

ADMINISTRATIVE PANEL DECISION

Lightonline v. EWBCD GmbH
Case No. DEU2022-0018

1. The Parties

Complainant is Lightonline, France, represented by Coblenz & Associés, France.

Respondent is EWBCD GmbH, Germany, represented by Hoeller Law, Germany.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <lightonline.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is Registrar.eu.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 17, 2022. On June 17, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On June 27, 2022, the Registry transmitted by email to the Center its verification response, confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 28, 2022. In accordance with the ADR Rules, Paragraph B(3)(a), the due date for the Response was August 10, 2022. On July 22, 2022, Complainant filed an unsolicited supplemental filing (“First Supplemental Filing”) to the Center, copying Respondent. The Response was filed with the Center on August 10, 2022. On August 13, 2022, Complainant filed a second unsolicited filing (“Second Supplemental Filing”) to the Center, copying Respondent.

The Center verified that the Response satisfied the formal requirements of the ADR Rules and the Supplemental Rules.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on August 25, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the ADR Rules, Paragraph B(5).

On September 20, 2022, the Panel issued Procedural Order Nr. 1 granting Respondent the opportunity to respond to Complainant's First Supplemental Filing by September 22, 2022. Respondent did not provide any response. Accordingly, the proceedings continued to this Decision.

4. Factual Background

Complainant is a French company that operates an e-commerce site marketing lighting products at the domain name <lightonline.fr>. It has also registered the domain name <lightonline.com> and numerous other domain names containing the element LIGHTONLINE. Complainant is the proprietor of several trademark registrations, including European Union Trade Mark No. 011156197 for LIGHTONLINE (word mark), registered on January 28, 2013, for goods and services in classes 4, 11, 20, and 35.

The disputed domain name was registered on July 3, 2021. At the time of the Decision, it did not resolve to an active website. It previously resolved to a website featuring pay-per-click ("PPC") links and a statement that the disputed domain name is available for sale.

The record indicates that Respondent is a German company engaged in business consultations. The record contains a copy of a notice letter sent by Complainant to Respondent on May 17, 2022. The record indicates that correspondence between the Parties ensued. Respondent provides a copy of an email dated July 7, 2022, in which Complainant (apparently in request to Respondent's reply to its notice letter) asks Respondent to clarify the intended use of the disputed domain name and states that "This information could be useful to discuss with our client about a coexistence agreement".

The record contains a copy of a document entitled "Brainstorming notes" dated July 25, 2021, and authored by Respondent, containing a summary of possible uses for the disputed domain name in connection with healthy nutrition.

5. Parties' Contentions

To maintain clarity in the timeline of this case, the Parties' submissions shall be set forth in the order in which they were received by the Center.

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it has registered rights in the LIGHTONLINE mark, and that the relevant part of the disputed domain name is identical to this mark.

Under the second element, Complainant states that it has neither authorized nor licensed Respondent to use the LIGHTONLINE mark, and that there is no relationship between the Parties. Complainant believes that Respondent was aware of its mark and registered the disputed domain name for the purpose of diverting Internet traffic from Complainant's website to a parking page featuring links similar to Complainant's goods. Respondent has not made a legitimate noncommercial or fair use of the disputed domain name.

Under the third element, Complainant states that it has used and registered the LIGHTONLINE mark for 10 years, and that therefore it is obvious that Respondent was aware of this mark. The disputed domain name redirects to a site featuring links that link to websites offering lighting products that compete with Complainant's.

Complainant requests transfer of the disputed domain name.

B. Complainant's First Supplemental Filing

Complainant's First Supplemental Filing, dated July 22, 2022, is directed to Complainant's claim that Respondent has registered the disputed domain name for the purpose of selling it for a sum in excess of the cost of registration. The Supplemental Filing consists of a copy of an email message, in French, on behalf of an entity that appears to be a domain name brokerage, stating that Respondent has made the disputed name available for sale for EUR 2999 and offering to negotiate with Respondent for its purchase. The email is dated April 6, 2022, which is approximately two months prior to the filing of the original Complaint. Complainant offers no explanation for the delay.

C. Respondent's Response to the Complaint

Respondent's contentions may be summarized as follows:

Respondent states that some of the materials submitted by Complainant are not in English, or cannot be accessed. Complainant should provide appropriate translations and accessible files. Respondent states that Complainant had earlier indicated willingness to enter into a co-existence agreement but had filed the Complaint regardless. Respondent states that Complainant had promised, but failed, to return Respondent's telephone calls requesting its application to extend the response deadline. Respondent requests permission to file an additional submission and requests the Panel to reject the additional submission by Complainant.

Under the first element, Respondent states that "light online" is a generic term and therefore lacks distinctiveness as a trademark. Indeed, the term "light", while used by Complainant in connection with the sale of lamps, is proposed to be used by Respondent in connection with low-calorie foods and products. Therefore, there can be no confusion.

