



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Truvo/ IHG Business Data S.L.

Case no. 44289: online-goldenpages.be

1. The parties

1.1. Complainant:

TRUVO BELGIUM, partnership with partial limited liability ("*gewone commanditaire vennootschap*"), a commercial corporation organised under the laws of Belgium, with registered office at 2018 Antwerpen, De Keyserlei 5 box 7, listed in the Belgian enterprises database under number 0826.960.632.

Represented by:

Mr. Peter L'Ecluse and Thibaut D'hulst
Attorneys-at-law
with offices at 1050 Brussels, Louizalaan 165.

1.2. Domain Name Holder:

IHG BUSINESSDATA S.L.
with registered office at 28220 Majalahona Madrid, Avda. Reyes Catolicos 4, Spain and with a local office at 1831 Diegem, Pegasuslaan 5, Belgium;

2. Domain name

Domain name: **"online-goldenpages.be"**
Registered on: 22 May 2012 (last update: 22 May 2012 at 11.31 AM)

hereafter referred to as "the Domain Name".

3. Factual background information

The Complainant is the owner of the Benelux trademarks 'Golden Pages' with registration numbers 569245, 636556 and 732071. The Complainant is also the owner of Community trademark 'Golden Pages' registered under the number

CEPANI – NON-PROFIT ASSOCIATION

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161000.

In addition, the Complainant is the holder of the Domain Name 'goldenpages.be', which he registered on 13 November 1996.

According to the Complaint, the Complainant was recently informed by his Customers that misleading and illegal fax messages were being sent by the company IHG Businessdata S.L., proposing advertising space in "onze Belgische Golden Pages op Internet". According to the Complainant, the misleading and illegitimate fax messages constitute unlawful soliciting of advertisers and constitute a clear infringement of his trade marks. The Domain Name was referred to in the unlawful solicitations.

On 28 September 2012, the Complainant sent a notice letter to IHG Businessdata, the Domain Name Holder, asserting that *"through the use of trademarks of my client (the Complainant) and similar domain names, the recipients of the Fax Messages are led to believe that the offer originates from my Client, the publisher of the well-known Golden Pages paper and online directories and owner of the verbal trade mark Golden Pages (...)."*

The notice letter was sent by registered letter, by fax (04 290 03 00) and by email. In the notice letter, Complainant requested the Domain Name to be transferred to him. However, the Domain Name Holder failed to collect the registered letter and did not reply to the e-mail or fax of the Complainant.

On 15 November 2012, the Complaint was filed with Cepani.

On 17 December 2012, Cepani appointed the undersigned as the third-party decider to settle the dispute involving the Domain Name. The undersigned filed his Statement of Independence with the Secretariat of Cepni. Pursuant to Article 12 of the CEPANI Rules for Domain Name Dispute Resolution and given an extension because of the Christmas holidays, the deliberations were closed by 4 January 2013.

4. Position of the parties

4.1. Position of the Complainant

The Complainant requests the transfer of the Domain Name in accordance with article 10 (b) and (e) of the DNS.be policy and article 4 of the Law on abusive registration of Domain Names of 26 June 2003 on the basis of (i) the identity or at least confusing similarity between the Domain Name and Complainant's registered trademarks; (ii) the absence of a right or legitimate interest for the Domain Name Holder; and (iii) the bad faith registration and use of the Domain Name.

Regarding the first condition, the Complainant argues that it is undeniable that the distinctive part of the Domain Name is identical and in its entirety confusingly similar to the Complainant's trademarks.

The use of the sign 'online-goldenpages.be' would also infringe article 2.20.1 (a) or (b) of the Benelux Treaty on Intellectual Property and articles 9 (1) (a) and (b) of the Community Trademark Regulation 207/2009, as, arguably, the sign is identical or at least very similar to Complainant's registered trademarks.

The Complainant cites the EU case law, which confirms that there is a likelihood of confusion, if there is a risk that the public will be led to believe that the goods or services in question originate from the same company or from economically-linked companies.

The Complainant states that the relevant part of the Domain Name is 'online-goldenpages' as the '.be' extension must not be taken into account. The disputed Domain Name differs only from Complainant's registered trademarks through the addition of the descriptive term 'online'. This addition would not diminish the likelihood of confusion since it is descriptive of the online environment in which all websites operate.

Finally, the Domain Name would also infringe article 2.20.1 (c) of the BTIP and article 9 (1) (c) of the CTM regulation.

Regarding the second condition, the absence of a right or legitimate interest for the Domain Name Holder, the Complainant submits that the Domain Name Holder has no prior rights or any legitimate interest in the Domain Name or the sign 'Golden Pages'. The Complainant did not issue a licence or give permission of any other kind to the Domain Name Holder, allowing him to incorporate the Complainant's trademarks in the Domain Name.

The Domain Name Holder did not use a name corresponding to the Domain Name prior to the registration of the Domain Name. In addition, the Complainant states, the Domain Name Holder clearly does not use the sign in good faith, as it uses different signs in different territories, presumably with the sole purpose of confusing potential advertisers by using brand names with a good local reputation.

