

**IN THE MATTER OF THE COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: ENDERMOWEAR.CA

Complainant: LPG Systems S.A

Registrant: Distribution4web

Registrar: Groupe iWeb Technologies

Panellist(s): Myra J. Tawfik

Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is LPG Systems S.A a legal person constituted under the laws of France with its registered office at Technoparc de la Plaine, BP 35- 30 rue du Dr. Abel, 26902 Valence Cedex 09, France

The Complainant is represented in Canada by Brouillette and Partners LLP, 1550 Metcalfe Street Suite 800, Montreal, QC H3A 1X6

The Registrant is Distribution4web. A WHOIS database search indicates its address as 8 Place du Commerce, Montreal, QC H3E 1N3 and its administrative contact as Distribution4web at the same address with a telephone number and e-mail address. The Complainant has provided an alternate address for the Registrant that does not appear on the WHOIS database as 38-10 Place du Commerce 103, Montreal, QC H3E 1T8. An individual identifying himself as “Charles” replied, on behalf of the Registrant, to e-mails sent by Resolution Canada. The signature stamp on the Registrant’s e-mail shows its address as 38-10 Place du Commerce 103, Montreal, Qc H3E 1T8.

2. The Domain Name and Registrar

The disputed domain name is ENDERMOWEAR.CA and the Registrar is Groupe iWeb Technologies 3185 Hochelaga, Montreal Qc H1W 1G4

3. Procedural History

On June 12, 2008 the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules).

On June 17, 2008 the Complainant filed an Amended Complaint (the "Complaint"), whereby it requested that the Complaint be submitted for decision in accordance with the CDRP and the Rules and requesting the transfer of the domain name ENDERMOWEAR.CA.

Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days from June 18, 2008 to file 5 copies of a Response to the Complaint.

By e-mail dated July 8, 2008, the Registrant requested an extension to file its Response to the Complaint. The Registrant requested 30 days. By reply e-mail dated July 8, 2008, Resolution Canada authorized the maximum extension of 20 days under Rule 5.4.

The Registrant did not file a Response within the stipulated delay.

On August 5, 2008, further to Rule 6.5, Resolution Canada appointed Myra J. Tawfik as sole panellist on the complaint after having received from her a declaration of impartiality and independence. A notice of selection of panellist was sent to all parties at that date.

As the Registrant has not responded to the Complaint, the Panel shall decide the proceeding on the basis of the Complaint.

4. Eligible Complainant

The Complainant is a legal person under the laws of France and has its registered office in France. The Complainant meets the Canadian Presence Requirements for Registrants (2003) (the "CPR") under the exception in Rule 1.4 given that it is a registered trademark holder in Canada of the trademarks ENDERMO, ENDERMOLOGIE and ENDERMOTHERAPIE.

The Complainant asserts that should the Panel order a transfer of the domain name ENDERMOWEAR.CA, it will meet the Canadian Presence Requirements at that time.

The Complainant has also filed an application to register the trademark ENDERMOWEAR on August 7, 2007. However, this application is still pending and under the CPR, the Complainant has no standing in respect of this trademark. As a result,

the Complaint will be determined on the basis of the Complainant's registered trademarks only.

5. Applicable Law

The Registrant as well as the Complainant's legal representatives are located in the province of Quebec and the Complainant has requested that the laws of Quebec be applied.

6. Parties' Contentions

A. The Complainant:

The Complainant alleges that it is the registered owner in Canada and in the United States of the trademarks ENDERMO, ENDERMOLOGIE and ENDERMOTHERAPIE in relation to beauty, fitness and health care products and services. It has provided copies of the relevant records of the Canadian registrations from the CIPO Trademark Database.

The Complainant also has a pending application to register the trademark ENDERMOWEAR in association with bodysuits as evidenced from a copy of the relevant record from the CIPO Trademark Database. These bodysuits are intended for use in conjunction with the Complainant's treatments and services.

