered domains.

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 identical or at least confusingly similar to the trademarks 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 is not and has not been commonly known under the Domain Name. The Complainant also argues that he has never granted permission to the Licensee to use the Domain Name. The Complainant alleges that this Domain Name was registered for the purpose of stocking a reputed trademark as Domain Name. He stresses that the Licensee registered the Domain Name with the sole aim of attracting internet users as the website hosted under the Domain Name contains numerous " sponsored links" that generate income from the clicks and links on the respective website connected to the Domain Name.

Lastly, the Complainant asserts that the Licensee's Domain Name 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 prior to the registration and are widely known throughout the world. He also stresses that this Domain Name is used to attract, for commercial gain, Internet users who may be confused as to the source, the sponsoring, affiliation or endorsement of Domain Name holders' website. The Complainant alleges that this Domain Name was registered for the purpose of preventing the Complainant from operating their business at that address.

5.2. Position of the Licensee

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

6. Discussion and findings

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 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 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."*

Preliminary Ruling

The additional company "AEO management Co" mentioned in the complaint as a second complainant that would act conjointly with "Retail Royalty Company" cannot be considered as a complainant as it has not been mentioned as such in the complaint form under the section "identity of the complainant" according to article 2.2.2 of the Cepani Rules. Nor has AEO management Co filled its data in the complaint form or appointed N.A. Winthagen as representative.

Therefore, the complaint is only deemed filed by the Complainant "Retail Royalty Company".

6.1. Identical or confusingly similar

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 trade mark "American Eagle Outfitters" as a community word trade mark and as an international figurative trade mark (see annex 7 to the complaint). The Complainant's rights on its trade marks does not seem questionable *prima facie*.

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

According to established case law, the risk of confusion is established on a comparison *in abstracto* of the signs in presence (see example, Cepani, case 44106). The Third-Party Decider finds the Domain Name "americaneagleoutfitters.be" identical or at least confusingly similar to the trade mark "American Eagle Outfitters". The only differences between the Domain Name and the trade mark are that : (1) the American Eagle Outfitters consists of three separate words and the Domain Name is a contradiction of those words; (2) the suffix ".be".

The first difference is minor and does not distinguish the mark from the Domain Name.

As to the second difference, according to the well established case law of Cepina, the suffix " be" does not exclude the identity and/or the similarity since the suffix refers only to the geographical extension and origin of the website.

The Licensee does not dispute this identity and similarity.

As a result of the above, the Domain Name can be considered as identical or at least confusingly similar 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

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 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 evidencing of the case, since he did not reply to the Complainant's 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.

The Domain Name was registered with the Registrar on June 27, 2012. At this time, the Complainant had already registered its trademarks.

The Complainant states that the Licensee had no license or permission from the Complainant to use the Trademark or to apply for use any Domain Name incorporating that mark.

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 "americanoutfitters.be" website did not convince Third-Party Decider on the existence of a Licensee legitimate interest on the Domain Name.

"Americanoutfitters.be" content is indeed exclusively made of sponsored links to other companies, under which direct competitors of the Complainant mainly in Belgium and in The Netherlands (see Annex 8 to the complaint). In the Third-Party Decider's view, it is difficult to consider hosting of sponsored links to Complainant competitors as an element justifying a legitimate interest on the Domain Name (see example Cepani, case nr. 44067). Therefore, in the case at stake, the Licensee appears to make a commercial use of the Domain Name with an intent for commercial gain to misleadingly divert Internet users.

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

In the absence of response, no contrary evidence is submitted to balance this appreciation.

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

6.3. Registration or use in bad faith

Bad faith may never be presumed but must be reasonably proven. This principle was confirmed by distinguished authors (B. Docquir, " Le contentieux des noms de domaine", J.T., 2007, p. 68 and ff., spec. nr. 27) as well as 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 a circumstantial evidence for establishing a license's bad faith.

Bad faith can be proven by any means, including presumptions and circumstances that indicate, with a reasonable degree of certainty, the existence of bad faith.

It must 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 trademarks of the Complainant were registered before the date of registration of the Domain Name. The Domain Name at stake is a well known trade mark. It is excluded or extremely unlikely that a third party would choose this word as a Domain Name. The Complainant's Trademark is highly distinctive, has a strong reputation and is widely known throughout the world for a long time (see annex 6 to the complaint). 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 for the Domain Name in order to misleadingly divert Internet users (see Cepani, case 4014).

Besides the above-mentioned bad faith registration of the domain name, the Third-Party Decider is of the opinion that the Domain Name is currently being used in bad faith. The content of website is indeed exclusively made of sponsored links. The sponsored links system implies that links hoster receives money each time a user click thereon (see case nr. 44209 socco.be). Furthermore, the website displayed under the Domain Name provides commercial links, mainly links to sellers of competing fashion brands (see case nr. 44228 scapa.be). It is therefore obvious that the Licensee use

of Domain Name is made to attract for commercial gain, Internet users to Licensee website by creating a likelihood of confusion with the Complainant's trade mark.

Furthermore, the annex 9 to the complaint shows that the intention of the Licensee in registering and in using the disputed domain is to monetize it by offering it for sale.

Lastly, some research on the internet reveals that the email address of the Licensee is associated with 1106 currently registered domain and 745 previously registered domains. As has been decided by Cepani and WIPO panels, the registration of multiple domain names ("stockpiling") brings into question the Licensee's good faith (see Cepani, 44085, 44078 ; WIPO case No D2000-035; see also B. Docquir, " Le contentieux des noms de domaine", J.T., 2007, p. 69, spec. nr. 31).

Therefore, without any response from the Licensee, the Third-Party Decider finds 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 "americaneagleoutfitters.be " Domain Name is to be transferred to the complainant.

Brussels, September 19, 2012



Emmanuel Cornu

The Third-Party Decider