



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Sputnik TV BVBA / Alexander White

Case no. 44260: sputnik.be

1. The parties

- 1.1. **Complainant:** Sputnik TV BVBA, with registered office at B-2600 Berchem (Belgium), Klokstraat 12A, bus B,

Represented by:

Mr. Kris Gaens, Manager and Legal Representative, with office at B-1000 Brussels (Belgium), Barthélémylaan 9, bus 3.

- 1.2. **Licensee:** MADEUROPE.com (Mr. Alexander White), with registered office at B-1050 Brussels (Belgium), Rue de l'été 74.

2. Domain name

Domain name: "sputnik.be"
Registered on: 19 June 2001

hereafter referred to as "the domain name".

3. Background to the case

On 1st February 2012, Complainant filed a complaint with the Belgian Centre for Arbitration and Mediation (CEPANI-CEPINA) concerning the domain name. No exhibits were filed in support of the complaint.

On 1st February 2012, CEPINA informed Licensee of the pending proceedings.

Licensee did not respond to the complaint.

On 24 February 2012, Complainant and Licensee were notified that the undersigned had been appointed as third-party decider to settle the dispute pursuant to Article 12 of the Rules for Domain Name Dispute Resolution, and that the deliberations would be closed 7 days from the

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date of the letter, i.e. on 2 March 2012 and that the third-party decider had to submit her decision to CEPINA's secretariat by 16 March 2012 at the latest.

4. Factual information

Having examined the complaint submitted by Complainant, the third-party decider finds that the following facts have been established.

4.1. Complainant

- Complainant is a television production company based in Antwerp which makes popular TV shows on national television like "Tournée Générale" (éen) or "Exotische Liefde" (VT4).
- The Complainant owns a Benelux trademark "SPUTNIK" with registration number 0904603.

4.2. Licensee

- Licensee registered the domain name sputnik.be on 19 June 2001.
- The domain is currently used for domain name parking, meaning that visitors of the website www.sputnik.be get to see advertisements.

5. Position of the parties

5.1. Position of Complainant

Complainant requests the third-party decider to order the transfer of the domain name, since the conditions provided for in Article 10(b)(1) of the Terms and Conditions of Domain Name Registrations under the ".be" Domain operated by DNS BE are met.

- (i) *Licensee's domain name is identical to a trademark in which Complainant has rights:*

Complainant relies on its Benelux trade mark registration for the word "SPUTNIK". This is not substantiated by any exhibits.

From the wording of the complaint, it seems that the Complainant does not invoke other rights such as trade name or company name. It merely states that "*Sputnik is a television production company, based in Antwerp and originated in 2001*". This is not substantiated by any exhibits.

- (ii) *Licensee has no right or legitimate interest in the domain name:*

Complainant states that it has contacted the domain name holder regarding the transfer of the domain name but that these actions did not have any result. According to the Complainant, the Licensee has answered that he is involved in an unspecified project that is going to be called 'Sputnik' and that it seems to them that the

activities of the Licensee have no relationship with the domain name, and that the domain name has not been used since its registration in 2001. Complainant does not submit the relevant correspondence.

(iii) *Licensee's domain name has been registered or is being used in bad faith:*

Complainant states that its company name generates a significant amount of traffic on sputnik.be and that visitors of this site get to see advertisements through the activity of domain name parking. This is not substantiated by any exhibits.

5.2. Position of Licensee

Licensee did not file any response with CEPINA.

6. Discussion and findings

Pursuant to Article 15.1 of the CEPINA rules for domain name dispute resolution, the third-party decider shall decide on the complaint in accordance with the Policy and the CEPINA 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, Complainant has to prove that:

- 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 Complainant has rights; and
- Licensee has no rights or legitimate interests in the domain name; and
- Licensee's domain name has been registered or is being used in bad faith.

6.1. *Identical or confusing similarity to a name or sign of the Complainant:*

In order to meet the first condition Article 10(b)(1) of the DNS BE Policy, the domain name must be either identical or confusingly similar to a sign owned by Complainant.

It is sufficient that a domain name conflicts with one of Complainant's rights or interests mentioned in this Article.

It is also sufficient that the domain name is either identical or similar to one of the rights or interests mentioned.

Complainant does not seem to rely on the existence of a right in a trade name. It only relies on its Benelux word mark "SPUTNIK".

In the case at hand, the domain name is identical to Complainant's Benelux trademark "SPUTNIK".

