



BELGIAN CENTER FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Malamine Kone / Globevents BVBA

Dispute N° 44155 : airness.be

1. Parties

- 1.1. Complainant: Malamine Kone
Established at 8, allée Auguste Renoir
F-92300 Levallois Perret, France

Represented by:

Sela Casalunga , Attorney at Law, represented by Caroline Casalunga and Philippe Comte, having their offices at 5-7, rue Percier à 75008 Paris, France

- 1.2. Licensee: Globevents BVBA
Established at Aarschotsesteenweg 179
3012 Wilsele / Leuven, Belgium

2. Domain Name

Domain Name: airness.be
registered on 26 August 2004

Hereafter referred to as « Domain Name »

3. History of the procedure

The Complaint was submitted to CEPANI-CEPINA, the Belgian Centre for Arbitration and Mediation ("Cepani"), on 17 March 2009.

Cepani informed the Licensee of the Complaint, but the Licensee did not submit his Response within the term set by Cepani.

On 17 April 2009, Cepani informed the Complainant and the Licensee that the undersigned had been appointed as the third-party decider to settle the dispute pursuant to Article 12 of the Cepani Rules for the Domain Name Dispute Resolution.

The deliberations would be closed by 24 April 2009.

On 16 April 2009, the third-party decider sent the Declaration of Independence to Cepani.

CEPANI – ASSOCIATION SANS BUT LUCRATIF

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On 23 April 2009, the Licensee asked for an additional term to respond to the Complaint, because he would not have received in due course a copy of the Complaint.

On 23 April 2009, the third-party allowed the Licensee to file his Response by 4 May 2009.

On 4 May 2009, Cepina received the Response of the Licensee and invited the Third Party Decider to render his decision by 18 May 2009.

4. Facts

4.1. The Complainant

The Complainant, Mr. Malamine KONE, is the founder of a line of sports equipment that started in 1999 and became an international business under the name AIRNESS.

According to the Complainant's exhibits and press articles, the clothing and sports line of AIRNESS grew 100% per year since 1999 and realized a turnover of 120 million EUR in 2005. The business success of AIRNESS was reported in several media, including in the newspapers and magazines TIME (2006), Het Belang van Limburg (2005/2006), Il Giornale (2005), Sueddeutsche Zeitung (2005), Le Monde (2005), L'Equipe Magazine (2004), etc.

The Complainant is the proprietor of several trademarks, including:

- The French trademark AIRNESS (word + device) n° 99 774 553 filed on 11 February 1999 and registered for the products of classes 18, 25 and 28;
- The Community trademark AIRNESS (word + device) n° 1532159 filed on 15 February 2000 and registered for the products of classes 18, 25 and 28;
- The French trademark AIRNESS (word/device) n° 023197927 filed on 4 December 2002 and registered for the products and services of classes 3, 9, 14, 16, 18, 25, 28, 36, 38 and 41;
- The Community trademark AIRNESS (word + device) n° 3978781 filed on 10 August 2004 and registered for the products and services of classes 3, 9, 14, 16, 36, 38 and 41;
- Other International Trademarks for sports and sports related products and services, provided in the exhibits 6 and 7 of the Complainant.

The Complainant registered the following domain names :

- Airness.fr on 10 February 2003;
- Ariness.es on 19 December 2005 and
- Airness.eu on 10 June 2006.

4.2. The Licensee

The Licensee, Globevents, is a licensed travel agent in Belgium, which was created in 1995 and which seems to specialize in winter sports holidays. In his brochure of 2006-2007, the Licensee promotes ski holidays in many ski resorts in France, but also in Austria.

According to the Licensee, the name AIRNESS has been used since 1999 for "specific snowboard training and events."

On 26th August 2004, the Licensee registered the Domain Name airness.be with DNS Belgium, according Exhibit 1 of the Complainant.

According to the Licensee, however, the Domain Name was registered initially on 28 May 2001 for a legal entity called Airness Ride Your Style. This was confirmed by the registry, DNS Belgium, in an e-mail of 29 April 2009 (Exhibit 3 of the Licensee).

This legal entity is, according to the Licensee, the non-profit organization Airness Ride your Style, abbreviated "Airness". This organization was created on 3 December 2000 and its articles of incorporation were published in the Official State Gazette (*Moniteur belge*) on 6 February 2001. On 20 October 2005, the non-profit organization published its new articles of incorporation in the Belgian Official State Gazette (*Moniteur belge*).

