



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

## DECISION OF THE THIRD-PARTY DECIDER

LOUIS VUITTON MALLETIER/ SHIFU KIM

Case no.44240:louisvuitton.be

### 1. The parties

- 1.1. Complainant: **Louis Vuitton Malletier**, company with registered office at 75001 Paris, rue du Pont-Neuf, n°2 (France).

Hereinafter referred to as "*the Complainant*"

Represented by Ms. Delphine LENOIR, Trademark Attorney at Novagraaf Belgium SA, with registered offices at 1170 BRUSSELS, 187 Chaussée de la HULPE (Belgium)

- 1.2. Licensee: **SHIFU KIM**, Yangqiaozhong Road, 350014 Fuzhou, CHINA, e-mail: [cocoschanel@163.com](mailto:cocoschanel@163.com).

Hereinafter referred to as "*the Licensee*"

### 2. Domain name

Domain name: "*louisvuitton.be*"  
Registered on: 2 April 2011

hereafter referred to as "*the domain name*".

### 3. Background to the case

Complainant has submitted a Complaint dated July 8, 2011 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.

CEPANI – NON-PROFIT ASSOCIATION

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

The undersigned was appointed by CEPANI as Third Party Decider by letter dated 13 September 2011, after having transferred his declaration of independence on September 12, 2011.

On September 16, 2011, the Third Party Decider asked both parties to provide him with any additional appropriate information to support/contest the fact that the domain name is used to offer counterfeited items.

This query was based on article 12 of the CEPANI Rules for Domain Name Dispute Resolution which states that *"If the Third Party considers the file incomplete, he/she can invite, within the deadline, the parties or one of the parties to give further information. By all times the principle of contradictory debate must be respected."*

The Parties have not submitted any response.

The deliberations were closed on 20 September 2011.

#### **4. Factual information**

The Complainant is a French fashion house which has business activities on a worldwide scale.

The Company proposes a wide range of products, from luxury trunks and leather goods to ready-to-wear, shoes, watches, jewellery, accessories, sunglasses, and books, and is the owner of trademark registrations for the mark "VUITTON" and "LOUIS VUITTON" on the Benelux, European territory and abroad:

- VUITTON Community nominative trademark n° 001515212 filed on May 03, 2001;
- LOUIS VUITTON Community nominative trademark n°001172857 filed on June 09, 2000;
- LOUIS VUITTON Community nominative trademark n° 009547761 filed on May 10, 2011;
- LOUIS VUITTON Community nominative trademark n° 000015610 filed on March 1, 1996 (renewed);
- LOUIS VUITTON International nominative trademark covering the Benelux n°416052 filed on June 19, 1975 (renewed).

The Complainant is also the holder of the domain names :

- louis-vuitton.be registered on March 6, 2001
- vuitton.be registered on July 5, 2011

The Licensee registered the Domain name "louisvuitton.be" on April 2, 2011.

The dispute Domain name points to the website [www.louisvuitton.be](http://www.louisvuitton.be) dedicated to the online sale of "authentic LV purses and handbags" and proposing "Louis Vuitton outlet" ie "the best quality products with lowest price".

## 5. Position of the parties

### 5.1. Position of the Complainant

In summary, the Complainant argues that:

- The domain name "louisvuitton.be" is identical to its trademarks, company names and domain names;
- The Licensee has no rights or legitimate interests to register this domain name;
  - o he does not own any trademark or trade name containing the words LOUIS VUITTON and has no prior right on any of these words;
  - o he has not been commonly known by the mark LOUIS VUITTON or VUITTON alone;
  - o he received no license or has not been otherwise authorized to use the trademark LOUIS VUITTON or any domain name incorporating the trademark;
  - o he gets no right to use the dispute Domain name as the complainant has prior ("as from 1968") and exclusive rights on the name LOUIS VUITTON;
  - o he does not make any legitimate non commercial or fair use of the domain name.
- The Licensee has registered and is using the disputed Domain name in bad faith:
  - o the website [www.louisvuitton.be](http://www.louisvuitton.be) offers to consumers to buy counterfeited items of trademark LOUIS VUITTON. To support this allegation, the Complainant provides that:
    - "LOUIS VUITTON guarantees the authenticity of its products through a network of selected and exclusive sellers. The genuine products LOUIS VUITTON are sold exclusively in sale point which handled and controlled and approved by the company LOUIS VUITTON and also accessible on the website [www.louisvuitton.com](http://www.louisvuitton.com)"
    - "LOUIS VUITTON does not offer reduction or sales on its products whereas the Respondent on its website [louisvuitton.be](http://louisvuitton.be) offers to buy bags and accessories LOUIS VUITTON at lowest price"
  - o The LOUIS VUITTON trademarks are famous and predate any of Licensee's activity. He could not ignore the pre-existence of the complainant trademark rights.
  - o Since the disputed Domain name points to a website containing counterfeited items, this is disrupting and infringing complainant's business: the licensee "has intentionally attempted to attract, for commercial gain, Internet users to the disputed website by creating a likelihood of confusion with complainant's mark (...)."
  - o The Licensee's "apparent purpose is to profit from the reputation and goodwill associated with Complainant's LOUIS VUITTON marks. The use of a trademark by an unlicensed party as all or part of a Domain name with the intention of misleading or deceiving consumers constitutes bad faith".

