



BELGIAN CENTER FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Papier Present bvba / Exip

Dispute N° 44167 : present.be

1. Parties

- 1.1. Complainant: Papier Present BVBA
Preenakker 19
1785 Merchtem
Belgium

Represented by:

Mrs. An de Puydt, lawyer,
having her office at 1700 Dilbeek, Verheydenstraat 61

- 1.2. Domain Name Holder:

EXIP
Willem van Noortplein 15
3514GK Utrecht
The Netherlands

2. Domain Name

Domain Name: "present.be"
Registered on: 8 November 2007

Hereafter stated as « Domain Name »

3. History of the procedure

On 4 July 2009, the Complainant electronically submitted a complaint with CEPANI, the Belgian centre for Arbitration and Mediation, according to the CEPANI Rules for Domain Name Dispute Resolution and the Dispute Resolution Policy of DNS BE, incorporated in its Terms and Conditions for domain name registrations under the ".be" domain. CEPANI received a hard copy of this complaint on 7 July 2009.

The complaint was notified to the Domain Name Holder by registered mail on 9 July 2009.

A response has been filed electronically by the Domain Name Holder on 29 July 2009. CEPANI received a hard copy of the response on 10 August 2009.

On 5 August 2009, a Third-party Decider was appointed to settle the dispute involving the Domain Name. The Parties have been notified of the Third-party Decider's appointment by CEPANI by registered mail on 6 August 2009.

On 10 August 2009, the Complainant filed an electronic request for permission from the Third-party Decider for an additional extension of the deadline in order to submit retort and respond to the response of the Domain Name Holder in accordance with the Dispute Resolution Policy of DNS BE.

On 11 August 2009, by electronic mail, the Third-party Decider granted this request and allowed the Complainant to file its arguments not later than 26 August 2009 and the Domain Name Holder to respond to those arguments not later than 9 September 2009.

The Complainant's retort was filed electronically on 12 August 2009 and communicated electronically on the same day to the Third-party Decider and the Domain Name Holder.

The final response from the Domain Name Holder was filed electronically on 7 September 2009 and communicated electronically on the same day to the Third-party Decider and the Domain Name Holder.

4. Facts

The Complainant is the holder of the Benelux word mark "PRESENT", registered under number 0493079, with application date 21 December 1990, renewed on 21 December 2000 and valid till 21 December 2010 (hereafter referred to as the "Trademark"). The Trademark is registered in classes 16 (paper, cardboard and products manufactured from these materials, including packaging materials, plastic materials for packaging, all aforementioned products insofar as not included in other classes), 35 (advertising services) and 42 (design of packaging, design of logos).

The Complainant is acting under the corporate name "bvba Papier Present" in the sector of printed packaging. It designs and manufactures paper, plastic and recyclable bags.

The Domain Name Holder registered the Domain Name on 8 November 2007. The Domain Name Holder describes its activities as follows: design of web pages and management of a digital market place for antiques and art (see exhibit 3 of the Complainant's file – extract from the trade register of the Chamber of Commerce).

When entering the Domain Name, the internet user is redirected to the website "www.sedoparking.com/present.be". This website contains a link saying "*Buy this domain. The domain present.be may be for sale by its owner!*". The link redirects the internet user to a URL (http://www.sedo.com/search/details.php4?domain=present.be&partnerid=14460&language=nl&et_cid=25&et_lid=65) where he can make an offer to buy the Domain Name.

The company Sedo.com LLC offers a domain parking service for registered domain names for websites which are not currently operational.

5. Position of the Parties

5.1. Position of the Complainant

- (i) *The Domain Name is identical or confusingly similar to a trademark, a trade name or corporation name in which the Complainant has rights*

The Complainant claims that the Domain Name is identical to the Trademark, and at least that confusion is possible.

According to the Complainant, the Domain Name is very similar to its corporation name "Papier Present", claiming that the word "present" is essential in that denomination, which is identical to the Domain Name, and at least confusingly similar.

According to the Complainant, the name "papier present" and consequently the trade name "present" is used by the Complainant in commercial documents and known as such by customers.

(ii) The Domain Name Holder has no rights or legitimate interests in the Domain Name

The Complainant claims that the Domain Name Holder cannot put forward any rights or legitimate interests with respect to the Domain Name. According to the Complainant, no data are available from which it would appear that the Domain Name Holder would have used previously the Domain Name or a name that corresponds to it for offering products or services, and even if this would have been the case, the Complainant claims that this use would not have been sufficient to be generally known under such name.

