



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

RED DIAMOND HOLDINGS SARL/ SOS ORDI

Case no.44261: leecoopershop.be

1. The parties

- 1.1. Complainant: **Red Diamond Holdings Sarl**, company with registered office at 1736 Senningerberg, Heienhaff n°1B (Luxembourg)

Hereinafter referred to as "*the Complainant*"

Represented by Mr.Olivier Laidebeur, European Trademark Attorney at Office Freylinger S.A, with registered offices at 8001 Strassen, Route d' Arlon n°234 (Luxembourg)

- 1.2. Licensee: **SOS ORDI**, with the address at 5060 Tamines, rue du Chesselet, n°39b

Hereinafter referred to as "*the Licensee*"

2. Domain name

Domain name: "*leecoopershop.be*"
Registered on: 13 April 2005

hereafter referred to as "the domain name".

3. Background to the case

On February, 15, 2012, the Complainant submitted a Complaint against the Licensee seeking the transfer of the domain name.

The Licensee was notified of the complaint by means of registered mail and email and was invited to reply.

No Response was submitted by the Licensee within twenty-one (21) calendar days of the date of commencement of the proceeding.

On 22 March 2012, the undersigned was appointed by CEPANI as Third Party Decider to settle the dispute involving the Domain Name, after having transferred his declaration of independence.

The deliberations were closed on 29 March 2012.

4. Factual information

Main factual elements of the case are the following:

The Complainant is the owner of several well-known trademarks "LEE COOPER" which refers to a wide range of products, such as clothing and fashion articles.

Here are some of its trademark registrations in force on the Benelux and European territory:

- LEE COOPER Benelux nominative trademark N° 537827 filed on September 7, 1993 - for products of class 9;
- LEE COOPER Benelux nominative trademark N° 535699 filed on October 8, 1993 - for products of class 14;
- LEE COOPER Community nominative trademark N°183335 filed on April 1, 1996 - for products of class 9, 14, 18, 25;
- LEE COOPER Community nominative trademark N°1984947 filed on December 4, 2000 - for products of class 25;
- LEE COOPER Community nominative trademark N° 3364081 filed on September 22, 2003 - for products of class 16.

Copies of those trademark registrations are attached to the complaint.

The Complainant operates its business activities from the website www.leecooper.com.

The Licensee registered the Domain name "LEECOOPERSHOP.BE" on April 13, 2005.

It appears from the complainant's exhibits that the website hosted under "LEECOOPERSHOP.BE" did link to a site dedicated to shops located in three places in Belgium (Auvelais, Wavre, Huy) and proposing the sale of clothing.

The Complainant has filed pieces of evidence which are printed page of this "former" web site.

On July 27, 2011, the Complainant's representative has sent (by registered mail) a cease-and-desist letter to the Licensee, informing him about his earlier trademarks and requesting him "to cease any and all use of the trademark "LEE COOPER" as a domain name(..) and [to] transfer the ownership of such domain name" to his client.

The Licensee did not answer to this cease-and-desist letter. Nevertheless he apparently put the website - which existed under the disputed domain name - off line and replaced it with an "under construction" web page.

As a result, the dispute Domain name resolves now to a web page which is an elaborate "under construction" page in contrast with the previous web page dedicated to the Belgian shops of clothing.

The Complainant interpreted this reaction as a clear sign that the Licensee was not interested in settling this matter amicably and therefore launched this ADR proceeding.

5. Position of the parties

5.1. Position of the Complainant

The Complainant argues that the domain name is confusingly similar to the earlier mark LEE COOPER. To support this view, the Complainant alleges that:

- the term "LEE COOPER" correspond to its several trademarks (see above), registered for the Belgian territory before the registration of the disputed domain name.
- the domain name "LEECOOPERSHOP" incorporates the "well-known" trademark LEE COOPER, "only supplemented by the merely descriptive word SHOP"

According to the Complainant:

- "the addition of the word "SHOP" cannot avoid confusion between the dispute domain name and the earlier mark, as it is completely descriptive and devoid of distinctive character." He refers to the average consumer who "is on the look for complainant's products" and who "will immediate consider the disputed domain name as an on-line shop of Complainant";
- the suffix ".be" is irrelevant when considering the possible confusing similarity between the domain name and its earlier mark;
- the spacing between the words LEE and COOPER cannot as such be reproduced in a domain name. As a result, the corresponding domain name can only be "LEECOOPER" or "LEE-COOPER".