The Licensee and the non-profit organization Airness seem to cooperate. The Licensee acts as a licensed travel agent and the non-profit organization Airness Ride your Style takes care of promoting snowboarding and organizes lessons.

5. Position of the parties

5.1. Position of the Complainant

The Complaint is based on the following grounds:

- The Domain Name is identical or confusingly similar to the trademarks in which the Complainant has rights

The Complainant points out that the only difference between the trademarks and the domain name is the ".be" extension, but the extension is not to be taken into account in the assessment (see Cepani decision N° 44039 of 21 November 2003).

- The Licensee has no rights or legitimate interests in respect of the Domain Name

The Licensee did not use the Domain Name or a name corresponding with the domain name prior to the dispute in relation to a bona fide offering of products or services, because the Licensee is a travel agent operating under another name, GLOBEVENTS. The Domain Name is being used by the non-profit organization Airness Ride your Style.

The Complainant has not licensed or otherwise permitted the Licensee to use the name AIRNESS.

The Licensee does not own any AIRNESS trademarks, based on research in the relevant French, Benelux, Community and International trademark databases. The Licensee is not known under the name AIRNESS, which is evidenced by research on the internet.

The word AIRNESS does not have a specific meaning. It is not a generic term used to refer to the goods or services in relation to which the Complainant's trademarks are registered.

The Domain Name was registered after the filing or registration of several trademarks of the Complainant in the Community and many other countries.

According to the Complainant, the Licensee must have had knowledge of the Complainant's trademarks when the Domain Name was registered.

The Complainant also states that the logo's of both parties are similar and that a very similar calligraphy is used. The logos of the Complainant, respectively the Licensee are the following:



The Complainant also states that the Licensee did not make a legitimate, non commercial fair use of the Domain Name. The opposite is true: the Licensee is making a commercial use of the Domain Name intending to misleadingly divert consumers to his website where winter sports vacations are being promoted.

- The Domain Name was registered or is being used in bad faith

The Complainant asserts that many elements of the case show evidence of the Licensee's bad faith, both when registering the Domain Name and when using it.

The trademark AIRNESS was created in France in 1999 and thanks to famous football players the mark AIRNESS became well known in the world of football. When the Domain Name was registered (in 2004), the mark had already become famous for sport related goods and many newspapers and magazines published articles about the brand. A simple search in the trademark registers or on internet search engines would have revealed immediately that the name AIRNESS could not be registered as a ".be" domain name without interfering with the Complainant's rights.

After the registration of the Domain Name, it is still being used in bad faith. According to the Complainant, the Domain Name is used to attract internet users to promote winter sports in the French Alpes. By doing so the Licensee intentionally benefits from the growing reputation of the Complainant's trademarks for sports related goods. The similarity of the logos (cf. above) confirms the bad faith of the Licensee.

For these reasons, the Complainant requests the Third Party Decider to order the transfer of the Domain Name.

5.2. Position of the Licensee

The Licensee disputes that the requirements for the Complainant to prevail in this dispute are met:

- The Domain Name is identical or confusingly similar to the trademarks in which the Complainant has rights?

The Licensee recognizes that the Domain Name is similar to the Complainant's trademarks, but leaves it open for discussion whether there is likelihood of confusion.

- The Licensee has no rights or legitimate interests in respect of the Domain Name?

The Licensee points out that it was incorporated 1995 and that it has used the name Airness since 1999. The non-profit organization with the name Airness was incorporated on 3 December 2000. The Licensee and Airness have closely co-operated ever since; the Licensee alleges to be a sponsor and partner of Airness. While Airness takes care of promoting snowboarding and organising lessons etc., the Licensee organises travel activities as an officially licensed travel agent. Together with Airness, the Licensee claims to have all the rights and legitimate interests.

The Licensee and Airness choose the name AIRNESS because it constitutes a link to the freestyle ski and snowboarding courses, where the skier jumps in the air. When the Domain Name was registered, the Licensee and Airness had never heard of the young French company which used the same name. The only use of "airness" at the time, was the surname of Michael Jordan, the famous basketball player who was called "his royal airness".

The Licensee contests that the logo's of both parties are similar, except for the name AIRNESS. If the logo would be a problem, this is open for discussion, states the Licensee.

The non-profit organization Airness organizes ski and snowboard events and trainings, but does not divert consumers. The website states on almost every page that the activities relate to ski and snow and they do not relate to clothing, football or any other sport.

