



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

Decision of the Third-Party decider

Mr. Alexander E.G. HANJOUL / Mr. Daniele KAMENETZKI

Case No. 44375: palazzuolodue.be

1) The Parties

Complainant is **Mr. Alexander E.G. HANJOUL**, residing at Redingenstraat 7, 3000 Leuven, Belgium, represented by Tom HEREMANS and Lisbeth DEYPERE, Attorneys with offices at Terhulpesteenweg 178, 1170 Brussels, Belgium.

Respondent is **Mr. Daniele KAMENETZKI**, residing at Loc. Ceppetto 136, 52048 Monte San Savino, Italy.

2) Domain Name

The domain name at issue is <palazzuolodue.be>, registered on 29 March 2014, hereinafter referred to as the "Disputed Domain Name".

3) Procedural History

Complainant filed its complaint on 17 March 2015.

On 23 April 2015, Respondent submitted a response to Complainant's complaint.

On 29 April 2015, Cepani appointed Mr. Flip PETILLION as the Third-Party Decider (hereafter also "the Administrative Panel" or "Panel").

On 6 May 2015, Complainant requested to submit additional retort to the response on the basis that the Respondent submitted many exhibits that required an answer from the Complainant. The Complainant also invoked the fact that he had to respond to the Respondent claim regarding the abuse of the Cepani proceedings.

On 11 May 2015, the Administrative Panel accepted the Complainant's request and allowed the Respondent to reply to the Complainant's retort.

On 20 May 2015, the Respondent sent a response to the Complainant's retort, which was forwarded to the Panel on 21 May 2015.

The Administrative Panel shall render its decision based on the Complaint, the Response, the Complainant's retort, the Respondent's reply to the Complainant's retort, Article 10 of the "Terms and conditions of domain name registrations under the ".be" domain operated by DNS", entitled "Dispute resolution policy" (the "Policy"), and the Rules.

4) Elements of Fact

The Complainant and his wife own an apartment in Italy which they bought from the Respondent. The Complainant rents the apartment to tourists. The Respondent owns two apartments which are located in the same property as the Complainant's apartment. The Respondent is also in the holiday house and apartment renting business.

The Respondent registered the Disputed Domain Name <palazzuolodue.be> on 29 March 2014, and uses it to redirect to another website offering holiday houses and apartments for rent.

The Complainant is the holder of the following trademark, which he uses in relation to its apartment renting business:

- Benelux trademark registration number 0967024 for the word mark PALAZZUOLO DUE, filed on 1 December 2014 for classes 36 (agency for the renting of apartments), 39 (organization of holidays) and 43 (renting of holiday houses and apartments).

On 17 March 2015, Complainant filed a complaint with the request to transfer the Disputed Domain Name to Complainant.

5) Parties Contentions

a) Complainant

According to the Complainant:

- The Disputed Domain Name is essentially identical and confusingly similar to a trademark, a trade name and a corporation name in which Complainant has rights;
- Respondent has no rights or legitimate interests in the Disputed Domain Name; and
- The Disputed Domain Name has been registered and is being used in bad faith.

b) Respondent

According to the Respondent, Complainant's trademark cannot be taken into account as it was filed and registered after the registration of the Disputed Domain Name. The Respondent argues that the term "Palazzuolo Due" is not a famous or unique brand but a name of a building.

The Respondent states that he has a very strong and established right and legitimate interest in the Disputed Domain Name, as he uses it to rent apartments in a property where an old script "PALAZZUOLO II" is mentioned on one of the buildings.

Finally, Respondent contends not to have registered or used the Disputed Domain Name in bad faith.

6) Discussion and Findings

a) Analysis of the Complaint

Article 15.1 of the Rules instructs the Third-Party Decider 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 dispute resolution policy, the registration agreement and following the provisions of the present Rules.*"

By virtue of Article 10, b, 1, of the Policy Complainant must prove each of the following:

- "the domain name holder's domain name is identical or confusingly similar to a trademark, a trade name, 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 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."

i) Identity

The Administrative Panel is of the opinion that, since article 10, b, 1 of the Cepani Rules refers to "a trademark" without any further specification, all trademarks irrespective of the territory for which they are registered or their anteriority compared to the registration date of the Disputed Domain Name may be considered.

