

CEPANI

THE BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

ARBITRATION N°444164 – VIVAMODEL.BE

DV INTERNATIONAL LIMITED

vs.

ADRIANA VILMA GIMENEZ GONZALEZ

DECISION OF THE THIRD-PARTY DECIDER

MAY 30, 2022

1. The parties

Complainant : DV INTERNATIONAL LIMITED

with registered offices at Castle Street 7, JE2 3BT Jersey St. Helier, United Kingdom

hereinafter referred to as “*the Complainant*”

Represented by

Etienne WERY, attorney at Ulys Law Firm, Avenue de la Couronne 224, 1050 Brussels, Belgium (etienne.wery@ulyes.net)

Domain name holder, Respondent : Adriana VILMA GIMENEZ GONZALEZ

With address at Pablo Picasso 15, 48012 Bilbao, Bizkaia, Spain (adri65gimenez@yahoo.es)

hereinafter referred to as “*the Domain name holder*”

2. Domain name

Domain name: **VIVAMODEL.BE**

Registered on: 12 April 2019

hereinafter referred to as “*the domain name*”

3. Background of the case

On March 22, 2022, the Complainant filed a complaint with CEPANI in view of a decision of a Third-Party Decider, according to the Belgian Centre for Arbitration and Mediation for domain name dispute resolution rules (hereinafter “the CEPANI Rules”) and Article 10 of the “Terms and conditions of domain name registrations under the “.be” domain operated by DNS”, entitled “Dispute Resolution Policy” (hereinafter “the Policy”).

The Complainant request that the contested domain name be transferred in their favour.

The complaint was notified to the Domain name holder who was invited to reply.

The Domain name holder submitted on April 27, 2022 a letter and on April 28, 2022 an empty response form.

Mr. Fernand de Visscher was appointed on May 2, 2022 by the CEPANI as the Third-Party Decider to settle the dispute pursuant to Article 7.2. of the CEPANI Rules.

The CEPANI also informed the Third-Party Decider that the deliberations would be closed by May 9, 2022 and that his decision has to be filed by May 23, 2022. Both the Complainant and the Domain name holder were informed of the aforementioned deadlines.

On May 17, 2022, the Third-Party Decider asked the parties to provide more information and comments on the lack of registration of the licence relied upon by the Complainant (Article 13 of the CEPANI Rules).

On May 20, 2022, the Complainant gave some comments regarding the issue raised by the Third-Party Decider.

On May 21, 2022, the deliberations were closed.

The Third-Party Decider's decision is issued in consideration of:

- the complaint dated May 22, 2022 and the annexed documents;
- the empty response form dated April 28, 2022 and the letter dated April 27, 2022;
- the comments given by the Complainant dated May 20, 2022;
- the CEPANI Rules;
- the Policy.

4. Factual information : summary

- 4.1. The Complainant set out that Digital Ventures Malta Limited, owner of the Benelux trade mark VIVASTREET (registered on April 12, 2010 – registration No. 875393), have granted an exclusive licence on the trade mark to the Complainant. The Benelux trade mark is registered to designate services in class 38, i.e. telecommunications services.

The Complainant also set out they operate a website that is a reference worldwide and that their domain name (vivastreet.be) dates back to December 7, 2004, and their trade mark (VIVASTREET) to at least 2010.

4.2. The Domain name holder sets out that she is the owner of an EU trade mark “VIVAMODEL” registered on February 19, 2019. The European Union trade mark is registered to designate services in class 38, i.e. telecommunications services.

She also sets out that she has registered the contested domain name VIVAMODEL.be and has been the holder since April 12, 2019.

5. Position of the parties

6.1. Position of the Complainant

The Complainant argue in their complaint that the conditions of Art. 10.b.1. of the Policy are met since:

- the domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Domain name holder has no rights or legitimate interests in the domain name; and
- the domain name was registered or is being used in bad faith.

As a result, the Complainant request that the domain name VIVAMODEL.be be transferred to the Complainant.

6.2. Position of the Domain name holder

An empty response form was received from the Domain name holder with respect with this proceeding.

In a letter dated April 27, 2022, the Domain name holder argues that she has registered the trade mark VIVAMODEL as well as the domain name VIVAMODEL.be.

The Domain name holder asks that the request for the transfer of the domain name VIVAMODEL.be to the Complainant be dismissed.

6. Discussion and findings

6.1. Pursuant to Art. 10.b.1. of the Policy, the Complainant have to assert and to prove that:

i) “the Registrant’s domain name is identical or confusingly similar to a trade mark, 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

ii) the Registrant has no rights or legitimate interests in the domain name; and

iii) the Registrant’s domain name has been registered or is being used in bad faith.”

(i) Preliminary issue

6.2.1. The Complainant argue that the Third-Party Decider could not, of his own motion, raise the question of the registration of the licence, as he must limit his examination and decision to the arguments raised by the parties.

