

WIPO Arbitration and Mediation Center  
Zaak-/rolnummer: DNL2012-0005  
Datum: 30 mei 2012

### **1. The Parties**

The Complainant is Intertek Group Plc of London, United Kingdom of Great Britain and Northern Ireland (“United Kingdom”), represented by Melbourne IT Digital Brand Services, United Kingdom.

The Respondent is Beleid en Kwaliteit of Zwijndrecht, The Netherlands, internally represented.

### **2. The Domain Name and Registrar**

The disputed domain name <intertek.nl>, hereinafter the “Domain Name”, is registered with SIDN through Realtime Register.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 6, 2012. On February 7, 2012, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On February 8, 2012, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 10, 2012. In accordance with the Regulations, article 7.1, the due date for the Response was March 1, 2012. The Response was filed with the Center on February 13, 2012.

On February 20, 2012, SIDN commenced the mediation process. On March 21, 2012, SIDN extended the mediation process to April 20, 2012. On April 20, 2012, SIDN further extended the mediation process to May 20, 2012. On May 1, 2012, SIDN informed the parties that the dispute had not been resolved in the mediation process.

The Center appointed Richard C.K. van Oerle as the panelist in this matter on May 23, 2012. The Panel finds that it was properly constituted. The Panelist submitted the Statement of Acceptance and the Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

### **4. Factual Background**

The Panel will proceed on the facts as stated by the Complainant and not contested by the Respondent. Furthermore, the Panel will take into account the information provided by the Center and by SIDN.

The Complaint is based on, *inter alia*, Community Trademark registration number 003047099 for the word mark INTERTEK, filing date February 11, 2003, held by the Complainant.

The Domain Name was first registered on February 11, 2000. The date of registration of the Domain Name by the Respondent is April 25, 2007.

### *Use of the Domain Name*

The Domain Name currently shows the homepage of Starhosting, a hosting company that is also listed as Administrative Contact and Technical Contact for the Domain Name.

## **5. Parties' Contentions**

### *A. Complainant*

The INTERTEK mark is in possession of substantial inherent and acquired distinctiveness. The awareness of the trademark INTERTEK is considered to be significant in the whole Community. The protection for INTERTEK goes far beyond the goods and services protected through trademark registrations.

The Complaint is also based on rights in a trade name of a local company of the Complainant in The Netherlands that has been doing business under the name "Intertek Testing Services" since 1997, and a second local company called "Intertek Holdings Nederland B.V." since October 3, 1996. ITS Caleb Brett Nederland BV is the only shareholder of Intertek Holdings Nederland B.V.

In addition to the above ITS Caleb Brett Nederland BV is also doing business under the trade name "Intertek Testing Services".

According to the Complainant, the Domain Name is confusingly similar to the Complainant's registered trademark INTERTEK and trade name "Intertek". The entire Domain Name is comprised of the distinctive part of all of the Complainant's registered trademarks and businesses. The registered business in The Netherlands has the mark INTERTEK as a dominant part of its trade name.

The Complainant submits that the Respondent has no rights to or legitimate interests in the Domain Name. The Complainant has not found that the Respondent has any registered trademarks or trade names corresponding to the Domain Name. The Complainant has also not found anything that would suggest that the Respondent has been using INTERTEK in any other way that would give them any rights or legitimate interests in the name. The Complainant contends that the Respondent has not been commonly known by the Domain Name. The Respondent's failure to respond to the cease and desist letter indicates that the Respondent lacks rights and legitimate interests in the Domain Name. It is also clear that no license or authorization has been given by the Complainant to the Respondent to use the INTERTEK mark in the Domain Name.

The Complainant further argues that the Domain Name has been registered or is being used in bad faith.

The Complainant first tried to contact the Respondent through a cease and desist letter. The Complainant advised the Respondent that the unauthorized use of the INTERTEK trademark within the Domain Name violated the Complainant's rights in said trademark and offered compensation for the expenses of registration and transfer fees (not exceeding out of pocket expenses). No response was received.

Mr. H. Palte, the owner of the Respondent named in the Complaint, was employed by the Complainant until 2003. Therefore the Respondent is clearly aware of the Complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the Domain Name and any potential rights of the Complainant. Thus bad faith can be found.

