



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

Decision of the Third-Party decider

1) The Parties

Complainant is Michel Fournel, with address Rue Caremberg 57, 7850 Petit-Enghien, Belgium.

Respondent is Brand Protection LLC, company under US law, 1621 Central Avenue, WY 82001 Cheyenne, USA.

2) Domain Name

The domain name at issue is <www.decooo.be>, registered by the Respondent on 10 September 2020, hereafter referred to as the “Disputed Domain Name”.

3) Procedural History

The Complainant filed his complaint on 22 April 2021.

The Respondent did not submit an administratively compliant response.

On 21 May 2021, Bart Van Besien was appointed as Third-Party Decider (hereafter also the “Panel”) to settle the dispute with regard to the Disputed Domain Name.

The deliberations were closed on 28 May 2021.

4) Elements of Fact

The Complainant is a Belgian entrepreneur, specialised in the sale of personalised stickers and other decorative items, located in Petit-Enghien, Belgium.

The Complainant is the registered owner of the EU trademark n. 015445811 “decooo.be”, registered on 1 September 2016 (application date 17 May 2016), in class 16 (for stickers and other sub-classes in class 16). This trademark is hereafter referred to as the “Complainant’s Decooo.be Trademark”.

The Respondent is the registered owner of the Disputed Domain Name <www.decooo.be>, registered on 10 September 2020.

5) Parties Contentions

a) Complainant

In summary, the Complainant argues that:

- The Disputed Domain Name is identical to the Complainant’s Decooo.be Trademark.

- The Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Respondent does not use the Disputed Domain Name. The Respondent has no relationship with the Disputed Domain Name. The Respondent has no activity in Belgium (and hence no interest in the .be extension). The homepage of the website available via the Disputed Domain Name displays third party ads without a link to the terms “decooo” or “decooo.be”. The Respondent does not intend to use the Disputed Domain Name, “since it is for sale” (through a banner published on the homepage).

- The Disputed Domain Name has been registered or is being used in bad faith, in the sense that the Respondent acted with the aim to harm a third party or to derive an illegitimate advantage.

The Respondent illegitimately takes advantage of the notoriety of the Complainant’s Decooo.be Trademark to attract traffic and generate advertising revenue. The website available via the Disputed Domain Name consists only of a home page with advertising links.

The Respondent is offering the Disputed Domain Name for sale for an excessive price of 4.800 euros (excl. VAT). The Respondent’s main objective is to obtain “a significant income at the expense of the owner of the brand”.

The Respondent is specialised in brand protection (its company name being “Brand Protection LLC”) and should have known that “decooo.be” is a protected brand.

The Complainant further argues that he is the former owner of the Disputed Domain Name and that he owned the Disputed Domain Name for about 10 years until its expiry in 2020. The Complainant alleges that he did not know about the expiry of his domain name registration in 2020. The Complainant alleges that he did not receive any invoices or e-mails regarding the expiration of the Disputed Domain Name. The Complainant argues that he was busy dealing with the consequences of the COVID-19 pandemic on his business and did not notice the domain name expiry.

b) Respondent

The Respondent did not submit a response.

6) Discussions and Findings

a) Analysis of the Complaint

Article 16.1 of the Cepani Rules for Domain Name Dispute Resolution (hereafter the “Rules”) instructs the Third-Party Deciders as to the principles the Third-Party Decider is to use in determining the dispute: *“The Third-Party Decider shall decide following the Parties views and in accordance with the dispute resolution policy of DNS.be, the registration agreement and following the provisions of the present Rules.”*

By virtue of Article 10 of the Terms and Conditions for .be Domain Name Registrations (hereafter the “DNS Belgium Dispute Resolution Policy” or the “Policy”), more specifically Article 10.b.1 of the Policy, the Complainant must assert and prove each of the following:

- the registrant’s domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company 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 registrant has no rights or legitimate interests in the domain name; and
- the registrant's domain name has been registered or is being used in bad faith.

i. Identity or confusing similarity

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

The Disputed Domain Name consists of the Complainant's Decooo.be Trademark in its entirety. This EU trademark includes the ".be" suffix.

The Panel finds that the Disputed Domain Name is identical to the registered EU trademark of the Complainant within the meaning of article 10.b.1 (i) of the Policy.

ii. Rights or legitimate interests

As regards article 10.b.1 (ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative.

Considering the Respondent did not file a response, the Panel notes the following:

- The Complainant states that the Respondent is not effectively using the Disputed Domain Name and did not intend to use the Disputed Domain Name (according to the Complainant, the Respondent's only intention is to sell it).
- The Complainant asserts that, at the time of filing the complaint, the Disputed Domain Name was used only to publish third-party advertisements.
- The Complainant states that the Respondent is not known under the Disputed Domain Name and/or has no relation to the Disputed Domain Name. The Complainant states that the webpage to which the Disputed Domain Name refers displays ads without any link to the names "decoo" or "decooo.be".
- The Complainant further states that the Respondent does not have any activity in Belgium (and hence has no interest in the .be domain name extension).
- The homepage of the Disputed Domain Name shows a banner in the top right corner which mentions that the Disputed Domain Name is available for sale ("acheter ce domaine"; translated as "buy this domain"). This banner links to another website (www.domainname.de) where it is mentioned "the domain decooo.be is offered for sale by the current owner!" (with the possibility to enter an email address to obtain a price quote).

The Third-Party Decider is of the opinion that Complainant has made it plausible that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

None of the (non-exhaustively) listed circumstances in Article 10.b.3 of the Policy appears to be present in the case at hand.