As to the absence of rights or legitimate interests of the Licensee, the Complainant firstly refers to the CEPANI case law regarding the burden of proof which basically state that even though the burden of proof rest on him, the Complainant cannot be supposed to provide definite proof regarding a negative fact. It is therefore sufficient for the Complainant to "make out a prima facie case that the [Licensee] lacks rights or legitimate interest".

In this respect, the Complainant argues that:

- The Licensee is not the owner of any registered mark corresponding to the disputed domain name;

- The Licensee is not known by the disputed domain name as an individual, company or other association;

The Complainant insists on the fact that the Licensee had “a chance to bring forward his legitimate interest and defend its domain name registration” after having received the cease and desist letter (July 27, 2011) but “he chose not to do so”;

- The Licensee is not actually using the website linked to the domain name for a bona fide offering of products and service since there is no website. Moreover, there are no indication that he would have made any preparation in respect thereof;

According to the Complainant, the creation of an “under construction” is not sufficient to create a legitimate interest in a domain name, “then it would indeed be very easy for cybersquatters to ‘fake’ having a legitimate interest and, as such to by-pass the Terms and Conditions of DNS.be”;

- The Licensee is neither a licensee nor a subsidiary company of the Complainant. He received no authorization to use the mark or to register any identical or similar domain names.
- The use of such domain name by the Licensee “is quite obviously done to free ride on the reputation and goodwill of the earlier mark, and to benefit from the confusion ensuing there from.”

The Complainant therefore holds that the Licensee had no rights nor legitimate interest in the domain name.

As to the third condition, the Complainant states that the domain name has been registered or is being used in bad faith.

He contends that the disputed domain name was registered more than 12 years after the first registration of his mark in the Benelux and then notably points out the well-known character of his trademark “LEE COOPER” in respect of clothing to assert that it is “highly improbable (not to say impossible) that [Licensee] was unaware of [his mark] at the time of registration of the disputed domain name”.

The complainant furthermore argues that the domain name “was used in relation with the sale of clothing amongst which (but not exclusively), clothing articles bearing [his] mark” and that the website already existed during the period 2007-2009.

The complainant then stresses that such registration and use of the domain name “grants a substantial commercial advantage to the [Licensee] and certainly so in respect of clothing articles”. Indeed, such use is likely to cause confusion with customers of its products, who will believe that the domain name LEECOOPERSHOP.BE refers to a website that belongs to the Complainant. The Complainant adds that the such use by the Licensee is also abusive “as he did also sell clothing and fashion articles from marks which do not belong to complainant (and not originate from its undertaking)”.

He refers to the fact that the registration of the domain name prevents him from developing a webshop under the domain name “LEECOOPERSHOP.BE”. According to

him "this statement is even truer as there is no website under the disputed domain name". The website link indeed to a "under construction" web page.

Finally, the Complainant claims that the fact that the Licensee placed the website off-line, after receiving the cease and desist letter, "shows that he was well aware of the illegitimate nature of his activities".

5.2. Position of the Licensee

The Licensee did not submit any response. Therefore, the Third Party Decider does not know his position.

Pursuant to article 5.4 of the Rules for Domain Name dispute resolution, the dispute shall be decided on the basis of the Complaint and its exhibits.

6. Discussion and findings

Pursuant to Article 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, the Complainant must provide evidence of the following:

- *" the licensee's domain name is identical or confusingly similar to a trademark, a tradename, 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*
- *the licensee has no rights or legitimate interests in the domain name; and*
- *the licensee's domain name has been registered or is being used in bad faith."*

6.1. Identical or similar to ...

Based upon the exhibits attached to the complaint, Complainant's prior rights on verbal trademarks "LEE COOPER" doesn't seem questionable prima facie.

The domain name at stake is "LEECOOPERSHOP.BE".

