



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

NATURA SPRL / Markus JANK

Case no. 44274: natura.be

1. The parties

- 1.1. Complainant: NATURA SPRL;
with registered office at 1190 Brussels, Chaussée de
Neerstalle 96;
listed in the Brussels trade register under number
0.831.909.513.

Represented by:

Matthieu ALADENISE, Attorney,
with office at 1000 Brussels, Avenue des Phalènes 26.

- 1.2. Licensee: Markus JANK;
residing in Austria at 9624 Bei Hermagor, Egg 18.

Represented by:

Torsten BETTINGER, Attorney,
with office in Germany, 81679 Munich, Cuvilliesstrasse 14a

2. Domain name

Domain name: " **natura.be** "
Registered on: February 15, 2011

Hereafter referred to as "the Domain Name".

3. Background to the case

On July 2, 2012, Complainant filed a complaint with the Belgian Centre for Arbitration and Mediation (CEPANI).

On August 1, 2012, the Licensee filed a response with CEPANI.

On August 9, 2012, CEPANI appointed the Third-party Decider.

On August 10, 2012, the Complainant filed a response with CEPANI to the Licensee response of August 1, 2012.

On August 16, 2012, the Licensee filed an additional response with CEPANI to the Complainant response of August 10, 2012.

On August 16, 2012, pursuant to Article 12 of CEPANI Rules for Domain Name Dispute Resolution, the deliberations were closed.

4. Factual information

According to the Notary Act of June 28, 2012 produced by Complainant with its Complaint, the Complainant was incorporated under Belgian law on February 26, 1970. It seems however that the Complainant has pursued a former business that existed under the same commercial name since 1939.

The company name as well as the business name of the Complainant is "NATURA".

The Complainant is the owner of a verbal trademark n°0098497 filed on December 23, 1971, with prior rights for Belgium, Netherlands and Luxembourg dated May 4, 1940 (hereafter the "Trademark"). The Trademark is registered in class 29 for "*fish and more precisely fish preserve*" (translation from the Third-party Decider) and class 30 for "*sauces and more precisely béarnaise and tartare sauce; salad sauces and more precisely mayonnaise and mayonnaise sauce*" (translation from the Third-party Decider). The activity of the Complainant is the production of sauces and dressings and the commercialization in Belgium and abroad of these products.

According to its assertion, the Licensee "*is in the business of domain name resale, and maintains a portfolio of generic domain names in connection with its activities*".

The Licensee registered the Domain Name on February 15, 2011.

When entering the Domain Name, the internet user is directed to a "parking" webpage operated by the company SEDO GmbH (hereafter "SEDO"). On the webpage, under the Domain Name, SEDO indicates explicitly that the Domain Name is "*for sale*" and provides the following hyperlinks "*buy this domain*", "*Hire a Domain Broker*" and "*Buying Domain Tips*" on the left side of the website.

Close by these hyperlinks, the internet user is directed on the right side of the webpage to hyperlinks of third parties' websites.

On the bottom part of the webpage, SEDO mentions that:

*"This page [is]¹ provided to the domain owner **free** by Sedo's Domain Parking. Disclaimer: Domain owner and Sedo maintain no relationship with third party advertisers. Reference to any specific service or trade mark is not controlled by Sedo or domain owner and does not constitute or imply its association, endorsement or recommendation".*

Under this last assertion and disclaimer, SEDO provides other hyperlinks such as "Buy Domains", "Domain parking", "Domain Transfer", etc.

5. Position of the parties

5.1. Position of the Complainant

The Complainant states that the Domain Name is identical to its prior Trademark, trade name and company name.

The Complainant is of the opinion that the Licensee has no rights and legitimate interest in the Domain Name. More particularly, the Complainant argues that the Licensee has no trademark rights or activity linked with such trade name in any territory, except an activity of provider of parking website. The Complainant adds that the Licensee should have known the existence of (1) the Trademark due to an obligation as a professional to have checked the existence of a possible conflicting trademark via online tool search of the Benelux Office of Intellectual property and (2) the trade name via a "Google.be" research. The Complainant also invokes a notoriety or well-known character of the Trademark.

The Complainant is also of the opinion that the Licensee did register the Domain Name in bad faith. Among others, the Complainant invokes the "parking" of the Domain Name with SEDO and the "stockpiling" activity that is recognized the Licensee.

Consequently, Complainant asks the transfer in its favor of the Domain Name.

