

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2015-0020
Datum: 2 juni 2015

1. The Parties

Complainant is Tecfrigo S.p.A. of Castelnuovo Sotto, Italy, represented by Contino Ed Associati, Italy.

Respondent is Handelonderneming V. of Ottoland, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <tecfrigo.nl> (the “Domain Name”) is registered with SIDN through Cronon AG.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 1, 2015. On April 1, 2015, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On April 2, 2015, SIDN 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 Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 8, 2015. In accordance with the Regulations, article 7.1, the due date for Response was April 28, 2015. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 29, 2015.

The Center appointed Paul L. Reeskamp as the panelist in this matter on May 13, 2015. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

Complainant is an Italy-based company that manufactures and supplies machinery, equipment and tools for the preservation and display of foods, from refrigerated to heated. Complainant sells and delivers its products throughout Europe, including the Netherlands.

Complainant is the proprietor of several trademarks, under which the following trademark registrations, which are also valid in the Netherlands;

TECFRIGO, word/device mark, International Registration with a designation for inter alia the Benelux, with registration no. 523236, registered on May 12, 1988 in class 11 (refrigeration apparatus, including refrigerating cabinets and refrigerated showcases, heated display cases);

COLD ENGINEERING TECFRIGO, Community word/device trademark, with application No. 002585792, registered on March 31, 2003 in class 11 (refrigeration apparatus, including refrigerating cabinets and refrigerated showcases, heated display cases).

These trademarks will hereafter be referred to jointly as: the "Trademarks".

Furthermore, Complainant operates the website "www.tecfrigo.com".

Respondent registered the Domain Name on March 12, 2005. The Domain Name resolves to a website where refrigerated and heated display cases and related products are offered for sale.

5. Parties' Contentions

A. Complainant

Complainant seeks the transfer of the Domain Name from Respondent to Complainant in accordance with the Regulations.

The Domain Name is identical or confusingly similar to the Trademarks

Complainant contends that the Domain Name is identical or confusingly similar to the Trademarks.

Complainant argues that the Domain Name is used by Respondent in connection with (the offering of) the same kind of goods for which the Trademarks are registered.

Respondent has no rights or legitimate interests in the Domain Name
Complainant contends that Respondent has no rights or legitimate interests in the Domain Name.

Complainant has not provided Respondent with a license or authorization to use its Trademarks for a domain name registration.

The Domain Name has been registered or is being used in bad faith by Respondent
Complainant argues that Respondent has registered and used the Domain Name in bad faith. According to Complainant, Respondent was very much aware of Complainant, its products and its Trademarks at the time of registration of the Domain Name and during the use it has made of the Domain Name, as both Complainant and Respondent are active in the same market.

Regarding the bad faith use of the Domain Name, Complainant alleges that it is clear that Respondent intends to take advantage of the notoriety of Complainant in the market and of the reputation of its products, and that it simultaneously aims to create confusion in the market. On the website under the Domain Name, Respondent offers products from Complainant's competitors similar to those offered by Complainant under the Trademarks.

Also, Complainant argues that Respondent uses the Domain Name to deliberately create a likelihood of confusion with Complainant's Trademarks, for the sole purpose of generating commercial gain by intentionally taking advantage of the Internet traffic generated by the Trademarks.

Finally, Complainant, states that the fact that Respondent has not responded to Complainant's (and its counsel's) numerous letters and reminders also contributes to the finding of bad faith on part of the Respondent.

B. Respondent

Respondent has not replied to the Complainant's contentions.

6. Discussion and Findings

Article 10.3 of the Regulations provides that in the event that a respondent fails to submit a response, the complaint shall be granted unless the panelist considers it to be without basis in law or fact.

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

- a. the disputed 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 interests in the domain name;
- 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

There are two requirements that a complainant must establish under the first criterion, being i) that it has rights in a trade name or trademark protected under Dutch law, and ii) that the domain name is identical or confusingly similar to such trade name or trademark.

Complainant founds its Complaint on an International Trademark Registration and a Community Trademark and has submitted copies of the trademark registrations from which follows that it is the holder of these Trademarks. The Trademarks are protected under Dutch law.

It is established case law that the Top-Level Domain ".nl" may be disregarded in assessing the similarity between the relevant trademark(s) on the one hand, and the disputed domain name on the other (see, e.g., Pieter de Haan v. Orville Smith Ltd., WIPO Case No. DNL2008-0017, confirmed in, inter alia, Egon Zehnder International B.V. v. Lotom Group S.A., WIPO Case No. DNL2011-0012).