However, as can be verified in the register of Benelux trademarks (online available at www.boip.int), Complainant's Benelux trademark "SPUTNIK" was filed on 23 June 2011 and registered on 10 November 2011, whereas the domain name was already registered on 19 June 2001.

The third-party decider observes that earlier case law and legal doctrine take different views on the question of whether the name or sign relied on by the Complainant must pre-date the Licensee's registration of the domain name.

The third-party decider takes the view that no such anteriority of the invoked rights is required for the first condition of Article 10(b)(1) to be fulfilled, and this for the following reasons:

1. First, Article 10(b)(1) of the DNS BE Policy does not contain such a condition. It merely states that the complainant must be able to prove that *"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"* (emphasis added). There is no requirement that the complainant owned the right (here: the trademark) at the time of registration of the domain name. It is sufficient that the complainant is entitled to the right (here: the trademark) at the time of filing of the complaint¹. Unlike what is suggested in some earlier decisions², the third-party decider is of the opinion that this interpretation of Article 10(b)(1) of the DNS BE Policy does not go against the general rule of trademark law according to which the exclusive right in the trademark only arises from the registration thereof (Art. 2.2 of the Benelux Treaty on Intellectual Property Rights). The finding that Complainant's exclusive trade mark rights in the sign "SPUTNIK" only arise as of the registration thereof (i.e., 10 November 2011) is not contrary to the finding that the complainant as of that date can rely on this trademark to file a complaint under the DNS BE Policy against a domain name, even if such domain name was registered before the trademark was registered. Moreover, such broad interpretation of Article 10(b)(1) of the DNS BE Policy is justified taking into account the scarcity of available domain names which is inherent to the domain name system.
2. The third-party decider is of the opinion that no argument in favour of a requirement of anteriority under Article 10(1)(b) of the DNS BE Policy can be drawn from the principles applying to the .eu domains. Where Articles 21 and 10.1 of the ".eu Regulation" explicitly require the existence of "prior rights", i.e. rights which precede the registration of the domain name, there is no corresponding provision in the DNS BE Policy. The absence of a corresponding provision in the DNS BE Policy should be interpreted as meaning that no such requirement exists under the DNS BE Policy.

¹ See B.A.C. Lieben and F.J.C. Petillion, "Overzicht van de .be beslissingen in de ADR-procedure van Cepina (2001-2006)", *Computerrecht* 2007, issue 42, (74) 76 and 82 and Cepina decisions in cases 4021 (decision of 12 November 2002), 44/81 (decision of 23 December 2009), 44057 (decision of 8 March 2005), 44074 (decision of 13 February 2006), 44085 (decision of 31 July 2006).

² See e.g. Cepina decision of 27 August 2009 in case 44169.

3. Also, a domain name is not an intellectual property right in the sense that trademarks are. It is a temporary license to use a technical facility which consists of being able to identify a computer that is connected to the Internet through the alphanumeric representation of a numeric IP (Internet Protocol) address. The holder of a domain name does not own the domain name but is only entitled to use the domain name during a certain period of time³. Hence, the mere registration of a domain name does not create an intellectual property right⁴. It would therefore be inappropriate to simply transpose the principles governing intellectual property rights such as trademarks, like the principle of anteriority, to the context of domain names⁵. It would go against the *rationale* of the domain name system to allow that a domain name, regardless the use that is being made thereof, becomes a perpetuate right which would outweigh the legitimate interests of an IPR (e.g. trademark) owner⁶, even if the relevant intellectual property right is of a later date than the domain name.
4. Finally, the three conditions set out in Article 10(b)(1) of the DNS BE Policy are closely linked to each other and one condition can serve to interpret the other. The situations in which bad faith can be withheld under Article 10(b)(3) of the DNS BE Policy, confirm the abovementioned interpretation of Article 10(b)(1) thereof. More specifically, the third condition of Article 10(b) of the DNS BE Policy requires that the licensee has registered or is using the domain name in bad faith. Where the existence of the complainant's rights at the time of registration of the domain name can contribute to a finding that the licensee has registered the domain name in bad faith, it is not required to find that the licensee acted then in bad faith. Indeed, bad faith can also be withheld based on the use that is made afterwards of the domain name. Interpreting Article 10(b)(1) of the DNS BE Policy in the sense that it would require anteriority of the complainant's rights, would in fact significantly reduce the useful effect of the "use in bad faith" element of Article 10(b)(1) of the DNS BE Policy.

Hence, the third-party decider is of the opinion that it is required but sufficient that the complainant is able to demonstrate his rights at the time of filing the complaint. As a consequence, the first condition of Article 10(b)(1) is fulfilled in the case at hand.

