



BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

VITA-MIX Corporation / CAP&SEAL KB

Case no. 44276: vitamix.be

1. The parties

- 1.1. Complainant: Vita-Mix Corporation;
with registered office at 44138 Cleveland Ohio, 8615 Usher
Road, United States of America.

Represented by:

Ms. Malisheia O. Douglas, Attorney at Law with offices at
Benesch, Friedlander, Coplan & Aronoff LLP, 200 Public
Square, Suite 2300, Cleveland Ohio 44114-2378, United
States Of America,

- 1.2. Licensee: Cap & Seal KB;
with registered office at 611 24 Nykoping, Box 21040, 162,
Sweden.

Represented by:

Mr. Frederick Rotemark, owner of Cap & Seal KB

2. Domain name

Domain name: "vitamix.be"
Registered on: 29 July 2005

hereafter referred to as "the Domain Name".

3. Background to the case

On July 19, 2012 Complainant filed a complaint against the registration of the Domain Name pursuant to Article 2 of the Rules for Domain Name Dispute Resolution (hereinafter: "the Rules") of the Belgian Centre for Arbitration and Mediation (hereinafter: "the Centre").

On August 13, 2012 Licensee proposed a friendly settlement. On August 14, 2012 Complainant agreed with it but requested the transfer of all the domain names owned by Licensee and including the word "vitamix". The friendly settlement failed.

Licensee responded to the complaint on August 15, 2012 pursuant to Article 5 of the Rules. Moreover from mid- to end-Augustus Licensee sent to the Centre several emails related to the present issue.

On August 22, 2012 the Centre invited Mr. Ignace Vernimme, pursuant to Article 6.2 of the Rules, to serve as the Third-Party Decider. The Centre sent a copy of the full case file to the Third-Party Decider on the same day.

On August 29, 2012 Complainant filed a retort as well as additional documents pursuant to Article 12 of the Rules, which were accepted by the Third-Party Decider.

On September 10, 2012 Licensee filed a response to the retort as invited by the Third-Party Decider in his email to the Centre dated on August 30, 2012.

The deliberations closed on September 10, 2012.

Pursuant to Article 15.2 of the Rules, the Third-Party Decider's decision is due to within 14 days of the conclusion of the deliberations, therefore by September 24th, 2012 at the latest.

4. Factual information

Complainant is a global leader in food blending equipment doing business throughout the United States, Canada, United Kingdom and, through its distributors, throughout the world, including without limitation in Continental Europe, Hong Kong, Japan, Australia, and Taiwan.

Complainant is the owner of several trademark registrations worldwide (hereinafter: "Trademarks") and domain names for the sign "vita-mix" and "vitamix", such as:

- The Community Trademark registration "VITA-MIX", n°1316272 dated on December 4, 2000, for goods in class 7 (electric machines for processing, grating, blending, mixing, kneading, mincing, grinding and cutting food);
- The domain names: www.vita-mix.com (created on January 30, 1996) and www.vitamix.com (created on February 6, 1996).

Licensee is a small Swedish company. It results from the case file that Licensee's sister company, namely "Mobila Dryckessystem" concluded in 2003 with

Complainant an agreement to distribute Complainant's products but terminated it in 2008.

Licensee obtained the registration of the Domain Name on July 29, 2005.

On April 29, 2010 Marlene Wilson, on behalf of the company CSC Corporation Service Company contacted Licensee to know whether the latter was willing to sell the domain name "vitamix.fi". On October 13, 2011 Licensee replied and said that it owned several domain names including "vitamix" ("vitamix.se"; "vitamix.dk"; "vitamix.es"; "vitamix.be"; "vitamix.it"; "vitamix.fr"; "vitamix.fi") and that it was about to sell them to another interested company but asked Marlene Wilson whether her client [apparently Complainant] was still interested in buying "vitamix.fi" and willing to buy the other ones (Annex 8 of Complainant's file).

On October 19, 2011 Marlene Wilson sent an email to Licensee stating that her client was offering \$8,500 plus the escrow fees for all 7 domain names. On the same day Licensee refused the deal. Marlene Wilson informed then Licensee that the best her client could do was \$12,000 for all domain names. Licensee replied: "*With all that I have told you I am surprised that you offer less then we already have. Just to park the domain and sell advertising will get more. The dollar is around 6 in currency exchange so this is not a winning bid.*" (Annex 9 of Complainant's file).

On November 23, 2011 a counsel for Complainant, namely Mark E. Avsec sent a formal notice to Licensee, among others, in order to offer again the amount of \$12,000 for the transfer of all the domain names owned by Licensee and including the word "vitamix" (Annex 10 of Complainant's file).

According to the information provided by Complainant, the third-Party Decider is not aware of any pending or decided legal proceeding which may affect the Domain Name.

