



BELGIAN CENTER FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

LENSLOGISTICS AB / LENSON AB

Dispute N° 44149 : lensway.be

1. Parties

- 1.1. Complainant: Lenslogistics AB
With registered office at Box 1290 – Östergötagatan 4, SE – 104
29, Kista, Sweden

Represented by:

Mr Peter Helle, lawyer
With offices at Box 7543, SE – 103 93, Stockholm, Sweden

Hereinafter referred to as the "Complainant"

- 1.2. Domain name holder:

LensOn
Box 30203, SE - 104 20, Stockholm, Sweden

Hereinafter referred to as the "Respondent"

2. Domain Name

The domain name at issue is "lensway.be", registered on June 5, 2007, hereafter stated as the "Domain Name".

3. History of the procedure

Following the Complaint received from the Complainant, dated on November 3, 2008, the Belgian Center for Arbitration and Mediation (hereinafter referred to as "CEPINA") invited the undersigned on December 17, 2008 to settle the dispute regarding the Domain Name as Third-Party Decider.

On December 22, 2008, the Third-Party Decider sent the statement of independence to CEPINA.

By e-mail dated December 19, 2008, CEPINA informed the Complainant and the Respondent of the appointment of the Third-Party Decider. CEPINA stated in this e-mail

that the deliberations should be concluded by December 26, 2008 and that the Third-Party Decider must inform the CEPINA secretariat of his decision by January 9, 2009 at the latest.

4. Facts

Having carefully examined the evidence submitted by the Complainant, the Third-Party Decider finds that the following relevant facts are established or readily available:

- Complainant sells on-line soft contact lenses.
- Complainant is the holder of the Community Trademark "lensway", registered on February 20, 2002 under number 001740182.
- Complainant is running its business inter alia through the web site "lensway.se", and is also the holder of several other domains including its Community Trademark "lensway" (e.g. "lensway.com", "lensway.co.uk", "lensway.eu", "lensway.de").
- Respondent is a competitor to the Complainant, that also sells on-line contact lenses, inter alia through its web site "Lenson.com"
- Respondent is the holder of the Domain Name since June 5, 2007.

5. Position of the parties

5.1. Position of the Complainant

Complainant requests the Third-Party Decider to order the transfer of the Domain Name since all conditions provided in the Dispute Resolution Policy contained in Article 10 of the general terms and conditions for domain names registration under the ".be" domain operated by DNS.BE (hereinafter the "Policy") are fulfilled.

In summary, the Complainant argues as follows:

1. Respondent's domain name is identical or confusingly similar to a trademark, a trade name, a social name or corporation name, in which the Complainant has rights.

The Domain Name registered by the Respondent is identical to the Community Trademark "lensway" owned by the Complainant. The Community Trademark is registered since February 20, 2002.

The identity between the Domain Name and the Community Trademark "lensway" owned by the Complainant is absolute, except for the suffix ".be", which, however, is in this regard irrelevant.

The Domain Name is also identical to the Complainant's domain name "lensway.se".

2. The respondent has no rights or legitimate interests in the domain name

According to the Complainant, there exists no natural reason or link nor between the Respondent and the Community Trademark "lensway", nor between the Respondent and the Domain Name, which must be considered as proved by the circumstance that the Respondent has not used the Domain Name since it was registered.

3. Respondent's domain name has been registered or is being used in bad faith

According to the Complainant, the Respondent must have been aware of the existence of the Complainant and its trademark, which constitutes the domain name under which the Complainant sells its products.

The Domain Name was registered by the Respondent for the purpose of disrupting the business of the Complainant, which is a competitor to the Respondent. By blocking the Domain Name, the Respondent prevents the Complainant from developing its business in Belgium. In this respect, the Complainant alleges that the Respondent is also the owner of the domain name "Lensway.pl" in Poland, what proves that the Respondent systematically tries to prevent the Complainant to develop its business in Europe by registering domain names containing its Community Trademark.

5.2. Position of the Domain Name holder

The Respondent did not file any Response.

6. Discussion and conclusions

According to article 15.1 of the CEPINA rules for domain name dispute resolution (hereinafter the "Rules"), the Third-Party Decider shall decide on the Complaint in accordance with the Policy and these Rules.

According to article 10,b,1 of the Policy, the complainant has to prove

- the Domain name holder'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 Domain name holder has no rights or legitimate interests in the domain name; and
- the Domain name holder's domain name has been registered or is being used in bad faith.

If the respondent does not submit a Response, the proceeding shall continue and the Third-Party Decider shall decide the dispute on the basis of the Complaint and such pursuant to Article 5.4 of the Rules.

6.1. Identical or confusingly similar to a Community Trademark

From the evidence submitted by the Complainant it is clear that the Complainant has rights in the Community Trademark "lensway" registered on February 20, 2002 (see exhibit 2 to the Complaint).

Except for the suffix ".be", which is generally accepted as being irrelevant for determining the similarity between the disputed domain name and the name on which the Complainant claims a right, the Domain Name and the Community Trademark "lensway" are identical (cfr. CEPINA Case of 13 April 2001, n° 4004, *Pernod Ricard S.A. v. Mr Christophe Roelandt*; CEPINA case of 2 January 2003, n° 44025, *Allianz Aktiengesellschaft v. Constantin European Internet* ; CEPINA Case of 30 September 2003, n° 4035, *Accor SA v. Mw. Veerle Lefever*; CEPINA Case of 30 December 2004, n° 44053, *Classics Gallery N.V. v. Cornelius Morees* ; CEPANI Case of 23 February 2005, n° 44056, *Ideal-Standard GmbH & Co. OHG v. Mrs Aline Bouvy*).

