

WIPO Arbitration and Mediation Center**ADMINISTRATIVE PANEL DECISION****Carapelli Firenze S.p.A. v. Parnassia Holding b.v.****Case No. DNL2018-0008****1. The Parties**

Complainant is Carapelli Firenze S.p.A. of Tavarnelle Val di Pesa, Italy, represented by Herrero & Asociados, Spain.

Respondent is Parnassia Holding b.v. of Utrecht, Netherlands, self-represented.

2. The Domain Name and Registrar

The disputed domain name <carapelli.nl> (the “Domain Name”) is registered with SIDN through XS4ALL Internet B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 19, 2018. On the same day, the Center transmitted by e-mail to SIDN a request for registrar verification in connection with the disputed domain name. On February 20, 2018, SIDN transmitted by e-mail 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 February 23, 2018. In accordance with the Regulations, article 7.1, the due date for Response was March 15, 2018. The Response was filed with the Center on March 9, 2018. On March 21, 2018, Complainant submitted a Supplemental Filing to the Center.

On March 12, 2018, SIDN commenced the mediation process. On April 9, 2018, SIDN extended the mediation process until May 9, 2018. On April 25, 2018, SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Dinant T. L. Oosterbaan as the panelist in this matter on April 30, 2018. 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.

On May 3, 2018, the Panel issued Procedural Order No. 1 pursuant article 11 of the Regulations, giving Respondent the opportunity to comment on Complainant’s Supplemental Filing of March 21, 2018 within 7 days of the Center forwarding the Procedural Order No. 1 to the Parties, *i.e.* by May 10, 2018. Respondent filed this Supplemental Filing on May 9, 2018.

4. Factual Background

Complainant is part of a Spanish food group and sells bottled olive oil.

According to the evidence submitted by Complainant, Complainant owns multiple trademark registrations for CARAPELLI and variations thereof, including:

- International trademark CARAPELLI with registration number 546560, date of registration: January 15, 1990 (designated in the Benelux);
- European Union Trademark registration CARAPELLI DAL 1893 FIRENZE with registration number 001041607, registration date: February 29, 2000.

The Domain Name, <carapelli.nl>, was registered by Respondent on November 9, 2004, and resolves to a single web page displaying Respondent's logo, as well as Respondent's name and contact details.

5. Parties' Contentions

A. Complainant

Complainant submits that in order to protect its products Complainant has a substantial trademark portfolio, among which the CARAPELLI sign stands out. Complainant asserts that the Domain Name is identical or confusingly similar to the trademark CARAPELLI as it is reproduced in full in the Domain Name to the point of misleading users, thus meeting the first condition of article 2 of the Regulations.

According to Complainant, Respondent has no rights to or legitimate interests in the Domain Name. Complainant submits that Respondent is a direct competitor of Complainant, distributing and selling food products, such as olive oil. Complainant asserts that it is clear that Respondent holds neither legitimate rights to nor interests in the Domain Name and that there is no evidence that Respondent is commonly known by the Domain Name or is making a legitimate noncommercial or fair use of the Domain Name. There is no website content. Respondent has not been authorized by Complainant to use its CARAPELLI trademarks. Respondent is also not a licensee of Complainant. The fact that Respondent resold or distributed products of Complainant in the past does not mean that Respondent may have received authorization to register the Domain Name. In particular Complainant submits that a reseller must use the Domain Name to offer the goods and services at issue and that the right to resell or market a product does not create the right to use a mark more extensively than required to advertise and sell the product at issue. Complainant submits that Respondent does not meet this requirement.

According to Complainant the Domain Name has been registered or is being used in bad faith. CARAPELLI is a well-known trademark and Respondent has registered the Domain Name being aware of the existence of the trademark that was incorporated in the Domain Name in its entirety.

Complainant also submits that Respondent registered the Domain Name to disrupt Complainant's activity. In December 2017 Complainant contacted Respondent to request the transfer of the Domain Name.

The answer of Respondent was as follows: "Yes, we are the owner of carapelli.nl. We are happy to have this name in our portfolio but when you do a good bid above €10.000,- we might consider." Asking for an excessive amount of money is evidence of bad faith.

Finally, Complainant submits that Respondent never used the Domain Name and that non-use does not prevent a finding of bad faith under the doctrine of passive holding.

B. Respondent

In its Response Respondent states that it does not question the rights the Complainant holds in its CARAPELLI trademark. However, Respondent does not agree with the fact that the Domain Name has been registered or is being used in bad faith.

