

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2016-0060
Datum: 21 december 2016

1. Parties

The Complainants are “Dr. Martens” International Trading GmbH of Graefelfing, Germany and

“Dr. Maertens” Marketing GmbH of Seeshaupt, Germany (hereinafter jointly referred to as the “Complainant”), represented by Beetz & Partner, Germany.

The Respondent is [Verweerder]’s nets of Elmshorn, Germany.

2. The Domain Name and Registrar

The disputed domain name <drmartens-schoenen.nl> (the “Domain Name”) is registered with SIDN through Registrar.eu.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 11, 2016. On November 11, 2016, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On November 14, 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.

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 November 17, 2016. In accordance with the Regulations, article 7.1, the due date for Response was December 7, 2016. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 8, 2016.

The Center appointed Willem J. H. Leppink as the panelist in this matter on December 19, 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 is the owner of a number of registrations for the DR. MARTENS trademark in various countries, including but not limited to the European Union Trade Mark, registration no. 59147, registered on March 3, 1999, with a filing date of April 1, 1996 (the “Trademark”).

DR. MARTENS is a widely-known international brand for footwear, clothing and accessories, particularly renowned for its distinctive shoes and boots, first sold in the late 1950s.

The Domain Name was first registered, by the Respondent, on September 1, 2016. The Domain Name resolves to a website selling the Complainant's products (the "Website").

5. Parties' Contentions

A. Complainant

Insofar as relevant, the Complainant contends the following.

The Domain Name is phonetically highly similar to the Trademark. The Trademark is identical to the "dr martens" element in the Domain Name, being the distinctive part of the contested Domain Name. The mere addition of the element "schoenen" (which is Dutch for shoes) does not in any way prevent the likelihood of confusion in the minds of the relevant Internet users. The term "schoenen" refers to the kind of products offered by Complainant and is merely and clearly descriptive and the consumers will especially pay attention to the first characterizing element "drmartens".

The Respondent is not authorized to use the Domain Name for a website selling DR. MARTENS products. By doing this the Respondent is likely to mislead and deceive consumers that the Respondent has a commercial relationship with the Complainant. The Respondent is making false representations in that regard. The use of the Domain Name constitutes trademark infringement. The use of the Domain Name and the website to which the Domain Name resolves causes confusion as to the identity of the entity operating the Website. The Internet user will likely believe that the Website is operated by or under the control of the Complainant and therefore the Respondent attempts to pass itself off as the Complainant.

By choosing the Domain Name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Trademark as to the source, sponsorship or affiliation or endorsement of the Respondent's website.

The Respondent must have had knowledge of the Complainant's rights when it registered the Domain Name, since the Trademark is well-known. The Respondent acted in bad faith when registering the Domain Name because of the longstanding advertisement and marketing of goods and services under the Trademark. The addition of the descriptive term "schoenen" to the element "drmartens" implies that the Complainant had knowledge of the Trademark.

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 Complainant has shown that it has rights in the Trademark.

The Domain Name incorporates the Trademark in its entirety (without the period) and adds the word “schoenen” (which translates to “shoes” in English), connected by a hyphen. The Panel finds that the dominant part of the Domain Name is “drmartens” and that the element “schoenen” is descriptive.

The Panel finds that the Domain Name is confusingly similar to the Trademark for purposes of the Regulations. As the Trademark is known for in particular shoes and boots, the inclusion of the descriptive element “schoenen” even adds to the confusing similarity between the Trademark and the Domain Name.

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 alleges that the Respondent has no rights or legitimate interests in the disputed domain name for the reasons listed above under Section 5.A. The Panel is satisfied that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name.

If and to the extent the Respondent may be considered to be a reseller, the question whether it is using the Domain Name in connection with a bona fide offering of goods or services is to be assessed in light of the decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. Having been rendered under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) this 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;

- 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 Website fails to accurately and prominently disclose the Respondent's (lack of) relationship with the Complainant.

The Panel further notes that, in accordance with article 16.4 of the Regulations, the Center has fulfilled its obligation to employ reasonably available means to achieve actual notice of the Complaint to the Respondent; the Center even used the "contact us" form on the Website. However, the Written Notice to the postal address as provided to SIDN by the Respondent at registration of the Domain Name was undeliverable. The Panel also notes that no response has been submitted, that no address or commercial register details are included in the contact details on the Website and that the Respondent's email address appears to bear no particular connection to the stated business. The Panel considers that these circumstances cast doubt on the authenticity of the Respondent's operations for purposes of the Regulations.

Accordingly, the Panel is not convinced that the Domain Name was used in connection with a bona fide offering of goods or services, and in any event concludes that the Respondent fails the Oki Data test.

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.

The Panel finds that the Respondent has used the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the 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.

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

7. Decision

For the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name, <drmartens-schoenen.nl>, be transferred to the Complainant "Dr. Martens" International Trading GmbH.

Willem J. H. Leppink

Panelist

Date: December 21, 2016