It is generally settled that the ccTLD suffix.be has not to be taken into account for the determination of the similarity.(see among others 44076, 44060, 44059, 44054, 44053, 44138)

The domain name to analyse consists then in "LEECOOPER" and "SHOP".

The term "SHOP" distinguishes the domain name from the trademark which consequently cannot be considered as identical. However, this doesn't preclude the existence of a confusingly similarity between both signs.

Indeed, the word "SHOP" is a merely generic word, frequently used even in Belgium while the word "LEECOOPER" forms the most distinctive part of the domain name.

Then, since the words “LEE” and “COOPER” are mentioned in both domain name and trademark, the risk that the public might believe that the domain name is linked to the trademark of the complainant and may therefore mislead, is then real. This risk is even greater because of the fact that the products linked respectively to the domain name (at least before the website was put off line) and to the trademark are identical (clothing). (see among other case n°4039)

The absence of space between each word composing the trademarks of the complainant in the disputed domain name, does not change the sequence of these words that are visually or at least phonetically and intellectually, similar.

The Third Party Decider concludes therefore that the domain name is confusingly similar to the trademarks of the Complainant.

The first condition stipulated under article 10.b(i) is fulfilled.

6.2. Rights and legitimate interests

6.2.1. The Policy, under art. 10,b,3 provides for a number of circumstances that can establish that the Licensee has rights or legitimate interests in the Domain Name.

It is commonly accepted that even if it the Complainant’s duty to put forward elements which support the fact that the Licensee has no rights or legitimate interest to the Domain Name, such condition must be applied in the general context. When a Complainant puts forward heavy elements in its complaint, together with evidence, and when the Licensee does not take the opportunity of the Response to contest this view, the Panel may based its decision on the sole allegations of the Complainant and verify whether those allegations are sufficient to reasonably establish the absence of right or legitimate interest (see among others cases nr.4138, 4030, 4064, 4013, 4020, 4039).

The Complainant’s arguments include:

- the Licensee has no trademark “LEE COOPER”;
- the Licensee has not been commonly known under the name “LEE COOPER”;
- the Licensee is not using the domain name for a bona fide offering of products and services;
- the Licensee is neither a licensee nor a subsidiary company of the Complainant;
- the Licensee use the complainant’s trademark without prior consent and intend therefore to misleadingly divert consumers and freeride on the reputation and goodwill of the trademark.

6.2.2. It appears from the complaint and exhibits provided by the Complainant that the disputed domain name currently redirects to a website “under construction” with this message: « *The site you are trying to view does not currently have a default page. It may be in the process of being upgraded and configured.* »

The mere connection of a domain “under construction” webpage does constitute a use of the domain name in question, such use however is merely an announcement regarding the status of the site, here: “*in process or being upgraded and configured*”.

This kind of general announcement does not create a right or legitimate interest in the domain name. Should it contains an advertising for Licensee's shops, or a description of the services it offers, this could even not constitute a bona fide offering of goods or services enabling the creation of a legitimate interest in the Domain name. (see among others: 4014)

6.2.3. The others arguments provided by the Complainant are quite persuasive.

The Complainant underlines facts and legal elements that are indeed good signs that the domain name has been registered by the Licensee without rights or legitimate interest in the name "LEE COOPER".

The Licensee had a chance to challenge and contradict this reasonable demonstration of the Complainant, in a first time after receiving the cease and desist letter sent by the Complainant on July 27,2011 and in a second time after receiving this present complaint.

Nevertheless, both remained answered.

The Licensee has therefore no asserted any right or legitimate interest in his registration of the Domain name.

Based on the - and apparently reasonable and credible - information provided by the Complainant, considering the renown of the name "LEE COOPER", and in the absence of any denegation from the Licensee, the Third Party Decider concludes the second condition is fulfilled.

6.3. Registration/use in bad faith

Bad faith (in the meaning of terms and conditions of domain name registration under .be) can be deduced from several elements indicating bad faith registration and use of the domain name.