6.2.2. The Third-Party Decider is of the opinion that he, like any other judge, “is required to decide the dispute in accordance with the rules of law applicable to him. He is obliged to examine the legal nature of the facts and acts alleged by the parties and may, whatever the legal characterisation given by the parties, complete *ex officio* the grounds they have invoked, provided that he does not raise a dispute which the parties have excluded in their submissions, that he bases himself exclusively on elements which have been duly submitted to him, that he does not modify the subject matter of the claim and that he does not violate the parties’ rights of defence” (Cass., 14 December 2012, C.12.0018.N). Moreover, only an explicit agreement allows the parties to bind the judge on a point of law or fact on which they intend to limit the debate (Cass., 9 May 2008, C.06.0641.F).

6.2.3. The Third-Party Decider could therefore, without violating the Rules, the Policy or the case law, ask the parties for their observations on a specific point, even not of public order.

(ii) “Is identical or confusingly similar to ...”

6.3.1. Pursuant to Article 10.b.1., i) of the Policy, the Complainant have to prove that the contested domain name is identical or confusingly similar to a trade mark, 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 have rights.

6.3.2. The Complainant allege to be the exclusive licensee of the Benelux trade mark “VIVASTREET”, confusingly similar to the domain name VIVAMODEL.be.

The Benelux trade mark registration No. 875393 of the word mark VIVASTREET was filed on January 15, 2010 and registered on April 12, 2010 (see annex 2 of the complaint). That trade mark is registered to designate services in class 38.

6.3.3. The wording of Article 10.b.1., i) of the Policy does not specify the kind of rights the Complainant should have in the trade mark.

First, the Complainant produce a letter dated March 14, 2022 from the trade mark owner referring to a licence between Digital Ventures Malta Limited (the trade mark owner) and DV International Limited (the Complainant), entered into force on November 1, 2018. Said letter confirms that the licensor supports the complaint (see annex 3 of the complaint). Various WIPO rulings support the view that a licensee may bring proceedings for infringement of a trade mark only if its owner consents thereto (see *inter alia*: WIPO, D2003-0942, “HQUK Limited v. Head Quarters”; WIPO, D2008-1859, “NA PALI SAS v. BWI Domains, Domain Manager”).

In addition, according to Article 2.32.4., 1st sentence, of the Benelux Convention on Intellectual Property, the licensee’s right to bring proceedings for infringement of a trade mark is subject to the trade mark owner’s consent.

Second, the Complainant argue that the lack of registration of the licence should not prevent them from acting to protect their rights. This is accepted.

The Court of justice of the European Union stated that a “licensee may bring proceedings alleging infringement of a Community trade mark which is the subject of the licence, although that licence has not been entered in the Register”, with the view that the non-opposability of non-registered licence is only to protect “third parties who have, or are likely to have, rights in the Community trade mark” (Case C-163/15 of February 4, 2016, points 20 and 26).

Therefore, the Complainant have proved that they have rights in the VIVASTREET trade mark for the purpose of the Policy.

6.3.4. The trade mark is not identical to the contested domain name. Nevertheless, for the first requirement to be met, it is sufficient that the domain name is confusingly similar to the trade mark.

First and according to a constant case law, the country code top-level domain (ccTLD) “.be” will be disregarded in verifying the identity or similarity between the earlier rights of the Complainant and the contested domain name.

Second, in cases where at least a dominant feature of the relevant trade mark is recognizable in a domain name, the domain name will normally be considered confusingly similar to that trade mark (see *inter alia*: WIPO, D2017-1112, “Tonino Lamborghini s.p.a. Mr. Tonino

Lamborghini v. Samvel R Yusufiants; WIPO, D2010-1071, “RapidShare AG, Christian Schmid v. Protected Domain Services/Dmytro Gerasymenko”).

In the Third-Party Decider’s view, the first verbal element “VIVA” is the dominant element of the trade mark. The contested domain name exactly replicates it.

Third, the replacement of a generic and basic term “street” with an equally generic and basic term like “model” does not eliminate the risk of confusion.

6.3.5. The contested domain name is confusingly similar to above-mentioned Complainant’s relevant earlier rights.

The first requirement is thus met.

(iii) Rights and legitimate interests of the Domain name holder

6.4.1. Pursuant to Article 10.b.1., ii) of the Policy, the Complainant have to prove that the Domain name holder has no rights or legitimate interests in the contested domain name.

6.4.2. The Complainant state that the Domain name holder lacks rights and legitimate interests in the contested domain name due to the existence of prior rights belonging to the Complainant, to the fact that the Domain name holder should have been aware of the existence of the Complainant given the obvious anteriority and reputation of their trade mark, to the fact that the Domain name holder has no authorization from the Complainant to use the protected name “VIVASTREET” and to the fact that the Domain name holder registered the domain name to host a website that looks very similar to the Complainant’s website.