The Domain Name Holder has not been commonly known by the Domain Name, because the Domain Name Holder is a Spanish entity with no known activities in Belgium prior to the registration of the Domain Name. The Complainant points out as well that the fax messages sent by the Domain Name Holder do not refer to any other service or activity that could justify a right or interest to use the trademarks. The Complainant further notes that the Domain Name is linked to an inoperative webpage, which is "under construction".

Finally, the Complainant states that is very unlikely that the Domain Name Holder would have been ignorant of the Complainant's legal rights, as the trademarks are famous trademarks in Belgium. The sole motive of the Domain Name Holder to register the Domain Name would be to (ab)use the Complainant's trademarks to gain an unfair and illegitimate advantage.

Regarding the third condition, the bad faith registration and use, the Complainant points out that no response was given when the Complainant tried to contact the Domain Name Holder. The Domain Name Holder failed to mount a defence or raise legitimate arguments to justify the registration of the Domain Name.

The Complainant argues that is unlikely that the Domain Name Holder was unaware of the well-known trademarks of the Complainant. Since the Domain Name Holder pretends to offer a service akin to Complainant's own services, it is clear that the Domain Name Holder intended to use the reputation of the Complainant's trademarks to derive a commercial advantage. Advertisers may in fact respond to the fax messages thinking the products and services originate from or are connected with the Complainant.

4.2. Position of the Domain Name Holder

The Domain Name Holder did not reply to the Complainant's submission.

Consequently, the dispute shall be decided on the basis of the Complaint (art. 6.4 of the CEPANI Rules for Domain Name Dispute Resolution).

5. 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 Domain Name Holder'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 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."*

5.1. Identical or similar to

It appears clearly that the Complainant has prior rights in the name Golden Pages. The Complainant has established the existence of several GOLDEN PAGES trademarks which he owns, and he has been using the trade name Golden Pages for a long time.

The EU case law on trademark disputes, quoted by the Complainant, is not relevant in this case. The notion "confusingly similar" in CEPANI domain name disputes is not the same as the likelihood of confusion in trademark disputes. Confusing similarity in domain name disputes brought before CEPANI has to be evaluated *in abstracto*, without consideration of the concrete use which has been made of the Domain Name and the perception amongst consumers.¹ It is sufficient to establish that the signs are objectively so close that confusion is likely to arise *in abstracto*.²

In abstracto, it is obvious that the GOLDEN PAGES TRADEMARKS and the Domain Name 'online-goldenpages.be' are very similar. The relevant part of the Domain

¹ B. DOCQUIR, « Examen de Jurisprudence (1995-2005) – Le contentieux des noms de domaine », *JT* 2007, 6253, p. 64.

² CEPANI, 44106, argente.be ; CEPANI, 44248, whitecu.be; CEPANI, 44244, jambondeparme.be.

Name is 'online-goldenpages' as the '.be' extension must not be taken into account, according to the well-established case law of CEPANI.

The Domain Name is confusingly similar to the Golden Pages trademarks because the most distinctive element is Golden Pages and this is the element that the Domain Name has in common with the trademark. The word 'online' is descriptive for the online environment and adding this descriptive word to the terms Golden Pages does not take away the likelihood of confusion.

The Domain Name Holder does not dispute this similarity.

As a consequence, the first condition of article 10.b.1. of the Terms and Conditions of DNS.be is met.

5.2. Rights and legitimate interests

The Complainant refers to article 10.b.3. of the DNS Policy which gives a non-exhaustive list of circumstances that lead to a finding that the Domain Name Holder does not have rights or legitimate interests, because:

- prior to any notice of the dispute, the Domain Name holder did not use 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 Domain Name holder (as an individual, business or other organization) has not been commonly known by the Domain Name, even if he has acquired no trademark,
- the Domain Name holder is not making a legitimate and non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or trade name at issue.

Since the Complainant reasonably asserts that the Domain Name Holder does not have any rights or legitimate interests, the burden of proof lies on the Domain Name Holder, who has to prove that he actually does have rights or legitimate interests.

In the absence of such proof, it must be concluded that the second requirement is met.

5.3. Registration or use in bad faith

According to the Complainant, the Domain Name is registered or is being used in bad faith as "*the Domain Name Holder intended to use, in a confusing manner, the reputation of the Complainant's trademarks to derive a commercial advantage*". This statement is not contradicted by the Domain Name Holder and therefore the third party decider accepts that bad faith has been established.

Moreover, the extensive exhibits of the Complainant prove that this is a regular practice of the Domain Name Holder.

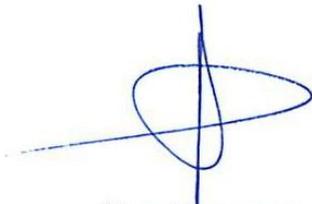
Finally, the disputed practices of soliciting advertisers are unlawful under several laws, even criminal laws, which confirms that the Domain Name Holder is acting in bad faith.

Without any response from the Domain Name Holder, it is sufficiently evidenced that the Domain Name was registered and is being used in bad faith.

6. 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 "**online-goldenpages.be**" Domain Name is to be transferred to the complainant.

Brussel, 16 January 2013

A handwritten signature in blue ink, consisting of a vertical line on the left, a horizontal line crossing it, and a large, loopy shape on the right.

Tom Heremans

The Third-party decider