



THE BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

ACCOR / TAO WANG

Case no. 44441 / joandjoe.be

1. The parties

1.1. Complainant: **ACCOR SA**, 82, rue Henri Farman, 92130, Issy-Les-Moulineaux, France

Represented by:

Dreyfus & associés, 78, avenue Raymond Poincaré, 75116, Paris, France

Hereinafter referred to as "Complainant".

1.2. Domain name holder: Mr. **TAO WANG**, No. 22, Hankou Road, Gulou District, 210000, Nanjing, Jiangsu, China

Hereinafter referred to as "Licensee"

2. Domain name

Domain name: <joandjoe.be>
Registered on: 27 September 2016

Hereafter referred to as the "Domain Name".

3. Procedure

On 5 February 2018, Complainant submitted its complaint in relation to the Domain Name to CEPANI, requesting the transfer of the Domain Name to Complainant (hereinafter referred to as the "Complaint").

On 20 March 2018, the undersigned (hereinafter referred to as the "Third-party Decider") signed the Declaration of Acceptance, Availability and Independence to decide on the present Domain Name dispute (hereinafter referred to as the "Dispute").

On 20 March 2018, Complainant and Licensee were informed that the Third-party Decider was appointed to decide on the Dispute.

On 28 March 2018, the deliberation was closed.

4. Factual Background information

Complainant is one of the world leaders in hotel services under different brands, such as SOFITEL, PULLMAN, NOVOTEL, MERCURE and IBIS.

In September 2016 Complainant launched its new brand JO&JOE.

The Domain Name was registered by Licensee on 27 September 2016.

Complainant is in particular the owner of the following trademark registrations: (i) a French word trademark "JO & JOE" (No. 4245719), registered on 2 February 2016 and covering services in class 43; (ii) an International trademark "JO & JOE" (No. 1312382), registered on 29 July 2016 and covering services in class 43; and (iii) a French figurative trademark ("JO & JOE") (No. 4301661), registered on 23 September 2016, and covering services in class 43 (hereinafter referred to as the "Trademarks").

Complainant also operates the following domain names: (i) <joandjoe.com> (registered on 15 January 2001); and (ii) <joandjoe.fr> (registered on 23 September 23) (hereinafter referred to as "Other Domain Names").

On 24 November 2016 Complainant sent a cease-and-desist letter to Licensee via registered letter and e-mail on the basis of its Trademarks. The cease-and-desist letter requested Licensee to cease the use of the Domain Name and to transfer the Domain Name to Complainant.

On 28 November 2016, Complainant received an answer from the agent of Licensee stating that (i) the project corresponding to the Domain Name had not yet started; and (ii) his client was willing to transfer the Domain Name to Complainant in exchange of a "*reasonable transfer price*".

Complainant did not answer to this e-mail, given the fact that, as Complainant has put in the Complaint, it "*was not willing to pay for a domain name whose value is provided by its own trademark*" and decided to file the Complaint.

5. Position of the parties

5.1. Position of Complainant

According to Complainant, a total of 50 hotel venues is set to open by 2020 under the brand name JO&JOE, with locations including Paris and Bordeaux (in 2018) as well as Warsaw, Budapest, Rio and Sao Paulo.

Complainant also contends that, given the advertising, information and communication campaigns combined to the support of their partners Quiksilver and Roxy for the first JO&JOE Hotel in Hossegor, JO&JOE is already well-known in France and in neighbouring countries.

Furthermore, Complainant alleges the brand JO&JOE benefits substantially from the strength of Complainant's trademarks.

According to Complainant, the conditions of Article 10, b, 1 Article 10b (1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE (hereinafter referred to as the "DNS Terms and Conditions") are fulfilled in the present case.

Firstly, Complainant states that the Domain Name is identical to Complainants' Other Domain Names and confusingly similar to the Trademarks. According to Complainant, the use of the word "and" in place of the ampersand symbol does not affect confusing similarity, as the ampersand symbol means "and". Concerning the ccTLD suffix, Complainant states that it has no relevance in order to establish the identity or similarity and has no distinctive character within the Domain Name. Accordingly, Complainant further contends, Licensee created a likelihood of confusion with the Trademarks and services by registering the Domain Name. Complainant also alleges that it is likely that the Domain Name could mislead Internet users into thinking that it is, in some way, associated with Complainant.

Secondly, Complainant alleges that Licensee has no rights or legitimate interests in the Domain Name, given i.a. (i) Licensee has no prior rights or legitimate interest in the Domain Name; (ii) the Domain Name is identical/very similar to the Trademarks, that Licensee cannot reasonably pretend it was intending to develop a legitimate activity through the Domain Name; (iii) Licensee is not commonly known by the name JO&JOE, nor it is affiliated with Complainant, nor authorized or licensed to use the Trademarks, or to seek registration of any domain name incorporating the Trademarks; and (iv) there is no evidence that Licensee has used the Domain Name in connection with a bona fide offering of goods and services, or made demonstrable preparations for such use – on the contrary, the website related to the Domain Name is linked to an inactive page, which does not constitute a bona fide offering of goods or service, while the agent of the Domain name holder specifically explained in correspondence that Licensee "*registered the domain or one project but it is not starting now*", however without explaining sufficiently what kind of project Licensee intended to set up, nor proved that he has made preparations for such use.

