

DECISION OF THE THIRD-PARTY DECIDER
SmileDirectClub LLC / Mr. Tao Wang
Case no. 44498 / smiledirectclub.be

1. The Parties

- 1.1. Complainant: SMILEDIRECTCLUB LLC
414 Union Street, 8th floor
37219 NASHVILLE
TENNESSEE
UNITED STATES OF AMERICA

Represented by:

NOVAGRAAF BELGIUM NV/SA
Ms. Sandrine COLLIN
Trademark and Design Attorney
Chaussée de la Hulpe 187,
BRUSSELS 1170
BELGIUM

Hereafter referred to as "the Complainant"

- 1.2. Domain name holder: Mr. Tao Wang
Gulou District, Hankou Road, NO.22
JIANGSU, 210000 NANJING
CHINA

Hereafter referred to as "the Respondent"

2. Domain name

Domain name: smiledirectclub.be
Registered on: November 2, 2017

Hereafter referred to as "the Domain Name".

3. Procedure

On 5 May 2020, the Complainant filed a Complaint concerning the Domain Name with Cepani, the Belgian Centre for Arbitration and Mediation, in accordance with the Cepani Rules for Domain Name Dispute Resolution (hereafter referred to as the "Rules") and the Dispute Resolution Policy of DNS, incorporated in its General terms and conditions for .be domain name registration (hereafter referred to as the "Policy").

On 8 June 2020, Cepani appointed the undersigned, Mr. Geoffrey Froidbise, as a Third Party Decider (hereafter referred to as the "Third-Party Decider") to settle the dispute involving the Domain Name.

The deliberations were closed on 16 June 2020.

The Respondent did not file a response to the Complaint.

In accordance with article 6.4. of the Rules, this decision is based solely on the Complaint and the Complainant's exhibits.

4. Factual Background information

Having examined the complaint and the exhibits submitted by the Complainant, the Third-Party Decider finds that the following facts have been established.

SmileDirectClub LLC is the legitimate rights owner of several trademark registrations SMILE DIRECT CLUB around the world for inter alia clear aligner products and related dental services in several countries worldwide, including the EUTM trademark registration no. 015998231, registered on 5 April 2017.

The Complainant (originally known as "SmileCareClub") was founded in 2014 by Jordan Katzman and Alex Fenkell. Its registered offices are located in Nashville, Tennessee, U.S.A.

The Complainant has been in business since 2015 and adopted the SMILE DIRECT CLUB tradename and trademark on 29 March 2016.

The Complainant is one of the market leaders in the clear aligner industry around the world.

The SMILE DIRECT CLUB trademark and tradename are used intensively on the market and continue to be used worldwide. In that regard, the Complainant uses various websites. The Complainant's main domain name is smiledirectclub.com, registered on 2 February 2015, but the Complainant has also registered various other domain names with its trademark incorporated therein (including smiledirectclub.co.uk for example).

From the exhibits, it is clear that Complainant has spent considerable time, effort and money in advertising and promoting its goods and services in connection with its trademark SMILE DIRECT CLUB.

The Domain Name was registered on November 2, 2017.

5. Position of the parties

5.1. Position of the Complainant

The Complainant requests the transfer of the Domain Name and submits that the three cumulative conditions for such transfer are met: (i) the Complainant owns various earlier SMILEDIRECT trademarks, (ii) the Respondent has no rights or legitimate interests in the Domain Name and (iii) the Domain Name was registered in bad faith as follows from the historical background information.

5.2. Position of the Respondent

The Respondent did not file any response or observations.

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 10 b), 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 registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company 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 registrant has no rights or legitimate interests in the domain name; and*
- *the registrant's domain name has been registered or is being used in bad faith.*

6.1. The Domain Name is identical or confusingly similar to trademarks in which the Complainant has rights

The Domain Name is phonetically, visually and conceptually identical to the Complainant's registered trademark, its tradename and the domain name of its main website, smiledirectclub.com. The Domain Name even incorporates the earlier trademark of the Complainant.

Consumers will perceive the addition of the domain extension ".be" only as an indication of Belgium, as confirmed by the well-established case law of CEPÄNI. Therefore, consumers will likely assume that the Domain Name is affiliated to the Complainant.

Considering the above, it is clear that the Domain Name is confusingly similar to the trademark of the Complainant.

The Respondent did not dispute this as he did not file any response or observations.

As a consequence, the first condition under article 10, b), 1), i), of the Policy is fulfilled.