According to Respondent a subsidiary of Respondent negotiated in 2003 and 2004 with Complainant regarding the exclusive representation of Complainant on the Dutch market and in October 2004 the subsidiary was appointed as representative of Complainant for the Netherlands. No formal distribution agreement was concluded. Respondent submits that Complainant at that time was neglectful in the registration of domain names in several European countries, including in the Netherlands, and that it did not have any interest in the registration of domain names. With the plans for the introduction of the products of Complainant on the Dutch market, Respondent submits that it decided to register the Domain Name on behalf of Complainant. This action had the approval of the export manager of Complainant. Complainant submits that in 2004 Complainant obviously had no interest to register domain names for their main markets. As distributor of Complainant for the Dutch market Respondent was surprised by this attitude and took its responsibility to register the Domain Name in order to defend the interests of Respondent and Complainant in the Dutch market.

According to Respondent, not long after the first delivery of the products of Complainant to the subsidiary of Respondent, in the middle of 2005, there was a change in the attitude of Complainant; mails were not answered and telephone calls ended with silence. Respondent submits that it was put aside without a proper explanation and without proper compensation as it suffered substantial damages. Going to court was an option but the lawyers of Respondent advised against this. According to Respondent: "A court case would be extremely expensive and a big company as Carapelli is able to spend much more money to such a case that we can. As our lawyer said: 'keep the domain name well, take care of it; one day they will come!'".

Respondent submits that it acted in good faith and with the knowledge of Complainant at the time it registered the Domain Name in November 2004. Respondent became the legal owner of the Domain Name. Respondent never acted in bad faith nor used the Domain Name for its own benefit. Respondent submits that possibly Complainant acted in bad faith because they knew that they acted wrongly against Respondent in 2004-2005. Possibly they made their calculation: a fair compensation for Respondent against the value of the Domain Name.

Respondent concludes by suggesting that Complainant and Respondent will be in contact for a fair compensation for the transfer of the Domain Name. If both parties are reasonable a solution can be found.

In its Supplemental Filing Respondent repeats that it registered the Domain Name in good faith and that it never used the Domain Name infringing the intellectual rights of the CARAPELLI brand. Respondent is asking for a fair compensation, in fact not for the Domain Name but for the damages suffered by Respondent and caused by the one-sided termination without reason of the distributorship for the Netherlands in 2005. In its conclusion Respondent states that it used and still uses its legal right of retention as

Complainant was and is not willing to compensate Respondent for the non-compliance of Complainant's obligations pursuant to the distributorship for the Netherlands in 2005. Respondent furthermore submits that the Center is not authorized to decide in this matter as the Domain Name is subject of Respondent's right of retention. This procedure is also not the forum to discuss and to prove details of Respondent's damages. Although it is quite long ago (more than 13 years) Respondent is well documented and it might well be possible that Complainant has evidence in its administration too. Respondent is willing to discuss the case with Complainant to come to an amicable settlement. Respondent regrets that Complainant has seen this as a proof of bad faith. When Complainant insists on claiming the Domain Name without any financial compensation for Respondent for damages suffered, only a Dutch court can decide in this matter. In such a court case Respondent will document its position.

6. Discussion and Findings

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

- a. the 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 mentioned in article 2.1(a) under II of the Regulations; 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.

A. Preliminary – Admission of Supplemental Filings and Competence of Panel

In accordance with article 11.2 of the Regulations the Panel decides to admit the Supplemental Filing of Complainant of March 21, 2018 and the Supplemental Filing of Respondent of May 9, 2018 for a more comprehensive consideration and examination of the case.

The Panel notes the following about the Supplemental Filing of Respondent, in particular about the submission that the Center is not authorized to decide in this matter.

If Respondent may have suffered damages caused by the termination of the alleged 2004-2005 distributor or reseller relationship it could have pursued such claim in court at that time. Disputes about the registration and use of domain names in the .nl domain name space are governed by the Regulations to which registrants submit as part of the applicable terms and conditions of registration. Also, the Regulations do not provide for any possibility for a counterclaim for damages or the use of the alleged right of retention.

In addition, the Panel notes that article 21 of the Regulations provides that participation in proceedings covered by the Regulations would not have prevented and does not prevent Respondent from submitting the dispute to an independent court of competent jurisdiction. Contrary to arbitral proceedings, proceedings under the Regulations are not exclusive. Article 20.1 of the Regulations provides that Respondent is able to institute legal proceedings in a Dutch court against Complainant in relation to the registration of the Domain Name after the decision of the Panel has been notified to SIDN by the Center.

In accordance with article 10.2 of the Regulations the Panel decides that it is competent in this matter and that it is able to decide in accordance with the provisions of the Regulations with respect to the remedy requested by Complainant pursuant to article 1 of the Regulations.

