CEPANI

THE BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Lenovo Ltd/Segreteria Associazione Genexi-Onlus

Case no. 44411: lenovo.be

1. The parties

1.1. Complainant: Lenovo (Beijing) Ltd., Chuangye Road, No 6 Shangdi Information Industry Base Haidian District 100085, Beijing

Hereinafter referred to as "the Complainant"

represented by:

Ewoud Vanhecke and Katia De Clercq, Tradmark and Design Attorneys, Gevers Legal N.V., Kouter 1, bus 3, 9000 Ghent, Belgium

1.2. Licensee: Segreteria Associazione Genexi-Onlus, Via Oberdan 32, 51017, Pescia, Italy,

hereinafter referred to as "the Licensee"

not represented

2. Domain name

Domain name: "**lenovo.be**"
Registered on: December 3 , 2004

hereafter referred to as "the Domain name ".

3. Background to the case

3.1. On August 5, 2016 the Complainant filed a complaint with CEPANI according to the CEPANI Rules for Domain Name Dispute Resolution ("the Rules") and the Dispute Resolution Policy of DNS BE, incorporated in its Terms and Conditions for domain name registrations under the ".be" domain operated by DNS ("the Policy").

The Complainant requests that the Domain name shall be transferred to the Complainant.

The complaint was notified to the Licensee and the latter was invited to reply.

No response was submitted by the Licensee.

3.2. On September 14, 2016 CEPANI informed Mr. Jan Surmont that it has the intention to propose Mr. Jan Surmont as Third-Party Decider in the present case.

CEPANI duly received the declaration of independence of the Third-Party Decider.

3.3. On September 15, 2016 and pursuant to Article 7.2. of the Rules CEPANI appointed the Third-Party Decider to settle the dispute involving the Domain Name.

By registered letter dated September 15, 2016 CEPANI transferred the entire file concerning the Complaint to the Third-Party Decider, including the complaint form and annexes.

In the aforementioned letter CEPANI stated that the deliberations should be closed by September 22, 2016 and that the deadline for the decision is October 6, 2016 at the latest.

3.4. On September 22, 2016 and according to Article 13 of the Rules, the deliberations were closed.

The Licensee did not submit a response on the Complainant's arguments and motifs.

3.5. The Third-Party Decider asked CEPANI to extend the deadline for the decision with one week.

By letter of October 4, 2016 CEPANI informed the Third-Party Decider that the deadline for the decision was extended to no later than October 13, 2016.

4. Factual information

4.1. The Complainant is a multinational technology company with headquarters in Beijing (China) and Morrisville, North Carolina (United States).

The Complainant designs, develops, manufactures and sells personal computers, tablet computers, smartphones, workstations, servers, electronic storage devices, IT Management software and smart televisions.

The Complainant in 2004 rebranded to "Lenovo".

The Complainant had registered over 400 trademarks worldwide, such as:

- EU-trademark no. 003065381 for the device mark ***lenovo*** of February 24, 2003 for goods in class 9 and services in class 37 and 42;
- EU-trademark no. 003705746 for the device mark ***lenovo*** of March, 11, 2004 for goods in class 7, 11, 16 and 28 and services in class 35;
- International trademark no. 1299513 for the wordmark LENOVO of September 29, 2015 with designation of the EU for goods in classes 9, 14 and 18 and services 35, 36, 37, 38, 41 and 42;
- Benelux trademark no. 013199111 for the wordmark LENOVO PHAB of October 16, 2015 for goods in class 9.

The Complainant registered the domain name "lenovo.com" on May 9, 2002.

4.2. Apparently, no information is available on the Licensee or its activities.

The Domain Name was registered on December 3, 2004 in the name of Ms. Marilena Biancardi. Afterwards, the Domain Name was transferred to the Licensee, according to the Complainant after the first Domain Name holder was put on notice.

At present there is no (active) website linked to the Domain Name. At the web page www.lenovo.be, only a message appears that the page cannot be reached.

According to Appendix 7 of the Complainant, the Licensee has at least 66 domain names in portfolio.

