

## **EXPERT DECISION**

**Belfius Bank S.A. / Belfius Bank N.V. v. A.A.**  
**Case No. DCH2022-0012**

### **1. The Parties**

The Claimant is Belfius Bank S.A. / Belfius Bank N.V., Belgium, internally represented.

The Respondent is A.A., France.

### **2. The Domain Name**

The dispute concerns the domain name <belfius.ch>.

### **3. Procedural History**

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 11, 2022. On July 12, 2022, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the Disputed Domain Name. On July 13, 2022, SWITCH transmitted by email to the Center its verification response confirming that the Respondent is listed as the holder of the Disputed Domain Name and providing the relevant contact details. The Center verified that the Request satisfied the formal requirements of the Rules of procedure for dispute resolution procedures for “.ch” and “.li” domain names (the “Rules of Procedure”), adopted by SWITCH, on January 1, 2020.

In accordance with the Rules of Procedure, paragraph 14, the Center formally notified the Respondent of the Request, and the Dispute resolution procedure commenced on July 14, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was August 13, 2022.

The Respondent filed a Response and did not express its readiness to participate in the conciliation on August 13, 2022. No Conciliation conference has taken place within the deadline specified in paragraph 17(b) of the Rules of Procedure.

On August 29, 2022, the Center appointed Thomas Legler as Expert in this case. The Expert finds that it was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared his independence of the parties.

#### **4. Factual Background**

The Claimant is a Belgian bank and financial services provider. It has more than 5,000 employees, over 500 agencies and almost 4 million clients, and is 100 percent state-owned. Up until March 1, 2012, the company was called Dexia Bank Belgium.

The Claimant is the owner of the domain name <belfius.be>, registered on January 23, 2012, which it uses for its official website offering banking and insurance services, as well as <belfius.com>, registered on January 20, 2012, which redirects to a website intended for institutional partners and journalists.

The Claimant is also the owner of numerous Benelux trademarks incorporating iterations of “BELFIUS”, among else the word mark BELFIUS registered on May 10, 2012, as well as a European Union Trade Mark for the word mark BELFIUS, registered on May 24, 2022, in the International Classes 9, 16, 35, 36, 41 and 45 (hereinafter “BELFIUS trademark”). On June 17, 2022, the Claimant has filed a corresponding Swiss trademark application for the word mark BELFIUS, which is currently pending according to the present submissions by the Claimant.

The Respondent is a French entrepreneur, teacher and investor in more than 20 companies all around Europe. He was owner and manager of the French cosmetics retailer Parashop. Today, he owns a cosmetics factory and two cosmetics brands.

The Respondent registered the Disputed Domain Name on February 29, 2012.

#### **5. Parties' Contentions**

##### **A. Claimant**

According to the Claimant, its trade name BELFIUS is composed of “bel” for “Belgium”, “fi” for “finance”, and the English word “us” and was specifically invented for the Claimants' business. The Claimant thus submits that it holds a right to a name in Switzerland in accordance with article 29 of the Swiss Civil Code.

The Claimant further contends that it is a renowned Belgian bank and financial services provider, but also has customers in Switzerland, and that the BELFIUS trademark has gained reputation in Switzerland despite the Claimants' activities being mainly focused on the Belgian territory. To support its assertion, the Claimant indicates that, as a sponsor of several sports teams playing on an international level, its name and logo is featured on player's outfits, and that a Google search with the keyword “Belfius” set to Switzerland leads directly to webpages by or about the Claimant. The Claimant further states that “Belfius” is featured in the e-mail address of its employees (consisting of the name/department followed by [...]@belfius.be).

The Claimant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, because the registration of the Claimant's domain names and the Belgian and European Union trademarks predate the Respondent's registration of the Disputed Domain Name.

The Respondent is further not associated with the Claimant, and the Claimant has not licensed nor consented to the registration and use of its trademark in the Disputed Domain Name. The Claimant further points out that the Respondent has no trademark rights with the term “Belfius” and does not carry out any commercial activities under this name. The Claimant adds that the Disputed Domain Name is inactive and has not been used for over 10 years, so the Respondent is not making any legitimate noncommercial or fair use of the Disputed Domain Name.

