

ADMINISTRATIVE PANEL DECISION

Brembo S.p.A. v. NVA Online Advertising B.V.
Case No. DNL2024-0018

1. The Parties

The Complainant is Brembo S.p.A., Italy, represented by Convey Srl, Italy.

The registrant of the disputed domain name is NVA Online Advertising B.V., Netherlands (Kingdom of the), represented by (the “Respondent”).

2. The Domain Name and Registrar

The disputed domain name <brembo.nl> (the “Domain Name”) is registered with SIDN through NVA Online Advertising B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2024. On April 2, 2024, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name.

On April 3, 2024, SIDN transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named respondent and contact information in the Complaint. On April 5, 2024, the registrar in its turn transmitted by email to the Center further information about the effective domain name user and party in interest in these proceedings.

The Center sent an email communication to the Complainant on April 5, 2024, providing the information disclosed by SIDN and the registrar, and inviting the Complainant to amend the Complaint in this light. The Complainant filed an amended Complaint on April 9, 2024.

The Center verified that the Complaint as amended satisfies the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent and the effective domain name user and party in interest in these proceedings of the Complaint, and the proceedings commenced on April 11, 2024. In accordance with the Regulations, article 7.1, the due date for Response was May 1, 2024. The Response was filed with the Center on April 12, 2024.

On April 18, 2024, SIDN commenced the mediation process. On April 23, 2024, SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on May 14, 2024. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

The Complainant is an Italian manufacturer of automotive braking systems, especially for high performance cars and motorcycle, founded in 1961. A variety of Formula One teams, including Ferrari, use Brembo brakes. The Complainant also supplies the majority of MotoGP teams. Since 2005, Brembo has been an official brake caliper supplier for the GP2 Series and the FIA Formula 2 Championship. Since 2010, Brembo has been an official whole brake supplier for the GP3 Series and the FIA Formula 3 Championship and the exclusive supplier of braking systems for the MotoE World Cup.

The Complainant is the owner of a number of trademark registrations, including but not limited to (the "Trade Marks"):

- European Union ("EU") Trademark BREMBO, registered under No. 000401554 on October 21, 1998;
- International Trademark BREMBO RACING, registered under No. 001728989 on October 23, 2001, designating the Netherlands; and
- International Trademark BREMBO registered under No. 001728799 on July 31, 2001.

The Trade Marks have been employed in the contest of numerous motor racing in the Netherlands and articles have appeared in Dutch online newspapers that mention the BREMBO brand.

SIDN informed the Center that the Domain Name was first registered on March 31, 2023, and that the date of the current registration by change of registrant is November 1, 2023, and resolves to a website on which the Domain Name is offered for sale and visitors are invited to make a bid to purchase the Domain Name. By email of 8 March 2024, the Complainant sent a cease-and-desist notice to the Respondent, demanding transfer of the Domain Name. In a follow-up email of March 18, 2024, the Complainant offered to pay EUR 99 for the transfer. In response to this offer, the Respondent by email of March 21, 2024 indicated that it was prepared to transfer the Domain Name against payment of EUR 995 exclusive of VAT.

5. Parties' Contentions

A. Complainant

The Complainant demands transfer of the Domain Name on the grounds set out below.

The Complainant and the Trade Marks are well-known in the Netherlands through their association with various international automotive events, as well as through publications in online magazines in the Netherlands. The Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights, as the Domain Name incorporates the whole of the Trade Mark BREMBO, while the country code Top Level Domain .nl does not affect the confusing similarity.

The Respondent has no rights or legitimate interests in respect of the Domain Name, as the Respondent is not a licensee or authorized agent of the Complainant nor in any other way authorized to use the Trade Marks as part of the Domain Name or otherwise. Furthermore, the Respondent is not an authorized reseller of the Complainant and is not using the site to which the Domain Name resolves to promote only BREMBO goods, while this website does not display a prominent disclaimer about the relationship with the Complainant.

As to bad faith at the time of registration, in light of the intensive use of the Trade Mark BREMBO since years and the investments of the Complainant to promote the brand, the Respondent could not have possibly ignored the existence of the Trade Marks, which are identical to the Domain Name. The Domain Name was registered in 2023, many years after the Complainant obtained the first of the Trade Marks. Therefore, by virtue of the Complainant's extensive use of the Trade Marks and of the Trade Marks' distinctiveness, it is inconceivable that the Respondent was unaware of the existence of the Trade Marks at the time of the registration of the Domain Name. Moreover, on the website to which the Domain Name resolves, the Respondent is offering for sale the Domain Name for an amount exceeding any documentable out-of-pocket costs connected with the registration of the Domain Name, exploiting the Complainant's fame and notoriety for his own commercial gain.

B. Respondent

The Respondent states, on the grounds set out below, that the claim of the Complainant should be dismissed and that the Respondent, as a legitimate domain name registrant, should retain the registration of the Domain Name.