5. Position of the parties

5.1. Position of the Complainant

In summary, Complainant contends that, in accordance with Article 10 of the Terms and Conditions for domain name registrations under the ".be" domain operated by DNS BE (hereinafter: "Policy"), the complaint is based on the following grounds:

- ***The Domain Name is identical and may be confused with the Trademarks***

Complainant asserts that the Domain Name is virtually identical to the Trademarks as well as confusingly similar to its domain names.

Complainant contends that the only difference between the Domain Name and the Trademarks is the ccTLD ".be" and the absence of a hyphen. According to Complainant, the ccTLD ".be" should not be considered when comparing the Domain Name and the Trademarks and the absence of hyphen in the Domain Name does not distinguish it from the Trademarks.

Complainant asserts that many Internet users would suppose that the Domain Name was registered by Complainant or would type it by mistake when seeking the Belgian

counterpart to Complainant's principal websites at www.vita-mix.com and www.vitamix.com.

- ***Licensee has no rights or legitimate interests to the Domain Name***

Complainant asserts that Licensee is not currently known as "vitamix" and is not making a bona fide offering of "vitamix" goods or services. Complainant emphasizes that parking a domain name is not a bona fide offering of goods or services (CEPANI n°44203, cybermut.be).

Annex 2 of Complainant's file shows that the Domain Name resolves to an inoperative webpage and a close-up view of the title bar of the inoperative webpage reveals the phrase: "Viamix, silent blender, vita-mix".

According to Complainant, this demonstrated that Licensee is using the Domain Name in a manner designed to prevent the rightful owner of the Trademarks from using the Domain Name.

- ***Licensee registered or used the Domain Name in bad faith***

Complainant asserts that given Complainant's longstanding use of highly distinctive VITA-MIX trademarks (since 1937; USA trademark registration in 1996) it is unlikely that Licensee was not aware of Complainant's rights while registering the Domain Name. Complainant emphasizes that Licensee was one of Complainant's former distributor. The distributorship was revoked around 2008 and Licensee currently has no relationship with Complainant, according to the latter. Complainant never authorized Licensee to obtain the Domain name, nor to use the Trademarks.

Complainant asserts that Licensee registered the Domain Name for the purpose of transferring the Domain name at a cost which is higher than the costs reasonably born by Licensee. In that respect, Complainant refers to Annex 8 – 9 – 10 of its file which are the letters exchanged between Complainant and Licensee about the transfer of the Domain Name and its cost. Complainant contends that it offered \$12,000 for the Domain Name in addition to several others but that Licensee refused to sell stating that it could earn more by parking the Domain Name and earning advertising revenue.

Furthermore, Complainant asserts that Licensee demonstrated a pattern of using the Trademarks to attract consumers who are looking for authentic Vita-Mix products. According to Complainant, Licensee registered several domain names which incorporate the Trademarks (vitamix.es; vitamix.dk; vitamix.se; mitamix.it; mitamix.fr; mitamix.fi), without using them to promote any legitimate Vita-Mix products. Regarding the domain name "vitamix.es", it is currently being transferred to Complainant in WIPO domain dispute procedures (Annex 4 of Complainant's file).

5.2. Position of the Licensee

In summary, Licensee contends that, in accordance with Article 10 of the Policy, the complaint is groundless for the following reasons:

- ***The Domain Name is not identical, nor confusingly similar to the Trademarks***

In that respect, Licensee asserts that Complainant always used a hyphen both in its trademarks and all the logos used for marketing purpose. Licensee emphasizes that the public has been used to see Complainant's trademarks and logos spelled with a hyphen over the last 65 years.

Moreover Licensee contends that 74 trademarks are registered for the word "vitamix" and that Complainant owns merely 4 of them.

Finally Licensee emphasizes that "vitamix" is a word that can be found in a Latin wordbook contrary to "vita-mix".

- ***Licensee has rights or legitimate interests with regard to the Domain Name***

Licensee contends to have used the Trademarks and the Domain Name for its own products over several years, while Licensee decided around 2008 to change its business concept.

Licensee asserts that the Swedish company, namely OBH Nordica - which apparently registered the trademark "vitamix" in Sweden – granted Licensee the right to use "vitamix.se".

- ***Licensee did not register or use the Domain Name in bad faith***

Licensee asserts that it first registered the domain name "vitamix.se", two years later the Domain name, then three years later the domain name "vitamix.fr" and finally "vitamax.fi" and "vitamix.it" in 2009. According to Licensee these registrations correspond to business opportunities in the respective countries. Licensee contends that Complainant was aware of all these registrations and that Licensee kept its contact, namely Darren Arvidson informed.

According to Licensee, since the termination of the agreement with Complainant, Licensee has never used anything connected to Vita-Mix. Regarding the use of the phrase "Viamix, silent blender, vita-mix" pointed out by Complainant on the inoperative webpage, Licensee contends that it was a mistake of the Internet provider and such use is now over.

