

Dispute N° 44094: EMANUELUNGARO.be

DECISION OF THE THIRD-PARTY DECIDER

Emanuel Ungaro S.A.S. / Cat Fox

1. Parties

1.1. Complainant:

Emanuel Ungaro S.A.S., company under French law established at 75008 Paris (France), Avenue Montaigne 2, registered in the national register under 348885500

Represented by:

Dr. Annick Mottet, attorney at law, having her office at 1932 Sint-Stevens-Woluwe (Belgium), Woluwedal 20.

1.2. Licensee:

Cat fox, established at 21800 Hong Kong (Hong Kong), Paomadj NO. 186

2. Domain Name

Domain Name: “*emanuelungaro*”.be
registered the: 05.10.2005
Hereafter stated as “*domain name*”

3. History of the procedure

On July 28, 2006 the complainant filed a complaint with the Belgian Center for Arbitration and Mediation (hereafter referred to as the “Center”) relating to the domain name in hard copy and in electronic version.

On August 30, 2006 the licensee was notified of the complaint and was invited to submit a response by September 6, 2006. The licensee didn't submit his response to the “Center”.

Mrs. Christine De Keersmaecker forwarded a declaration of Independence to the center and was appointed on August 30, 2006 by the Center as the Third-Party Decider both by registered mail and by e-mail to settle the dispute involving the aforementioned domain name “*emanuelungaro*”.be

The Center also informed the Third-Party decider that the deliberation would be closed by September 6, 2006 and that its decision needed to be filed by September 20, 2006. Both the Complainant and the Licensee were informed of the aforementioned appointment and information.

The Third-Party Decider's decision is issued according to:

- the complaint dated 28 July 2008 and annexed documents;
- the Rules of the Belgian Center for Arbitration and Mediation for Domain Name dispute resolution (hereafter "Cepani Rules");
- the "Terms and conditions of domain name registrations under the ".be" domain operated by DNS", entitled "Dispute Resolution Policy" (hereafter "the Policy").

4. Facts

The complainant is a company under French law which is internationally active under the trade name Emanuel Ungaro, a well-known designer, couturier and lifestyle specialist. Its product range includes designer clothing, accessories and perfumes.

The complainant is the holder of the registered trademark "Emanuel Ungaro". This mark was registered, among others, as:

- International word trademark "Emanuel Ungaro", as it results from the WIPO registration nr. 764126, which he provides under annex 3;
- Community word trademark "Emanuel Ungaro", as it results from the official CTM register nr. 000797423, which he provides under annex 4.

Excerpts of the official databases proving the ownership of these trademarks are added as annex 3 and 4 to the complaint.

The complainant exploits these trademarks on the Belgian market and therefore wishes to register the domain name emanuelungaro.be. Such does however not seem possible since the domain name was registered by the licensee (see annex 3 of the complaint).

The complainant has hosted its main web site under the domain name emanuelungaro.com.

The licensee identified himself in the DNS-database as Cat Fox, established at Paomadj NO. 186, 21800 Hong Kong and reacDhable on heikeyou2@126.com.

The licensee registered the domain name "emanuelungaro".be on November 5, 2005.

The complainant did send a cease and desist letter to the licensee on 6 January 2006 (annexes 7 and 8 to the complaint).

The complainant's e-mail message was left unanswered, although it seems that no error message was returned by the Licensee's mail server.

The complainant's registered letter was sent back by the Hong Kong postal authorities on 9 January 2006, indicating that the physical address did not exist ("No such address" indicated on the envelope, see annex 9 to the complaint).

The licensee's website hosted under the domain name shows that the licensee uses the domain name to present Chinese language content consisting of a representation of personal holiday photos. These personal photos have been taken on Chinese territory.

