

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2015-0062
Datum: 8 december 2015

1. The Parties

The Complainant is Rolls Royce Motor Cars Limited of Hampshire, United Kingdom of Great Britain and Northern Ireland, represented by Simmons & Simmons, the Netherlands.

The Respondent is [persoonsnaam] of Shanghai, China.

2. The Domain Name and Registrar

The disputed domain name <rolls-roycemotorcars.nl> (the "Domain Name") is registered with SIDN through E-Nom Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 29, 2015. On October 29, 2015, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On October 30, 2015, 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 October 30, 2015. In accordance with the Regulations, article 7.1, the due date for Response was November 19, 2015. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 20, 2015.

The Center appointed Wolter Wefers Bettink as the panelist in this matter on November 24, 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

The Complainant owns inter alia the Community trade mark ROLLS-ROYCE MOTOR CARS (Reg. No. 010206233), registered on January 24, 2012 and the Community trade mark ROLLS-ROYCE (Reg. No. 003384071), registered on March 2, 2005 (hereafter the "Trade Marks").

Created in 1904, the ROLLS-ROYCE mark is one of the most recognized brands in the world.

The Domain Name was registered by the Respondent on October 7, 2015. The Domain Name resolves to a website displaying pay-per-click links, containing an advertisement for "The Real Car Co Ltd." "Specialist in early Rolls-Royce and Bentley cars", as well as links to various websites offering, inter alia, "Rolls-Royce" and "Bentley" parts, "USA classic & exotic cars" and various job offers and vacancies in diverse industries.

The website connected to the Domain Name contains the logo of "sedo.com", a reseller of domain names, which links to a page on the "sedo.com" website where the Domain Name is offered for sale for EUR 8,500.

On October 21, 2015, the Respondent sent an e-mail to the Complainant with the following text:

"I have a domain name: rolls-roycemotorcars.nl you may be interested in. Please reply back at your earliest convenience, or visit <http://www.rolls-roycemotorcars.nl> to make your offer."

5. Parties' Contentions

A. Complainant

The Complainant submits that the Domain Name is identical or confusingly similar to the Trade Marks because it comprises the Trade marks in their entirety, which greatly increases the likelihood of confusion between the Domain Name and the Trade Marks.

According to the Complainant, the Domain Name is not being used in connection with a bona fide offering of goods and services nor does it constitute a legitimate noncommercial or fair use, since the Domain Name is connected to a pay-per-click parking website which contains sponsored-link advertisements for directly competing and other commercial websites.

The Complainant points out that there is no evidence in the record, including the Whois information, to demonstrate that the Respondent is commonly known by the Domain Name, while it is not a licensee of the Complainant, nor has the Complainant authorized the Respondent to register or use the Domain Name.

The Complainant further forwards that, in view of the reputation of the Trade Marks, the Respondent was, or must be considered to be, aware of the Complainant and the Trade Marks and therefore the Respondent must have consciously and deliberately adopted the same in the Domain Name.

In addition, the Complainant states, the Domain Name is offered for sale, as evidenced by the e-mail of October 21, 2015 and by the link on the website connected to the Domain Name to a website where it is offered for sale for an amount of EUR 8,500. It follows, the Complainant submits, that the Respondent acquired the Domain Name primarily for the purpose of selling the same for valuable consideration in excess of documented out-of-pocket costs directly related to the registration thereof.

The Complainant points out that the Respondent was involved as a respondent in fourteen previous UDRP¹ decisions in which the UDRP panels ruled that the Respondent had registered and used the domain names in question in bad faith. According to the Complainant this shows that the Respondent engages in a pattern of conduct of registering domain names comprising well-known trademarks of third party brand owners (including, e.g., BASF, GUCCI, L'ORÉAL, PORSCHE and REMY MARTIN) without their authorization or approval, in order to sell them for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name and/or to unlawfully profit from (parked) domain monetization.

In addition, the Complainant submits, registration and use of the Domain Name constitute bad faith under article 2.1(c) and 3.2(d) of the Regulations because the Respondent uses

¹ The mechanism of the Regulations is in part comparable to the Uniform Domain Name Dispute Resolution Policy ("UDRP").

the Domain Name to intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, and/or endorsement of the Respondent's activities and/or the pay-per-click (parking) website associated with the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

The Respondent filed no response and the Complainant's claims were uncontested as such. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or fact.

A. Identical or Confusingly Similar

The Complainant has shown that it has rights in the Trade Marks, which are famous worldwide.

The Trade Marks consist of or contain the name "Rolls-Royce", which forms the dominating element of the Domain Name (including the hyphen), while the trade mark "Rolls-Royce Motor Cars" is incorporated in its entirety in the Domain Name. The country code Top-Level Domain .nl is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see, inter alia, Roompot Recreatie Beheer B.V. v. Edoco LTD, WIPO Case No. DNL2008-0008).

Therefore, the Panel finds that the Domain Name is identical or, in any case, confusingly similar to the Trade Marks.

B. Rights or Legitimate Interests

The Complainant has to make out a prima facie case that the Respondent does not have rights to or legitimate interests in the Domain Name. There is no evidence that the Respondent is commonly known by the Domain Name or that it has acquired trade mark rights in the name "Rolls-Royce". Furthermore, the evidence before the Panel shows that the Domain Name is connected to a pay-per-click parking website which contains sponsored links to websites offering competing products and services, which does not constitute use in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use of the Domain Name.

In view of the above, the Panel concludes that the Respondent has no rights to or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

In view of the world-wide reputation of the Trade Marks, it is inconceivable that at the time of the registration of the Domain Name the Respondent was not aware of the Complainant's rights in the Trade Marks. In addition, the name "Rolls-Royce", which is incorporated in its entirety in the Domain Name, is not a name that a person wishing to register a domain name would accidentally think of.

Furthermore, a simple trade mark register search prior to the registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

On these grounds, the Panel assumes that at the time of registration of the Domain Name the Respondent was or should have been aware of the Trade Mark.

Under these circumstances, the Panel concludes that the Domain Name has been registered in bad faith.

For completeness' sake – although this is not necessary for a complainant to prove its case under the Regulations – the Panel has also considered whether there is bad faith use of the Domain Name. This is indeed the case. Firstly, the fact that the Domain Name is connected to a website containing advertisements for and hyperlinks to websites offering products of competitors of the Complainant (such as Bentley), clearly indicates that the Domain Name has been or is being used for commercial gain, by attracting Internet users to a website of the Respondent through the likelihood of confusion which may arise with the Trade Marks, as to, for example, the source, sponsorship, affiliation or endorsement of the website of the Respondent or of products or services on the Respondent's website (article 3.2(d) Regulations). Secondly, the invitation by e-mail of October 21, 2015 – two weeks after the Respondent registered the Domain Name – "to make your offer" for the Domain Name and the sale offer for EUR 8,500 on a web page connected to the website to which the Domain Name resolves are evidence that the Respondent the Domain Name has been registered or acquired primarily for the purpose of selling, renting or transferring it to the Complainant or to the Complainant's competitors for valuable consideration in excess of the cost of registration (article 3.2(a) Regulations).

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

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <rolls-roycemotorcars.nl> be transferred to the Complainant.

Wolter Wefers Bettink

Panelist

Date: December 8, 2015