The non-profit organization Airness does not make a commercial use of the Domain Name and is not misleading consumers.

- The Domain Name was registered or is being used in bad faith?

Neither the Licensee or Airness are football organizations and all their members and customers all are skiers or snowboarders. They started using the name AIRNESS almost at the same time as the Complainant (if not earlier), and certainly not when the AIRNESS mark of the Complainant was already famous.

The Domain Name was registered 21 months prior to the registration of the name "airness.fr".

Moreover, in Belgium the mark AIRNESS only became known in 2007 when the Complainant (or his companies) started sponsoring the football club of Genk.

Neither the Licensee or Airness ever considered selling the Domain Name. They want to keep the Domain Name because in the Belgian snowboard-world they are very well known under this name and domain name.

This all shows, according to the Licensee, that there is no bad faith.

The Licensee concludes that he is not a cybersquatter and neither is the small non-profit organization Airness. If they were cybersquatters, they would not only have registered the Domain Name "airness.be" 21 months before Complainant registered "airness.fr" but they would also have registered "airness.fr" and "airness.com."

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 » Domain operated by DNS.BE., the complainant has 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; 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.

6.1. Is the Domain Name identical or confusingly similar to AIRNESS?

The relevant part of the Domain Name is AIRNESS; the ".be" extension must not be taken into account (see Cepani case n° 4004, Pernod-Ricard v. C. Roelandt and cases n° 44003, 44019, 44021, 44039, 44042 and 44068).

This part of the Domain Name must be compared with the trademarks of the Complainant. None of the Complainant's trademarks for which the certificate of registration is provided, are merely word marks. They are all word+device marks.

As a result, none of the marks is identical to the Domain Name.

But because the word AIRNESS is an essential distinctive element of the marks and this word is identical to the Domain Name, the Third Party Decider comes to the conclusion that the Domain Name is confusingly similar to the trademarks of the Complainant. This is not really disputed by the Licensee.

As a consequence, the first condition set forth in article 10.b.1 (i) of the Dispute Resolution Policy of DNS.BE is met.

6.2. No right or legitimate interest

The Third-Party Decider finds that the Licensee does have rights or legitimate interests in the sign AIRNESS for the reasons below.

The Licensee contends that it is closely related to the non-profit organization Airness Ride Your Style, abbreviated "Airness", which was incorporated on 3 December 2000. The articles of incorporation were published in the *Moniteur belge* and also later changes to the articles were officially published.

Both parties have worked together from the very beginning and have each developed their own activities. For commercial and legal reasons, the non-profit organization Airness is responsible for promoting the sport of snowboarding (cf. its articles of incorporation, Exhibit 2 of the Licensee), while the Licensee is responsible for organizing ski and snowboarding vacations and is a licensed travel agent.

According to an e-mail of the registry DNS Belgium (Exhibit 3 of the Licensee), the Domain Name was initially registered on the name of Airness since 28 May 2001.

For practical reasons, the Domain Name was acquired by the Licensee on 26 August 2004 (Exhibit 1 of the Complainant), who pays the license fees of the Domain name and the hosting fees of the Airness website in the framework of what can be seen as a sponsorship agreement. The content of the website, however, is merely a matter of the non-profit organization Airness. According to the research of the Licensee via www.archive.org, there has been a website for the non profit organization Airness since 7 November 2002. The same source shows that Airness permanently had a website under the Domain Name, with information in relation to snowboarding, which confirms that the non-profit organization acted according to its articles of incorporation.

It is true, as stated by the Complainant, that the non-profit organization Airness is a different legal entity, separate from the Licensee. This does not mean, however, that therefore the Licensee cannot have a right or legitimate interest in the domain name. If a party A has rights in a sign A and it allows a party B to also use the sign A, then party B has a legitimate interest in using the sign B, provided that party A also has a legitimate interest. This was stated in the Cepani decision n° 44054 of 25 January 2005 re Gallup-Europe.be:

"Although the Licensee itself is not the owner of these trademarks, it credibly claims to be licensed to use the "Gallup" trademark. (...).

The Policy does not require the Licensee to be the direct owner of the trademark rights. It merely requires the Licensee to have a legitimate interest in the domain name. The Third-Party Decider therefore holds that the Licensee, being licensed to use the trademark "Gallup", has legitimate rights in the disputed domain name."

