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BELGIAN CENTER FOR ARBITRATION AND MEDIATION

**DECISION OF THE THIRD-PARTY DECIDER**

***SPA TELECOM ITALIA/EASY DOMAIN CONNECT LTD***

**Dispute N° 44160: Olivetti.be**

**1. Parties**

1.1. Complainant: SPA TELECOM ITALIA

having its registered office at 20123 Milano (Italy) Piazza degli Affari 2

*Represented by:*

Porta, Checcacci & Associati SPA, Miss Anne Maria Bardone,  
Attorney at Law, Via Trebia 20, 20135 Milano (Italy)

1.2. Domain name holder:

EASY DOMAIN CONNECT LTD

Having its registered office at SK7 2DH Stockport, Cheshire (United Kingdom), 1 Maple Road

*Not represented*

**2. Domain Name**

Domain Name: Olivetti.be

Registered: August 15<sup>th</sup>, 2007

Hereafter stated as « Domain Name »

### **3. History of the procedure**

On March 23<sup>th</sup> 2009, the Complainant filed a complaint with CEPANI according to the CEPANI rules for domain name dispute resolution and the dispute resolution policy of DNS, incorporated in the General Conditions, concerning the Domain Name. The Complainant requests that the Domain Name shall be transferred to the Complainant.

On April 15<sup>th</sup> 2009, CEPANI communicated the Complaint to the Domain Name holder.

The date of commencement of the proceedings is April 15<sup>th</sup> 2009.

No Response was submitted by the Domain Name Holder.

The undersigned was appointed by CEPANI as third-party decider on May 13<sup>th</sup> 2009. The undersigned has filed his statement of independence with the Secretariat of CEPANI.

On May 13<sup>th</sup> 2009, CEPANI informed the Complainant and the Domain Name holder that the undersigned was appointed as third-party decider.

The deliberations were closed on May 20<sup>th</sup>, 2009.

### **4. Facts**

The Complainant (formerly Ing. C. Olivetti & C. Spa, originally established in 1908) is active in the following business areas:

- fax, printers, multifunctional devices, calculators and original office supplies;
- digital systems for copying and printing requirements;
- products and services for the retail sector and automated gaming systems.

The Complainant holds several International and European trademarks (both word and figurative trademarks) for "Olivetti".

The Domain Name was registered by the Licensee on August 15<sup>th</sup>, 2007.

The Domain Name holder operates a website under the Domain Name, which contains a number of sponsored links to websites which offer products or services similar to those of the Complainant:

The screenshot shows the Olivetti website interface. At the top, there is a navigation menu with links for 'Cartridges Olivetti Fax', 'Caractéristiques Olivetti', 'Olivetti', and 'Photo'. Below the menu is a search bar with the text 'Recherche' and a search button. To the right of the search bar is a list of sponsored links, including 'Conference Call', 'Transfert de données', 'Expand Portable Displays', 'MIT Europe', 'Téléchargement SQL Server', 'AFM Applications', 'Interpreters in Ireland', 'Conférences Audio/Video', 'Destination Management Co', and 'CRM'. Each link includes a brief description and a URL.

## 5. Position of the parties

### 5.1. Position of the Complainant

#### 5.1.1.

The Complainant argues that the Domain Name is perfectly identical to its trademarks and its brand name.

He states that the trademarks have been used for many years in connection with the typewriter field and that he actually owns and uses the following domain names: Olivetti.it, Olivetti.com, Olivetti.eu, Olivetti.co.uk, Olivetti.com.mx, Olivetti.se.

The Complainant points out that the Domain Name is also confusingly similar to its trademarks and domain names. He refers to the fact that the Domain Name Holder places on his website links to third parties which offer similar products for office products (Olivetti fax, cartridges Olivetti, photocopieur Olivetti ...) or services offered under the well known domain name, trade name or trade mark, in order to generate as many clicks as possible. According to the Complainant, the risk of confusion exists and increases due to the fact that the name "Olivetti" as well as the product are well-known on a worldwide scale and in the Benelux.

### 5.1.2.

The Complainant argues that he has not authorized or licensed the Domain Name holder to use his trade mark or trade name. He refers to the fact that a quick research on the online registers does not show that the Domain Name holder owns a trademark right on the Domain Name.

The Complainant states that there is no evidence suggesting that the Domain Name holder is commonly known by the Domain Name.

He observes that the Domain Name is linked to a *parking website* (containing pay-per-click links), so that the Domain Name holder is using the reputation and fame of the Complainant in bad faith for a website of dubious qualities.

### 5.1.3.

The Complainant argues that the Domain Name holder is unfairly and opportunistically appropriating of the goodwill associated with the Complainant's famous Olivetti trademarks. According to him, these circumstances strongly evidence the Domain Name holder's bad faith registration and use of the domain names since there is no evidence even in the Internet suggesting that the Domain Name holder is commonly known by the "Olivetti" domain name.