The Domain Name must be compared to the Trademarks in their entirety. In this regard it must be noted that both the Trademarks are combined word/device marks, featuring not only the word element "tecfrigo".

The TECFRIGO word/device mark also comprises a figurative element configured out of a black square with curved corners, in which two separate white elements are depicted which run parallel to each other from the bottom (middle-section) of the square in a straight line, towards the middle of the square and then up to the respective top corners thereof, where the lines gradually widen into a white flat, creating a white, "Y"-shaped form, against an otherwise black background.

The COLD ENGINEERING TECFRIGO word/device mark also comprises a figurative element, which has largely the same features of the figurative element of the TECFRIGO word/device mark, albeit that in this form the white elements create a white "V"-shape against a black background. Furthermore, the COLD ENGINEERING TECFRIGO mark also comprises the word elements "cold engineering", which are placed between the figurative element (above) and the "Tecfrigo" word element (below).

Having established these facts, the Panel notes that since the figurative or graphic part of a trademark cannot be translated into a domain name, such elements may be disregarded for the purpose of assessing identity or confusing similarity, such assessment is generally between the alpha-numeric components of the domain name and the dominant textual components of the relevant mark (reference is made to paragraph 1.11 of the WIPO Overview of WIPO Panels Views on selected UDRP Questions, second edition, 2011).

Consequently, the Panel is satisfied that the Domain Name is confusingly similar – at least – to the TECFRIGO word/device mark. The word “tecfrigo” is a prominent part of this trademark and the Panel considers that those familiar with the mark would be likely to assume that the Domain Name locates a website of its proprietor (comparison can be made to Comservice SA v. Mdnh Inc., Brendhan Height, WIPO Case No. D2010-1591).

This alone means that the first requirement of article 2.1(a) of the Regulations is met.

The Panel is thus not required to proceed and consider the (level of) similarity of the Domain Name and the COLD ENGINEERING TECFRIGO word/device mark, the Panel considers that also with regard to this trademark and for the aforementioned reasons, the Domain Name is confusingly similar to this trademark. Because the words “cold engineering” must be considered to be descriptive for the goods and services offered by Complainant under this trademark the word “tecfrigo” may be considered the dominant word element in this trademark.

B. Rights or Legitimate Interests

Pursuant to article 2.1(b) of the Regulations Complainant must demonstrate that Respondent has no rights to or legitimate interests in the Domain Name. This condition is met if Complainant makes a prima facie case that Respondent has no such rights or interests, and Respondent fails to rebut this (see for example Technische Unie B.V. and Otra Information Services v. Technology Services Ltd., WIPO Case No. DNL2008-0002, confirmed in, inter alia, Nutri-Akt b.v. v. Edoco LTD., WIPO Case No. DNL2011-0003).

According to the Complaint, the fact that Complainant is the sole proprietor of the Trademarks indicates that Respondent does not have any relevant trademark or trade name rights regarding the word “Tecfrigo”. Moreover, it also follows from the Complaint that Respondent is not affiliated to Complainant and that Respondent has not received consent to use the Trademarks. Respondent uses the Domain Name to offer for sale products of competitors of Complainant. Such use is not a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name.

Respondent has not disputed the above, and the Panel could not establish any indications that any of the circumstances as described in article 3.1 of the Regulations apply, nor that Respondent in any possible other way has a right to or legitimate interests in the Domain Name. In particular, the Panel notes that the Domain Name is being used not only to attract buyers to Complainant’s product, but also to competing products offered by third parties. The Panel is therefore satisfied that Respondent has no rights to or legitimate interests in the Domain Name (HRB Royalty, Inc. v. Charlenia Owens, WIPO Case No. D2007-1656).

C. Registered or Used in Bad Faith

The registration date of the Trademarks predates the Domain Name registration. Given this fact as well as Complainant’s uncontested statement that both parties operate in the same market and offer/sell the same goods and services, the Panel is of the opinion that Respondent was or must have been aware of Complainant and the use of the Trademarks at the time of the registration.

Furthermore, when taking into account that the website under the Domain Name is used to offer for sale products and services of competitors of Complainant, which products and services are also identical, or highly similar to the products and services for which the Trademarks are registered, the Domain Name can be considered as being used for commercial gain, by attracting Internet users to Respondent's website, through the likelihood of confusion that may arise with the Trademarks. This constitutes improper use of Complainant's Trademarks (see for example J. Choo Limited v. Lai Ruipao, WIPO Case No. D2011-1074).

Given the above, the Panel holds that the Domain Name has been registered and is being used in bad faith. The third criterion is therefore also met.

7. Decision

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

Paul L. Reeskamp
Panelist