### *B. Respondent*

According to the Respondent, the Dutch subsidiary of the Complainant requested to transfer the Domain Name to Intertek Netherlands. The Respondent requested an appropriate

transfer price, but an aggressive telephone call from the Intertek IT manager in The Netherlands proved that they were not willing to pay an appropriate transfer price for the Domain Name. The Respondent submits that “under normal communication skills of Intertek Netherlands”, the parties would have found an appropriate way to resolve this issue.

## 6. Discussion and Findings

Based on article 2.1 of the Regulations, a request to transfer a domain name must meet three cumulative conditions:

- A. The domain name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the complainant has rights, or other name by means of article 2.1(a) under II of the Regulations; and
- B. The respondent has no rights to or legitimate interest in the domain name; and
- C. The domain name has been registered or is being used in bad faith.

Considering these conditions, the Panel rules as follows:

### A. Identical or Confusingly Similar

The Complainant has established that it is the owner of a Community Trademark registration for INTERTEK. Numerous .nl panels have found that a domain name that wholly incorporates a complainant’s registered mark may be sufficient to establish confusing similarity for the purposes of the Regulations. (See, e.g., *Stichting VVV Groep Nederland v. C. Henriquez*, WIPO Case No. DNL2008-0040). The Domain Name <intertek.nl> incorporates the entirety of the INTERTEK trademark.

It is established case law that the top level domain “.nl” may be disregarded in assessing the similarity between the relevant trademark on the one hand, and the domain name on the other hand (see: *Caterpillar Inc. v. H. van Zuylen Materieel*, WIPO Case No. DNL2011-0073; *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

As the Complainant’s trademark rights are sufficient to fulfil the first requirement of the Regulations, the Panel shall not address the extent to which the Complainant may be able to invoke rights in relevant trade names in this case.

The Panel finds that the Domain Name is identical to the Complainant’s trademarks within the meaning of article 2.1(a) of the Regulations. Therefore the first criterion is met.

### B. Rights or Legitimate Interests

According to article 2.1(b) of the Regulations, the Complainant must demonstrate that the Respondent has no rights to or legitimate interests in the Domain Name. This condition is met if the Complainant makes a *prima facie* case that the Respondent has no rights or legitimate interests, and the Respondent fails to rebut that showing, by, for example, providing evidence of one of the three circumstances mentioned in article 3.1 of the Regulations (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd*, WIPO Case No. DNL2008-0002 and *LEGO Juris A/S v. M. Moench*, WIPO Case No. DNL2009-0052).

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Panel understands that the Complainant has not licensed or otherwise authorized the Respondent to use the INTERTEK trademark. The Panel could not find any indication in the Response or elsewhere in the record that the Respondent, before having been notified of the dispute, made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services (Regulations, article 3.1(a)), is commonly known by the Domain Name (Regulations, article 3.1(b)), or is making a legitimate noncommercial use of the Domain Name

(Regulations, article 3.1(c)), nor could the Panel find any other indication that might give rise to rights or legitimate interests on part of the Respondent.

Consequently, the Panel concludes that the Respondent has no rights to or legitimate interests in the Domain Name.

For these reasons, the Panel finds that the Complainant has satisfied article 2.1(b) of the Regulations.

#### *C. Registered or Used in Bad Faith*

Pursuant to article 2.1(c) of the Regulations, the Complainant must assert and establish that the Domain Name has been registered or is being used in bad faith.

The Panel is satisfied that the Domain Name has been registered in bad faith. The Complainant has noted that the Respondent's owner is a former employee of the Complainant. The Respondent notably has not denied this. As such, it may reasonably be inferred that the Respondent registered or acquired the Domain Name with actual knowledge of and intent to target the Complainant's trademark (see *Stanworth Development Limited v. Traffic Label Limited*, WIPO Case No. D2011-0683).

The Respondent does not use the Domain Name in any way since the Domain Name resolves to the homepage of a hosting company, but is not prepared to transfer the Domain Name unless an "appropriate transfer price" is paid. Taking also into account that the Respondent had actual knowledge of and intent to target the Complainant's trademark, and the Respondent has provided no evidence whatsoever of any actual or contemplated good-faith use by it of the Domain Name, the Panel finds that this type of holding can be considered as use in bad faith.

The Panel concludes that the Domain Name has been registered and is being used in bad faith.

The Panel therefore rules that the Complainant has met the third element of the Regulations as set out in article 2.1(c).

## **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name <intertek.nl> be transferred to the Complainant.

**Richard C.K. van Oerle**

Panelist

Dated: May 30, 2012

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