The Claimant states that the Disputed Domain Name is confusingly similar to its protected trade name BELFIUS, because the former incorporates the latter. Furthermore, the Claimant submits that the fact that the Disputed Domain Name resolves to a standard placeholder page of the Registrar might result in the tarnishing of the Claimant's trade name as Swiss customers may perceive it as unprofessional or believe that

the website has been hacked and therefore trigger security concerns.

Finally, the Claimant submits that the Respondent's use of the Disputed Domain Name constitutes cybersquatting: the Respondent registered an identical fictional name that was specifically created for the Claimant's business as domain name only one month after the Claimant's application for its Benelux and European Union trademarks while (likely) having had notice of the Claimant's trademark and domain name registrations beforehand. By choosing the country code Top-Level Domain ("ccTLD") ".ch", the Respondent did so deliberately with a view to Switzerland's association with banking activities. The Respondent is further passively holding the Disputed Domain Name without using it for any type of legitimate business or service, nor is he making demonstrable preparations in this regard.

The Claimant adds in particular the following: "The timing of the registration of a completely identical fictional name as a domain name by the Respondent, is no coincidence, and leads to the inevitable conclusion that the Respondent knew of the Claimant's trademark and domain name registrations. In fact, in its reply, the Respondent admits he knows that Belfius is a trademark used for products, services, activities and events linked to Claimant's business (Annex 5). The LinkedIn profile of the Respondent states that he has been working in Brussels (where the head office of the Claimant is located) for more than 12 years, which shows a link with Belgium (Annex 11)." "One can confidently assume that Respondent at least must have heard of Belfius during this period. In this regard, it should also be noted that Switzerland is a country typically known for banking activities, which suggests that the Respondent did not choose the ccTLD ".ch" by chance."

## **B. Respondent**

The Respondent claims that the Claimant's request is abusive as the Claimant has waited over 10 years to file for a transfer of the Disputed Domain Name.

The Respondent further contends that there exists no legal duty for the Disputed Domain Name to resolve to an active webpage and maintains that the Claimant itself has owned the domain name <belfius.at> for years which also leads to a mere placeholder page.

The Respondent also contests any right of the Claimant to the name "Belfius" and submits that the Claimant does not own any Swiss trademarks.

He further contests that the Claimant has no registered company, business, clients, or turnover in Switzerland and denies that the Claimant is famous in Switzerland. According to the Respondent, a Google search set to Switzerland but leading to a webpage with the Belgian ccTLD ".be" does not indicate a connection between the Claimant and Switzerland.

The Respondent denies the allegation of cybersquatting and having registered the Disputed Domain Name in bad faith and claims to have had no prior knowledge of the Claimant's domain name registrations, submitting that the Claimant only officially changed its name in Belgium in March 2012, whereas the Respondent registered the Disputed Domain Name in February 2012.

The Respondent further submits that there is no confusion in the minds of customers between the Claimant's brand and his own as he is planning to use the Disputed Domain Name in the context of selling cosmetic products.

The Response concludes as follows: "After 10 years of no-show & silence, the Claimant which claims being a big and serious Belgian established bank, suddenly gives notice to the Respondent to recover for free a Swiss domain name, that the Respondent registered before that the Claimant went public with his new name in Belgium. The Claimant has no registered company in Switzerland, no business, no client, no turn-over. He doesn't own any rights or trademark in Switzerland on the name Belfius related to the domain name claimed. The Respondent, which is a well-known European entrepreneur with expertise in Cosmetics, invested time and money to elaborate a concept of cosmetic Swiss brand. The timing of settling a company, launching a concept and financing a start-up belongs to him, and he doesn't have to justify in front of any third party

about the “why” and “when” he will go ahead with his projects. The Respondent clearly notified the Claimant he wants to keep his ownership on the domain name, the name BELFIUS potentially could be used in cosmetics (by him) and in finance (by the Claimant), with no risk of confusion in the minds of consumers.”