According to the Complainant, it has made several requests to the Licensee in order to obtain the Domain Name.

5. Position of the parties

5.1. Position of the Complainant

The Complainant argues that:

(i) The Domain Name is identical to the international trademark registration and both EU-trademarks mentioned above and very similar to the Benelux trademark "Lenovo Phab";

(ii) The Licensee has no rights or legitimate interest in the Domain Name since the Domain Name is not actively used;

(iii) The Domain Name was registered in bath faith, since there is no active website, the Domain Name has been inactive since it was registered and the Licensee tries to disguise the Domain Name from the Complainant.

The Complainant requests:

(i) That the Domain Name registration is transferred to the Complainant;

(ii) That a decision would be issued "to recover the administrative costs paid by the Complainant to CEPANI from DNS Belgium".

5.2. Position of the Licensee

The Licensee did not submit a response.

As a consequence, the dispute shall only be decided on the basis of the Complaint (Art. 6.4. of the Rules).

6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

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 confusingly similar to

Based on the evidence submitted by the Complainant, it is clear that the Complainant is the owner of amongst others the following trademarks:

- EU-trademark no. 003065381 for the figurative mark ***lenovo*** of February 24, 2003 for goods in class 9 and services in class 37 and 42;

- EU-trademark no. 003705746 for the figurative mark ***lenovo*** of March, 11 2004 for goods in class 7, 11, 16 and 28 and services in class 35;
- International trademark no. 1299513 for the wordmark LENOVO of September 29, 2015 with designation of a.o. the EU for goods in classes 9, 14 and 18 and services 35, 36, 37, 38, 41 and 42;

According to the CEPANI case-law, country code top-level domains such as the suffix "be" are not relevant for establishing the identity or the similarity between a domain name and a trademark (CEPANI case n° 44409 "dell-arte.be", September 21, 2016).

Article 10b)1 (i) of the Policy does not require that the invoked rights are prior tot the registration of the domain name (CEPANI case n° 44398 "sla.be", May 13, 2016).

The fact that a figurative trademark is invoked cannot as such lead to the conclusion that there is no similarity between the said trademark and the domain name (CEPANI case 4007, "witgelekruis.be", Augustus 28, 2001). To the extent that the invoked trademark is a (semi-)figurative trademark, the domain name should be compared to the verbal elements of said trademark (CEPANI case n° 44398 "sla.be", May 13, 2016).

Both the figurative EU trademarks no. 003065381 and no. 003705746 (which predate the registration of the Domain Name) merely consist of the word "lenovo" presented in a specific font. It is clear that the Domain Name, abstraction made of the suffix "be", is identical to the word "lenovo" comprised in both EU trademarks, such from an visual, oral and conceptual point of view.

Further it cannot be discussed that the Domain Name is also identical to the International wordmark LENOVO of September 29, 2015, such from an visual and oral point of view.

Moreover the arguments made by the Complainant were not refuted by the Licensee.

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

6.2. Rights and legitimate interests

The Complainant has to prove that the Licensee has no rights or legitimate interests to the Domain Name.

However, according to CEPANI case law it is sufficient, taking into account all the facts of the case, that the Complainant can credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (CEPANI case no. 44409 "dell-arte.be", September 21, 2016).

Article 10 (b) of the Policy provides that the Licensee can prove that he has a right or a legitimate interest to the Domain Name due to the following circumstances:

- prior to any notice of the dispute, he used the domain or a name corresponding to the domain name in connection with a bona fide offering of goods 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, trade name, social name or corporation name, geographical designation, name of origin, destination of source, personal name or name of the geographical entity at issue.

The Third-Party Decider concludes that the Complainant sufficiently demonstrates that the Licensee has no rights or legitimate interests to the Domain Name, taken into account the following elements:

- there was and is no active use, including a legitimate and non-commercial or fair use, of the Domain Name;

- there is no website linked to the Domain Name used to offer goods or services nor are there indications that the Licensee has been preparing for such use;

- the Licensee is not commonly known under the Domain Name; the Licensee does not hold any trademark providing a legitimate right nor does it use Lenovo as a trade name and nor it operates through any Belgian (or other) company with Lenovo as or as part of its company name.

