

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2016-0045
Datum: 29 september 2016

1. The Parties

The Complainant is United Parcel Service of America, Inc. of Atlanta, Georgia, United States of America, represented by Knijff, the Netherlands.

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

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2016. On August 17, 2016, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On August 18, 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 response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint on August 22, 2016. 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 August 23, 2016. In accordance with the Regulations, article 7.1, the due date for Response was September 11, 2016. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2016.

The Center appointed Willem J. H. Leppink as the panelist in this matter on September 26, 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 following facts are undisputed:

The Complainant was founded in 1907 and is one of the world's largest package delivery companies and the leading provider of specialized transportation and logistics services. The Complainant offers and provides in the United States of America and worldwide various goods and services, including, but not limited to, transportation services, logistics services, freight services, shipping services, franchising services and retail services, and associated products under the UNITED PARCEL SERVICE trademark.

The Complainant has over 9.8 million pickup and delivery customers in over 220 countries and territories. In 2014, the Complainant delivered an average of 18 million packages and documents per day worldwide.

The Complainant is the owner of a substantial number of registrations for the UNITED PARCEL SERVICE trademark throughout the world, including but not limited to European Union Trade Mark, registration no. 442467, registered on April 7, 1999 and Benelux Trade Mark, registration no. 337480, with a filing date of January 19, 1976. These trademarks will in singular be referred to as the "Trademark". Furthermore, the Complainant is also the owner of a number of registrations for the UPS UNITED PARCEL SERVICE word/device mark.

Furthermore, the Complainant owns and operates in connection with its goods and services the domain name <unitedparcelservice.com>.

The Domain Name was first registered on April 4, 2012. The Respondent registered the Domain Name on June 18, 2014. As evidenced by the Complainant, the Domain Name, which is currently inactive, used to resolve to a website offering package delivery services of both the Complainant and its competitors, as well as various forms of unrelated advertisements.

5. Parties' Contentions

A. Complainant

Insofar as relevant, the Complainant contends the following.

The Domain Name incorporates the Trademark in its entirety. The Domain Name was registered long after the Trademark became famous worldwide, and approximately 25 years after the Complainant registered the Trademark in the Netherlands.

The Complainant became aware of the Respondent's registration and use of the Domain Name in September 2015. At that time, the Domain Name resolved to a page titled "PakketService Online" displaying a photograph of one of the Complainant's trademarks. The website behind the Domain Name promoted the Respondent's reselling services in connection with shipping services of the Complainant's competitors.

The Respondent does not have permission from the Complainant to use the Trademark, nor is the Respondent commonly known by the Domain Name. Nothing in the Respondent's Whois information or the record demonstrates that the Respondent is commonly known by the Domain Name. The Complainant has not authorized the Respondent to use the Trademark.

The Respondent registered and used the Domain Name to promote the Respondent's reselling services, not only in connection with the Complainant's shipping services but also shipping services of the Complainant's competitors.

The Respondent's registration and use of the Domain Name was to divert the attention of Internet users to competitive services and therefore not legitimate.

The Respondent registered the Domain Name in 2012, several decades after the Trademark was registered in the Netherlands and worldwide. The Respondent is in the shipping services business and knew about the Complainant's Trademark when the Respondent registered the Domain Name.

The Respondent used the Domain Name to attract and divert Internet traffic to the Respondent's website, offering not only the Complainant's services but also competing services to those of the Complainant, for the purpose of achieving commercial gain, through the likelihood of confusion which may arise with the Complainant's Trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. Such conduct constitutes in bad faith.

The Respondent demanded a "nice offer" in order to transfer the Domain Name to the Complainant. In response to the Complainant's offer to pay the nominal transfer fee, the Respondent said that it would transfer the Domain Name only if the compensation were sufficient, and would otherwise sell the Domain Name to a foreign company. The Respondent later demanded EUR 5,000 for the transfer of the Domain Name, claiming another party had already offered EUR 4,000. This suggests that the Respondent registered the Domain Name primarily to sell, rent, or otherwise transfer it for valuable consideration in excess of the Respondent's registration expenses, which constitutes registration or use in bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to article 2.1 of the Regulations the Complainant must prove each of the following three elements:

a. the Domain Name is identical or confusingly similar to:

I) a trademark or trade name protected under Dutch law in which the Complainant has rights; or

II) 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

b. the Respondent has no rights to or legitimate interests in the Domain Name; and

c. 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) under I 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 identical to the Trademark as the Domain Name incorporates the Trademark in its entirety.

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

B. Rights or Legitimate Interests

Pursuant to article 2.1 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 listed in article 3.1 of the Regulations:

- 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 or 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. The Complainant has established that the Respondent is not commonly known by the Domain Name and that the Respondent is not authorized to use the Trademark.

Whether the Respondent, which appears to view itself as a reseller, is or was 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*

¹ While the Complaint is brought under the Regulations, and not the UDRP, given the similarities between the two, where applicable the Panel considers UDRP precedent relevant to the current proceedings, and will refer to it throughout.

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;
- 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. See, e.g., 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, e.g., 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 original website under the Domain Name does not meet two of the above requirements. First, the Respondent has not used the site to offer only the trademarked services, in fact has used the Trademark to bait Internet users and switch them to inter alia its competitors' services.

Second, the Respondent does not meet the requirement that the website has to accurately and prominently disclose the Respondent's (lack of) relationship with the Complainant.

The Panel therefore finds that the Domain Name was not used in connection with a bona fide offering of goods or services.

Whatever the present status of the website, the Panel further notes that the Respondent has made demands to sell the Domain Name in a manner which cannot constitute a right to or legitimate interest in the Domain Name.

Accordingly, also noting the Respondent's failure to contest the allegations, 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 Section 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.

Furthermore, the Panel notes that the Respondent offered to sell the Domain Name to the Complainant for a price that exceeds the cost of the registration thereof.

For the above reasons, 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, <unitedparcelservice.nl>, be transferred to the Complainant.

Willem J. H. Leppink

Panelist