

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2016-0001
Datum: 4 februari 2016

1. The Parties

The Complainant is The Procter & Gamble Company of Cincinnati, Ohio, United States of America, represented by Bakker & Verkuijl B.V., the Netherlands.

The Respondent is [persoonsnaam] of Leiden, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <crestwhiteshop.nl> (the “Domain Name”) is registered with SIDN through The Registrar Company B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2016. On January 5, 2016, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On January 6, 2016, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 January 7, 2016. In accordance with the Regulations, article 7.1, the due date for Response was January 27, 2016. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 28, 2016.

The Center appointed Willem J.H. Leppink as the panelist in this matter on February 3, 2016. 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 the following Community Trade Mark (“CTM”) registrations:

- CTM CREST, registered on February 28, 2000 with registration number 273201;
- CTM CREST, registered on August 27, 2003 with registration number 1843630;
- CTM CREST, registered on January 29, 2007 with registration number 4772075;
- CTM CREST WHITESTRIPS PREMIUM, registered on January 24, 2007 with registration number 3142858.

In this decision these trademarks will also be referred to as the “Trademarks”.

The Domain Name was registered by the Respondent on July 26, 2013. The Domain Name resolves to a website where teeth whitening products are offered for sale. The predominant language of the website is Dutch.

5. Parties’ Contentions

A. Complainant

The Complainant contends the following.

The Complainant is the owner of the Trademark, to which the Domain Name is confusingly similar. The Respondent has no rights or legitimate interests in the Domain Name. The Domain Name is confusingly similar to the trademark CREST and CREST WHITESTRIPS PREMIUM, since it consists of the trademark CREST, the word white, which is a part of the trademark CREST WHITESTRIPS PREMIUM, and the descriptive and non-distinctive word "shop".

The Domain Name is not used in a legitimate, noncommercial and honest manner. The products sold on the website behind the Domain Name are teeth whitening products, which are products currently forbidden on the European Union ("EU") market, under EU Regulation 1223/2009, since the products concerned contain more than 0,1% hydrogen peroxide (H₂O₂).

The Respondent does not have rights in the Trademarks or other trademarks comprising the word crest, or any other similar trademark. The Respondent is not generally known under the name "Crestwhiteshop" either.

The Domain Name has been registered with the sole purpose of selling unauthorized products, the sale of which is forbidden under the mentioned EU Regulation. The Domain Name was registered in 2013, after the EU Regulation became effective. Besides, the Respondent has been informed that the unauthorized sale of teeth whitening products is an offense of applicable laws and regulations.

The Trademarks have all been registered before the Domain Name is registered.

By using the Domain Name for the sale of products that are not admitted on the EU market, the Respondent disturbs the legitimate activities of the Complainant under the Trademarks, namely the sale of products that are compliant with relevant legislation.

B. Respondent

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

6. Discussion and Findings

According to article 2.1 of the Regulations, for the Complaint to be successful in relation to the Domain Name the Complainant must prove that:

- (i) the Domain Name is identical or confusingly similar to a trademark or a trade name, protected under Dutch law in which complainant has rights; or a personal name registered in the General Municipal Register ("gemeentelijke basisadministratie") of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the complainant undertakes public activities on a permanent basis; and
- (ii) the Respondent has no rights to or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

As the Respondent has not filed a response, the Panel shall rule on the basis of the Complaint. 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 in fact.

A. Identical or Confusingly Similar

Pursuant to article 2.1(a) of the Regulations, the Complainant must establish that the Domain Name is identical or confusingly similar to a trademark or trade name in which the Complainant has rights.

The Panel finds that the Domain Name is confusingly similar to the Trademark. The Domain Name incorporates the trademark CREST in its entirety and also an important portion of the trademark CREST WHITESTRIPES PREMIUM. The addition of the descriptive element “shop” does not take away the confusing similarity.

The Complainant has therefore established the first element of article 2.1 of the Regulations.

B. Rights or Legitimate Interests

Pursuant to article 3.1 of the Regulations, the Complainant must demonstrate that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent may demonstrate such rights or legitimate interests on its part inter alia through the following circumstances:

- a. before having any notice of the dispute, the [Respondent] made demonstrable preparations to use the Domain Name (or a name corresponding to the domain name) in connection with a bona fide offering of goods and services;
- b. the [Respondent] as an individual, business or other organization is commonly known by the Domain Name;
- c. the [Respondent] is making a legitimate noncommercial use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish or otherwise damage the relevant trademark, trade name, personal name, name of a Dutch public legal entity or name of an association or foundation located in the Netherlands.

The Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name.

Whether the Respondent is using the Domain Name in connection with a bona fide offering of goods or services, has to be assessed in light of the decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, which decision has been rendered under the Uniform Domain Name Dispute Resolution Policy¹ (“UDRP”) and which decision has been confirmed to be of relevance for the Regulations, inter alia in *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024 and *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No. DNL2011-0074.

Pursuant to this test, to be bona fide the offering must meet several requirements. These include, at minimum, the following:

- the respondent must actually be offering the goods or services at issue. See, e.g., *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles*, WIPO Case No. D2000-1306;

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

- the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods. *Nikon, Inc. and Nikon Corporation v. Technilab, Inc.*, WIPO Case No. D2000-1774;

- the site must accurately disclose the respondent's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents. See, e.g., *Houghton Mifflin Co. v. The Weatherman, Inc.*, WIPO Case No. D2001-0211; *R.T. Quaife Engineering, Ltd. and Autotech Sport Tuning Corporation d/b/a Quaife America v. Bill Luton*, WIPO Case No. D2000-1201; and *Easy Heat, Inc. v. Shelter Products.*, WIPO Case No. D2001-0344;

- the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name. See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525.

Oki Data furthermore confirms that the above criteria are non-limitative and that other indications relevant to the legitimacy of respondents' conduct may be taken into account.

In the present case the Panel notes that the website under the Domain Name prima facie meets three of the above requirements, but not the requirement that it has to accurately and prominently disclose the Respondent's relationship with the Complainant.

The Panel considers that such failure by the Respondent to actively and prominently disclose its relationship with the Complainant is all the more relevant to this case in light of the Complainant's substantiated claim that the sale of the products offered on the website linked to the Domain Name is forbidden under EU Regulation 1223/2009. The Panel finds that such use cannot be considered bona fide.

Accordingly, noting the Respondent's failure to contest the foregoing, the Panel finds that the Respondent lacks rights to or legitimate interests in the Domain Name.

The Complainant has thus established the second element of article 2.1 of the Regulations.

C. Registered or Used in Bad Faith

The Panel refers to its considerations under 6.B.

In light of those considerations and the lack of a Response, the Panel finds that the Domain Name has been registered and used in bad faith. The Respondent has used the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion which may arise with the Trademark as to the source, sponsorship and endorsement of the website.

This constitutes evidence of bad faith registration and use in accordance with article 3.2(d) of the Regulations.

Therefore, the Panel finds that the Complainant has also established the third element of article 2.1 of the Regulations.

7. Decision

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

Willem J. H. Leppink
Panelist