It should also be taken in consideration that the Licensee did not submit a response en therefore made no arguments demonstrating his rights or legitimate interests to the Domain Name.

The Complainant on the other hand demonstrates that he has a legitimate interest in the Domain Name (Appendix 9 and 10 of the file of the Complainant).

The Third-party Decider concludes therefore that the second condition is met.

6.3. Registration/use in bad faith

Article 10 (b) 2 of the Policy sets out certain circumstances which can be used to demonstrate the registration or use in bad faith:

- circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant or a competitor of the complainant;

- the domain name was registered in order to prevent the owner of the trademark from reflecting this name in a corresponding domain name;

- the domain name was registered primarily for the purpose of disrupting the business of a competitor;

- the domain name was intentionally used to attract, for commercial gain, internet-users to the licensee's website or other on-line location, by creating a likelihood of confusion with the complainant's trademark;

- the licensee registered one or more personal names without existence of a demonstrable link between the licensee and the registered domain names.

The enlisted circumstances are not exclusive.

The Complainant argues that the Domain Name is registered and being used in bad faith.

6.3.1. The Complainant refers to the well-known character of the name "Lenovo" and of its trademarks and argues that the Licensee cannot reasonably argue that is was not aware of the use and the protection of the trademark "Lenovo" by the Complainant.

Based upon the evidence provided by the Complainant, the name "Lenovo" and its trademark must be considered as well-know, also in the European Union. It was in the opinion of the Third-Party Decider almost impossible for the Licensee to ignore the pre-existing rights of the Complainant.

This element is indicative for bath faith (CEPANI case no. 44383, Instagram.be; July 24, 2015; WIPO case no. D2006-1003, "pepperdineuniversitywaves.com", September 25, 2006) and even more in combination with the fact that the Licensee has registered at least 66 domain names (Appendix 7 of the file of the Complainant).

6.3.2. The Complainant further argues that several requests from the Complainant's legal representative to obtain the domain name remained without any response and that the Domain Name has been transferred after the prior Domain Name holder was put on notice. However, the file of the Complainant does not contain any proof of letters or notices which would have been sent to the Licensee or the prior Domain Name holder.

The Complainant further invokes a passive holding of the Domain Name.

In the opinion of the Third-Party Decider the Licensee's conduct can indeed be qualified as passive holding.

As demonstrated by the Complainant the Domain Name has been inactive since it was registered.

There is no active website connected to the Domain Name. The user is directed to a web page that only displays a message that the page cannot be reached (Appendix 8 filed by the Complainant).

However the mere passive holding of a domain name is not sufficient to meet the conditions of Article 10 b) 1 (iii) of the Policy (CEPANI case no. 44398, sla.be, May 13, 2016). Other circumstances are required.

Appendix 7 of the file of the Complainant shows that the Licensee has 66 domain names in portfolio. There is no demonstrable link between the Licensee and those domain names.

This element combined with the well-established passive holding leads to the conclusion that the Domain Name was registered an is being used in bad faith.

It can be deducted from the conduct of the Licensee that the Domain Name was registered in order to prevent the Complainant to register a domain name in the ".be" top level corresponding to its trademarks.

6.3.3. The Third-party Decider concludes that the third condition is met.

6.4. Costs

The Complainant requests that a decision would be issued "to recover the administrative costs paid by the Complainant to CEPANI from DNS Belgium".

However, there is no need for such a ruling since Article 10 k) of the Policy provides that DNS Belgium shall repay the total of the costs to the complainant if the Third-Party Decider concludes that the domain name registristration needs to be transferred, which is the case here.

7. Decision

Consequently the Third-party Decider hereby rules that the domain name registration for the Domain Name (lenovo.be) is to be transferred to the Complainant.

Turnhout, October 13, 2016,

Jan Surmont

The Third-party decider