
WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Case No. DNL2018-0027

Date 11 June 2018

1. The Parties

The Complainant is W-D Apparel Company, LLC of Wilmington, Delaware, United States of America / Williamson-Dickie Manufacturing Company of Fort Worth, Texas, United States of America, represented by Novagraaf Nederland B.V., Netherlands.

The Respondent is [X] of Reinsdorf, Germany.

2. The Domain Name and Registrar

The disputed domain name <dickiesamsterdam.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 April 26, 2018. On the same day, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On April 30, 2018, 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 May 2, 2018. In accordance with the Regulations, article 7.1, the due date for Response was May 22, 2018. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 23, 2018.

The Center appointed Willem J. H. Leppink as the panelist in this matter on May 28, 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.

4. Factual Background

The following facts are undisputed:

The Complainant is an American fashion company established in 1922. Dickies is a well-known international brand for *inter alia* clothing and fashion accessories.

The Complainant owns various registrations for the DICKIES trademark in a number of jurisdictions, including but not limited to the European Union Trademark DICKIES,

registration number 000065201, registered on May 22, 1998 and with a filing date of April 1, 1996 (the “Trademark”).

The Respondent registered the Domain Name on June 28, 2017. The Domain Name resolves to a website which appears to sell clothing of different brands (the “Website”).

5. Parties’ Contentions

A. Complainant

Insofar as relevant, the Complainant contends the following.

The Domain Name is confusingly similar to the Trademark. The Domain Name contains the element “dickies” which is identical to the Trademark. The addition of the descriptive element “Amsterdam”, and the domain name extension is not sufficient to negate the confusing similarity between the Domain Name and the Trademark. The addition of the descriptive element “Amsterdam” to the Domain Name will be perceived as an indication of the place of business of an official reseller of the trademarked goods and/or a store in the Netherlands.

The Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent does not own any rights the Trademark, the trade name “Dickies” nor does the Respondent have any other right to the denomination “Dickies”. The Complainant has not given its consent to the Respondent to use and/or refer to the Trademark in the Domain Name. At the Website goods under the Trademark are offered, as well as goods from other brands such as “Esprit” and “Kookai”. By using the Domain Name the Respondent appears to attempt to direct consumers which are looking for goods under the Trademark to the Website to sell similar fashion products as well as possibly counterfeit products under the Trademark.

The Domain Name is registered and being used in bad faith by the Respondent. By choosing the Domain Name incorporating the Complainant’s well-known Trademark, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its Website. The Trademark was deliberately chosen because the Trademark is well-known and therefore particularly suitable for attracting fashion customers to the Website. The Respondent attempts to disrupt the business of the Complainant.

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 and adds the geographical term “Amsterdam”. The Panel finds that the dominant part of the Domain Name is “dickies” and that the addition of the element “Amsterdam” does not neutralize the similarity with the Trademark. The Panel finds that the Domain Name is confusingly similar to the Trademark for purposes of the Regulations.

The Complainant has thus 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 to 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 to or legitimate interests in the 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 to or legitimate interests in the Domain Name.

If and to the extent the Respondent can be viewed as a genuine reseller, the Panel notes that the Respondent does not meet the requirements of the Oki Data test.¹ The Website is not used to sell only the trademarked goods, as goods from other brands such as

Esprit and Kookai are being offered at the Website. Furthermore, the Website does not accurately disclose the Respondent's (lack of) relationship with the Complainant.

In conclusion, the Panel finds that the Domain Name was not used in connection with a *bona fide* offering of goods or services, and 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

In light of its considerations under Section 6.B, 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.

As noted, the Website lacks a disclaimer to clarify the absence of a relationship between the Respondent and the Complainant. This is all the more relevant in light of the style and presentation of the Website; the use of the Complainant's advertising images on the website here amounts to a form of impersonation by the Respondent.

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, <dickiesamsterdam.nl>, be transferred to the Complainant.

Willem J.H. Leppink
Panelist

¹ The decision in *Oki Data Americas, Inc. v. ASD, Inc.*, [WIPO Case No. D2001-0903](#) guides the question as to whether a reseller is using a disputed domain name in connection with a *bona fide* offering of goods or services. 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](#).