Under the second and third elements, Respondent states that, prior to receiving notification of the Complaint, it was not aware of Complainant. Registering a generic term, Respondent could not have assumed that usage of this term is restricted.

Respondent does not consent to the remedy requested by Complainant.

D. Complainant's Second Supplemental Filing

Complainant's Second Supplemental Filing refutes points made in Respondent's Response, including an explanation of the phone calls that Respondent alleges Complainant did not return, and disputing the probity of Respondent's internal document about possible uses of the disputed domain name. Complainant alleges that Respondent acted improperly in disclosing an email sent by its counsel regarding coexistence.

E. Respondent's Response to First Supplemental Filing

On September 20, 2022, the Panel granted Respondent additional time to respond to the First Supplemental Filing to address the issue of whether the disputed domain name had been made available for sale by the broker. Respondent did not provide any response within the time granted.

6. Discussion and Findings

As the dispute concerns a .eu Top-Level Domain, the Decision is rendered in accordance with Regulation (EU) 2019/517 of the European Parliament and of the Council of March 19, 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 (the “Regulation”) and the .eu Alternative Dispute Resolution Rules (the “ADR Rules”), with reference as needed to the Uniform Domain Name Dispute Resolution Policy (UDRP) (the “UDRP Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “UDRP Rules”), and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

6.1 Supplemental Filings

Pursuant to paragraph B(7)(b) of the ADR Rules, “In all cases, the Panel has a duty to ensure that the Parties are treated fairly and with equality”. To this end, pursuant to paragraph 8 of the ADR Rules, “the Panel may request or admit, in its sole discretion, further statements or documents from either of the Parties”.

At the same time, however, pursuant to paragraph B(7) of the ADR rules, “(c) The Panel shall ensure that the ADR Proceeding takes place with due expedition. (d) The Panel shall determine in its sole discretion the admissibility, relevance, materiality and weight of the evidence”.

Accordingly, unsolicited supplemental filings are generally discouraged. Exceptionally, they may be accepted to consider material new evidence or to provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. (See, by analogy, [WIPO Overview 3.0](#), section 4.6, and cases cited thereunder.)

In respect of the First Supplemental Filing, the Panel notes that the date on the email submitted by Complainant as additional evidence in support of the Complaint is April 6, 2022, which is well in advance of June 17, 2022, the date on which the Complaint was filed. Complainant offers no explanation for the delay and it does not appear to the Panel that there are any obvious circumstances that would have made it impossible for Complainant to file this evidence at the time of the filing of the Complaint. This email is, however, directly relevant to the issue of Respondent’s intent in registering the disputed domain name. Therefore, the Panel admits the First Supplemental Filing on the basis that it is relevant and material to the case.

Noting Respondent’s earlier request for additional time to prepare the Response and to reply to the First Supplemental Filing, the Panel issued a Procedural Order granting Respondent additional time to address the First Supplemental Filing only. However, Respondent provided no response.

In respect of the Second Supplemental Filing, the Panel finds that it consists of a restatement of points made in the Complaint and a rebuttal of various points raised by Respondent in its Response. In the Panel’s view, the Second Supplemental Filing does not provide any relevant or material new evidence. Therefore, the Panel does not admit it and shall not consider it in this Decision.

6.2 Substantive Issues

Under paragraph B(11)(d)(1) of the ADR Rules, in order for the Complaint to succeed, it is for Complainant to establish:

- (i) that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law and;
- either
- (ii) that the disputed domain name has been registered by Respondent without rights or legitimate interest in the name; or

(iii) that the disputed domain name has been registered or is being used in bad faith.

Furthermore, Article 22(10) of the Regulation provides that “[f]ailure of any of the parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty”.

A. Identical or confusingly similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

Complainant has provided evidence establishing that it has trademark rights in the LIGHTONLINE mark through use and registration in the European Union. This is sufficient for the Panel to make a finding that Complainant has rights recognized by European Union law for the purposes of standing to bring a Complaint under paragraph B(11)(d)(1)(i) of the ADR Rules.

In comparing Complainant’s LIGHTONLINE with the disputed domain name, the Panel finds that the disputed domain name is identical to the mark. It is well established in decisions under the ADR Rules that the country code Top-Level Domain (“ccTLD”) “.eu” is typically ignored when assessing the similarity between a trademark and a domain name.

Respondent challenges the distinctiveness of the LIGHTONLINE mark. However, the Panel finds that Complainant has provided evidence, unchallenged by Respondent, that it owns rights in the European Union in the LIGHTONLINE mark, and that the disputed domain name is indeed identical to this mark. Therefore, the Panel finds that Complainant has the necessary standing to bring this Complaint. See, for example, *Epic Systems Corporation v. Domain Administrator, See PrivacyGuardian.org / CGM Publishing LLC*, WIPO Case No. [D2021-0702](#).

