



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

Formlabs INC / WEZACON, Eduard de Boer

Case no. 44455: formlabs.be

1. The parties

1.1. Complainant: Formlabs, INC, with registered office at 35 Medford St., Suite 1, Somerville MA 02143, United States;

Represented by:

Roberto Ledesma and Brett Lewis (Lewis & Lin, LLC), attorneys at law, residing at 45 Main Street Suite 608, Brooklyn NY 11201, United States;

1.2. Respondent: Wezacon, Eduard de Boer, Proosdijpassage 2, 7411KZ Deventer, Netherlands.

2. Domain name

Domain name: "formlabs.be"
Registered on: 26 September 2012

hereafter referred to as "the Domain Name".

3. Background to the case

On 16 July 2018, the Complainant filed a complaint with CEPANI under article 10 of the general terms and conditions of the domain name registration within the ".be" domain

CEPANI – NON-PROFIT ASSOCIATION

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governed by DNS BE (hereafter referred to as "the Policy") and in accordance with the CEPANI rules for domain name dispute resolution (hereafter referred to as "the Rules").

On 18 July 2018, the Complainant filed a request to change the language of the Administrative Proceeding to English (the language of the Domain Name's registration agreement being Dutch) in accordance with article 12 of the Rules.

On 8 August 2018, CEPANI appointed Mr. Geert Glas to act as third-party decider pursuant to the Rules (hereafter referred to as "Third-Party Decider"). The Third-Party Decider accepted this instruction and provided CEPANI with the declaration of independence in accordance with article 7 of the Rules.

Pursuant to article 7.2 of the Rules, CEPANI formally appointed the Third-Party Decider in an email dated 8 August 2018 and provided him with an electronic copy of the case file, consisting of the completed complaint form (hereafter referred to as "the Complaint").

On the same day, CEPANI informed the Complainant and the Respondent of the appointment of the Third-Party Decider and notified them that deliberations would be closed on 16 August 2018, with the final decision being due on 30 August 2018.

The Respondent filed a response to the Complaint and also requested that the language of the proceeding be Dutch.

4. Factual information

The Complainant, Formlabs INC, is a company launched in 2011 and counting more than 400 employees, that specialises in the sale of 3D printers and related products. The Complainant's products and services are especially used in the dentistry sector.

The Complainant registered the FORMLABS trademark in numerous countries around the world including the Benelux (for products in class 1 and 9), the United States, China, Israel, South Korea, Japan and Canada (the FORMLABS trademarks). The oldest FORMLABS trademark was filed by the Complainant on 1 April 2013 in the United States.

On 26 September 2012, the Complainant launched a Kickstarter campaign to fund the development of a new type of 3D printer. It appears from the documents provided by the Complainant that the Respondent pledged 2.999 \$ to this campaign in exchange for a 3D printer from the Complainant. On that occasion the Respondent also posted some comments on the Complainant's Kickstarter webpage.

On that same 26 September 2012, the Respondent registered the Domain Name as well as the other following domain names incorporating the Formlabs name: <formlabs.eu>, <formlabs.nl>, <formlabs.net>, <formlabs.org>, <formlabs.biz>, <formlabs.info>, and <formlabs.nu>. At the time of drafting this decision, a UDRP case is pending before the World Intellectual Property Organisation (WIPO) for the following domain names : <formlabs.net>, <formlabs.org>, <formlabs.biz>, <formlabs.nu>and <formlabs.info>.

On 27 August 2014, the Respondent registered the Benelux figurative trademark FORMLABS (for products in class 14).

The website to which the Domain Name resolves redirects Internet users to a website operated under the domain name <formlabs.net> which has also been registered by the Respondent. Over time, at least four different types of content have been displayed on the website to which the Domain Name redirects: (i) a list of <formlabs> domain names owned by the Respondent with the mention "you can buy", (ii) a general informative excerpt about 3D printers from a seminar report available online and authored by a third-party to this proceeding, (iii) an auction form to buy the <formlabs.net> domain name as well as a list of other <formlabs> domain names with the indication of a 2500 euros price for each domain name and (iv) a presentation of Respondent's business which consists in the manufacturing of jewels via, *inter alia*, 3D printing technologies.