5. Position of the parties

5.1. Position of the Complainant

In the complaint form, the complainant argues that:

- the domain name is identical or confusingly similar to a trademark, a trade name, a social name or corporation name, a geographical designation, a personal name or some of a geographical entity in which the complainant has rights;
- the domain name emanuelungaro.be is the verbal contraction of the complainant's corporate name and trade name Emanuel Ungaro and is clearly identical or confusingly similar to the complainant's legally protected denomination;
- the use of the complainant's trade marks, incorporating the denomination Emanuel Ungaro, is o.a. a clear violation of Benelux trademark legislation, most notably because the name is used without valid reasons in a manner which is detrimental to the distinctive character of the trademark;
- the use of the domain name emanuelungaro.be should be considered confusingly similar to the complainant's denomination, as the general public looking for information regarding the complainant's activities in Belgium will be confused also due to the fact that complainant has hosted its main web site under the domain name emanuelungaro.com (and not under emanuel-ungaro.com);

- the licensee has no rights or legitimate interest in the domain name;
- the web site of the licensee contains exclusively Chinese language information and contains no elements which could indicate a Belgian affiliation;
- the web site contains information of personal holiday photos that could be offered through any of the multitude of existing sites rather than for no justified reason, through a private site;
- the web site doesn't contain contact data for the Belgian visitor to contact the site owner/administrator. There is no interacting with the Belgian visitor;
- the site's contents show no link, with denomination of Emanuel Ungaro or the Belgian national territory;
- the licensee has not responded to complainants cease and desist letter and failed to state any rights or legitimate interests in the Domain Name;

- the licensee's domain name has been registered in bad faith or is being used in bad faith;
- the lack of reply is a sign of bad faith;
- there is no link with Emanuel Ungaro or Belgium, which is another sign of bad faith;
- the licensee abuses a protected designation to flaunt personal holiday photos, without any logically justified reason;
- the Emanuel Ungaro trademark is well-known, therefore the licensee knew or should have known about the existence or use of the well-known trade name;
- the licensee's use of the domain name harms the complainant's business reputation.

5.2. Position of the Licensee

The Licensee did not reply to the Complainant's contentions.

6. Discussion and conclusions

According to article 15.1 of the Cepina Rules for domain name dispute resolution, the Third-Party Decider decides on the complaint in accordance with the DNS. be Policy and these Rules.

According to article 10,b,1, of the Policy, the complainant has to prove that

- i. *the licensee'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 the complainant has rights; and*
- ii. *the licensee has no rights or legitimate interests in the domain name; and*
- iii. *the licensee's domain name has been registered or is being used in bad faith.*

6.1. Identical or confusingly similar

This question raises two issues: (1) does the Complainant have rights in a trademark; and (2) is the domain name identical or confusingly similar to such trademark.

As to the first question, complainant provides the evidence that he is the owner of the third-party the mark Emanuel Ungaro as an international word trademark and as a community word trademark (see annex 3 and 4 to the complaint).

As to the second question the third-party decider finds the domain name "*emanuelungaro*".be identical or at least confusingly similar to the trade mark "Emanuel Ungaro". The only differences between the domain name and the trade mark are that: the Emanuel Ungaro trademark consists of two separate words and the Domain Name is a contraction of those words; and (2) the suffix ".be". The first difference is minor and does not distinguish the mark from the domain name. The second difference, the suffix "be", does not exclude the identity and/or the similarity since this suffix refers only to the geographical extension and origin of the web site (cases nr. 4068, 4067, 4061, 4060, 4059, 4056, 4054, 4053, 4053, 4042, 4039, 44038, 4035, 44034, 4032, 44030, 4025).

In the opinion of the third-party decider there exists an important risk of confusion in Internet web searcher's minds. Average consumers may be led to think that the disputed domain name is owned, controlled or endorsed by the Complainant.

The Third-Party Decider therefore concludes that the first condition is met.

6.2. Rights or legitimate interests

According to art. 10 b, 1, of the Policy the complainant has to prove that the licensee has no rights or legitimate interests to the domain name.

Considering the difficulty of proving such a negative fact ("negative non sunt probanda"), this burden of proof is considered to be satisfied when, taking into account all the facts of the case, the complainant could credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (cases nr. 4064, 4030, 4013).