6.3.1. One of the circumstances to establish bad faith is the well-known character of the trademark or trade name. (See among others: 4014, 4019)

The Licensee registered the domain name in April 13, 2005, when "LEE COOPER" brand of the Complainant was already a well known brand after 12 years of great expansion in the Benelux. Therefore it seems impossible, at least extremely improbable that the registration of the domain name was a mere coincidence. In other words, considering the high degree of distinctiveness of the domain name "LEECOOPERSHOP" chosen by the Licensee, it is unlikely that he would have independently without deliberately seeking a business opportunity chosen and registered the name "LEE COOPER". (See among others 4013)

Moreover since, the domain name pointed initially to a website dedicated to the commercialisation of clothes and thus products identical or similar to those covered by the trademark rights of the Complainant, the Licensee must have known the trademarks of the Complainant.

In the absence of any other credible explanation, it seems well more likely that the Domain name was chosen because of its similarity with the Complainant's name.

6.3.2. Article 10 b), 2 of DNS.be terms and conditions, provide with a non exclusive and a non cumulative list of circumstances that can establish bad faith such as the fact that : *“the domain name was intentionally used to attract, for commercial gain, Internet users to the domain name holder's web site or other on-line location, by creating a likelihood of confusion with the Complainant's trademark, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of a geographical entity as to the source, sponsorship, affiliation, or endorsement of the domain name holder's web site or location or of a product or service on his web site or location.”*

The document in our possession, and in particularly the web page <http://web.archive.org/web/20090624014250/http://www.leecoopershop.be>, show that the Licensee used this domain name to promote and offer clothes. Therefore, we agree that by using (at least before the creation of an “under construction” page) the Domain name “LEECOOPERSHOP.BE”, the Licensee manifestly intended to attract users to its website in order to increase such sales of clothes. The Licensee created and exploited “a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the domain name holder’s website or of a product or service on his web site or location”. (art.10 b), 2)

The confusion is amplified by the fact that the Domain name was then apparently used to sell - but not exclusively - “LEE COOPER”’s items, while these items did not belong to the Complainant or did not originate from its undertaking. By his silence, the Licensee did not took the chance to explain himself about this use of the complainant’s trademark in the domain name of its website and for the items proposed for sale on it.

6.3.3. This leads to another indices of bad faith. Bad faith may be deduced from the fact that the licensee did not answer to the Complaint.

This circumstance is not sufficient as such to conclude to the bad faith. Nevertheless, combined with other elements, the absence of answer can at least serve as an evidence to establish it. (see among other: 4030, 4045, 4053, 4150)

In this case, as underlined under point 6.2.3, the Licensee failed to answer first to a Complainant’s cease and desist letter of July 27, 2011 and then to this Complaint.

According to the Complainant, the cease and desist letter clearly mentioned that he (the Licensee) was using the disputed domain name for the sale of clothing. The Complainant deduces from the fact that the Licensee then placed the website off line, that he (the Licensee) “was well aware from the illegitimate nature of his activities”.

Without any other clear and reasonable explanation from the Licensee to justify the fact that after receiving the cease and desist letter from the complainant, he directly placed its website offline, the Third Party Decider can infer from this silence a sign that the Licensee was well aware of the illegitimate nature of his activities.

All these circumstances put together constitute a sufficient indice of bad faith.

In the Third Party Decider’s view, the third condition is fulfilled.

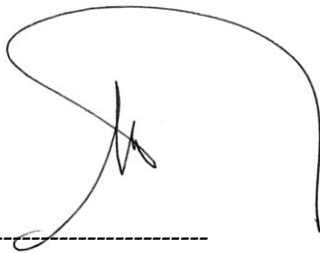
Based upon the circumstances as explained in the Complaint and based upon the evidence supplied by the complainant, the Third Party Decider holds that the three cumulative conditions are met.

- There is no indication whatsoever that the licensee might have a right or legitimate interest in the domain name;
- The combination of elements as outlined above clearly indicates that the licensee has registered the domain name in bad faith

7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third Party Decider hereby rules that the domain name registration for the "**leecoopershop.be**" domain name is to be transferred to the complainant.

Brussels, April 12th, 2012

A handwritten signature in black ink, consisting of a large, sweeping loop that starts on the left, goes up and over, then comes down and loops back to the left, ending in a small flourish.

WERY Etienne
The Third-party decider
(signature)