### 5.2. Position of the Licensee

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

Based on article 2 of the Rules, the third-party decider has requested both parties to "provide him with any additional appropriate information to support/contest the fact that the domain name is used to offer counterfeited items". He did not provide any information in order to contest the Complainant's contention on this important issue.

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 ...

Pursuant to the jurisprudence of the Third Party Decider, no consideration needs to be given to the suffix ".be" while evaluating if a domain name is identical or similar with the signs from which the Complainant may invoke rights (see among others 44076, 44060, 44059, 44054, 44053, 44138).

The Domain name is "louisvuitton.be".

The Third Decider finds therefore that the Domain name is identical 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.44138, 44030, 44064, 44013, 44020, 44039).



The Complainant's arguments include:

- the Licensee has no trademark "LOUIS VUITTON";
- the Licensee has not been commonly known under the name "LOUIS VUITTON"
- the Licensee is unknown on the list of authorized dealers, vendors or users of the LOUIS VUITTON products and trademark;

6.2.2. It appears from the Complaint and exhibits provided by the Complainant that the disputed domain name redirects to a website which offers the possibility to buy "authentic Louis Vuitton items".

Pursuant to article 10 of the Rules: *"If a complaint is filed, the domain name holder can demonstrate his rights or legitimate interests to the domain name by the following circumstances: prior to any notice of the dispute, the domain name holder 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 (...)"*.

According to the Complainant, such article does not apply in this case because "LOUIS VUITTON guarantees the authenticity of its products through a network of selected and exclusive sellers. The genuine products LOUIS VUITTON are sold exclusively in sale point which are handled and controlled and approved by the Company LOUIS VUITTON (...)". The complainant asserts that the licensee (and his website) is not part of this approved network.

As already stated, pursuant to article 12 of the Rules, the Third-Party gave a chance to the Licensee to contest this assertion (*"provide [the third-party decider] with any additional appropriate information to support/contest the fact that the domain name is used to offer counterfeited items"*).

The License remained silent.

Based on the – and apparently reasonable and credible – information provided by the Complainant, and in the absence of any denegation from the Licensee, the Third Decider conclude the second condition is fulfilled.

### 6.3. Registration/use in bad faith

6.3.1. The LOUIS VUITTON trademark is so famous that there is no doubt that the Licensee was aware of the Complainant's trademark at the time of registration.

One of the circumstances to establish bad faith is the well-known character of the trademark or trade name, because it will be more likely that the Licensee knew or should have known about the existence or use of the well-known trademark or trade name and thus more unlikely that the licensee registered the Domain Name in good faith (Cepani, cases nr.4025, 4013)

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.

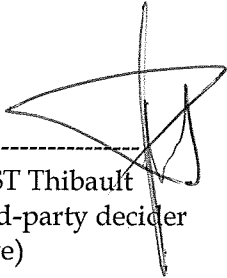
Another evidence of bad faith is the fact that - for the reasons underlined here above with the analysis of the second condition - the Domain name is used in order to sell counterfeited items.

In the third-party decider's view, the third condition is fulfilled.

## 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 "**louisvuitton.be**" domain name is to be transferred to the complainant.

Brussels, September, 26<sup>th</sup>, 2011

A handwritten signature in black ink, consisting of several overlapping loops and a vertical stroke, positioned over a horizontal dashed line.

VERBIEST Thibault  
The Third-party decider  
(signature)