6.2. The Respondent has no right or legitimate interests in the Domain Name

According to Article 10, b), 3) of the Policy, the registrant can demonstrate his rights or legitimate interests to the domain name by the following circumstances:

- *prior to any notice of the dispute, the registrant 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 registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if he has no trademark;*
- *the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain 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.*

The Complainant asserts the following facts:

- The Respondent has no rights nor any known legitimate interests whatsoever in respect of the Domain Name in view of the Complainants registered trademarks and tradename.

- To the best knowledge of the Complainant, the Respondent does not own any rights to the trademark or tradename SMILE DIRECT CLUB nor does the Respondent have any other right on the wording SMILE DIRECT CLUB. The Complainant has not granted a license or authorized the Respondent to use the trademark or apply for registration of the Domain Name.
- The Complainant considers that SMILE DIRECT CLUB is a uniquely used combination of words, solely used and registered as a trademark by the Complainant in the clear aligner industry and therefore the Complainant has a legitimate right to keep the use of the word combination exclusively within its own organization in order to prevent dilution of its trademark.
- There is no commercial link between the Complainant and the Respondent.
- The Respondent is not using the domain name for a legitimate and non-commercial purpose.

The Complainant has therefore reasonably asserted that the Respondent does not have any rights or legitimate interests.

The Respondent failed to demonstrate the contrary. The Respondent has indeed not filed any response or observations and has therefore not provided any explanation or evidence to establish his rights and/or legitimate interests in the Domain Name.

The second condition under article 10, b), 1), ii), of the Policy is also fulfilled.

6.3. The Respondent's Domain Name has been registered or is being used in bad faith

According to Article 10, b), 2) of the Policy, evidence of such bad faith registrations or use of domain names can inter alia be demonstrated by the following circumstances:

- *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 who is the owner of the trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity, or to a competitor of the complainant, for a price that exceeds the costs that the registrant can show are directly related to the acquisition of the domain name;*
- *the domain name was registered in order to prevent the owner of a trademark, a trade name, a registered name or a company name, a geographical designation, a name*

of origin, a designation of source, a personal name or a name of a geographical entity to use the domain name and that the registrant has engaged in a pattern of such conduct;

- *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 registrant's web site or other on-line location, by creating confusion with the complainant's trademark, trade name, registered name or company 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 registrant's web site or location or of a product or service on his web site or location.*
- *the registrant has registered one or more personal names without the existence of a demonstrable link between the registrant and the registered domain names.*

Based on the Complainant's exhibits, it appears that its activities have generated a lot of exposure over the years. In 2016 for example, as the Complainant highlights, it was featured extensively in the news because it was engaged in patent litigation with another clear aligner company.

Registration of the Domain Name occurred in 2017, i.e. one year after the publication of the news articles provided by the Complainant. Therefore, the Respondent was aware of, or should have known, the trademark and tradename of the Complainant at the time of registering the Domain Name. A simple trademark register search, or even an Internet search, prior to the registration of the Domain Name would have informed the Respondent of the existence of the SMILE DIRECT CLUB trademark of the Complainant.

From the exhibits submitted by the Complainant, the registration of the Domain Name appears to have been a deliberate action to disrupt the business of the Complainant during its market expansion in Europe, for the purpose of selling, renting, or otherwise transferring the Domain Name to the Complainant or to a competitor.

In that regard, on request of the Complainant, a third party contacted the Respondent showing its interest in buying the Domain Name and offering USD 1.000 to this end. The Respondent reacted to this offer by asking first USD 20.000 and, after a second offer, USD 11.000. From this exchange, it appears that the Respondent has acquired the domain name for the purpose of selling it to the Complainant for a price that exceeds the costs related to the acquisition of the Domain Name, which is a clear indication of bad faith from the Respondent.

Finally, the conclusion that the Respondent is acting in bad faith is confirmed by the fact that the Domain Name has not been used since the registration. Therefore, there is no credible explanation for the registration of the Domain Name by the Respondent.

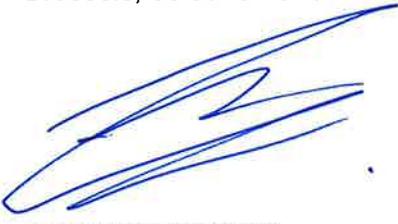
Based on the above, it is clear that the domain name **smiledirectclub.be** is being used and has been registered in bad faith.

The condition stated in Article 10, b), 1, iii), of the Policy is therefore 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 "**smiledirectclub.be**" domain name is to be transferred to the Complainant.

Brussels, 30 June 2020.



Geoffrey FROIDBISE
The Third-party Decider