5.2. Position of the Licensee

Procedural issue

The Licensee considers that the Complainant's response filed on August 10, 2012 goes beyond a reply limited to the new information or arguments raised by the Licensee in its response filed on August 1, 2012 and that therefore the Third-party Decider, pursuant to its powers provided by Article 10.4 and 12 of *CEPANI rule for domain name dispute resolution*, should disregard the portions of the Complainant's response which should properly have formed the Complainant's initial filing of the Complaint under the *CEPANI rules for domain name dispute resolution*. The Licensee expresses this claim in the additional response he filed with CEPANI on August 16, 2012. In addition to this claim, he answers the arguments developed by the Complainant in its response filed on August 10, 2012.

¹ This word seems to be missing in the phrase and is added by the Third-party Decider.

The grounds

The Licensee agrees on the fact that the Domain Name is identical to the Trademark.

The Licensee is of the opinion, however, that the registration and sale of dictionary-term domains is a legitimate business activity. According to him, this activity falls under a "safe-harbor" as long as the registrants of domain names who wish to trade domain names take care to register only generic, dictionary-term domain names. Therefore, he has adopted what he is naming as a careful business practice to register only dictionary-meaning terms that do not (to his knowledge) have any associated trademark meaning. In his opinion, the term "*natura*" is a generic term in Latin, Italian and Spanish languages. The term "nature" and "*natureza*" are variations of the quoted Latin term that has survived in modern language, more precisely in French and English ("*nature*") and Portuguese ("*natureza*"). He adds that according to CEPANI case 44106 (Argente.be) "*monetizing generic terms, in the absence of bad faith on the side of the domain name owner, is not a breach of the DNS.be terms and conditions, and should not be sanctioned through the specific CEPANI procedure...*".

More specifically, the Licensee considers that he proves a legitimate interest in the Domain Name, since the activity of registering generic domain names is a legitimate business not proscribed by the Belgian rules relating to the registrations under the ".be" domain and by case law.

The Licensee also considers that the Domain Name was not registered or used in bad faith since he had no knowledge of the Complainant's business, and the Domain Name has not been used to target the Complainant's Trademark. The Licensee considers that nothing indicated that he should have known the Trademark. The Licensee asserts, among other things, that the Complainant does not conduct business or advertise (the newspaper clippings invoked by the Complainant were published in Belgium and in languages unknown to the Licensee –i.e. French and Dutch-) in the Licensee's country of residence (Austria). The Licensee also invokes that the Complainant did not register a trademark in Austria.

6. Discussion and findings

6.1. Procedural issue

According to Article 12 of *CEPANI rules for domain name dispute resolution*, the debates were closed on August 16, 2012. The Complainant filed its response on August 10, 2012, which means before the closing of the debates. Moreover, this response appears to be an answer to the facts and arguments contained in the Licensee response filed on August 1, 2012. The Licensee also filed an answer to the Response of August 10 of the Complainant. This answer was filed before midnight on August 16, 2012, which means before the closing of the debates.

According to Article 10.4 and 12 of *CEPANI rule for domain name dispute resolution*, the Third-party Decider will consider all submissions from both parties.

6.2. The grounds

Pursuant to Article 15.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for *the*

Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE (hereafter the "Policy") and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10 b(1) of the Policy, 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.*

6.2.1. Identical or similar to

The Domain Name is identical to Trademark and both parties agree on this. The Domain Name is also identical to Complainant's trade name and company name.

6.2.2. Rights and legitimate interests

Pursuant to Article 10 b) 3 of the Policy, the Licensee can demonstrate his rights or legitimate interests to the Domain Name. The same article of the Policy gives a non-exhaustive list of such circumstances:

- *prior to any notice of the dispute, the registrant 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; or*
- *the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if he has no trademark; or*
- *the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain or to tarnish the trademark, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.*

The Complainant cannot be imposed the burden of proof of a negative fact in occurrence of the absence of rights or legitimate interests. The Complainant has however to make acceptable that the Licensee has no rights or legitimate interests in the Domain Name (F. petillon en B. Lieben, "Overzicht van de .be beslissingen in de ADR procedure van Cepina (2001-2006)", *Computerrecht*, 2008, p. 74-87, n° 7.1. to 7.5. and cases quoted; B. Docquir, "Le contentieux des noms de domaine", *J.T.*, 2007, p. 61-71, n°18 and cases quoted). If this is the case, the Licensee has to prove the contrary.

The Licensee does not invoke or prove that he is commonly known under the Domain Name.

There is no evidence 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 made demonstrable preparations for such use.