The Third-Party Decider therefore holds that the Complainant has rights in a trademark that is identical to the Domain Name and that the condition stated in Article 10, b), 1, i) of the Policy is fulfilled.

The Complainant adds that the Domain Name is also identical to its domain name "lensway.se". This argument is irrelevant since domain names are not included in the exhaustive list of rights which can be invoked in the framework of the Policy (cfr. CEPINA

Case of 25 January 2005, n° 44054, *The European Omnibus Survey srl v. Magyar Gallup Intezet*, in which the Third-Party Decider refers to T. HEREMANS, *Domeinnamen: een juridische analyse van een nieuw onderscheidingssteken*, pages 117-118).

Consequently, the condition stated in Article 10 b), 1, i of the Policy is fulfilled.

6.2. Nor right nor legitimate interest

Pursuant to Article 10 b) 3 of the Policy, Licensee's rights or legitimate interest to the domain name can be proved by certain circumstances. Article 10, b), 3 of the Policy gives a non-exhaustive list of such circumstances:

- *prior to any notice of the dispute, the licensee used the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or*
- *the licensee (as an individual, business or other organization) has been commonly known by the domain name, even if he has acquired no trademark; or*
- *the licensee 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, designation of source, personal name or name of the geographical entity at issue.*

Although the Complainant does not refer explicitly to Article 10, b), 3 of the policy, it is clear that it challenges that circumstances hereabove or any other legitimate reason may apply to the Respondent.

The Respondent has not filed any Response. It has therefore *a fortiori* not provided any explanation or evidence which may establish its rights and/or legitimate interests in the Domain Name, so that Complainant's contentions are not contradicted.

The Third-Party Decider therefore concludes that the Respondent has no right or legitimate interest in the Domain Name.

Consequently, the condition stated in Article 10 b) 1 ii of the Policy is fulfilled.

6.3. Registered in bad faith

Article 10, b), 2 of the Policy enumerates in a non-limitative way a number of circumstances, by which the Complainant can demonstrate that the Licensee registered or uses the Domain Name in bad faith.

The absence of a response is not sufficient to prove bad faith but can serve, in combination with other circumstances, as circumstantial evidence to establish bad faith of the Respondent (CEPINA case of 23 September 2005, n° 44068, *Vueling Airlines v. Eclark Howard*; CEPINA case of 5 April 2004, n° 44045, *Confederatie Brouwerijen België v. Meuleman*; CEPINA case of 17 August 2005, n° 44067, *Rembo Styling NV v. Cenal.com*)

Bad faith must be reasonably proven (CEPINA case of 23 September 2005, n° 44068, *Vueling Airlines v. Eclark Howard*; CEPINA case of 17 August 2004, n° 44049, *N.V. DR Oetker/ N.V. FML*) and may be proven by any means, including presumptions and circumstances that indicate with a reasonable degree of certainty the existence of bad faith, excluding any reasonable doubt (CEPINA case of 2 December 2005, n° 4471, *Hotel Reservation Service Robert Ragge GmbH v. Hydrant Refuelling System*; CEPINA case of 5 March 2001, n° 44030, *S.A. Le Petit-Fils de L.U. Chopard et Cie v. Joël Glycer (Orlogio NV)*).

Added to the absence of Response from the Respondent, the following circumstances support the presumption that in the case at hand the Respondent has registered and used the Domain Name in bad faith:

- Complainant and Respondent act in exactly the same market, being the sale of contact lenses via the Internet. Since this market seems to be very specific and limited, the Respondent must be presumed to know the other partakers of the market, including the Complainant. This presumption is reinforced by the fact that both parties are located in Sweden. It is therefore very unlikely that Complainant's Community Trademark was not known by the Respondent at the time of the registration. There is bad faith if the Respondent knew or should have known about the existence of the trademark (CEPINA Case of 7 February 2002, n° 4013, *Guinness UDV North America vs Olivier Noël*; CEPINA case of 12 November 2002, n° 4021, *Napster Inc. vs TheInternetOne C.V.*; CEPINA case of 3 March 2005, n° 44058, *Six Continents Inc. vs Gerard Riat*)
- It is also impossible, at least extremely unlikely that the registration of the Domain name was a hazard, since the word "lensway" is not of such a generic nature that it becomes obvious to use by other partakers in the here relevant market.
- The non-use of the Domain Name by the Respondent furthermore supports the conclusion that the registration of the Domain Name was done in the sole purpose of preventing the Complainant to develop its business in Belgium.

The Third-Party Decider finds that the above constitutes sufficient evidence of bad faith.

As a consequence, also the condition stated in Article 10 b) 1 iii of the Policy is fulfilled.

7. Decision

The third-party decider decides, according to the Policy (by virtue of article 10, e), to transfer to the complainant the registration of the domain name "lensway.be".

Brussels, January 9, 2009

Yves Van Couter