For the Third Party Decider, it is clear here that the non-profit organization has rights and legitimate interests in the sign AIRNESS, which is part of its name and which has been

used at least since 3 December 2000. (There is no evidence of any use of the sign AIRNESS by the Licensee prior to the incorporation of the non-profit organization Airness).

In December 2000, the Complainant already had rights in the name AIRNESS because he had obtained the registration of the French AIRNESS trademark with n° 99774553. He had also applied for the Community trademark AIRNESS with n° 1532158, which would be registered on 13 September 2001. The French prior rights of the Complainant in relation to sports and other equipment (classes 18, 25 and 28), however, do not mean that the non-profit organization Airness cannot have rights or legitimate interests in the name AIRNESS to promote snowboarding.

Therefore, the Licensee has a right or a legitimate interest in the Domain Name, even though the Complainant has not licensed or otherwise permitted the Licensee to use the name AIRNESS and even though the Licensee does not own any AIRNESS trademarks.

The Third Party Decider comes to the conclusion that the Licensee did use the Domain Name prior to the dispute in relation to a bona fide offering of products or services, in particular because he made the Domain Name available for the website of the non-profit organization Airness which has rights and legitimate interests in the name AIRNESS.

As a result, the second requirement is not met and the Complaint must be dismissed.

6.3. Registration or use of the Domain Name in bad faith

Finally, the Third Party Decider does not agree with the Complainant that the Licensee registered and used the Domain Name in bad faith.

This case is not a traditional case of cybersquatting, amongst others because the Licensee has never offered the Domain Name for sale or intended to make a profit from the sale of the Domain Name and because the Licensee does not have a history of bad faith registrations in the past.

Also, we cannot see in this case that the Licensee, given the reputation of the AIRNESS brand, was or must have been aware of the brand and nevertheless registered the Domain Name. It is true that in 2004, when the Licensee registered the Domain Name, he was or he should have been aware of the AIRNESS trademarks of the Complainant. However, because the Licensee only registered the Domain Name to support and continue the activities of the non-profit organization which has been using the AIRNESS name since the year 2000, the Licensee did probably not act in bad faith.

The use of the website under the Domain Name, which has been a constant use since 2002 in relation to the activities of the non-profit organization Airness, also seems to indicate that the Licensee does not act in bad faith.

The existence of bad faith must be shown by the Complainant. He can show bad faith with all means of evidence, as long as they support with reasonable certainty the finding of bad faith (Cepina n° 4013, 7 February 2002, Smirnoff.be).

In case of doubt, the bad faith requirement will not be met.

In this case, the Third Party Decider comes to the conclusion that there is at least doubt about the bad faith of the Licensee, given the history of the non-profit organization Airness and its cooperation with the Licensee.

The Complainant states that the use of his trademark AIRNESS by the Licensee constitutes a trademark infringement, because the Licensee would be taking advantage of the reputation of the trademark for sports to sell winter trips in France in connection with sports (Complaint, page 20). Also the logos of both parties would be too similar to each other, according to the Complainant.

The Third Party Decides disagrees and refers to the Cepina case n° 4014 of 8 May 2002, re fa.be, where it was decided that :

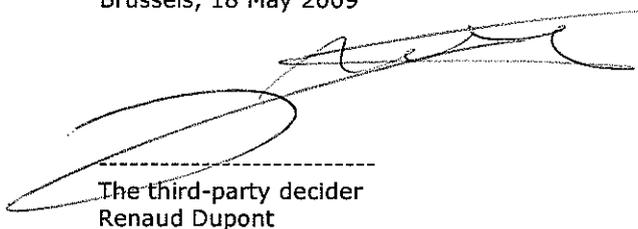
"the use of the Domain Name may well constitute a trademark infringement under the Benelux trademark Act. The question which the Third-Party Decider needs to answer is, however, not whether the Domain Name constitutes a trademark infringement but whether the Domain Name has been used or was registered in bad faith, which is a more severe test. Having carefully assessed all the facts and circumstances of this case, the Third-Party Decider finds that there is enough doubt."

All these circumstances lead to the conclusion that there is not sufficient evidence of bad faith here, so that the third requirement is not met either.

7. Decision

The third-party decider, according to article 10, e of the Terms and Conditions of Domain Name Registration Policy under the « .be » domain operated by DNS Belgium, denies the request that the Domain Name airness.be is transferred to Complainant.

Brussels, 18 May 2009



The third-party decider
Renaud Dupont

(Signature)