When entering the Domain Name, the internet user is directed to a "parking" webpage operated by SEDO. This website offers nothing but hyperlinks to third parties websites. As mentioned on the website, these third parties are advertisers who maintain no relationship with the Licensee and who will pay for the consultation of their advertisement. The webpage also promotes the activity of SEDO as intermediary for the transfer of domain names placed "for sale". Such webpage created by SEDO cannot be considered as a proof of the *bona fide* offering of goods and services (case n°44167 – present.be; B. Docquir, "Le contentieux des noms de domaine", *J.T.*, 2007, p. 61-71, n°21).

It is not disputed that the Licensee is using the Domain Name for commercial use. The Licensee does not establish however that he makes a fair use of the Domain Name, in the sense that it is "necessary" under said circumstances to use the Domain Name (case n°44167 – present.be). In other words, the Licensee does not establish that there was a necessity to use the word "Natura" in consideration of the circumstances.

The Licensee invokes that he is pursuing a "*legitimate business, which is not proscribed by the Policy or case law*". The Licensee claims that its registration and sale of domain names fall under a "safe-harbor" as long as he takes care to register only generic, dictionary-term domain names.

As reminded by the Court of Justice of the European Union (hereafter "CJEU") this assertion is wrong for various reasons that may depend upon the circumstances of each case (CJEU, 3 June 2010, Internetportal und marketing GmbH c/ Richard Schilicht, C-569/08, points 73 and 74; B. Docquir, "Le contentieux des noms de domaine", *J.T.*, 2007, p. 61-71, n°20). In the present case as reminded by the CJEU (point 74 of the CJEU decision quoted), a term may appear as generic in one country of the European Union, but may validly be registered as trademark in another country of the European Union because it is not considered generic in this second country. The Trademark invoked by the Complainant may correspond to a dictionary-term in Spanish and Italian languages as invoked by the Licensee but is not a dictionary-term in the Benelux. Consequently, the assertion that NATURA is a dictionary term is incorrect at least for Belgium (where the official languages are Dutch, French and German) which is the relevant territory for ".be" domain names.

Moreover, the mere assertion of the Licensee that he is pursuing a "*legitimate business*" does not correspond to the proof of a right or legitimate interest in the Domain Name.

The Third-party Decider therefore concludes that the Licensee has no right or legitimate interest in the Domain Name.

6.2.3. Registration or use in bad faith

Article 10 b) 2 of the Policy gives a non-exhaustive list that can demonstrate the registration or use in bad faith of the Domain Name. Bad faith must be reasonably proven and deducted from assumption (B. Docquir, "le contentieux des noms de domaine", *J.T.*, 2007, p. 61-71, n°27)

The Licensee, being a professional of domain names registration and resale and the Domain Name being a non generic term for the sole territory at stake (Belgium), should have known the existing Trademark registration. Indeed, in these circumstances, the Licensee had the duty to act as a reasonable, prudent professional who is aware of the possible prior rights. This duty that applies to professionals when registering a generic term under the ".be" domain (case n°44167 - present.be; cf. also the motivation contained in this decision concerning the difference between top-level domain names and national domain names), is *a fortiori* applicable to a professional who registers non-generic terms.

In addition, it must be noted that the Final report of the WIPO Internet Domain Name Process of April 30, 1999 (<http://www.wipo.int/amc/en/processes/process1/report/finalreport.html>) (invoked by the Licensee to assert that there is no requirement that domain name registrants conduct trademark searches prior to the registration) concludes concerning the searches prior to registration to a domain name: "105. it is not recommended that domain name registrations be made conditional upon a prior search of potentially conflicting trademarks, but it is recommended that the domain name application contain appropriate language encouraging the application to undertake voluntarily such a search." (the Third-party Decider underlines). In other words, if relevant in the present case, this report does not recommend the search as a condition of the registration of the domain name but encourages such a search. A search therefore appears to be required certainly when the contemplated domain name is a non-generic ".be" domain name registered by a professional.

For the aforementioned reason, it is not necessary to review the alleged notoriety or well-known character of the Trademark invoked by the Complainant.

In addition, the Licensee has both parked the Domain Name with SEDO and clearly put it "for sale" through SEDO.

Complainant also produces an exchange of e-mails between Complainant and SEDO's account manager. After an offer from the Complainant to acquire the Domain Name for 200 €, SEDO manager replied "*as natura is a generic word term the owner won't sell below 1750 € + VAT +Sedo fees*". This amount, presented as a minimum (the amount concerning SEDO fees are also not mentioned but the proposal includes these fees in the amount that should be paid by the Complainant) and as related to a non-generic term is in excess of the costs directly related to the Domain Name.

The Third-party Decider therefore concludes that the Licensee has registered and used the Domain Name in bad faith.

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 "natura.be" domain name is to be transferred to the Complainant.

Brussels, August 23, 2012

Paul Van den Bulck
The Third-party Decider