



Alternative Dispute Resolution (ADR)

Decision
03-01-2016

Case number
902

Applicant

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Counsel:

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Domain holder

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Matter

Alternative dispute resolution regarding the domain name < **brentex.se**>.

Decision

The domain name <brentex.se> shall be transferred to the Applicant Brentex OU.

Background to the dispute

The Applicant is an Estonian company specialized in designing, manufacturing and distributing trailers and various related equipment to the Scandinavian and Baltic markets. The Applicant is the holder of Community trademarks BRENTEX (registration number 011802261) and BRENTEX TRAILER (registration number 011804465). The Applicant's Community trademarks were both registered in 2013.

The Domain holder is a Norwegian company that imports and distributes trailers in inter alia Scandinavia. The Domain holder registered the domain <brentex.se> on 23 November 2009.

The Applicant applied for an alternative dispute resolution of the matter on 3 February 2016. The Applicant requested that the matter should be determined by one arbitrator.

The Domain holder has responded within the given deadline.

On 9 February 2016 Peter Hedberg was appointed as the sole adjudicator in this matter.

Claims

The Applicant has requested that the domain name <brentex.se> shall be transferred to the Applicant.

The Domain holder has contested the claim.

Facts of the case / Parties' contentions

The Applicant

In 2007, the Applicant was contacted by the Domain holder with the intention of starting a cooperation regarding the provision of Brentex trailers on the Norwegian market, and later on the Swedish market as well.

Before the parties entered into said agreement, the Domain holder registered the domain <brentex.no>, in January 2008. The parties had no contractual relationship at this time. On 23 November 2009 the Domain holder registered the domain <brentex.se> without the Applicant's permission.

The Applicant and the Domain holder entered into an agreement regarding the development of a sales network and the provision of Brentex trailers in Norway in 2008. The agreement did not contain any provisions that gave the Domain holder any right to use or register the Applicant's trademarks, the company name or product names as a domain name.

The Domain holder acted as an exclusive representative for the Applicant in Norway until the end of 2014, and has also acted as a representative for the Applicant in Sweden. The Applicant and the Domain holder have no longer a contractual relationship.

The Applicant has never given its permission for the Domain holder to register and use <brentex.se>.

Furthermore, the Applicant states that the domain <brentex.se> is identical to the Applicant's registered Community trademarks and that the Domain holder has registered and used the domain in bad faith. The Domain holder uses the domain name to redirect internet users to the Domain holder's own website *www.arctictrailer.no* where competing products are sold. The Applicant further states that the circumstance that the Domain holder has acted as a representative/reseller of the Applicant's goods does not establish a right or justified interest to register the Applicant's trademark as a domain name. The Applicant has not consented to this registration. If the Domain holder has had a justified right to register and use the domain <brentex.se>, this no longer remains as the parties have no longer any contractual or business relationship. The Domain holder uses <brentex.se> for commercial purposes that infringes the Applicant's trademark rights and prohibits the Applicant from registering and using its trademark as a domain name in Sweden.

The Domain holder

The Domain holder bought the domain <brentex.se> in 2009. At this time the Domain holder and the Applicant had a contract. 60 % of the total production of Brentex trailers were sold by the Domain holder in Norway, and some were sold in Sweden.

The Domain holder has paid for, maintained and used the domain <brentex.se> for marketing purposes, for which they have invested significant resources.

In 2014 the Applicant offered to the Domain holder to provide a new homepage for *www.brentex.se*, in order to create a similar profile for all brentex-domains. For this reason, the Domain holder gave the Applicant access to the domain <brentex.se>.

On 30 December 2014 the Domain holder received a draft contract from the Applicant, in order to extend the cooperation between the parties for a period of five years. However, the parties could not agree on the terms and conditions for an extended cooperation. The contract relationship between the Domain holder and the Applicant ended in February 2015 due to disagreements of the parties.

The Domain holder is the rightful owner of <brentex.se> because of the "first come, first serve" principle.

Findings of the Arbitrator

According to the terms and conditions of the Internet Foundation In Sweden, a domain name may be deregistered or transferred to the party requesting dispute resolution proceeding if the following three conditions are fulfilled:

- a) the disputed domain name is identical or confusingly similar to a registered exclusive right, e.g. a trademark or company name, which is legally binding in Sweden and to which the party requesting dispute resolution can prove its rights,
- b) the Domain Name has been registered or used in bad faith, *and*
- c) The Domain Holder has no rights or justified interest in the Domain Name.

Identical or confusingly similar

The Applicant has shown that it is the holder of BRENTEX (CTM reg. No. 011802261) and BRENTEX TRAILER (CTM reg. No. 011804465). Both trademarks were registered 26 November 2013.

The Applicant's trademark BRENTEX is identical to the domain name <brentex.se>. Furthermore, the domain name coincides with the dominant element of the Applicant's trademark BRENTEX TRAILER.

The Applicant has shown that the disputed domain is identical and confusingly similar to the Applicant's registered trademarks.

Registered or used in bad faith

It has not been shown by the documentations in the proceeding that the Applicant held any exclusive right to the name BRENTEX that was legally binding in Sweden at the time of registration of the disputed domain. However, the terms and conditions of registration for a .se domain does not state that the exclusive right that the Applicant relies on under rule 7.2.1. of the terms and conditions must be older than the disputed domain for a transfer to be possible.

By the submissions from the parties, it is clear that Domain holder and the Applicant had initial contacts and discussions of a cooperation at least a year before the Domain holder registered the domain name <brentex.se>. At that time, the Applicant did not own any trademark or other intellectual property rights to BRENTEX with legal effect in Sweden. However, the Applicant uses BRENTEX as its company name in the Estonia based company BRENTEX OU. The Domain holder has also been in cooperation with the Applicant as an authorized reseller in Norway and Sweden and had initially used the domain for marketing of the Applicant's products and services. The Domain holder is no longer an authorized reseller of the Applicant's products and has no permission from the Applicant to sell its products or use its trademarks.

After the contractual relationships ended between the parties, the Domain holder has used the domain <brentex.se> to direct internet users to the Domain holder's own website. On said website the Domain holder is marketing competing and complementary products. Similar situations have been discussed in earlier ATF decisions, see e.g. <jewelultra.se>, <diamondbrite.se> and <alessi.se>. It has been deemed use in bad faith if an agent or authorized reseller in these situations keep using the trademarks of the former principal as domain names.

The Arbitrator therefore concludes that the Domain holder has used <brentex.se> in bad faith.

Rights or legitimate interest

It follows from what is stated above of the current situation that the Domain holder has no rights nor legitimate interest in the domain name, even if that might have been the case during the cooperation of the parties. The Domain holder has not presented any arguments that changes the situation.

The domain name <brentex.se> shall be transferred to the Applicant Brentex OU

On behalf of IIS

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Peter Hedberg