B. Identical or Confusingly Similar

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

Complainant has established that it is the owner of a large number of trademark registrations including an International registration for CARAPELLI.

The Top-Level Domain “.nl” may be disregarded for purposes of article 2.1(a) of the Regulations.

The Panel finds that the Domain Name is identical to Complainant’s CARAPELLI trademark.

C. Rights or Legitimate Interests

In the Panel’s opinion, Complainant has made out a *prima facie* case that Respondent lacks rights to or legitimate interests in the Domain Name. There is no evidence that Respondent, beyond the web page described in section 4 above, is making or has made any substantive use of the Domain Name, or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. Furthermore, the Panel could not find any indication in the record that Respondent is commonly known by the Domain Name or that it has acquired trademark rights corresponding to the Domain Name.

In addition, the Panel takes into account the following: Article 3.1 of the Regulations sets out examples of circumstances through which a respondent may demonstrate that it has rights to or legitimate interests in a domain name for purposes of article 2.1(b) of the Regulations.

In this regard the Panel notes that under the UDRP¹, as set out in the [WIPO Overview of WIPO Panel views on Selected UDRP Questions, Third Edition](#) (“WIPO Overview 3.0”), [section 2.8](#), a reseller or distributor can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name at issue if certain requirements are met. The leading case on this point is *Oki Data Americas, Inc. v. ASD, Inc.*, [WIPO Case No. D2001-0903](#). 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](#).

For a respondent to be successful under the *Oki Data* test it must meet each of the following criteria:

- a. Respondent must actually be offering the goods or services at issue;
- b. 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;

c. the site must accurately disclose Respondent's relationship with Complainant; it may not, for example, falsely suggest that it is Complainant, or that the website is the official site, if, in fact, it is only one of many sales agents;

d. Respondent must not try to corner the market in all domain names, thus depriving Complainant of reflecting its own mark in a domain name.

In the view of the Panel, Respondent fails to meet criteria a, b and c as there no evidence that Respondent uses or has ever been using the Domain Name for a website in order to offer any products, including any products of Respondent. Moreover, Respondent's web page does not disclose Respondent's relationship with Complainant.

In view of the foregoing, the Panel holds that Respondent has not established rights to or legitimate interests in the Domain Name. The requirement of article 2.1(b) of the Regulations is therefore met.

D. Registered or Used in Bad Faith

There are conflicting statements and little evidence about the possible bad faith registration of the Domain Name in 2004. In its initial submission Complainant asserts that the registration of the Domain Name was in bad faith as Respondent was aware of the trademark of Complainant at the time of registration. Respondent acknowledges that Complainant owns the trademark. However, it states that Complainant through its export manager gave explicit or implicit approval to the registration of the Domain Name by Respondent.

The procedure under the Regulations does not lend itself to the further collection and analysis of evidence concerning the question whether or not approval for the registration of the Domain Name was given by Complainant and thus whether or not the registration of the Domain Name in 2004 was in bad faith. The Panel does not make a determination on this issue.

However, bad faith under the Regulations is not limited to bad-faith registration but can also consist of bad-faith use. In this respect the Panel notes the following. According to Respondent, after registration on behalf of Complainant Respondent kept the Domain Name and "took care of it" in the event Complainant wanted to obtain the Domain Name in the future. Respondent submits that it never used the Domain Name or infringed Complainant's rights. In fact Respondent stated in its Response that it is willing to hand over the Domain Name but not without fair compensation.

According to Respondent its sole purpose in keeping the Domain Name was to obtain a compensation of over € 10.000,- not for the Domain Name as such but for damages Respondent allegedly suffered from the unilateral termination of the distributorship for the Netherlands in 2005. For purposes of the Regulations, such use of the Domain Name incorporating the trademark in which Complainant has rights constitutes bad faith.

Considering also that the trademarks of Complainant have been existing for a long time, that the Domain Name is identical and confusingly similar to Complainant's trademarks, that Respondent registered the Domain Name on behalf of Complainant and in particular that Respondent has provided no evidence of any past, current or contemplated good-faith use of the Domain Name the Panel concludes that Respondent's use of the Domain Name satisfies the requirement of article 3.2 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, <carapelli.nl>, be transferred to Complainant.

Dinant T. L. Oosterbaan

Panelist

Date: May 11, 2018

¹ In view of the fact that the Regulations are to an extent based on the UDRP, it is well established that cases decided under both the Regulations and the UDRP are relevant to this proceeding(see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, [WIPO Case No. DNL2008-0050](#)).