

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

Domain Name: WELLBOX.CA

Complainant: LPG Systems S.A.
Registrant: distribution4web
Registrar: Groupe iWeb Technologies Inc.
Panelist: David Lametti
Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is LPG Systems S.A. It is a French company 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 by M^e Thomas Geissman, of Brouillette & Partners, LLP, Lawyers, Patent & Trademark Agents, 1550 Metcalfe Street, Suite 800, Montreal, Quebec, H3A 1X6.
2. The Registrant is distribution4web, with a listed contact address as 8, Place du commerce, Montreal, Quebec, H3E 1N3. The person contacted via email uses the moniker "Charles D4W", at the following email address: distribution4web@videotron.ca. An email exchange with the Provider lists the address for distribution4web as 38-10 Place du commerce, 103, Montreal, Quebec, H3E 1T8.

B. The Domain Name and Registrar

3. The domain name at issue is < WELLBOX.CA >. The domain name is registered with Groupe iWeb Technologies Inc. of Montreal, Quebec.

C. Procedural History

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada, on 25 March 2009. The Complaint was written in English, as permitted by paragraph 10 of the *CIRA Domain Name Dispute Resolution Rules* [the "Rules"].
5. The Provider attempted to serve notice of the Complaint to the Registrant as required by paragraphs 4.3 and 2.1 of the Rules by courier on 26 March 2009, but the package was returned. An email notice sent to postmaster@wellbox.ca was also returned. An electronic version of the Complaint set via email to the address distribution4web@videotron.ca on 27 March 2009 was received by the Registrant, as

evidenced by an email response on 27 March 2009 from "Charles D4W". All attempts to serve notice to the Registrant were done in both French and English. Thus the Registrant was effectively served, as the Provider has met the requirements of paragraph 2.1 of the Rules.

6. While two email replies from the Registrant on 27 March 2009 and 6 April 2009 were received by the Provider in response to service of proceedings, no formal response to the Complaint was received prior to the twenty-day deadline to file a response, established as per the Rules. Nor was a request to extend the deadline received during that time frame.

7. The Complainant opted for a single Panelist and the Provider selected a single panelist according to the process outlined in the Rules.

D. Panel Member's Impartiality and Independence Statement

8. As required by paragraph 7.1 of the Rules, the Panelist has declared to the Provider that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.

E. Canadian Presence Requirement

9. The Complainant is the exclusive licensee of the owner of the registered trademark WELLBOX in Canada and thus satisfies Canadian Presence Requirement ("CPR") under paragraph 1.4 of the CIRA Policy and paragraph 2(q) of the CPR Policy. As held in *Canadadrugs.com v. NC Britton Holdings Ltd*, CIRA Decision No. 00028 [2005] (WWW.CANADADRUGS.CA), being a licensee of the trademark registered in Canada is sufficient to meet the requirements of the CPR under the Policy.

F. Applicable Law

10. Both the Registrant and the Complainant's legal representative reside in Quebec, and the Complainant has specifically requested that the decision be governed by any laws applicable in Quebec.

G. Factual Background

11. The facts of this dispute are as follows. The Complainant is a French company. Its founder, Mr. Louis-Paul Guitay, is the registered owner of the trademark WELLBOX in a number of jurisdictions including Canada, and he has granted an exclusive worldwide license to the Complainant. The Complainant has used the mark WELLBOX in association with health, fitness and beauty equipment products and services, and uses a < WELLBOX.COM > website as a significant part of its marketing strategy. The "Wellbox" device sold on the website appears to fight cellulite.

12. The Complainant filed for the trademark WELLBOX in Canada on 19 April 2005. The trademark matured to registration on 25 April 2008. The Complainant has other

identical WELLBOX marks internationally: its US trademark was filed on 19 April 2005 and was registered on 3 April 2007; its EU trademark was filed on 28 September 2004 and was registered on 16 November 2005.