Between 2014 and 2018 several contacts occurred between the parties in order to agree on a transfer of the Domain Name but no such agreement was ever reached.

Position of the parties

4.1 Position of the Complainant

The Complainant requests that the Domain Name be transferred to it since, according to the Complainant, the conditions provided for under b) 10. i - iii of the Policy are clearly met.

(A) the Respondent's Domain Name is identical or confusingly similar to a trademark, a trade name, 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.

The Complainant asserts that the Domain Name is identical to the Complainant's FORMLABS trademarks and that the country code top-level ".be" does not negate the identical character of the Domain Name to the FORMLABS trademarks.

The Complainant contends that since the launch of its business in 2011, the Complainant has established itself as one of the leaders in the 3D printing world and has been featured in various journals and websites such as The Boston Globe or Wired. As a consequence, the Complainant contends that the FORMLABS trademarks benefit from a strong reputation and goodwill.

(B) the Respondent has no rights or legitimate interests in the Domain Name.

The Complainant contends that the Respondent has no rights or legitimate interests in the Domain Name given that (i) the Respondent is not commonly known by the FORMLABS trademarks, (ii) the Complainant has not authorised the Respondent to use the FORMLABS trademark or trade name, (iii) the Respondent has not used the domain name with a *bona fide* offering of goods or services, and (iv) the Respondent has not made legitimate non-commercial use or fair use of the Domain Name.

The Complainant adds that the registration of the Benelux FORMLABS trademark on 27 August 2014 by the Respondent does not ground a finding of rights or legitimate interests in the Domain Name since merely owning a trademark registration is not sufficient to prove a respondent's rights or legitimate interests in a domain name, especially where the circumstances demonstrate that the registration of the trademark has been made with the purpose of bypassing a UDRP proceeding.

The Complainant also contends that the Respondent has no rights or legitimate interest in the Domain Name because the Respondent registered the Domain Name with the purpose of reselling it for profit, contacting the Complainant on several occasions (in April 2014, February 2015 and June 2018) with unreasonable offers. The Complainant adds that it tried to find an amicable solution by making offers to the Respondent that largely exceeded the out of pocket costs of the Domain Name's registration but that the Respondent rejected all offers.

(C) the Domain Name has been registered or is being used in bad faith.

The Complainant alleges that the Respondent registered and uses the Domain Name in bad faith.

The Complainant contends that when the respondent registered the Domain Name, the Complainant was already a reference in the 3D printing world. The Complainant adds that the Respondent registered the Domain Name on 26 September 2012, the exact same day that the Complainant launched a Kickstarter campaign to fund a new 3D printer. The Complainant alleges that the Respondent was aware of the Kickstarter campaign because (i) the Respondent pledged \$ 2999 to the Kickstarter campaign – in exchange of which Formlabs gave him a 3D printer – and (ii) the Respondent posted comments on the Kickstarter webpage. Consequently, the Complainant asserts that the Respondent was aware of the Complainant's rights in the FORMLABS mark at the time of registration.

The Complainant considers that the Respondent's bad faith can be inferred from the fact that there is no clear explanation for the choice of the Domain Name by the Respondent other than the Respondent's attempt to create a likelihood of confusion with the Complainant's trademarks to attract Internet users.

The Complainant also contends that the Respondent's bad faith can be found in the circumstances that the Respondent (i) tried to sell the Domain Name to the Complainant for an amount far in excess of registration costs and (ii) put the Domain Name for sale on the website to which the Domain Name redirects.

The Complainant adds that, in June 2018, it received an email from the Respondent in which the Respondent (i) threatened the Complainant to initiate legal action against it if the Complainant used the FORMLABS trademarks in the Benelux and (ii) indicated that the prices previously mentioned for the sale of the domain names had expired, implying that the prices had gone up.

The Complainant adds that the Respondent's above mentioned conducts amount to cybersquatting.

Consequently, the Complainant requests the transfer of the Domain Name registration.

4.2 Position of the Respondent

The following is a summary of the Respondent's contentions.

The Respondent contends that he has been using the Domain Name for years and that the mere fact that he was able to register the Domain Name demonstrates the Complainant's lack of interest in the Domain Name.