To the argumentation of the Domain Name Holder that the quote for the development of the website "www.present.be" (see exhibit 4 of the Domain Name Holder's file) proves its legitimate interest, the Complainant responds that the proposal submitted by the Domain Name Holder is no proof of a legitimate interest in the Domain Name: the document is a universal proposal for a software solution and is not based on a specific project as stated by the Domain Name Holder.

According to the Complainant, the Domain Name Holder does not have a commercial activity under the name "present" and it never took any initiative to start such an activity.

Furthermore, the Domain Name Holder's registration at the Chamber of Commerce does not mention an activity for the trade or sale of "presents" (see supra under 4. Facts). Neither has the Domain Name Holder applied for the registration of the trade name "present" at the Benelux Office for Intellectual Property.

Finally, according to the Complainant, the Domain Name is "parked", which is a solution to attract and mislead customers for commercial purposes.

According to the Complainant, it has not given the Domain Name Holder any authorization to use the Trademark (as such or a domain name containing that Trademark) and the Domain Name Holder has not any other relationship with the Complainant.

(iii) The Domain Name has been registered or is being used in bad faith

The Complainant claims that the Domain Name has been registered by the Domain Name Holder in bad faith.

According to the Complainant, the Domain Name has been registered by the Domain Name Holder in order to prevent him from using it. The Complainant would use the corporate website "www.papierpresent.com" in general communications because the company has an international reach and would have registered also "www.papierpresent.be" and "www.papierpresent.nl" because Belgium and the Netherlands are its main markets. The Complainant states that it registered the Trademark ("present" and not "papier present") because the company is known as such in the market and by the customers (since 19 years). The Trademark would therefore be the distinctive part in the corporation name.

The Complainant states that its interest in the Domain Name has come to its attention due to the use in bad faith by the Domain Name Holder since 21 months. Customers who refer to the Complainant as "present" would now be attracted to a misleading website.

The Domain Name Holder has put no content linked to a trade or service on this website "www.present.be" which offers generic ads and wants to entice the internet users to a website of the Domain Name Holder or to another on-line location to offer its own products and/or services. The Complainant indicates that when entering the Domain Name, the

internet user is automatically linked to another internet address, namely "www.sedoparking.com/present.be".

The Complainant also claims that the Domain Name Holder registered the Domain Name for the purpose of selling it at a (too) high price. The website "www.sedoparking.com/present.be" mentions that the Domain Name is "for sale".

Therefore the Complainant claims that the Domain Name Holder is preventing it in trade.

(iv) *Conclusion*

Consequently, the Complainant asks that the Domain Name be transferred to it.

5.2. Position of the Domain Name Holder

(i) *The Domain Name is not identical or confusingly similar to a trademark, a trade name or corporation name in which the Complainant has rights*

The Domain Name Holder claims that the Domain Name is not identical to the Complainant's corporation name "Papier Present", since:

- (1) the Complainant's corporation name consists of two generic words – "papier" and "present" – which are both frequently used Dutch words;
- (2) nor the Complainant's corporation name nor its trade name are commonly known; and
- (3) the word "present" is not inherently connected with the Complainant or its products or services.

In addition, there is no risk of confusion between the Domain Name and the Complainant's corporation name. Further, the Domain Name Holder claims that the Complainant does not establish any evidence of the fact that it is known under the name "present".

As regards the Trademark, the Domain Name Holder refers to article 2.26, par. 2, sub a, of the Benelux Treaty on Intellectual Property Rights, which provides that a trademark registration can be declared void if, for more than five years, the trademark has not been used in relation with products or services for which the trademark has been registered. According to the Domain Name Holder, the Trademark was never used and has become a generic word which is widely used to describe 'gifts' (among other meanings).

(ii) *The Domain Name Holder has rights or legitimate interests in the domain name*

The Domain Name Holder alleges that it has rights or legitimate interests in the Domain Name. The Domain Name Holder is a Dutch web-development company which builds and maintains websites and web-concepts for its clients and for its own account. It is the Domain Name Holder's strategy to build websites on generic, descriptive domain names. The Domain Name Holder claims that prior to any notice of the dispute, it used the Domain Name in connection with a *bona fide* offering of goods or services or made demonstrable preparations for such offering. The Domain Name Holder claims that it was its intention to develop the Domain Name into a web shop selling presents/gifts, the Domain Name Holder obtained several price quotes for the development of the website "present.be", obtained after intense and detailed explanation of the website features and design-components. Since the name of the website is mentioned throughout the offer, according to the Domain Name Holder, this might at least indicate that the price quote is individualized and entirely focused on the "present.be" project.