13. The Registrant registered the domain name in question on 10 April 2006.

14. The Complainant has offered evidence that its two attempts to seek the transfer of the domain name went unanswered, including a “cease and desist” letter on 9 April 2008. The Complainant then initiated this proceeding on 25 March 2009.

H. CIRA Domain Name Dispute Resolution Policy Requirements

15. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) 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; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name . . .

16. The Registrant has not filed a response. The Policy and Rules nevertheless allow this complaint to proceed, and the Panel shall proceed by holding the Complainant to the usual burdens of proof and argument incumbent on it under the CIRA domain name regime.

I. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

1) The Complainant’s Marks

17. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]

(c) a trade-mark . . . that is registered in CIPO . . .

18. Mr. Guitay is the owner of the Canadian trademark registration for the trademark WELLBOX. The Complainant is the exclusive licensee of the mark in Canada and accordingly has established rights in same.

19. This alone is not dispositive in this matter, as the registration date of the domain name, while after the filing date of the trademark by Mr. Guitay, actually preceded the registration date of the trademark. Paragraph 3.2 (c) above infers that it is the registration date that is relevant. In this case, however, both Mr. Guitay and the Complainant have, to the satisfaction of the Panel, established common law trademark rights under paragraph 3.2 (a). These common law trademark rights precede the domain name registration date: the affidavit evidence of sums expended and revenues received in 2006 is sufficient to infer that both Mr. Guitay and the Complainant had common law rights in the mark in Canada well prior to the registration date. Indeed, the existence of common law rights in the mark is supported by the Registrant's unsuccessful attempt prior to March 2006 to secure authorized distributor status for the Complainant's product in Canada, as it indicates some perceived objective distinctiveness and value to the trademark in question, and that the Registrant knew of the existence of the rights in the mark in Canada. Finally, the original trademark filing itself in 2005, in the Panel's view, helps to establish common law rights in a mark when coupled with some concurrent evidence of use of the mark in Canada. (These unregistered common law rights in the mark are equally valid in Quebec, given federal jurisdiction over trademarks, and by virtue of having been effectively incorporated into Canadian law via sections 7(b) and (c) of the *Trade-marks Act*.)

20. The Complainant has thus established rights in the mark WELLBOX in Canada.

2) “Confusingly Similar”

21. Paragraph 3.4 of the Policy defines “confusingly similar” in the following terms:

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.

22. WELLBOX is a registered mark that has been used in Canada and internationally. As stated, it is used in association with a wide variety of services in the health, fitness and beauty equipment products and services, and especially cellulite reduction. It is a coined word, and has a high degree of inherent distinctiveness.

23. The substance of the domain name, that is the part of the domain name that precedes the “dot” and “TLD”, is identical to the Complainant's registered trademark. Moreover, in this case, the Complainant's website and the website to which the domain name at issue initially resolved to a website – WWW.CELLULITE-TREATMENT-PRO.COM – that contained products and services that were more or less identical to those of the

Complainant and certainly in direct competition. This is sufficient for a finding of "confusingly similar."

24. Interpreting "confusingly similar" under the Policy, the Panel finds the Registrant's domain name < WELLBOX.CA > to be confusingly similar to the Complainant's mark.

J. Was the Registration of the Domain Name Made in Bad Faith?

25. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if and only if one of the following three conditions is met:

(a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant's actual costs in registering the domain name . . . ;

(b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names; or

(c) the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.

26. On the facts and evidence adduced in this dispute paragraph 3.7 (c) is clearly applicable.

27. The Complainant has provided sufficient evidence in its arguments to show that the Registrant registered the domain name in order to divert internet traffic to its own website offering competing services. The Registrant's website provides similar health and beauty products and competes with the cellulite reduction products and services offered by the Complainant. It is now well-established that such behaviour fulfils the criterion of "primarily for the purpose of disrupting the business of the Complainant" by allowing for an inference to be reasonably drawn, even absent other factors, that the redirection of internet clientele was done for the purposes of disruption.