6.2. *Absence of rights or legitimate interests:*

In order to meet the second condition of Article 10(b)(1) of the DNS BE Policy, Complainant must prove that Licensee has no right to or legitimate interest in the domain name.

Although the complaint is not substantiated by any exhibits and the communications that would have taken place between Complainant and Licensee

³ T. Heremans, "Domeinnamen in het Belgisch vermogensrecht", *IRDI* 2003, (13) 14.

⁴ See e.g. H.W. Wefers Bettink, "Domeinnamen: merk of handelsnaam?", *IER* 1997, issue 5 (164) 168: "the mere registration of a domain name does not lead to creating a right on a trademark or tradename".

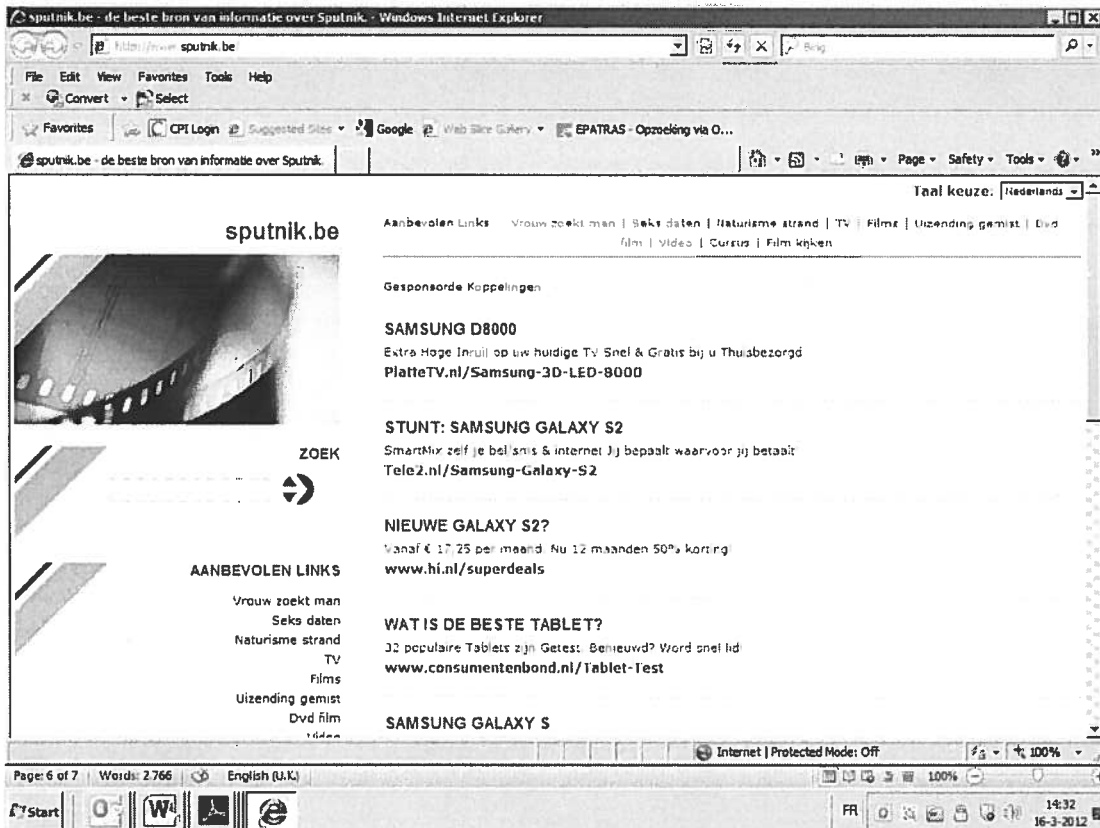
⁵ *Contra*: Cepina decisions in cases 44169 (decision of 27 August 2009) and 44192 (decision of 12 April 2010) which seem to treat domain names as an intellectual property right to which the same principles apply as to, for instance, trademarks.

⁶ Whereas trademark owners who do not use their trademarks within five (5) years after registration, can be sanctioned with revocation of their trademarks.

are not joined to the complaint, the third-party decider is of the opinion that Complainant has made it plausible that Licensee has no rights or legitimate interests in the domain name.

More specifically, none of the (non-exhaustively) listed circumstances in Article 10(b)(3) of the DNS BE Policy appears to be present in the case at hand.