The Respondent is a marketing agency engaged in online web design and marketing for websites and web shops and is not active in the world of (auto)racing. The Respondent has no affiliation with racing or any products of the Complainant, while no products are advertised on the website to which the Domain Name resolves which is a "for sale" landing page. On these grounds, the likelihood of confusion must be rejected. The Respondent has a rights or legitimate interest in the Domain Name as it was the first to buy the Domain Name when it was available. The Respondent makes fair use of the Domain Name without the intention to mislead the consumer or to damage the Complainant's Trade Marks for profit.

The Respondent disputes that the Domain name has been registered or is being used in bad faith. The fact that the Domain Name was offered for sale via <dan.com> and in response to the Complainant's communication is in itself insufficient to demonstrate that there is use in bad faith. Registration of a domain name with the aim of selling it as such, without additional circumstances, is not bad faith towards the Complainant.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name incorporates the distinctive BREMBO element of the Trade Marks in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)", section 1.7)¹), while the ccTLD ".nl" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under article 3.1 of the Regulations, the Complainant has to make out a prima facie case that the Respondent does not have rights to or legitimate interests in the Domain Name, upon which the burden of

¹ In view of the fact that the Regulations are substantially similar to the Uniform Domain Name Dispute Resolution Policy ("UDRP"), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#), may be relevant to the determination of this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the Domain Name ([WIPO Overview 3.0](#), section 2.1).

Article 3.1 of the Regulations provides that the Respondent “may demonstrate such rights or legitimate interests on its part inter alia through the following circumstances:

- a. before having any notice of the dispute, the registrant made demonstrable preparations to use the domain name (or a name corresponding to the domain name) in connection with a bona fide offering of goods or services;
- b. the registrant as an individual, business or other organization is commonly known by the domain name;
- c. the registrant is making a legitimate noncommercial use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish or otherwise damage the relevant trademark, trade name, personal name, name of a Dutch public legal entity or name of an association or foundation located in the Netherlands.”

The Complainant has brought forward that the Respondent:

- has no rights or legitimate interests in respect of the Domain Name, as the Respondent is not a licensee or authorized agent of the Complainant nor in any other way authorized to use the Trade Marks as part of the Domain Name or otherwise; and
- is not an authorized reseller of the Complainant.

The Respondent has not denied this.

In addition, the Respondent is using the website to which the Domain Name resolves to offer the Domain Name for sale. Therefore, the Respondent is not making a legitimate noncommercial use of the Domain Name, as set out in Article 3.1 sub c of the Regulations. Although holding domain names, consisting of acronyms, dictionary words, or common phrases, for resale can be bona fide (see [WIPO Overview 3.0](#), section 2.1) this does not apply where the Domain Name, as in this case, comprises of a distinctive trade mark. Generally speaking, panels have found that, when a domain name consists of the trade mark in its entirety – as is the case here –, it carries a high risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1). That is even more so since (as the Respondent has not disputed) the Complainant and the Trade Marks are well-known in the Netherlands, where the Respondent is located. Finally, the Respondent has provided no plausible explanation why it chose the Domain Name, other than to be able to offer it for sale to the highest bidder. Therefore, the offer to sell the Domain Name can in this case not be considered to be a ‘bona fide offering of goods or services’, as contemplated in Article 3.1 sub a of the Regulations.

Based on all of the above, the Complainant has made out a prima facie case that the Respondent does not have rights to or legitimate interests in the Domain Name as set out article 3.1 of the Regulations.

The Respondent has stated in its Response that it was ‘the first to buy when [the Domain Name] came available’. However, registration of a Domain Name does not in itself provide a right or legitimate interest. Domain names can be registered on a first-come, first-served basis, but a registrant should ensure upon registration that the Domain Name does not infringe third party rights, such as, in this case, older trade mark rights. If that is not ensured, the registrant does not have a right or legitimate interest in the Domain Name under article 3.1 of the Regulations.

The Panel concludes that, taking into account all these circumstances, the Respondent does not have a right or legitimate interest in the Domain Name.

C. Registered or Used in Bad Faith

In accordance with article 3.2 of the Regulations, the Complainant has to show that the Domain Name was registered or is being used in bad faith.

In this respect, based on the information and the unrefuted evidence provided by the Complainant, the Panel concludes that the Domain Name was registered in bad faith. In this context, the Panel notes that:

- registration of the Domain Name occurred twenty-five years after the registration of the oldest EU Trade Mark;
- the Respondent has not denied that it was aware of the Trade Marks when it registered the Domain Name; and
- the Domain Name incorporates the Trade Mark in its entirety and does not appear to be a term of which the Respondent was likely to spontaneously or accidentally think.

For the sake of completeness, the Panel notes with respect to bad faith use that the Respondent offered the Domain Name for sale to the Complainant for an amount of EUR 995, which is much more than the cost of registration. This shows that the Domain Name has been registered or acquired primarily for the purpose of selling, renting or transferring it to the Complainant or to the Complainant's competitors for valuable consideration in excess of the cost of registration, as set out in Article 3.2 sub a of the Regulations.

The Panel concludes that the Complainant has shown that the Domain Name has been registered and/or is being used in bad faith in accordance with article 3.2 of the Regulations.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the disputed domain name <brembo.nl> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Panelist

Date: 28 May 2024