

WIPO Arbitration and Mediation Center
Case No.: DNL2020-0011
Date: 4 July 2020

1. The Parties

The Complainant is Pelican Products, Inc., United States of America, represented by Novagraaf Nederland B.V., the Netherlands.

The Respondent is Apox B.V. / Apox, the Netherlands, represented by ARAG Rechtsbijstand, the Netherlands.

2. The Domain Name and Registrar

The disputed domain names <pele-air.nl>, <peleair.nl>, <pelicancase.nl>, <pelicas.nl>, and <pele-nederland.nl> are 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 February 26, 2020. On February 27, 2020, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On February 28, 2020, SIDN transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 2, 2020, providing the Respondent’s registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 6, 2020. The Center verified that the Complaint, together with the amended 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 March 10, 2020. In accordance with the Regulations, article 7.1, the due date for Response was March 30, 2020. The Center received emails from the Respondent on March 11 and 24, 2020, requesting to receive and file the documents in the Dutch language. With reference to the Regulations, article 17, the Center decided in the circumstances of this case that despite English being the language of the proceedings, the parties may also submit documents in Dutch, subject to the final judgment of the Panel. Finally, at the request of the Respondent’s representative, the Center extended the deadline for the submission of Response until April 15, 2020. The Response was submitted to the Center on April 14, 2020.

SIDN commenced the mediation process on April 23, 2020, which process was extended until May 18, 2020. On May 28, 2020, SIDN confirmed that the dispute had not been resolved in the mediation process.

The Center appointed Alfred Meijboom as the panel in this matter on June 20, 2020. The Panel finds that it was properly constituted. The Panel 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 is a luggage manufacturer which was founded in 1976 and operates globally. In January 1997 the Complainant opened its European headquarters. The Complainant is the owner of the following registered trademarks, which are valid in the Netherlands:

- European Union trademark PELI with number 000011056, filed on April 1, 1996, and registered on May 8, 1998, for flashlights, torches, and structural foam containers in classes 11 and 20;

- European Union trademark PELI with number 013444443, filed on November 10, 2014, and registered on July 15, 2017, for, *inter alia*, carrying cases, flashlights, luggage, structural foam containers, and portable coolers in classes 9, 11, 18, 20, and 21.

The European Union trademarks listed above are hereinafter referred to as the “PELI trademarks”.

The Respondent registered the disputed domain names on the following dates: <pelicases.nl> on July 22, 2013 (the original registration date being June 25, 2004); <pelel-nederland.nl> on February 3, 2017 (the original registration date being November 8, 2009); <pelialr.nl> on May 30, 2016; <pelel- air.nl> on May 30, 2016; and <pelicancase.nl> on November 26, 2018.

Presently, the disputed domain names <pelicases.nl> and <pelicancase.nl> resolve to a website for the sale of the Complainant’s products and tailor-made structural foam. The disputed domain names <pelel-air.nl> and <pelialr.nl> do not resolve to an active website and the disputed domain name <pelel- nederland.nl> resolves to a blank page with the text “De site is tijdelijk off line. Voor info [Respondent’s email address]” (in translation: “The site is temporary off line. For info [Respondent’s email address]”).

5. Parties’ Contentions

A. Complainant

The Complainant alleges that disputed domain names consist of the PELI trademarks. The addition of the term “air” refers to the Complainant’s “Peli Air” case series, while the addition of the generic terms “case” or “cases” merely describes the goods sold. The disputed domain name <pelicancase.nl> is a reference to the trademark PELICAN which the Complainant uses and registered outside Europe. Therefore, the disputed domain names are confusingly similar to the PELI trademarks. As the Complainant also sells its products under its PELI trademarks in the Netherlands, consumers will perceive the disputed domain names to be originating from or related to the Complainant.

Further, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names in view of the PELI trademarks. To the Complainant’s knowledge, the Respondent does not own any rights with respect to the trademark or tradename PELI nor does the Respondent have any other right with respect to the disputed domain names. The Complainant has not granted a license or authorized the Respondent to use the PELI trademarks in or apply for registration of the disputed domain names. The Complainant also did not consent to the Respondent’s use of and/or reference to the PELI trademarks. There is also no commercial link between the Complainant and the Respondent. Moreover, the Complainant claims that the Respondent is not using the disputed domain names for a legitimate and non-commercial purpose as it seems that the Respondent only registered the disputed domain names in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the PELI trademarks. In this respect, the Complainant refers to the websites under the disputed domain names <pelicases.nl> and <pelicancase.nl>, which also offer custom-made foam inlays instead of the Complainants’ original replacement foam sets.