In the meantime, the Domain Name was parked with Sedo.com. According to the Domain Name Holder, domain parking is allowed as long as a generic word is used and no ads are shown for products or services which are sold or rendered by the Complainant. In view of this, the Domain Name Holder refers to the CEPANI decisions Nos. 44106 ("argente.be") and 44120 ("sintniklaas.be"). The Domain Name Holder also refers to the WIPO decision No. D2000-0016 ("Allocation.com") which states that "If a respondent is using a generic word to describe his product/business or to profit from the generic value of the word without intending to take advantage of complainant's rights in that word, then it has a

legitimate interest". In the present case, the Domain Name Holder states to have parked the domain name – awaiting development - without intent to profit from or abuse the Complainant's trade name rights.

(iii) *The Domain Name has not been registered or is being used in bad faith*

The Domain Name Holder states that he did not register the Domain Name in bad faith for the following reasons:

(1) The word "present" is a commonly used Dutch word and the registration or use of descriptive words as a domain name is not unlawful as long as the holder does not use the Domain Name in a way to profit from or abuse the Complainant's rights.

(2) The Domain Name Holder is a Dutch company and had no idea of any rights linked to the word "present", since the Complainant does not benefit from broad brand recognition within Belgium and the word "present" is commonly used.

(3) The Domain Name Holder wants to develop a giftshop-website on the Domain Name and therefore registered a generic, descriptive word which describes perfectly the future goods or services to be offered or rendered on the PRESENT.BE website.

(4) Although the Domain Name is parked with Sedo.com, the Domain Name was never offered for sale to the Complainant or its competitors as selling the Domain Name was not the main purpose of the registration. It is a common practice among web-developers that a domain name is parked awaiting development.

(5) The Domain Name Holder registered the Domain Name because he intends to build a website on it. The income which might be generated by operating such a website is one of the objective indicators for the valuation of the Domain Name, as this is the case for any other business. Another indicator is the descriptive, generic nature of the Domain Name. Generic domain names are in high demand and especially when they describe goods and/or services which could be offered and/or rendered on the website to which they are linked. As the Domain Name Holder had received two significantly higher bids for the Domain Name from other interested parties before the Complainant made a bid via Sedo.com, it is understandable that the Domain Name Holder (1) did not accept the Complainant's bid and (2) made a (negotiable) offer which is (3) in-line with current market prices for this kind of domain names.

The Domain Name Holder also states that he did not use the Domain Name in bad faith for the following reasons:

(1) According to the Domain Name Holder, the latter did not know nor the Complainant nor the Complainant's trade name. The anonymous bid made by the Complainant and the offer by the Domain Name Holder do not undo the good faith registration. The Domain Name Holder claims that it was not the intention to sell to anyone, except if the full 'loss of opportunity' of the project would be compensated and that it is not illegal to ask money for a domain name, which was registered nor to be sold, nor to infringe on any rights owned by a third party and which could provide its holder significant revenue if developed.

(2) The Domain Name Holder claims that he did not prevent the Complainant from using the corresponding domain name(s). The Complainant uses the domain names "papierpresent.com" since February 2001 and "papierpresent.be" since 2003.

(3) Moreover, according to the Domain Name Holder, the latter is not engaging in the activities of the Complainant (packaging). It was not the intention to create a website in the same field as the Complainant, but to create a gifts-web shop. Even today, if internet-users land on the Domain Name, there will be no confusion with the website of the Complainant as no ads are displayed which are related to the Complainant's business or with its competitors. Moreover, the word "present" does not have a meaning which is inherently connected with the Complainant or its business activities. It is also rather strange that the Complainant is claiming the Domain Name more than 6 years after using the domain name "papierpresent.be", more than 8 years after using the domain name

"papierpresent.com", and more than 19 years after filing the trade name. This indicates that no disruption of business occurred.

(4) Finally, the Domain Name Holder states that there is no likelihood of confusion between the Domain Name (and the ads served) and the corporation name, the website or activities of the Complainant. Therefore, it is obvious that the Domain Name was not intentionally registered or used to attract internet users to the Domain Name Holder's website. Furthermore, as repeatedly stated, the Domain Name Holder didn't know about the existence of the Complainant.