Thirdly, Complainant contends the Domain Name was registered or is being used in bad faith. Complainant further states that bad faith must be reasonably proven, and may be proved by any means, including presumptions and circumstances that indicate with a reasonable degree of certainty the existence of bad faith (CEPANI case No. 44171). According to Complainant, bad faith can be found where Licensee "*knew or should have known*" of Trademarks and, nevertheless registered the Domain Name. Complainant further contends that it is implausible that Licensee was unaware of Complainant when he registered the Domain Name. Complainant refers in this respect to the geographic proximity between France and Belgium and the presence of Accor hotels in Belgium. So, Licensee could not reasonably have ignored the existence of Complainant's new project, which has been announced by a huge information and communication campaign, and the Trademarks. Accordingly, Complainant concludes that it is obvious that Licensee knew or should at least have known of the Trademarks, which are well-known. Moreover, a quick trademark search on the sign "JO&JOE" would have revealed to Licensee the existence of the Trademarks. Even a simple search via Google or any other search engine using the keywords JO&JOE or JO AND JOE would have demonstrated that all first results relate to Complainant's services or news. In addition, Complainant contends, as it appears from the correspondences between the parties, Licensee offers the Domain Name for sale at Complainant for a "*reasonable transfer price*". Finally Complainant contends that the Domain Name is not linked to any active website and is, therefore, not used by Licensee for its own activities. This suggests, according to Complainant, that the Domain Name was primarily registered to disrupt the Complainant's business.

5.2. Position of the Licensee

Licensee did not file a 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 DNS Terms and Conditions, 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."*

For the sake of clarity, the Third-party Decider observes that all three abovementioned conditions must be fulfilled in order rule the Domain Name is to be transferred to Complainant.

6.1. The Domain Name is identical or confusingly similar to Trademarks

The Third-party Decider concludes that the Domain Name is confusingly similar to the Trademarks, given the fact that (i) the ampersand symbol means indeed "and" and (ii) the ccTLD suffix has no relevance in order to establish the identity or similarity (e.g. CEPANI cases N°44021 "napster.be", N° 44025 "allienz.be", N° 44030 "chopard.be", N° 44034 "monsanto.be").

As to the Other Domain Names, which are also invoked by Complainant in order to demonstrate its rights, it should be noted that the registration of a domain name, as such, does not establish any right to other domain names (such as the Domain Name).

6.2. Licensee has no right or legitimate interests in the Domain Name

Article 10, b) 3) of the DNS Terms and Conditions provides that *"If a complaint is filed, the registrant can demonstrate his rights or legitimate interests to the domain name by the following circumstances:*

- *prior to any notice of the dispute, the registrant 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 registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if he has no trademark; or*
- *the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain 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."

It does not result from the Dispute file the Third-party Decider disposes that Licensee falls under any of the foregoing any of these conditions are fulfilled. In fact the file shows that:

- prior to any notice of the Dispute, Licensee did not use 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;
- Licensee has not been commonly known by the Domain Name;
- Licensee is not making a legitimate and non-commercial or fair use of the Domain Name.

On the basis of the foregoing, the Third-party Decider concludes that Complainant has sufficiently and reasonably established that Licensee has no right or legitimate interests in the Domain Name.

6.3. The Licensee's Domain Name has been registered or is being used in bad faith

Complainant correctly states that bad faith must be reasonably proven, and may be proved by any means, including presumptions and circumstances that indicate with a reasonable degree of certainty the existence of bad faith (See e.g. CEPANI case No. 44171).

According to Article 10, b), 2) of the DNS Terms and Conditions, the evidence of bad faith registration or use of a domain name can i.a. be demonstrated by the following circumstances:

- *circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity, or to a competitor of the complainant, for a price that exceeds the costs that the registrant can show are directly related to the acquisition of the domain name; or*
- *the domain name was registered in order to prevent the owner of a trademark, a tradename, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or a name of a geographical entity to use the domain name and that the registrant has engaged in a pattern of such conduct; or*
- *the domain name was registered primarily for the purpose of disrupting the business of a competitor; or*
- *the domain name was intentionally used to attract, for commercial gain, Internet users to the registrant's web site or other on-line location, by creating confusion with the complainant's trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of geographical entity as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or location or of a product or service on his web site or location.*
- *the registrant has registered one or more personal names without the existence"*

On the basis of the Complaint and the Dispute file, the Third-party Decider concludes that the Domain Name was registered in order to prevent Complainant to use the Domain Name and that Licensee has engaged in a pattern of such conduct (Licensee also seems to have registered the domain names <joandjoe.nl> and <joandjoe.es>).

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 <joandjoe.be> is to be transferred to Complainant.

Brussels, 11 April 2018.



Gunther Meyer,
The Third-party Decider