Regarding negotiations on Domain Name transfer, Licensee emphasizes that it has never tried to earn money. Licensee considers that the amount of \$12,000 was weight too low to cover all the disbursements related to the registration and the annual fees of all the domain names registered by Licensee and including the word "vitamix".

6. Discussion and findings

Pursuant to Article 15.1 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 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, Complainant must provide evidence of the following:

- *" the licensee's domain name is identical or confusingly similar to a trademark, a tradename, 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; and*
- *the licensee has no rights or legitimate interests in the domain name; and*
- *the licensee's domain name has been registered or is being used in bad faith."*

6.1. Identical or similar to

The Third-Party Decider finds that the Domain Name is confusingly similar to the Trademarks, if not identical.

As Complainant pointed out correctly, the only difference between the Domain Name and the Trademarks is the omission of the hyphen between the words "vita" and "mix".

Furthermore, Complainant registered and uses the domain name "vita-mix.com" as well as "vitamix.com".

As a result, the Third-party Decider finds that the Domain Name is at least visually and phonetically similar to the Trademarks. The omission in the Domain Name of the hyphen does not have an impact on the assessment of similarity and likelihood of confusion.

6.2. Rights and legitimate interests

The Third-Party Decider finds that the case file does not show that Licensee has any prior right – such as a trademark or a tradename – in the Domain Name. Moreover, it does not appear that Licensee has obtained the authorisation of Complainant to incorporate the Trademarks in the Domain Name.

Nor has it been proven that Licensee is commonly known by the Domain Name as an individual, business or other organisation.

Complainant contends that the Domain Name resolves to an inoperative webpage. Licensee seems to admit this as it states in its response form (p.3) that "the webpage is on hold by us". The Domain Name indeed resolves to an inoperative webpage.

No exhibit was filed showing that Licensee used at some point 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. Licensee contends that it is willing to relaunch the Domain Name and its business activity in Belgium. In that respect no evidence was submitted. It seems that since 2005 Licensee has merely parked the Domain Name.

Under these circumstances, the Third-Party Decider finds that Licensee has no rights or legitimate interests in the Domain Name.

6.3. Registration in bad faith

The Third-Party Decider concludes that it results from the case file that the Domain Name was registered – or at least has been used – in bad faith given the fact that:

- Licensee knew or ought to have known the existence of Complainant's Trademark in its capacity as Complainant's former distributor, yet Licensee registered the Domain Name incorporating the Trademarks. No evidence was submitted showing that such registration was authorized by Complainant. This suffices to demonstrate bad faith (CEPANI n°44046, zodiac.be);
- Licensee accepted to sell the Domain Name to Complainant but categorically refused the offer of \$12,000 from Complainant, without issuing any counter-offer and/or stating the desirable price. Licensee instead replied to the offer stating: *"With all that I have told you I am surprised that you offer less then we already have. Just to park the domain and sell advertising will get more. The dollar is around 6 in currency exchange so this is not a winning bid."* This shows that Licensee sought to prevent Complainant to use the Domain Name and/or to obtain an inappropriate amount of money for the transfer of the Domain Name;
- Licensee contends that it registered the Domain Name in 2005, as there were good business opportunities in Belgium. However, the Domain name resolves to an inoperative webpage and no exhibit related to any Licensee's business activity in Belgium was filed;
- Licensee has registered several domain names without the existence of a demonstrable link between itself and the registered domain names. The domain names "vitamix.fr", "vitamix.fi" and "vitamix.it" were registered after the termination of the agreement of distributorship. Regarding the Domain Name Licensee registered it during the agreement of distributorship but, as it results from the case file, without the authorization of Complainant. Licensee kept the Domain Name after the termination of the agreement, yet it results from the case file that Licensee did not want and/or plan to promote and/or distribute any Complainant's goods anymore;
- The termination of the distributorship agreement by Licensee in 2008 establishes that Licensee has no interest in distributing Complainant's goods and no interest in the Domain Name.

In view of the elements and evidence submitted by Complainant, the Third-Party Decider finds that there are sufficient indications that Licensee registered the Domain

Name because of, or by reference to, Complainant's Trademarks and it is proven that Licensee did register – or at least has used – the Domain Name in bad faith.

For all the foregoing reasons, the Third-Party Decider decides that the Domain Name "vitamix.be" registered by Licensee is confusingly similar to the trademarks of Complainant, that Licensee does not have a right or legitimate interest in respect of the Domain Name and that it is proven that Licensee did register – or at least has used – the Domain Name in bad faith.

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 "vitamix.be" domain name is to be transferred to the complainant.

Brussels, September 24, 2012.



Ignace, Verhimmé
The Third-party decider
(signature)