6.4.3. The Domain name holder submitted a letter and alleges having rights and legitimate interests in the contested domain name because of the existence of her EU trade mark VIVAMODEL, registered February 19, 2019.

6.4.4. Considering the difficulty of proving a negative fact (“*negative non sunt probanda*”), the burden of proof that the Domain name holder has no right or legitimate interest to the contested domain name is considered to be satisfied when taking into account all the facts of the case, the Complainant can credibly state that they are unaware of any reason or circumstance which could be indicative of such right or legitimate interest (see *inter alia*: WIPO, D2001-1020, “pokemonplanet.com”; CEPANI, 444145, “Disney-store.be”; CEPANI, 444140, “meguiarsshop.be”).

There is in this case no apparent reason or circumstance indicative of such right or legitimate interest. The burden to prove that there is a right or legitimate interest in the domain name therefore shifts to the Domain name holder.

The Domain name holder did not file any detailed or substantive response to the complaint and did not submit any fact or argument supporting her rights or legitimate interests before having the contested domain name registered on April 12, 2019 and her trade mark on February 19, 2019. Such registrations long after the Complainant's trade mark and domain name registrations do not suffice as such to evidence a right or legitimate interest in the use of the contested domain name. Therefore, the statement of the Complainant is deemed to be sufficient to determine the lack of rights and legitimate interests (CEPANI, 444137, "sddebouchage.be"; CEPANI, 444130, "charlottetilbury.be").

6.4.5. It results from the above that the Domain name holder has no rights or legitimate interests in the contested domain name.

(iv) Registered or used in bad faith

6.5.1. According to Article 10.b.1., iii) of the Policy, the Complainant have to prove that the Domain name has been registered or is being used in bad faith.

Article 10.b.2. of the Policy enunciates some circumstances allowing to demonstrate bad faith registration or use of a domain name.

6.5.2. The Complainant allege that the contested domain name was registered but is also being used in bad faith.

According to the Complainant, the Domain name holder designed her website to resemble to the Complainant's website as closely as possible (see annex 5 of the complaint) and the Domain name holder impersonated the Complainant in her privacy policy (see annex 6 of the complaint).

The Complainant also allege that the usurpation in bad faith creates legal and reputational risks for the Complainant as there is no control of the profiles, and that the objective of the website is fraud, or at least traffic diversion.

6.5.3. The Domain name holder did not submit any response on this issue either.

6.5.4. It should first be noted that the notion of bad faith is a broad notion and that in CEPANI case law, it is sufficient that the domain name has been registered in bad faith or is being used

in bad faith, these two criteria being alternative conditions (CEPANI, 444147, “sd-debouchages.be and sddebouchages.be”).

6.5.5. Bad faith can be proven by any reasonable means, including presumptions and circumstances that indicate, with a reasonable degree of certainty, that the Domain name holder knew, or should have known, the Complainant’s prior rights and that the Domain name holder nevertheless registered the domain name (see *inter alia*: CEPANI, 444150, “sddeboucheur.be and sd-deboucheur.be”).

The list of circumstances demonstrating bad faith registration or use of a domain name under Art. 10.b.2. of the Policy is merely illustrative and should therefore not be regarded as exhaustive (see *inter alia*: CEPANI, 444127, “anantara.be”).

Bad faith is construed as the knowledge (proven as having been actual or having taken place with a reasonable certainty of evidence in the circumstances) by the Domain name holder that the Complainant enjoyed a factual or legal situation previous to, and conflicting with, the litigious registration or use (CEPANI, 44436, “bollore-logistics.be”).

6.5.6. The Domain name holder must most probably have been aware of the Complainant’s rights in the VIVASTREET trade mark when it registered the contested domain name (see *inter alia*: WIPO, D2009-0323, “F. Hoffmann-La Roche AG v. P. Martin”, WIPO, D2010-1071, “RapidShare AG, Christsian Schmid v. Protected Domain Services/Dmytro Gerasymenko”), while the Complainant have never granted her any trade mark licence or similar authorisation to use the trade mark and the Domain name holder uses the Complainant’s name and address in her privacy policy (see annex 6 of the complaint).

These circumstances further indicate that the Domain name holder uses the domain name to intentionally attract, for commercial gain, Internet users to her website by creating a likelihood of confusion with Complainant’s trade mark and website (impersonation is an aggravating circumstance).

6.5.7. Considering the above, the Third-Party Decider is of the opinion that the domain name has been registered and is being used in bad faith.

7. Decision

Consequently, the Third-Party Decider hereby:

- rules that the complaint is founded;

- orders the contested domain name “VIVAMODEL.be” to be transferred from the Domain name holder to the Complainant pursuant to Art. 10.e. of the Policy.

Brussels, May 27, 2022

Fernand DE VISSCHER

Third-Party Decider