Consequently, through the PELI trademarks in the disputed domain names, the Respondent is using such trademarks to bait consumers to its website and then switch them to other goods. Moreover, the websites of the disputed domain names do not accurately disclose the relationship with the Complainant. In absence of a commercial link between the Respondent and the Complainant, the disputed domain names tarnish the PELI trademarks and are therefore unlawful towards the Complainant. By registering the disputed domain names, the Respondent also tries to “corner” the market in all relevant domain names, thus depriving the Complainant of the ability to reflect its own trademarks in a “.nl” domain name. The Complainant is therefore of the opinion that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant asserts that the Respondent intentionally included the PELI trademarks in the disputed domain names because these trademarks are well known and therefore particularly suitable to attract customers searching for PELI products to the website of the Respondent. Given the reputation and the fact that the Respondent offers the Complainant’s products in its web store, it is inconceivable that the Respondent was not aware of the PELI trademarks at the time of registering the disputed domain names. The Complainant is therefore of the opinion that the Respondent has registered the disputed domain names for the sole purpose of disrupting the business of the Complainant by attracting customers to its own website. The use of the PELI trademarks to direct customers to another website is objectionable and not *bona fide*, since it is a misleading use of the PELI trademarks as well as a form of unfair competition, and also for reasons of consumer protection, as it amounts to a form of “bait and switch” selling. The Complainant concludes that the Respondent has registered and used the disputed domain names in bad faith.

B. Respondent

The Respondent claims that it is a legitimate reseller of the Complainant’s products and has been reselling such products for 20 years without the Complainant ever asking it to stop using any of the disputed domain names. The Respondent has asked the Complainant’s distributor in the Netherlands if it could use images of the Complainant’s products, to which the distributor implicitly consented by sending images of such products for promotional use. The Respondent also obtained permission from the Complainant’s distributor in the Netherlands to register and use the disputed domain names <pelicases.nl> and <peliair.nl>, and the Respondent believes that such consent of the Complainant’s distributor implies authority from the Complainant to give such consent. The Respondent therefore alleges that it registered and has been using the disputed domain names in good faith. Further, the Respondent claims that the Complainant was aware of the Respondent’s use of the disputed domain names and the Complainant’s Sales Representative Benelux even complimented the Respondent at a fair around the turn of the century.

The Respondent further alleges that it uses the disputed domain names for a legitimate reason, which is the sale of the Complainant’s products, and before the Respondent became aware of the dispute, it used the disputed domain names to offer such products in good faith. The Respondent claims being a reseller that (a) actually sells only products under the PELI trademarks via the disputed domain names, while (b) it did not register so many domain names that the Complainant can no longer register a decent domain name which incorporates its PELI trademarks, and (c) the website under the disputed domain names accurately records the relationship between the Respondent and the Complainant.

6. Discussion and Findings

Language of the Proceedings

Article 17 of the Regulations provides that “[w]henver the complainant or the respondent neither resides nor is registered in the Netherlands, proceedings shall be conducted in the English language. In exceptional circumstances however (such as when both parties appear to have full command of the Dutch language), the Center (subject to the panel’s determination) or panel may decide that proceedings are to be conducted in Dutch, or that the complainant or the respondent may make submissions in Dutch”.

The Complainant correctly filed the Complaint in the English language. The Respondent asked the Center for a Dutch translation of “the documents” – which the Panel understands to be the Complaint – and permission to submit the Response in Dutch. While reserving the Panel’s final authority to apply the exception of the Regulations, article 17, the Center allowed the Respondent to file its Response in Dutch.

A party that wishes a change of language – in this case only the Response is in Dutch – should substantiate that it would be unreasonably onerous if the submission were to be in English (e.g. *LEGO Juris A/S v. M. Moench*, WIPO Case No. DNL2009-0052). The Respondent has motivated its request for a translation of the Complaint by stating that its command of English is insufficient to understand the Complaint. The Respondent’s representative’s subsequent request for a translation of the Complaint and permission to file the Response in Dutch was not substantiated at all. The Complainant did not respond to the Respondent’s requests.

The Complainant is an international company with its headquarters in the United States, represented in this case by a Dutch trademark agent. The Respondent is a Dutch company and the disputed domain names resolve to websites in the Dutch language. In the absence of indications to the contrary, the Respondent’s command of English is limited, although its representative filed a Response and is therefore supposed to have sufficient understanding of English to discuss the Complaint with the Respondent.

In these circumstances, and noting that the Complainant is represented by Dutch counsel and has not objected to the use of Dutch for the Response, the Panel finds that the Complainant is not prejudiced by such use of Dutch. Consequently, while the language of the proceedings is English, the Panel accepts the Response in Dutch.