He points out that:

- the "Olivetti" trademark is well-known, so that it can be assumed that the Domain Name holder knew or should have known about the existence or use of the well-know trademark or tradename;
- Olivetti cannot be a made-up name, since Olivetti is the founder's surname (Camillio Olivetti) and that it is inconceivable that the Domain Name holder would have accidentally chosen this name as domain name;
- the activities of the Domain Name Holder amount to passing off and create confusion over the source, sponsorship or affiliation with his trademarks;
- the Domain Name holder was already involved in an ADR procedure concerning the domain name "rbsjobs.co.uk" (Nominet UK Dispute Resolution Service, The Royal Bank of Scotland Group plc v. Easy Domain Connect LTd; case n° 4325) in which the panel judged that the use of the domain name for a list of affiliate recruitment websites including in the complainant's financial sector indicates that the domain name was registered in order to divert and profit from internet users seeking information about employment opportunities with the complainant;
- links on the parking webpage redirect to the websites ink-refiles-ink.com, quickpcsolutions.org, best-telecom.be and corporate-telecom.nl, which are active in the same field of activity as the Complainant; this shows that the Domain Name holder knows about the Complainant's activities and his purpose was to attract internet users to its website and to redirect them to competitor's websites.

## 5.2. Position of the Domain Name holder

The Domain Name holder did not submit any response.

According to article 5.4. Rules of Procedure, the dispute shall be decided on the basis of the Complaint.

## 6. Discussion and conclusions

According to article 15.1 of Cepani Rules for domain name dispute resolution, the Third-Party Decider shall decide on the Complaint in accordance with the DNS.BE Policy and these Rules.

According to article 10,b,1 of the terms and conditions of Domain name Registration under the « .BE » for domain operated by DNS.BE., the Complainant has to prove

- the 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 has been registered or is being used in bad faith.

### 6.1. *Is identical or confusingly similar to*

The Domain Name is identical to the various word trademarks for "Olivetti".

According to the CEPANI case-law, the suffix ".be" has no relevance in order to establish the identity or similarity between a domain name and a trademark.

Therefore, the first condition is met.

### 6.2. *Right and legitimate interest*

The Domain Name holder has not submitted any circumstance demonstrating his rights or legitimate interest to the Domain Name.

The file does not contain any evidence that the Domain Name holder has been commonly known by the Domain Name and/or that he owns trademark or other rights with respect to the Domain Name.

There is no proof of any authorisation by the Complainant, regarding the use of the Domain Name.

Moreover, the Domain Name is used for a website which contains sponsored links to websites of third parties and to divert internet customers interested in office products (fax, copiers, ...). The Domain Name holder is deriving income from such "pay-per-click" business.

The Domain Name is not used in connection with a bona fide offering of goods or services and the Domain Name holder is not making a legitimate and fair use of the Domain Name.

Apparently, the Domain Name holder made a similar kind of use of other domain names (Nominet UK Dispute Resolution Service, "rbsjobs.co.uk, case n° 4325; "magnerscider.co.uk, case n° 05779).

The elements submitted by the Complainant are not contested by the Domain Name holder.

The third-party decider rules that the Domain Name holder has no rights and legitimate interests in the Domain Name.

Therefore, the second condition is met.

### 6.3. *Registered or being used in bad faith*

The arguments submitted by the Complainant were not contested by the Domain Name holder.

These arguments indicate with a reasonable degree of certainty the existence of bad faith.

Olivetti is a well-known trademark and the third-party decider accepts that the Domain Name holder at least knew about the use thereof at the time the Domain Name was registered.

The website operated under the Domain Name contains various links to websites of firms which are active in the same field of business as the Complainant is.

It is clear that the Domain Name is intentionally used to attract, for commercial gain, Internet users to the Domain Name holder's website and those of competitors of the Complainant, by creating likelihood of confusion with the Complainant's trademarks.

The Domain Name holder abuses the notoriety of the name « Olivetti » and takes advantage of the fame and reputation of the Complainant's trademarks for his profit and that of advertisers.

Apparently, the Domain Name holder conducts such a business on a regular basis. The bad faith of the Domain Name holder has already been established in relation to other domain names (Nominet UK Dispute Resolution Service, "rbsjobs.co.uk, case n° 4325; "magnerscider.co.uk, case n° 05779).

The third-party decider rules that the Domain Name is registered and being used in bad faith.

Therefore, the third condition is met.

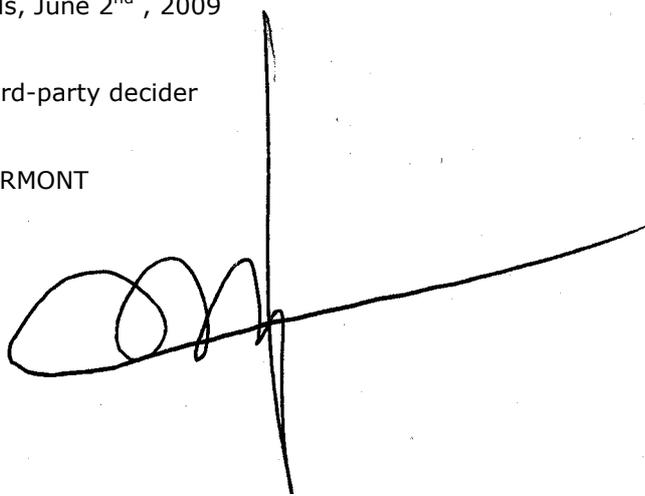
## **7. Decision**

The third-party decider decides, according to article 10, e of the terms and conditions of domain name registration under the « .BE » for domain operated by DNS.BE, to transfer to the Complainant the registration of the domain name "Olivetti.be".

Brussels, June 2<sup>nd</sup>, 2009

The third-party decider

Jan SURMONT

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right, positioned over the text 'The third-party decider' and 'Jan SURMONT'.