First, there are no indications that the Respondent has used the Disputed Domain Name or a name corresponding to it in connection with a bona fide offering of goods or services or that the Respondent has made demonstrable preparations for such use.

Second, there are no indications that the Respondent has made a legitimate and non-commercial or fair use of the Disputed Domain Name.

Third, there is no evidence or indication that the Respondent is commonly known by the Disputed Domain Name or a name corresponding to it.

The assertions of the Complainant were not contested by the Respondent (who did not file a response to the complaint).

From the evidence submitted by the Complainant, the Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of article 10.b.1 (ii) of the Policy.

iii. Registration or use in bad faith

In order to meet the third and last condition of article 10.b.1 of the Policy, the Complainant must demonstrate that the Respondent registered or used the domain name in bad faith.

The Complainant asserts that the Respondent has registered and is using the Disputed Domain Name with the aim of harming the Complainant, or deriving an illegitimate advantage. In particular, the Complainant asserts that the Respondent illegitimately takes advantage of the well-known “decooo.be” brand to attract traffic and generate advertising revenue. Furthermore, the Complainant asserts that the Respondent is offering the Disputed Domain Name for sale for an excessive price, namely 4.800 EUR. According to the Complainant, the main objective of the Respondent regarding the Disputed Domain Name is to obtain a significant income at the expense of the Complainant. Lastly, the Complainant asserts that the name of the Respondent (“Brand Protection LLC”) suggests that the Respondent should have known that the term “decooo.be” is identical to the Complainant’s registered EU trademark.

The Panel notes the following:

First, a domain name procedure should not be regarded as an automatic remedy to a complainant’s failure to renew its domain name registration in time. Also, the registration of an expired domain name by a new registrant does not in itself constitute proof of bad faith by the new registrant. However, the previous domain name holder’s failure to renew its domain name registration can be considered as a relevant factor, among other factors, in the assessment of the new domain name holder’s good faith or bad faith.

Second, the Panel is unaware of the business activities of the Respondent. Based on its name alone, the Panel cannot conclude that the Respondent is indeed specialised in brand protection.

Third, the Complainant has not shown that its registered EU trademark is well-known or has acquired a certain reputation.

Fourth, the homepage of the website available via the Disputed Domain Name contains third-party advertisements for various products and/or services by third parties. It is unclear whether these services are competing with the services or products offered by the Complainant (the complaint is silent on this point). The website shows a banner in the top right corner which mentions that the Disputed Domain Name is available for sale (“acheter ce domaine”; translated as “buy this domain”). This banner contains a link to the url <https://www.domainname.de/marketplace/decooo.be>, where it is mentioned “the domain decooo.be is offered for sale by the current owner!” (with the possibility to enter an email address to obtain a price).

The Complainant has provided evidence that, on 21 April 2021, several offers were made to buy the Disputed Domain Name by an account named “contact@imaggge.com”, via the website www.domainname.de. On 22 April 2021, this account received a counteroffer of 4.800 EUR for the sale/purchase of the Disputed Domain Name. Since the Respondent is the current owner of the Disputed Domain Name, the Panel assumes that this counteroffer was made by or in name of the Respondent, or that this counteroffer was at least approved by the Respondent. Furthermore, the Panel notes that the e-mail address contact@imaggge.com, via which several lower offers for the Disputed Domain Name were made, is linked to the domain name www.imaggge.com. The

Panel further notes that the contact details shown on this domain name refer to a company named 'Imaggge.com SRL' and that the Complainant is the manager of this company. The Panel therefore reasonably infers that the Respondent has offered the Disputed Domain Name for sale to the Complainant (albeit indirectly) for a price of 4.800 EUR.

Article 10.b.2 of the Policy states that evidence of registration or use of a domain name in bad faith can be demonstrated by circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to a complainant who is the owner of a trademark.

In this case, the Complainant has shown to the satisfaction of the Panel that (1) the Disputed Domain Name was offered for sale – indirectly - to the Complainant who is the owner of the corresponding identical trademark (such use seems to have been the main purpose for registering the Disputed Domain Name); and (2) the Respondent asked a disproportionate price for the Disputed Domain Name, namely 4.800 EUR.

Fifth, the Panel is of the opinion that it may be expected from a registrant that he or she verifies that a new domain name registration does not infringe upon a third party's rights (for instance, by checking the publicly available trademark registers). In this case, the names "Decooo.be" and "Decooo" are fanciful words without a common meaning in any language spoken in Belgium (the Disputed Domain Name has a .be extension) or even in English (the language of the home country of the Respondent). The Disputed Domain Name is identical to the earlier EU trademark of the Complainant. The Panel sees no credible explanation for the Respondent's choice of this particular domain name, let alone in the .be domain. The Respondent chose not to submit any response to the complaint and did not contest the complaint or provide a credible explanation for its registration of the Disputed Domain Name. The Panel finds it reasonable to conclude that the Respondent had knowledge or at least should have had knowledge of the earlier trademark rights of the Complainant. The Panel concludes that the Respondent acquired the Disputed Domain Name while knowingly taking advantage of the Complainant's prior rights.

From the combination of circumstances mentioned above, the Panel concludes that the bad faith of the Respondent has been sufficiently established, within the meaning of article 10.b.1 (iii) of the Policy.

7) Decision

Pursuant to Article 10.e of the Policy, the Third-Party Decider rules that the Disputed Domain Name <www.decooo.be> is to be transferred to the Complainant.

Mechelen, 11 June 2021,



Bart Van Besien
The Third-party decider