First, there are no indications that Licensee has used the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services. On the contrary, when typing in the domain name sputnik.be, an Internet user arrives at the following webpage:



Hence, Licensee seems to have “parked” the domain name, i.e. is using it to generate “pay-per-click” advertising income from sponsored links to websites of third parties offering various types of goods and services, thereby taking undue benefit from the brand awareness created by Complainant through its popular television shows.

Second, there are also no indications that Licensee is making a legitimate and non-commercial or fair use of the domain name. Using a domain name to build a website containing sponsored links to various commercial websites does not constitute a legitimate and non-commercial or fair use of the domain name.

Third, no evidence is available showing that Licensee would have been commonly known by the domain name. On the contrary, the company name used by Licensee is “MADeurope bvba” and Licensee does not seem to own any trademarks in relation to “SPUTNIK”.

Finally, Licensee, who according to the company data available through the KBO Public search, seems to engage in computer related activities and public relations

including domain name registrations (as can be seen from its website <http://madeurope.com>), nevertheless did not file any reply to the complaint. Licensee hence fails to demonstrate that these circumstances, or other circumstances that would demonstrate the existence of any rights or legitimate interests of Licensee in the domain name, would be present in the case at hand.

The third-party decider therefore concludes that Licensee has no rights or legitimate interests in the domain name and that the second condition of Article 10(b)(1) is also fulfilled.

6.3. Registration or use of the domain name in bad faith:

In order to meet the third and last condition of Article 10(b)(1) of the DNS BE Policy, Complainant must prove that Licensee registered or used the domain name in bad faith.

Given the fact that Complainant's trademark rights were registered after Licensee's domain name, the registration of the domain name cannot be held to have taken place in bad faith. Hence, in the case at hand, any bad faith can only reside in the subsequent use which has been made of the domain name.

Article 10(b)(2) provides a non-exhaustive list of circumstances which prove that a domain name is used (or registered, but this is, as mentioned above, not relevant in the case at hand) in bad faith.

The third-party decider is of the opinion that at least one of those circumstances is present in the case at hand.

More specifically, the third-party decider is of the opinion that it has been sufficiently established that Licensee is using the domain name to attract, for commercial gain, Internet users to Licensee's website, by creating confusion with Complainant's trademark and trade name as to the source, sponsorship, affiliation, or endorsement of Licensee's website or products or services offered thereon. Indeed, Licensee is using the domain name to operate a website which creates "pay-per-click" advertising income, thereby taking undue benefit from the awareness which Complainant has created amongst the general public with its television shows on Belgian national TV. This circumstance is in itself sufficient proof of the Licensee's bad faith.

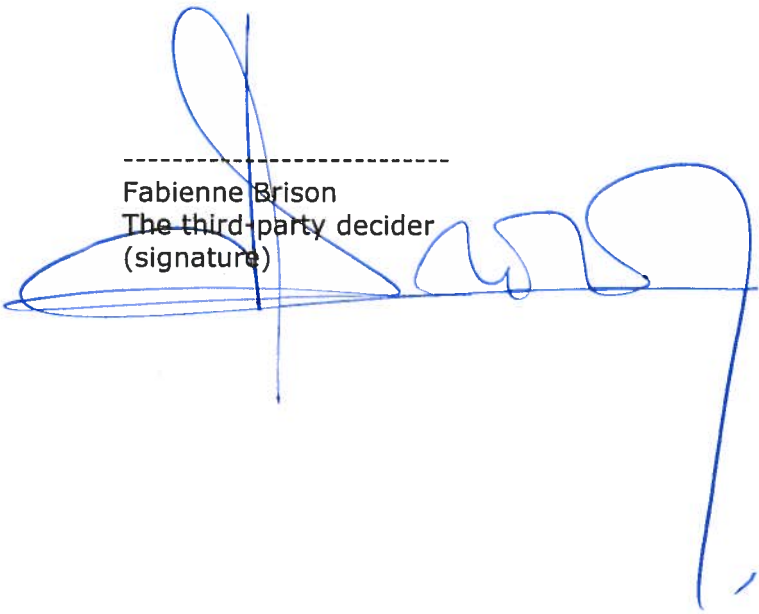
In light of this circumstance, the third-party decider is of the opinion that the third condition of Article 10(b)(1) is met.

7. Decision

Consequently, the third-party decider rules that the complaint is receivable and founded and rules that the domain name registration for the "sputnik.be" domain name is to be transferred to Complainant pursuant to Article 10(e) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE.

Brussels, 16 March 2012.

Fabienne Brison
The third-party decider
(signature)

A handwritten signature in blue ink, consisting of a large loop on the left, a vertical line, and a series of loops and a long tail on the right.