



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

BELGACOM / Core Consultancy

Case no. 44316 : belgacomcloud.be

1. The parties

1.1. Complainant:

BELGACOM Ltd
Koning Albert II laan, 27
1030 Brussels
Belgium

Represented by

Mrs. Rebecca De Meulder
Trademark and Design Attorney
Office Kirckpatrick
Avenue Wolfers, 32
1310 La Hulpe
Belgium

E-mail: r.demeulder@kirckpatrick.eu

1.2. Licensee:

CORE CONSULTANCY
SW4 0AF London
United Kingdom

E-mail coreconsultancy@hotmail.com

2. Domain name

Domain name: belgacomcloud.be
Registered on: 29 September 2011

CEPANI – NON-PROFIT ASSOCIATION

Stuiversstraat 8, B-1000 Brussels ● Telephone: +32 2 515 08 35 ● Fax: +32 2 515 08 75
E-mail: cepina@vbo-feb.be ● Website: <http://www.cepani.be>
FORTIS BANK: 210-0076085-89 ● KBC: 430-0169391-20 ● BBL: 310-0720414-81

hereafter referred to as "the Domain Name".

3. Background to the case

On 24 July 2013, Complainant filed a complaint concerning the Domain Name.

Licensee did not submit any response.

On 17 September 2013, Cepani appointed third-party decider to settle the dispute.

4. Factual information

Complainant is the largest telecom company in Belgium.

Complainant is providing a broad range of service, mobile and fixed-line phone, internet access, digital television, internet services.

Complainant is owner of a several Benelux and Community complex and word trademarks containing the word element "BELGACOM" (see Complaint exhibits).

In particular, Complainant registered

- a Benelux word mark "BELGACOM", in 1990 (registration demand filed on 1990, 14th of December – complaint, Exhibit 3),
- a Community complex trademark containing the word element "Belgacom", in 2002 (filed on 9th of December – complaint-Exhibit 5),
- a Benelux complex mark containing the word elements "CLOUDNET BELGACOM", in 2011 (filed on 21st of June),

all covering services of class 38 (telecom services).

Complainant discovered in 2011 the registration of the Domain Name, by an individual with an email address (in the WHOIS database file) containing the name of a company, established in London, which is providing IT services (data protection and disaster recovery consultancy, pursuant to the corresponding web site www.core-consultancy.com, last check on the 30th of September, 2013).

5. Position of the parties

5.1. Position of the Complainant

Domain Name contains the entire "Belgacom" trademarks and is confusingly similar to the "Cloudnet Belgacom" trademark.

"belgacom" sign is dominant within the Domain Name.

There exists a likelihood of confusion between the Domain Name and "Belgacom" series of marks, so that consumer may believe that Domain Name originates from Complainant.

"Belgacom" is also the tradename of Complainant, since 1991, which is very well known by Belgian consumers.

Licensee does not use the Domain Name and is not known under any similar tradename (no trademark registered). There is not any evidence of a use of the the Domain Name in connection with a bona fide offer of products/services by Licensee. There is therefore no evidence of Licensee's legitimate interest in the Domain Name.

Licensee did not react to Complainant requests to withdraw its registration of the Domain Name. This absence of reaction combined with the fact Complainant and Licensee are active within the same sector (IT services) prove the intent of Licensee to disrupt Complainant's business (bad faith registration).

5.2. Position of the Licensee

Licensee did not submit any response to the complaint.

6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, 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."*

6.1. Domain Name is identical or similar to Complainant's trademarks and corporate name

Complainant proved prior rights on "Belgacom" trademark and trade name, and in particular :

- Complainant has been using the Belgacom trade name since 1991 ;
- Complainant is owner of
 - o a Benelux word mark "BELGACOM", in 1990 (registration demand filed on 1990, 14th of December – complaint, Exhibit 3),
 - o a Community complex trademark containing the word element "Belgacom", in 2002 (filed on 9th of December – complaint-Exhibit 5),
 - o a Benelux complex mark containing the word elements "CLOUDNET BELGACOM", in 2011 (filed on 21st of June),

Domain Name is confusingly similar to these trade name and trademarks.

Pursuant to ECJ case law, a likelihood of confusion exists between a prior trademark and another sign as far as *"the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically"* (ECJ, C-120/04, nr. 31).

"The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details" (ECJ, C-120/04, nr. 28)

In present case, the Domain Name is composed of three elements

- Belgacom
- Cloud
- ".be"

Belgacom is the dominant and distinctive element of the Domain Name, since the ".be" is the code of the Belgian CcTLD's extension (see CEPANI case 44141 and mentioned references) and since the "Cloud" element is a descriptive sign.

The distinctive character has to be assessed according to the perception of the average consumer of the category of products concerned (ECJ, 16 September 2004, case C-329/02, paragraph 24 ; ECJ, 22 June 1999, case C-324/97, paragraph 26).

Concerning IT services, the "cloud" term shall be perceived by the average consumer as the indication of a kind of IT services (cloud computing services).

"The public will not generally regard a descriptive element forming part of a compound mark as the distinctive and dominant element of the overall impression conveyed by that mark" (ECFI, T-425/03, nr. 82).



Domain Name dominant element is therefore “belgacom”, which is identical to Complainant’s trade name and Benelux word mark and to the word dominant element of the two other Complainant’s trademarks invoked here-above.

First condition is therefore met.

6.2. Rights and legitimate interests

Licensee did not submit any explanation.

In these circumstances, a prima facie evidence of a lack of legitimate interest may be sufficient to meet the second requirement of DNS BE terms and conditions (CEPANI, cases nr. 44094 and 44217).

Domain Name has been registered two years ago but it is not linking to any content (Complaint, exhibit 9; NB: Domain Name on hold at the time of drafting present decision).

Prima facie, it indicates a speculative registration.

Furthermore, the existence of a possible legitimate interest is even more doubtful that the Licensee registered a domain name corresponding to well-known trade name and trademarks (or dominant element thereof) of Complainant.

Considering these elements and the absence of response from the Licensee, the third-party decider considers Complainant submitted sufficient evidence of a lack of legitimate interest of the Licensee.

Second condition is therefore met.

6.3. Registration or use in bad faith

Licensee registered Domain Name corresponding to Complainant’s trademarks (or dominant element thereof) without making any use of the Domain Name.

Licensee did not reply to Complainant letters (Complaint, exhibits 7 and 8).

Licensee did not submit any explanation in response to the complaint.

Licensee’s web site shows that Licensee is offering IT services.

It is also important to highlight that Third-party decider has to consider the well-known character of Belgacom trade name and trademark within the Belgian market, which requires a more severe assessment of bona fide use of the Domain Name (CEPANI cases nr. 44030 and 44051).



One can therefore reasonably conclude that registration of Domain Name constitutes an attempt to disrupt Complainant's business or to attract internet users by creating confusion with Complainant's trade name or trademarks.

The registration and/or use of the Domain Name are made in bad faith.

Third condition is therefore met.

7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-party decider hereby rules that the domain name registration for the "**belgacomcloud.be**" domain name is to be transferred to the Complainant.

Namur, 30/09/2013.



Alexandre Cruquenaire,
The Third-party decider