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 that:

- *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.*

6.1. 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

The Complainant is the owner of the Trademark.

The Domain Name Holder claims that the Trademark has never been used and has become a generic word used to describe gifts.

Article 2.26, par. 2, sub a, of the Benelux Treaty on Intellectual Property Rights indeed provides that a trademark registration can be declared void if, for more than five years, the trademark has not been used in relation with products or services for which the trademark has been registered. The right to a trademark does not lapse automatically. It remains valid until it is declared void by the competent court. The Third-Party Decider is not competent to judge whether the trademark is void or not. Such decision belongs to the exclusive competence of the court. The Complainant must therefore be presumed to be the holder of a valid trademark registration.

Except for the suffix ".be", which is generally accepted as being irrelevant for determining the similarity between the disputed domain name and the name on which the Complainant claims a right (cfr. Cepina cases nos. 4021 ("napster.be"), 4025 ("allianz.be") and 44030 ("chopard.be")), the Domain Name and the Trademark are identical.

The Third-Party Decider therefore holds that the Complainant has rights in a trademark that is identical to the Domain Name and that the condition stated in Article 10, b), 1, i) of the Dispute Resolution Policy is fulfilled.

The other identities/similarities do not have to be examined.

6.2. The domain name holder has no rights or legitimate interests in the domain name

Pursuant to Article 10 b) 3 of the Policy, the Domain Name Holder can demonstrate his rights or legitimate interests to use the Domain Name by certain circumstances. Article 10, b), 3 of the Policy gives a non-exhaustive list of such circumstances:

- *prior to any notice of the dispute, the domain name holder 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 domain name holder (as an individual, business or other organization) has been commonly known by the domain name, even if he has acquired no trademark; or*
- *the domain name holder is 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, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.*

The Complainant cannot be imposed the burden of proof of a negative fact (i.e. the absence of right or legitimate interest). It is generally accepted that the Complainant only has to make acceptable that the Domain Name Holder has no rights or legitimate interests in the Domain Name; the burden of proof of the contrary relies then on the Domain Name Holder (cfr. T. Heremans, De Wet van 26 juni 2003 betreffende het wederrechtelijk registreren van domeinnamen: een eerst analyse, *IRDI*, 2003, p. 109, nr. 14).

The Domain Name Holder does not prove that he is commonly known under the Domain Name.

There is no relation between the Domain Name and the Domain Name Holder's corporate names or activities, i.e. design of web pages and management of a digital marketplace for antiques and arts.

It is not established that prior to any notice of the dispute, the Domain Name was actually used in connection with a *bona fide* offering of goods or services. The fact that the Domain Name Holder had the intention to develop a web shop for selling gifts, is not sufficient.

When entering the Domain Name, the internet user is redirected to a website (www.sedo.com/present.be) containing nothing but hyperlinks to third parties' websites. It is well known that the creation of such pages is easy and quick and cannot be considered as a serious and sufficient proof of the bona fide offering of goods or services.

No sufficient evidence has been submitted establishing demonstrable preparations for such use. The Domain Name Holder has only submitted one single exhibit related to an alleged development of the website www.present.be (see exhibit 4 of the Domain Name Holder's file – quote for the development of [present.be](http://www.present.be)), which cannot be considered as a serious and sufficient proof of preparations to the offering of goods or services. The offer received is dated 11 December 2008, i.e. one year after the registration of the Domain Name. It is a rather general offer and no evidence is submitted that the Domain Name Holder took any further actions on receipt of this offer.

The Domain Name Holder makes a "commercial" use of the Domain Name. the domain Name Holder does not establish, however, that he makes a fair use of the Domain Name. The expression "fair use" needs to be interpreted restrictively. In the absence of prior rights, "fair use" should be interpreted as a "necessity" to use the Domain Name (cfr. T. Heremans, *Domeinnamen: Een juridische analyse van een nieuw onderscheidingsteken*, Larcier, Brussel, 2003, p. 148, No. 326). The Domain Name Holder does not prove that he needs to use the word "present" to deploy its activities.

Consequently, none of the circumstances listed under Article 10 b) of the Dispute Resolution Policy are established. The Third-party Decider therefore concludes that the Domain Name Holder has no right or legitimate interest in the Domain Name.

6.3. The domain name holder's domain name has been registered or is being used in bad faith

Bad faith can reside in the registration of the Domain Name or in its use.

Art. 10 b) 2 of the Policy provides a non-exhaustive list of circumstances that can demonstrate such bad faith.