The Panel therefore finds that Complainant has established the first element according to paragraph B11(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

Under paragraph B(11)(e) of the ADR Rules, Respondent may demonstrate its rights or legitimate interests in the disputed domain name for purposes of paragraph B(11)(d)(1)(ii) by showing any of the following circumstances, in particular but without limitation:

- (1) prior to any notice of the dispute, Respondent has used the disputed domain name or a name corresponding to the disputed domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
- (2) Respondent, being an undertaking, organization or natural person, has been commonly known by the disputed domain name, even in the absence of a right recognized or established by national and/or European Union law;
- (3) Respondent is making a legitimate and noncommercial or fair use of the disputed domain name without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or European Union law.

Complainant has established that it has no relation with Respondent, has never authorized Respondent to use the mark in any way, and that Respondent is not commonly known by the disputed domain name. The Panel finds that Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the burden of production on this element shifts to Respondent to submit evidence that it does, in fact, have rights or legitimate interests in the disputed domain name. See, e.g., *Gymworld Inc. and Magformers UK Limited v. Vanbelle Jo, Vanbelle Law*, WIPO Case No. [DEU2017-0001](#).

The Panel finds that the arguments and evidence submitted by Respondent do not establish rights or legitimate interests. Claiming a lack of subjective awareness of Complainant's mark does not establish such rights. Respondent provides a four-bullet-points list with the intention of showing that, a few weeks after registering the disputed domain name, it had brainstormed uses of the disputed domain name in connection with "light" foods. In this regard, while not conclusive in itself, the Panel notes that the disputed domain name does not include the term "food". The Panel finds that such notes are not sufficient, and most likely self-serving, to establish the actual reason for the registration of the disputed domain name. In addition, the Panel notes that the disputed domain name is identical to Complainant's registered LIGHTONLINE mark, and resolved to a website featuring pay-per-click links to entities providing services competing with the Complainant's services (e.g., "Paulmann Éclairage"). Beyond the meeting notes, there is no evidence of Respondent's activities in connection with the disputed domain name.

Under the circumstances, even interpreting the evidence in the record in a light most favorable to Respondent, the Panel finds that Respondent has failed to rebut Complainant's *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Rather, the Panel finds that, in the absence of persuasive evidence to the contrary, a disputed domain name that is identical to Complainant's mark would be perceived as a direct reference to Complainant. Using the disputed domain name to host a parked page comprising PPC links that compete with or capitalize on the reputation and goodwill of Complainant's mark does not support Respondent's rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.9.

The Panel therefore finds that Complainant has established the second element, according to paragraph B11(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

Under paragraph B(11)(d)(1) of the ADR Rules, lack of rights or legitimate interests and registration or use in bad faith are considered alternative requirements. The Panel will proceed for the sake of completeness to analyze Respondent's bad faith.

Under paragraph B11(d)(1)(iii) of the ADR Rules, the registration or use of the disputed domain name in bad faith are considered alternate bases for a successful complaint. Complainant has submitted evidence showing that Respondent registered the disputed domain name several years after Complainant registered its mark in Europe. According to the evidence filed by Complainant, it has owned a registration for the LIGHTONLINE mark in the European Union since 2013 and regularly conducts business under this trademark. In addition, the Panel notes that Complainant operates several domain names consisting of its LIGHTONLINE mark registered with different Top-Level Domains, including <lightonline.fr>, <lightonline.com>, and <lightonline.de>. Regarding the latter, the Panel notes that ".de" is the ccTLD for Germany, where Respondent is located. While the Respondent claims that it was not aware of Complainant and did not target it when registering the disputed domain name, the Panel is very skeptical considering the circumstances of this case. However, in light of the Panel's finding above in regards Respondent's lack of rights or legitimate interests, and further to the below analysis on use of the disputed domain name in bad faith, the Panel finds it unnecessary to concretely decide on the matter of registration in bad faith.

The Panel, however, finds that Complainant has carried its burden in providing bad-faith use of the disputed domain name. It is undisputed that the disputed domain name resolved to a website featuring pay-per click links. Respondent cannot disclaim responsibility for content appearing on the website associated with its disputed domain name, and lacking any evidence of efforts to avoid links that target Complainant's mark, the Panel finds that this is evidence of bad faith use of the disputed domain name. See [WIPO Overview 3.0](#), section 3.5. Further, Respondent did not refute the evidence provided by Complainant that the disputed domain name was available for sale for a sum considerably exceeding the presumable costs of registering it. See [WIPO Overview 3.0](#), section 3.1.4.

Under these circumstances and on this record, the Panel finds that Respondent used the disputed domain name in bad faith, and that Complainant has established the third element, according to paragraph B11(d)(1)(iii) of the ADR Rules.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <lightonline.eu> be transferred to Complainant, which is a French legal entity and therefore satisfies the general eligibility criteria for registration set out in Article 4(2)(b) of Regulation (EC) No. 733/2002 as amended by Regulation (EU) 2019/517.¹

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: September 30, 2022

¹ The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.