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BELGIAN CENTER FOR ARBITRATION AND MEDIATION

## DECISION OF THE THIRD-PARTY DECIDER

### BVBA TRANSFER / MARKUS JANK

Case no. 44279: transfer.be

#### 1. The parties

- 1.1 Complainant: Transfer bvba;  
with registered office at 8020 Oostkamp (Belgium),  
Hazelaarstraat 6,  
listed in the Belgian Crossroads Bank for Enterprises  
under number 0434.590.583

*Represented by:*

Jean-Claude Van Zandycke, director

- 1.2. Licensee: Markus JANK;

*Represented by:*

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

#### 2. Domain Name

Domain name: "transfer.be"  
Registered on: March 12, 2012

Hereafter referred to as the "Domain Name";

### **3. Background of the case**

On August 3, 2012, the Complainant filed a complaint with the Belgian Centre for Arbitration and Mediation (CEPANI)

On September 14, 2012, the Licensee filed a response with CEPANI.

On September 19, 2012, CEPANI appointed the Third-Party Decider.

On September 26, 2012, the Complainant filed a response with CEPANI to the Licensee response of September 14, 2012.

On October 3, 2012, the Licensee filed an additional response with CEPANI to the Complainant response of September 26, 2012.

On October 3, 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 December 20, 2008 (published in the Belgian Official Journal of January 26, 2009, produced by the Complainant with her complaint) the Complainant, incorporated under Belgian law since 1988, changed its corporation name from “Karel Van Massenhove” to ‘Transfer’.

The Complainant’s corporation name as well as its tradename (according to invoices produces by the Complainant) is “Transfer”.

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 March 12, 2012.

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 “koop dit domein” (translation : “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 hyperlink of third parties’ websites.

### **5. Position of the parties**

#### **5.1 Position of the Complainant**

The Complainant states that the Domain Name is identical to its prior corporation and trade name. The Complainant adds that the Licensee should have known the existence of the company name due to an obligation as a professional to have

checked the existence of possible conflicting corporation names via online tool search of the Belgian Crossroads Bank.

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 had no activity linked with such tradename in Belgium, except an activity of provider of parking website.

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 selling of it for the amount of 19.400 euro, which is in her opinion not a bona fide offering.

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

## 5.2 Position of the Licensee

The Licensee considers that the Complainant has provided absolutely no evidence to support his claim that it operates a business known as 'Transfer bvba'.

The Licensee is furthermore of the opinion, 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 registrant of domain names who wish to trade domain names takes 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 'transfer', when used in connection with the dictionary meaning (the act of moving something or someone to another place) is a common generic term widely known and used by English-speakers across the globe. 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 had not been used to target the Complainant's corporation- or tradename. The Licensee considers that nothing indicated that he should have known the corporation name.

## 6. Discussions and findings

Pursuant to article 15.1 of the *CEPANI rules for domain name dispute resolution*, the Third-Party Decider shall rule on domain names 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 Third-Party Decider ascertains that the Complainant effectively carries the name ‘transfer’ as corporation name since 2009. This appears undeniably from the publications in the Belgian Official Journal and the Belgian Crossroads Bank.

The discussion concerning the question if the Licensee should have known about the Complainant at the moment of registration is irrelevant, as this is not a condition imposed by Article 10 b) 1 of the Policy.

The Domain Name is thus identical to the corporation name of the Complainant.

#### 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) had 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 of corporation name, geographical designation, name of origin, designation of source, personal name of name of the geographical entity at issue.*

It is standing case law that the Complainant can technically not prove the absence of something, i.e. a ‘negative fact’ and that therefore the onus shifts to the Licensee to assert certain facts supporting a right/legitimate interest (F. PETILLION and B.

LIEBEN, "Overzicht van de .be beslissingen in de ADR procedures van Cepina (2001-2006)", *Computerrecht* 2008, 74-87, n° 7.1 to 7.5 and cases quoted; B. DOCQUIR, 'Le contentieux des noms de domaine', *J.T.* 2007, 61-71, n° 18 and cases quoted). Once the Licensee has done so the onus shifts back to the Complainant and it is then on the Complainant to provide proof that the facts asserted by the Licensee are not true.

Applied to the case at hand, this means the following: the Complainant asserted a lack of right and legitimate interest and in his response to the complaint the Licensee explained his business model (of "buying and selling generic domain names") and expressed his opinion that (in the legal assessment) this creates a legitimate interest. While the Complainant also asserts that the Licensee must have been aware of the Complainant and his corporation name the Licensee denies this and since the Complainant could not raise substantial doubts with regards to this denial the Third-Party decider treats the Licensee as if he had no such knowledge at the relevant time, i.e. the time of the registration of the Domain Name.

The Licensee does not claim to have a right in the Domain Name. The following reasoning therefore only concerns the question of whether the Domain Name has been registered without legitimate interest.