Bad faith must be reasonably proven (CEPANI case n° 44068 *Vueling Airlines v. Eclark Howard*"; CEPANI case n° 44049 *"N.V. DR Oetker/ N.V. FML"*), by the Complainant.

In the present case, the Domain Name has been registered by the Domain Name Holder for 21 months without using it to offer *bona fide* goods and/or services. By doing so, the Domain Name Holder prevents the Complainant, who is the owner of the Trademark from reflecting this word mark in a corresponding .be domain name. The fact that the Complainant has already registered several domain names reflecting its trade name "papier present" proves that the Complainant is registering many domain names to attract clients. The fact that the Complainant did not register all possible domain names at the same time does not take away its intention to do so.

In the CEPANI decision No. 44106 ("*argente.be*"), the Third-party Decider indicated that, *"as such, the mere fact that the Domain Name is parked through the services of NameDrive, or otherwise monetized, is not an evidence of bad faith in the registration or use thereof. (...) In other words, monetizing generic terms, in the absence of bad faith on the side of a domain name owner, is not a breach of the DNS.be terms and conditions, and should not be sanctioned through the specific Cepani procedure, unless specific circumstances demonstrate that the domain name owner tried (or can be assumed to try or to have tried) to harm the rights or interests of a definite holder of a prior right"*. This has been confirmed in the CEPANI decision No. 44120 ("*sintniklaas.be*").

If domain name parking is not sufficient to prove that the Domain Name has been registered in bad faith, monetizing generic terms in bad faith is a breach of the Dispute Resolution Policy.

This has been confirmed in the WIPO Arbitration and Mediation Center case No. D2000-0016 ("*Allocation.com*") which states that *"If a respondent is using a generic word to describe his product/business or to profit from the generic value of the word without intending to take advantage of complainant's rights in that word, then it has a legitimate interest"*. In the present case, it can reasonably be held that the Domain Name Holder had the intention to take advantage of the Complainant's rights in the word "present" (see below).

The Domain Name Holder's explanation that he selects different generic terms to register these as domain names seems acceptable. However, in the present case, the Complainant has a prior valid Trademark on the term concerned. In the WIPO Arbitration and Mediation Center case No. D2000-0016 ("*Allocation.com*"), to which the Domain Name Holder refers, the Complainant did not succeed in establishing that the Domain Name Holder should have known its trade name or trademark registrations. It is indeed impossible for registrars of generic top-level domain names to verify in each country whether there are national prior rights on the term it wants to register as a domain name.

However, as a professional web page designer, based in the Netherlands, the Domain Name Holder cannot reasonably allege that the Trademark was unknown to it, since a simple check of the Benelux trademark register reveals the Complainant's Trademark. A reasonable prudent professional in the Benelux would certainly do such check before registering a domain name.

The Domain Name Holder registered the Domain Name without the existence of a demonstrable link between the Domain Name and the Domain Name Holder. Indeed, the Domain Name has no link with the corporation name, trade name, trademark, activities, goods/services of the Domain Name Holder. In addition, no valid use is made of the Domain Name. The Domain Name is only used for enticing the internet users to a website where the Domain Name is moreover offered for sale.

In addition, it must be noted that the Domain Name Holder has not only parked the domain, but put it "for sale" through the Sedo services.

It appears from the exhibits submitted by the Complainant that the Domain Name Holder has offered to sell the Domain Name to the Complainant for an amount of 12.000 EUR (see exhibit 2 of the Complainant's file). This amount is clearly in excess of the costs directly related to the Domain Name. On 25 March 2009, the WIPO arbitration and mediation center has already ordered the Domain Name Holder to transfer the domain name "komatsu.nl" to the owner of the Community device mark including the word "KOMAT'SU", after having offered the domain name for sale for an amount of 13.000 EUR.

The above circumstances create a strong impression that the Domain Name was registered primarily for the purpose of selling it to the Complainant as the trademark owner or to a competitor of the Complainant, for valuable consideration in excess of the costs directly related to the Domain Name.

As a consequence, all these circumstances can demonstrate that the Domain Name Holder registered or uses the Domain Name in bad faith.

The Third-Party Decider finds that the above constitutes sufficient evidence of bad faith. As a consequence, also the condition stated in Article 10 b) 1 iii of the Policy is fulfilled.

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 « domain name ».

Brussels, 23 September 2009

The third-party decider
Fabienne Brison

(Signature)