Grounds of the Complaint

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

- a. the disputed 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 disputed domain name; and
- c. the disputed domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

It is established case law that the Top-Level Domain “.nl” may be disregarded in assessing the similarity between the trademark(s) on the one hand and the disputed

domain name(s) on the other hand (see, e.g., *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

The Panel finds that the disputed domain names are confusingly similar to the PELI trademarks. The Respondent has taken the PELI trademarks in their entirety and merely added the terms “air”, “can”, “cases”, and “nederland” (“the Netherlands” in Dutch).

Consequently, the Panel finds that the Complainant has satisfied the requirement of article 2.1(a) of the Regulations.

B. Rights or Legitimate Interests

Article 3.1 of the Regulations sets out examples of circumstances through which a respondent may demonstrate that it has rights or legitimate interests in a domain name for purposes of article 2.1(b) of the Regulations. Taking into account that the Regulations are to a large extent based on the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), both cases decided under the Regulations and cases decided under the UDRP are relevant to this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. DNL2008-0050).

In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (the “Oki Data decision”), the panel set out four criteria in which an authorized sales or service agent of trademarked goods may use the trademark at issue in its domain name. 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, *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No. DNL2011-0074, and *Bayerische Motoren Werke Aktiengesellschaft v. Quispel Motoren*, WIPO Case No. DNL2013-0026. The Panel notes that these considerations equally apply to a situation involving an unofficial reseller of genuine goods, which the Respondent appears to be. The essential issue addressed by the Oki Data decision is whether, in such circumstances, there is a *bona fide* offering of relevant goods or services, and an absence of any associated deception.

To resolve this issue, the Oki Data decision provides the following cumulative criteria:

1. the respondent must actually be offering the goods or services under the trademark; and
2. the respondent must only be offering those goods or services; and
3. the respondent must not try to take all of the relevant domain names so as to deprive the trademark owner of the ability to register its trademark as a domain name; and
4. the website must accurately describe the relationship between the respondent and the trademark owner.

The Respondent explicitly claims that it meets all criteria of the Oki Data decision, but has refrained from offering any evidence. As the disputed domain name <pelicases.nl> resolves to a website offering PELI marked products for sale, the Panel was able to apply the test of the Oki Data decision. Although the website offers the Complainant’s products for sale, it also offers tailor-made foam inlays for cases which undisputedly compete with the Complainant’s foam inlays, so that the second condition is not met. Furthermore, the website bears a disclaimer which reads “Wederverkoper van koffers. APOX vertegenwoordigd [sic] de sterkste merken!” (in English: “Reseller of cases. APOX represents the strongest brands!”). This disclaimer fails to mention the Complainant, but rather implies that the Respondent is reseller of other brands as well. Therefore, the Panel finds that the Respondent has not met the criteria set out in the Oki Data decision with the website under the disputed domain name <pelicases.nl>. Noting that the Response itself does not distinguish in this regard between the disputed domain names, the Panel’s finding with respect to <pelicases.nl> *mutatis mutandis* applies to the other disputed domain names.

The Respondent claims that it has been using the disputed domain names to sell the Complainant's products and that its annual turnover is considerable. However, that does not as such give rise to rights to or legitimate interests in the disputed domain names within the meaning of article 2.1(b) of the Regulations (*Dienst Wegverkeer (RDW) v. Versio / Moonshots Online Marketing*, WIPO Case No. DNL2016-0023 and *Trinnov Audio S.A. v. Ronald van Ovost*, WIPO Case No. DNL2017-0060).

Having regard to the foregoing, the Panel holds that the Respondent has not established rights or legitimate interests in the disputed domain names. The requirement of paragraph 2.1(b) of the Regulations is therefore met.

C. Registered or Used in Bad Faith

Article 2.1(c) of the Regulations requires the Complainant to show that the disputed domain names were registered and/or are being used in bad faith.

The evidence submitted by the Complainant shows that the disputed domain names <pelicases.nl> and <pelicancase.nl> are being used by the Respondent to attract Internet users to the Respondent's website, for commercial gain, through the likelihood of confusion with the PELI trademarks as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This constitutes evidence of bad faith in accordance with article 3.2 of the Regulations. The current passive holding of some of the disputed domain names does not prevent a finding of bad faith use (e.g. *Jacuzzi Inc. and Jacuzzi Europe S.p.A. v. Fonteyn*, WIPO Case No. DNL2016-0036).

As this finding already satisfies the requirement of article 2.1(c) of the Regulations, there is no need for the Panel to determine whether to assess, in this case under the Regulations, the circumstances surrounding the Respondent's initial registration of the disputed domain names in bad faith with consent from the Complainant's distributor in the Netherlands.

In conclusion, the Panel finds that the Complainant has satisfied the requirement of article 2.1(c) 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 disputed domain names <pele-air.nl>, <peleair.nl>, <pelicancase.nl>, <pelicases.nl>, and <pele-nederland.nl> be transferred to the Complainant.

Alfred Meijboom
Panelist