The Complainant asserts that it has widely used its registered trademarks in Canada and supports this with website evidence of use both from its own website and that of one its authorized distributors along with an affidavit of Mr. Antoine Barret, the General Director of the Complainant, providing marketing and sales figures in Canada for the periods 2006-2008. It claims that the registered trademarks are well-known in the Canadian health care industry and among consumers.

A WHOIS search conducted by the Complainant identifies the Registrant as Distribution4web with an office in Montreal with a registration date for the domain name ENDERMOWEAR.CA of February 19, 2007.

The Complainant alleges that the Registrant's domain name ENDERMOWEAR.CA is confusingly similar to the Complainant's registered trademarks and especially to the mark ENDERMO that is incorporated into the domain name in its entirety with only the addition of the generic word 'wear'.

The disputed domain name redirects users to another website at www.cellulite-treatment-pro.com that offers equipment and products in direct competition with Complainant. It also purports to sell some of the Complainant's own equipment and products even though not authorized. The Complainant has filed in support a copy of the Registrant's website.

In March 2006, Registrant had tried to become an authorized Canadian distributor of the Complainant's products but was refused. Later, the Registrant had tried to register the

trademark ENDERMOWEAR in both Canada and the US and in each case the application was denied because it was found to be confusing with the Complainant's registered trademark ENDERMO. The Complainant has filed the decisions of both CIPO and the US Patent and Trademark Office denying the Registrant's applications.

These actions, according to the Complainant, create a likelihood of confusion as to source or at least the inference of endorsement by the Complainant.

The Complainant further alleges that the Registrant has no legitimate interest in the domain name since it does not own any trademarks similar to the domain name. In trying unsuccessfully to register ENDERMOWEAR in the USA and Canada, the Registrant was trying to ride on Complainant's reputation and goodwill. In both the US and Canadian applications, the registration request was denied because ENDERMOWEAR was determined to be confusing with the Complainant's registered trademark ENDERMO. Further, according to the Complainant, the Registrant is using the domain name to compete directly with the Complainant and is not making legitimate non-commercial or fair use of the domain name.

The Complainant alleges that the domain name was registered in bad faith because it was registered long after the Complainant began to use its registered trademarks in Canada and the Registrant deliberately incorporated the Complainant's mark ENDERMO in its domain name. The Registrant's use of the domain name and website result in consumers assuming that the Registrant is associated with the Complainant and rides on Complainant's reputation and goodwill. The Respondent is not an authorized distributor of the Complainant.

The Complainant also states that the Registrant has purchased adwords from Google to appear as a sponsored link when searches for the Complainant are being conducted under LPG Systems or ENDERMOWEAR. The Complainant supports this allegation by providing print-out of the Google website showing a sponsored link whose title is "EndermoBodysuits" with the Registrant's website address www.cellulite-treatment-pro.com

B: The Registrant

The Registrant has not filed a Response to the Complaint

7. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that

- 1) The Registrant's "dot-ca" domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights

- 2) The Registrant has registered the domain name in bad faith
- 3) Some evidence that the Registrant has no legitimate interest in the domain name

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put.

7.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

Further to paragraph 3.2 c) of the CDRP, the Complainant's registered trademarks are Marks in which it had Rights prior to the date of registration of the domain name and continues to have such rights. All of the registered trademarks predate the Registrant's domain name registration date of February 19, 2007. ENDERMOLOGIE was registered in Canada in 1996, ENDERMOTHERAPIE in 1999 and ENDERMO in 2004.

According to Paragraph 3.4 of the CDRP a domain name is confusingly similar to a Mark "...if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark."

The Complainant's Marks are registered in association with products, equipment and services in relation to the health, fitness and beauty industry especially in relation to cellulite treatments. More particularly, the Mark ENDERMO has been registered for use in relation to a wide range of products and services including clothing for men and women. The Complainant alleges that the domain name is confusingly similar with its Mark ENDERMO and the Panel agrees.