Moreover, the fact that these trademarks may be invalid due to a lack of distinctive character is irrelevant in assessing whether these trademarks are identical or similar to the disputed domain names (Cepani Case No. 44050, *Startpagina b.v. vs. Take b.v.b.a.*, 17 November 2004 (startpagina.be); Cepani Case No. 4054, *The European Omnibus Survey s.c.r.l. vs. Magyar Gallup Intezet*, 25 January 2005 (gallup-europe.be); Cepani Case No. 4084, *Belgisch Instituut voor Normalisatie v.z.w. vs. Willy De Belder*, 9 August 2006 (benor.be); Cepani Case No. 4085, *Media Office NV vs. María Eguirón*, 31 juli 2006 (casas.be)).

Accordingly, Complainant's trademark can be relied upon when assessing the identity or confusing similarity of the Disputed Domain Name.

The Administrative Panel is of the opinion that the Complainant's trademark is identical to the Disputed Domain Name. Indeed, the presence of the suffix ".be" makes no relevant difference in this respect.

As the identity has been established with regard to the Complainant's trademark, there is no need to examine the other trademark and trade name rights invoked by the Complainant.

ii) Rights or legitimate interests

Pursuant to article 10.3 of the Cepani Rules, Respondent can demonstrate rights or legitimate interests in the Disputed Domain Names notably if "*prior to any notice of the dispute, the licensee used the domain name[s] or a name corresponding to the domain name[s] in connection with a bona fide offering of goods or services or made demonstrable preparations for such use*".

Respondent, who is active in the holiday house and apartment renting business, registered the Disputed Domain Name in March 2014. It is not disputed that the Disputed Domain Name is used to redirect to a website which is directly competing with the Complainant's business.

However, the Respondent argues that the Disputed Domain Name redirects to a page making reference to the name of the property in which both parties own apartments. The Respondent admits he has no exclusivity over the name "Palazzuolo Due". However, the Respondent claims that he has a legitimate interest in the name, as "Palazzuolo Due" is the name of the building he renovated and still owns in part.

The Complainant claims that the Respondent never used the term “Palazzuolo Due” outside the framework of the present dispute. However, the Administrative Panel considers that this is not relevant to assess the Respondent’s rights or legitimate interests in the Disputed Domain Name.

The Complainant also states that the Respondent knew about the Complainant’s use of the term “Palazzuolo Due” before he registered the Disputed Domain Name. The Administrative Panel considers that this knowledge does not prevent the Respondent to have a legitimate interest to use the Disputed Domain Name.

In the instant case, the Administrative Panel finds that the Respondent shows to have a legitimate interest in the Disputed Domain Name <palazzuolodue.be>. The Administrative Panel rejects the Complainant’s argument that, as the building contains the mention “PALAZZUOLO II” and not “PALAZZUOLO DUE”, the Respondent could have registered the domain names <palazzuololl.be> or <palazzuolo-II.be>. Given the fact that capital letters are not considered by the DNS, these domain names would not have the same meaning. The use of the word “due” is a natural choice, as this is the Italian translation of the Roman number 2 (“II”).

Given the descriptive character of the Disputed Domain Name, referring to the Respondent’s property and the business of Respondent, the Administrative Panel finds that Respondent could legitimately register the Disputed Domain Name, even if the Respondent was aware of Complainant’s activities. Domain names in the .be TLD are delegated at a first-come, first served basis and the Complainant had no trademark rights when the Respondent registered the Disputed Domain Name (See Cepani Case No. 44238, *S.A.R.L. Pneus Online Holding / DELTI.COM AG*, 31 January 2012 (pneus-online.be / pneusonline.be / pneu-online.be / pneuonline.be)).

In view of the above, the Administrative Panel considers that the Respondent has demonstrated a legitimate interest in the Disputed Domain Name.

iii) Registration or use in bad faith

Given the Administrative Panel’s decision regarding the Respondent’s rights or legitimate interests in the Disputed Domain Name, there is no need to rule on the bad faith registration or use criteria. Indeed, by virtue of Article 10, b, 1, of the Policy, the Complainant must prove each of the three criteria in order to obtain the cancellation or transfer of the Disputed Domain Name.

7) Decision

Pursuant to Article 10, e, of the Policy, the Administrative Panel denies the request of Complainant that the Domain Name <palazzuolodue.be> be transferred to Complainant.

Brussels, 8 June 2015



Flip Petillion
Third-Party Decider