## 6. Discussion and Findings

According to paragraph 24(a) of the Rules of Procedure, the Expert shall decide the Request on the basis of the pleadings of both Parties and the submitted documents in conformity with the Rules of Procedure.

The Expert shall grant the Request, if the registration or use of the Disputed Domain Name constitutes a clear infringement of a right in a distinctive sign which the Claimant owns under the laws of Switzerland or Lichtenstein (paragraph 24(c) of the Rules of Procedure).

In particular, according to paragraph 24(d) of the Rules of Procedure, a clear infringement of an intellectual property right exists when

- (1) both the existence and the infringement of the claimed right in a distinctive sign clearly result from the wording of the law or from an acknowledged interpretation of the law and from the presented facts and are proven by the evidence submitted; and
- (2) the Respondent has not conclusively pleaded and proven any relevant grounds for defense; and
- (3) the infringement of the right justifies the transfer or deletion of the Disputed Domain Name, depending on the remedy requested in the Request.

### A. Defense of Forfeiture of Rights

By submitting that the Claimant's request is abusive due to a long lapse of time, the Respondent is essentially claiming that the Claimant has forfeited its rights. It must be examined at the outset whether the Respondent has conclusively raised and proven this objection.

Pursuant to the Swiss Federal Tribunal, a forfeiture of rights for a long lapse of time cannot be accepted easily, as, according to article 2(2) CC, a right is only unprotected where the abuse is obvious (DSC 114 II 111, consid. 4).

Forfeiture is admitted only under the condition that the right holder has tolerated the violation of his rights through the use of an identical or similar sign without contradiction during a long time and that, in the meantime, the infringer has acquired valuable vested rights to the sign (DSC of January 21, 2005, 4C.376/2004, consid. 4.1). Only the infringer who is of good faith, may be protected in this respect (DSC 88 II 176 cons. 3).

The fact that the Claimant has waited 10 years to act, could basically in itself be considered as too long as the infringer may have been led to the conviction that the infringement is tolerated.

Even if the Claimant could have been expected to become aware of the Disputed Domain Name's existence earlier on; however, the Respondent must still fulfill the condition of the acquisition of vested rights (goodwill) and that of good faith.

Regarding the question whether the Respondent has acquired vested rights, the Expert concludes that the Respondent has failed to prove that he has acquired an important market position in Switzerland under the name “Belfius” (or even any other business). Although the Respondent sustains having “invested time and money to find a name, concept, packaging, etc. for an ‘indie cosmetic brand’ which should be ‘swiss-born’”, (whereas in his email to the Claimant dated May 17, 2022, he indicates the intention of using it in the context of a production facility *in France*), he did not provide evidence of any business plan, correspondence, financial investment or expenditure linked to the development of a cosmetics or other business under the name “Belfius” in Switzerland. In addition, the Respondent has not used the Disputed Domain Name to link

to an active website, which would show any concrete business activity deemed to be protected.

Failing a proof for vested rights, the question whether the Respondent fulfils the second requirement of good faith can be left open.

The Expert therefore concludes that the Claimant's rights are not forfeited and that the Respondent has not conclusively shown any relevant grounds for defense in this regard.

### **B. Claimant's claims for a distinctive sign**

The Claimant neither asserts that it owns a Swiss trademark for BELFIUS, nor does it indicate or submit evidence that the Claimant's Belgian and European Union trademarks constitute notorious trademarks as per article 6bis of the Paris Convention for the Protection of Industrial Property ("Paris Convention").

The Rules of Procedure however do not require the Claimant to base its Request on a registered trademark; it is sufficient for the Claimant, according to paragraph 24(c) of the Rules of Procedure, to justify that it has a right in a distinctive sign. The Rules of Procedure, according to paragraph 1, define "distinctive signs" as any "sign devolving from the registration or the use of a sign [...], including [...] registered business name, a personal name, [...] and the defensive rights devolving from the law of unfair competition".

The Claimant invokes both the protection of its name "BELFIUS BANK" under article 29(2) Civil Code ("CC") against any use by third parties of the distinctive element of the name, as well as under the Swiss Unfair Competition Act ("UCA") against misappropriation (article 2 and article 3(1)(d) UCA).