The Respondent adds that by letting years pass between the first time the Respondent made an offer to sell the Domain Name and the introduction of this proceeding, the Complainant has acknowledged the Respondent's rights in the Domain Name. The Respondent further contends that the fact that the Complainant made several offers to buy the Domain Name (as well as other <formlabs> domain names registered by the Respondent) implies that the Complainant was well aware of the Respondent's rights in the Domain Name.

The Respondent asserts that he has registered the Benelux FORMLABS trademark in the context of his jewellery business and that he uses the Domain Name to present the jewels that he sells under the Benelux FORMLABS trademark. The Respondent adds that the Complainant is only interested in owning the Domain Name now that the Respondent has developed a blooming business.

5. Language of the Proceeding

Pursuant to Article 12 of the Rules, the language of the proceeding for the domain name is the language mentioned in the WHOIS database available on the DNS website www.dns.be (the language of the registration agreement) but, in exceptional cases, the Third-Party Decider may select a different language. Such exceptional cases may be found where the Third-Party Decider deems appropriate, in the spirit of fairness and justice to both parties, taking into consideration matters such as command of the language, time and costs to conduct the proceeding in a language that is not the language of the registration agreement (See by analogy [WIPO Case No. DCC2006-0004](#), *Groupe Auchan v. xmxzl*).

In the present case, the language of the registration agreement is Dutch.

However, the Complainant requests that the language of the proceeding be English because the circumstances of the case clearly demonstrate that the Respondent understands English. In particular, the Complainant contends that the Respondent understands English given that the Respondent (i) has always communicated with the Complainant and its legal counsels in English (ii) has posted English content on the website to which the Domain Name redirects and (iii) registered multiple domain names (including the Domain Name) composed by two English terms, "form" and "labs". The Complainant adds that opting for English as the language of the proceeding will have a positive effect on time and costs.

The Respondent contends that the language of the proceeding should be Dutch because (i) he lives in the Netherlands and has a better command of Dutch than he has of English and (ii) he has always communicated with the Registrar in Dutch.

In the present case, the Third-Party Decider notes that it clearly appears from the different documents that have been submitted by the parties that the Respondent has a good command of English. The Respondent reached out to the Complainant in English and always communicated with the Complainant and his counsels in English. The Respondent also posted English content on the website to which the Domain Name redirects.

For the above reasons, the Third-Party Decider finds that in the circumstances of this case, article 12 of the Rules is best served by allowing the proceedings to be conducted in English

6. Discussion and findings

Paragraph 16 of the Rules instructs the Third-Party Decider on the principles that the Third-Party Decider must use in determining the dispute: "*The Third-Party Decider shall decide on the Complaint in accordance with the Policy and these Rules.*"

In accordance with article 10 of the Policy, entitled "*Dispute resolution policy*", *the complainant has to assert and to prove, in compliance with the rules of procedure, that :*

- (i) *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*
- (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.*

It appears from this provision that three cumulative conditions must be met to order the transfer of the disputed Domain Name to the Complainant.

6.1 The registrant's domain name is identical or confusingly similar to, *inter alia*, a trademark, a trade name, a company name in which the complainant has rights.

The Complainant is the owner of the FORMLABS trademarks which it has registered in several jurisdictions across the world.

The Policy states that the domain name in question in any dispute must be "*identical or confusingly similar to, inter alia, a trademark, a trade name, a company name in which the complainant has rights*". The policy does not however mention anything about the territory or the time of registration of the invoked rights. In this context, "*all trademarks irrespective of the territory for which they are registered or their anteriority compared to the registration date of the disputed domain name[...] may be considered*" (See, [case n°44238](#) – pneu-online.be / pneuonline.be / pneu-online.be / pneuonline.be).

Accordingly, the Complainant has demonstrated that it is the owner of trademarks – the FORMLABS trademarks – that can be relied upon for the purpose of assessing the first element of article 10 (b) (1) of the Policy.

The Domain Name incorporates the FORMLABS trademarks in their entirety and does not differ from them.

Given that the country code top-level domain '.be' must be disregarded for the purpose of assessing the identical character of a domain name (See, e.g., [case n°44030](#) – chopard.be), the Domain name is identical to the Complainant's FORMLABS trademarks.

Consequently, the Third-Party Decider finds that the first condition of Article 10 (b) (1) of the Policy is satisfied.