28. The affidavit evidence shows that the Registrant attempted to get authorized distribution rights of the Complainant's products in Canada in March 2006, but was refused. The Registrant then almost immediately thereafter registered the domain name based on the mark of the Complainant, and of whose mark the Registrant was well aware.

29. The Panel also notes that paragraph 3.7(b) is also relevant. The Registrant has attempted – unsuccessfully – to register some of the Complainant's other domain names and trademarks: *LPG Systems S.A. v Distribution4web*, WIPO Case No. D2008-0897 (ENDERMOWEAR.COM); and *LPG Systems S.A. v Distribution4web*, CIRA Case No. 00109 [2008] (ENDERMOWEAR.CA).

30. Finally, the Registrant ignored the “cease and desist” letter from the Complainant.

31. It is a foundational principle of Quebec Civil Law, enshrined in Article 6 of the Quebec Civil Code, that everyone is bound to exercise their civil rights in good faith. Consistent with the specific provisions of the CIRA Policy, it is also clear on the evidence that the Registrant did not fulfill his obligations under the fundamental law of Quebec.

32. The Panel therefore concludes that the Registrant did in fact register the domain name < WELLBOX.CA > in bad faith under paragraphs 3.7 (b) and (c) of the Policy.

K. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

33. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. Paragraph 3.6 of the Policy states:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- (b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or

(f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

34. This definition is restrictive – only the interests listed in subparagraphs (a) through (f) below can be considered legitimate interests. These all point to some legitimate activity and objective link in assessing the relationship between the domain name and the Registrant. In terms of procedure the Complainant must provide "some evidence" that none of these interests applied to the Registrant. The Panel interprets "some evidence" as being a lower burden for the question of "(no) legitimate interest", than the usual "balance of probabilities" standard. If met, the burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

35. That being said, the Complainant has provided some evidence of the following:

1. The Registrant has no legal right to use the WELLBOX mark -- its attempt to be a legitimate distributor was rejected -- and thus is not saved by subparagraphs 3.6(a);
2. The mark and domain name were inherently distinctive, and thus not descriptive or generic, and not saved by subparagraphs 3.6 (b) and (c);
3. It was asserted and indirectly supported with a reproduction of the Registrant's initial website of an illegitimate commercial use, that the Registrant has not made a legitimate non-commercial use or fair use of the website, and thus is not saved by subparagraph 3.6(d);
4. The Registrant does not use the name "Wellbox" as a business name, and is in no other way associated with the name, and thus is not saved by subparagraph 3.6(e); and
5. Also from the Registrant's website, it is clear that "Wellbox" does not refer to a geographical name, and thus is not saved by subparagraph 3.6(f).

36. The Panel therefore concludes that the Complainant has shown some evidence that the Registrant did not have a legitimate interest in the domain name < WELLBOX.CA > and has met the initial burden under paragraph 3.6 of the Policy.

37. Under the Policy, the burden would now shift to the Registrant to show that it has a legitimate interest in the domain name as defined under the Policy. Here, the Registrant has chosen not to reply, and thus the assertions of the Complainant are accepted by the Panel.

38. The Panel thus concludes that the Registrant did not have a legitimate interest in the domain name < WELLBOX.CA > under paragraph 3.6 of the Policy.

L. Conclusion and Decision

39. The Complainant has established on the balance of probabilities that the Registrant's domain name < WELLBOX.CA > is confusingly similar to the Complainant's mark.

40. The Complainant has established on the balance of probabilities that the Registrant had registered the domain name < WELLBOX.CA > in bad faith, as defined in the Policy.

41. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name < WELLBOX.CA>. The Panel accepts the assertions of the Complainant as having been established.

42. For these reasons, the Complaint regarding the domain name < WELLBOX.CA > is successful.

M. Remedy

43. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.

Dated 23 April 2009,

David Lametti (Sole Panelist)

A handwritten signature in blue ink, appearing to read "David Lametti", with a long horizontal flourish extending to the right.

David Lametti
23 April 2009