### **C. Claimant's claim for a trade name in Switzerland**

According to article 8 read in conjunction with article 2(1) Paris Convention, foreign trade names enjoy the same protection as comparable domestic signs (Decision of the Swiss Federal Supreme Court (hereafter "DSC") of November 8, 2004, 4C.31/2004, consid. 7.1).

If the trade name is inherently distinctive in character, as is clearly the case here, it is sufficient that the trade name is consistently used in Switzerland to establish the right to a name; if the trade name is only used abroad, it must have at least reached a high degree of knowledge due to media promotion in Switzerland (Roland Bühler, Basler Kommentar, 4<sup>th</sup> ed., *ad* Art. 29 CC, no. 16; see also DSC 114 II 106 and 109 II 483).

In the present case, the Claimant has not sufficiently evidenced that its trade name is consistently used in Switzerland nor that it has reached a high degree of recognition. The Claimant's allegation that it has customers in Switzerland and that its name and logo are also used in Switzerland in the context of sports events have not been corroborated by any evidence.

Furthermore, the Expert is of the opinion that a mere "Google search set to Switzerland, where the keyword "belfius" leads directly to web pages by or about the Claimant" as mentioned by the Claimant does not amount to a sufficient degree of public knowledge for that purpose.

The Expert therefore concludes that the Claimant cannot base its request on a trade name right in accordance with article 29(2) CC.

### **D. Claimant's claim for protection under the Unfair Competition Act ("UCA")**

It is unfair and unlawful to engage in "any conduct or business practice which is deceptive or otherwise contrary to the principle of good faith and which affects the relationship between competitors or between suppliers and customers". Even if there is no competition between the Claimant's services and those offered by the Respondent or any third person, the UCA is applicable (DSC 120 II 76 cons. 3a). It is sufficient that the conduct of the Respondent be of a nature to affect the market. Although the existence of the latter element is questionable as the Respondent had so far no activities in the Swiss market, the Expert proceeds

with the examination of the various claims submitted by the Claimant under the UCA.

As the Claimant has no distinctive sign registered in Switzerland, article 10 *bis* Paris Convention is the appropriate basis. Indeed, in the absence of a registration at the Swiss registry of commerce, a foreign trade name is protected under the UCA provided that the Claimant has obtained a certain recognition within the professional community of its field of activities and intends to expand its business activities also to the Swiss market (Reto Arpagaus, Basler Kommentar, 2013, *ad* Art. 3(1)(d) UCA, no. 224).

There is little doubt that the Claimant has a certain reputation in the field of financial services in Belgium and other countries. It has however not established that it is currently active or has the intention to become active in the Swiss market. As already noted above (section 5C) the Claimant alleges without submitting any evidence that it has customers in Switzerland and that its name and logo are also used in Switzerland in the context of sports events. The Claimant has not submitted either any documents showing that it is promoting its services in Switzerland. The Respondent's exhibit which shows that a Google research with the term "Belfius Suisse" refers back to the Claimant's Belgian website corroborates that situation.

Besides article 3(1)(d) UCA, the Claimant also invokes the *general clause* of article 2 UCA without developing in detail its legal standpoint under this provision. The Expert understands however that the Claimant may refer to a behavior which is called "Behinderungswettbewerb" (Reto Arpagaus, Basler Kommentar, 2013, *ad* Art. 3(1)(d) UCA, no. 210), *i.e.* the situation where the market activity of a legitimate holder of a distinctive sign is hampered.

In the absence of evidence of any market activity of Claimant in Switzerland nor the proof for the intention to become active in Switzerland, this argument must however also fail.

The Expert is of the opinion that the Claimant has not sufficiently pleaded its case under the applicable Rules. That should not hinder it to seek recourse in the ordinary courts where it will have the option to argue its case in detail and corroborate it with the necessary evidence.

## **7. Expert Decision**

For the above reasons, the Request is denied.

**Thomas Legler**

Expert

Dated: September 20, 2022