ENDERMO is a coined word and is an inherently distinctive trademark. The domain name incorporates in whole the Complainant's Mark ENDERMO and adds the descriptive word 'wear' at the end. The idea conveyed by the domain name is confusingly similar to the Complainant's Mark ENDERMO. The Registrant and the Complainant engage in a common sphere of activity namely the sale of clothing items suitable for the Complainant's various health and beauty treatments. An Internet user, on first impression and with imperfect recollection, seeing the domain name would likely mistake it for the Mark ENDERMO and believe that the domain name and the Complainant are associated. The addition of the descriptive word 'wear' to the Complainant's Mark ENDERMO does not dispel the confusing similarity between the domain name and the Complainant's Mark.

Further, while not binding on the question of confusing similarity, the fact that the CIPO Trademark Office and the US Patent and Trademark Office both denied the application

by the Registrant to register ENDERMOWEAR as a trademark because it was confusing with the Complainant's Mark ENDERMO is nevertheless persuasive.

7.2 The Registrant has registered the domain name in bad faith

The Complainant must prove bad faith on a balance of probabilities. The Panel considers that the Complainant has discharged its onus. By registering a confusingly similar domain name to Complainant's Marks and using it to redirect customer traffic to its website offering products for sale in direct competition with the Complainant, the Registrant's primary purpose is the disruption of the Complainant's business. This constitutes bad faith under Paragraph 3.7 c) of the CDRP. The Registrant was clearly aware of the Complainant's Marks prior to registering the domain name. The fact that it acknowledges on its website that ENDERMOLOGIE is a trademark of the Complainant reinforces this.

It is also the case that the Registrant had tried unsuccessfully to become a distributor of the Complainant and had attempted unsuccessfully to register the trademark ENDERMOWEAR in Canada. The registration of the domain name after these unsuccessful bids is highly suspect and suggests that the Registrant was motivated by a desire to interfere with the Complainant's business.

The Complainant uses the Mark ENDERMO in association with men's and women's clothing. Customers seeing the domain name ENDERMOWEAR.CA and being automatically redirected to the Registrant's website where they can purchase ENDERMOWEAR bodysuits for their cellulite treatments would likely be misled into thinking that they are at a website that is either the Complainant's or sponsored or endorsed by the Complainant. The notice on the website that ENDERMOLOGIE is a registered trademark of the Complainant does not dispel that misrepresentation.

It is also to be noted that the Complainant itself uses the trademark ENDERMOWEAR in Canada and has been using it since 2002. It has a pending application to register this trademark with the CIPO office. The application is unopposed. The fact that the Complainant itself uses ENDERMOWEAR in Canada in relation to bodysuits, that it has used it prior to the registration of the domain name and that the application to register is unopposed by the Registrant are surrounding circumstances that contribute to a finding of bad faith on the part of the Registrant.

7.3 The Registrant has no legitimate interest in the domain name

The Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. It alleges that the Registrant does not hold any trademarks similar to the Marks and that its sole purpose in having registered the domain name was to confuse consumers by redirecting them to its website in direct competition with the

Complainant. A Registrant has a legitimate interest in the domain name for the reasons set out in paragraph 3.6 of the CDRP. None of the six legitimate uses identified in this paragraph apply to this case. The Registrant had no right in the Marks at the time of registration of the domain name, it was not acting in good faith in registering the domain name and it is making a commercial use of the domain name. Finally, the domain name is not the legal name of the Registrant nor is it the geographical name of the location of its business.

8. Decision:

The Panel concludes that the Complainant has established its entitlement to a remedy under paragraph 4.3 of the CDRP. The domain name is confusingly similar to a Mark in which the Complainant has and continues to have rights. The Registrant registered the domain name in bad faith and without legitimate interest. The Complainant has requested a transfer to it of the domain name ENDERMOWEAR.CA and has undertaken to comply with the CPR at the time of transfer. The Panel orders the transfer of the disputed domain name ENDERMOWEAR.CA to the Complainant.

Myra J. Tawfik
Sole Panellist
August 22, 2008