Art. 10 b, 3 of the Policy however provides that the licensee can prove that he has a right or a legitimate interest to the domain name due to the following circumstances:

- he used the domain or a name corresponding to the domain name in connection with a bona fide offering of goods or service or made demonstrable preparations for such use;
- he has been commonly known by the domain name, even if he has acquired no trademark;
- he 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, tradename, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.

The Licensee does not collaborate to the evidencing of the case, since he did not reply to the complainant's complaint and therefore obviously, does not invoke a trademark right, a trade name, a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of geographical entity, nor explains why he could have a legitimate interest in the Domain Name.

The Third-Party Decider presumes that the licensee has no right or interest in the domain name.

The complainant provides indeed evidence that he addressed the licensee by e-mail and a registered letter (see annex 7 and 8 to the complaint).

The complainant states that the licensee had no license or the permission from the complainant to use the Trademark or to apply for or use any domain name incorporating that mark.

The domain name was registered with the Registrar on November 5, 2005. At this time the Complainant had already registered its trademarks.

The web site of the licensee contains exclusively Chinese language content, namely personal holiday photos and seems to have no interest in the Belgian market.

The site's content shows no link to the denomination of Emanuel Ungaro or to the Belgian national territory. Therefore the licensee has no reason to have registered emanuelungaro.be for his site.

The complainant may therefore credibly state that he is unaware of any reason or circumstance which could be indicative of a right or legitimate interest of licensee in the domain name emanuelungaro.be.

As a result, the Third-Party Decider considers that the licensee has no legitimate interest and therefore the Third-Party Decider concludes that the second condition is met.

6.3. Registered and used in bad faith

Bad faith can be proven by any means, including presumptions and circumstances that indicate, with a reasonable degree of certainty, the existence of bad faith.

The evidence of the registration and use of a domain name in bad faith can be provided by four circumstances, without limitation, namely art. 10, b, 2 of the Policy:

- i. circumstances indicating that the domain name was registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant;
- ii. the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name;
- iii. the domain name was registered primarily for the purpose of disrupting the business of a competitor;
- iv. the domain name was intentionally used to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark;
- v. the licensee register one or more personal names without the existence of a demonstrable link between the licensee and the registered domain names.

In the case at hand, the complainant did not prove that the main purpose of the registration of the domain name is a commercial gain, since the Licensee's web site doesn't contain any information with commercial gain. The site consists in personal holiday photos and can't be seen as a 'commercial gain'.

The licensee and the complainant operate in different sectors and therefore it is improbable that the licensee intended to disrupt the business of the complainant.

However by not submitting a response and the unwillingness of licensee to react to the request to transfer the domain name, it appears that the domain name is being used in bad faith. The intention underlying the licensee's registration stays unclear. The licensee who registers a confusingly similar domain name should be willing to show an intention to express himself or herself by responding to communications and indicating good faith (cases nr. 44002, nr. 44030, cases nr. 44038).

The domain name at stake is a well known trademark. It is excluded or extremely unlikely that a third party would choose this word as a domain name. In this case the complainant's Trademark is a personal name and has a strong reputation. It is probably so that the Licensee must have been aware of these trademark rights when it registered and used the domain name. Subsequently, complainant gave the licensee notice of his ownership of exclusive rights to the Trademark. The licensee didn't respond and continued to use the mark in the domain name (case nr. 4025).

Therefore, the Third-Party Decider finds that the licensee has registered and used the domain name in bad faith under art. 10, b, 2, v.

As a result, the Third-Party decider considers that the third condition is met.

7. Decision

The Third-Party Decider decides that the conditions under article 10,b,1 of the Policy are met and that the complaint is founded. Therefore the Third-Party Decider orders that the domain name “emanuelungaro”.be must be transferred to the complainant Emanuel Ungaro.

Brussels, September 19, 2006.

The Third-party decider

Christine DE KEERSMAEKER