6.2 The registrant has no rights or legitimate interests in the domain name

Pursuant to Article 10 (b) (3) of the Policy, a respondent's rights or legitimate interest to the domain name can be proven by certain circumstances. Article 10 (b) (3) of the Policy gives a non-exhaustive list of such circumstances:

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

In the present case, the Third-Party Decider notes that the Respondent has used the Domain Name to redirect Internet users to a website where the Domain Name (and other domain names incorporating the FORMLABS trademarks) was put up for sale and has tried to sell the Domain Name (and other domain names incorporating the FORMLABS trademarks) to the Complainant for substantial amounts. Contrary to what the Respondent claims, the fact that the Complainant made several offers to buy the Domain Name (and other domain names incorporating the FORMLABS trademarks) does not amount to the Complainant's acknowledgment of the Respondent's rights or legitimate interests in the Domain Name. It merely demonstrates that the Complainant tried to find an amicable solution to the issue before initiating the present proceeding. Moreover, several offers to sell the Domain Name were initiated by the Respondent.

Additionally, the Third-Party Decider finds that the existence of the Respondent's rights or legitimate interests cannot be inferred from the Benelux registration by the Respondent of the FORMLABS trademark. Indeed, "*the existence of a respondent trademark does not [...] automatically confer rights or legitimate interests of the respondent where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights*" (See by analogy Section 2.12 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \(WIPO Overview 3.0\)](#)). In the present circumstances, given the fact that the Respondent registered the FORMLABS Benelux trademark one day after the Complainant had emailed him an offer to buy the Domain Name (and other domain names incorporating the FORMLABS trademarks) and one day before the Respondent emailed the Complainant stating that he was not interested in the Complainant's offer, it appears likely to the Third-Party Decider that the Respondent registered the Benelux FORMLABS

trademark to try to legitimize its ownership of the Domain Name (and other domain names incorporating the FORMLABS trademarks) and prevent the Complainant to exercise its rights (See by analogy [WIPO Case No. D2013-1568](#), Aukro Ukraine LLC v. PrivacyYes.com, Igor Spodin). This is further confirmed by a recent threat by the Respondent to initiate legal action against the Complainant if it would use its Benelux trademark.

Consequently none of the examples listed in Article 10 (b) (3) of the Policy are supported by the facts asserted by the Respondent and the Third-Party Decider is of the opinion that the Complainant has made an acceptable case that the Respondent has no rights or legitimate interests in the Domain Name (See, [case. n° 44167- present.be](#)).

For these reasons, the Third-Party Decider finds that the second condition of Article 10 (b) (1) of the Policy is satisfied.

6.3 The Respondent's domain name has been registered or is being used in bad faith

In order to meet the third condition of Article 10 (b) (1) of the Policy, the Complainant must prove that the Respondent registered or used the Domain Name in bad faith.

(a) Registration in bad faith

On 26 September 2012, the Complainant, using its FORMLABS name, launched a Kickstarter campaign to fund the development of a new 3D printer. On the exact same day, the Respondent registered the Domain Name (and other domain names incorporating the FORMLABS trademarks). Given the fact that the Respondent contributed to the Complainant's Kickstarter campaign and posted comments on the page of the Complainant's Kickstarter campaign, the Third-Party Decider is of the opinion that the Domain Name was registered in bad faith since it is factually impossible that the Respondent was not aware of the Complainant's use of the FORMLABS name when registering the Domain Name.

In addition to this, the Third-Party Decider finds that the fact that the Parties have attempted for several years to settle this matter does not as such reduce, let alone compensate for the bad faith present when the Respondent registered the Domain Name.

The Third-Party Decider therefore concludes that the Respondent has registered the Domain Name in bad faith.

(b) Use in bad faith

As the bad faith requirement is met either by the registration in bad faith or by the subsequent use in bad faith, and as it has been concluded above that the Respondent registered the Domain Name in bad faith, there is no need to assess whether or not the subsequent use of the Domain Name by the Respondent was made in bad faith or not.

7. Decision

Consequently, in accordance with Article 10 (e) of the Policy, the Third-Party Decider orders that the Domain Name "**formlabs.be**" should be transferred to the Complainant.

Brussels, 30 August 2018.

P.P



Geert Glas

The Third-Party Decider