Under lit. (a) legitimate interest can be demonstrated where prior to any notice of an ADR procedure the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods and services or has made demonstrable preparation to do so. These requirements are not fulfilled in the present case. This would only be the case if one would regard the offering for sale of the Domain Name as qualifying to be in connection with the offering of goods or services. This is not what is intended by this provision. Rather there should be a genuine use in form of content being available under the Domain Name.

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; case n° 44274 – natura.be; B. DOCQUIR, 'Le contentieux des noms de domaine', *J.T.* 2007, 61-71, n° 21).

Under lit. (b) the holder of a domain name being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a trade mark. These requirements are also not fulfilled in the present case and such requirements are not even alleged by the Licensee.

Lit (c) suggests legitimate interest where the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name (...). The requirement

of non-commercial is not fulfilled since offering the Domain Name for sale (here for 19.400 EUR) is a commercial undertaking.

Consequently none of the examples listed in Art. 10 b) 3 of the Policy are supported by the facts asserted by the Licensee. However, Art. 10 b) 3 of the Policy is non-exhaustive. The question to be answered is than what consequences follow from the fact that the Licensees course of action fulfills neither of the requirements of Art. 10 b) 3.

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 falls under a “safe-harbor” as long as he takes care to register only generic, dictionary-term domain names

The difficulty in answering this question is that there is little guidance to the meaning of ‘legitimate interest’. In the view of the Third-Party decider the next step would be to enquire whether the facts of the present case create a situation of which he is convinced the Policymaker would have added to the list of examples if had he been aware of this at the time of the drafting of the Policy. For this exercise the Third-Party decider reverts to the three examples given in Art. 10 b) 3 and try to extract a common denominator on which all examples are based. In doing so the conclusion is that such common denominator can be identified in the use of term in question, be it as domain name or otherwise. Art. 10 b) 3) (i) and (iii) expressly require that the domain name is used in a specific way. Art. 10) b) 3) (ii) requires that the holder of the domain name has commonly been known by the domain name. This requires a use of some form, be it by the holder of the domain name himself or by third parties.

The Third-Party decider does not consider the registration of a domain name for the sole purpose of offering it for sale as a genuine use as required by the Policy. No legitimate interest in the Domain Name has thus been demonstrated (See also .eu ADR n° 6199: remarkable.eu, in which the Licensee was involved).

### 6.2.3 Registrations 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, 61-71, n° 27).

According to the Complainant, the only purpose of the Licensee at the registration, was being able to sell the domain name for a higher price.

The Complainant submits evidence which proves that the Licensee wanted to sell the domain name via SEDO to the Complainant for 19.400 euro. The Licensee does not deny this. The Complainant also lodges documents which prove the proposition of sale.

From those documents can be deduced that the domain name was registered with the purpose of selling it, for a price that excels the expenses of the acquisition.

The Licensee contests the bad faith at the registration, for reason that he had no knowledge of other rights in favor of Complainant at the moment of registration. The Licensee furthermore states that the bad faith should stand “in relation” with the Complainant for being considered and that thus there is only bad faith if the registration or the acquisition is specifically addressed at the Complainant.

The offering for sale of a domain name can be seen as a prove that the holder of the domain name proceeded with bad faith (see case n° 44244: jambondeparme.be). It is hereby not relevant if the offer of selling the domain name has been done directly at the holder of a right concerning this name, or done at the public (See .eu ADR cases n° 2733: hotel-adlon.eu and n° 5824: diehl.eu).

The Third-Party Decider has after all the opinion that when article 10, b) 2, as example of registration or use with bad faith, mentions the registration with an eye to the sale “to the Complainant”, hereby is understood the registration with an eye to the sale for every possible complainant (See n° 44246: uns.be) .

Naturally, the registration with bad faith stays, even if done only with an eye to sale, at a higher price than the expenses for acquisition, to other persons (potential ‘complainants’) than the Complainant in the pending conflict. The offering for sale of domain names for a price excelling the price of acquisition, is bad faith as repeatedly ascertained in decisions of CEPINA (n° 44103: farowball.be and n° 44246: uns.be). The amount of 19.400 is furthermore an excess of the costs directly related to this Domain Name (n° 44274: natura.be, in which the Licensee was involved, and UDRP n° 100391: sbkgear.com).

It appears that the Licensee has only used the domain name for the sale of it for a price that excels the cost of acquisition, which is sufficient to demonstrate the utilization with bad faith in the meaning of article 10 b) 3 of the Policy.

## **7. Decision**

Consequently, pursuant to Article 10 e) of the Policy, the Third-Party Decider hereby rules that the domain name registration for the ‘transfer.be’ domain name is to be transferred to the Complainant.

Brussels, October 10, 2012

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Joris DEENE  
The Third-Party Decider