

WIPO Arbitration and Mediation Center
Case No.: DNL2020-0013
Date: 25 May 2020

1. The Parties

The Complainant is JUNG S.A.S., France, represented by AB INITIO, France.

The Respondent is [X], the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <backmarket.nl> (the “Domain Name”) is registered with SIDN through TransIP Group (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2020. On February 28, 2020, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On March 2, 2020, 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 March 5, 2020. In accordance with the Regulations, article 7.1, the due date for Response was March 25, 2020. The Respondent sent an email communication to the Center on March 25, 2020.

On April 6, 2020, SIDN commenced the mediation process. On April 20, 2020, SIDN informed parties that the dispute had not been solved in the mediation process.

The Respondent sent two additional email communications to the Center on April 20 and 29, 2020, respectively.

The Center appointed Willem J. H. Leppink as the panelist in this matter on May 11, 2020. 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 Complainant is Jung S.A.S, incorporated in France. The Complainant is trading under the name BACK MARKET (the “Company Name”) and is a global marketplace selling refurbished electrical and electronic products in Europe since 2014. The Complainant owns many domain names for “backmarket” and has approximately 11 million monthly visitors.

The Complainant owns numerous trademark registrations worldwide for BACK MARKET, including:

- International trademark registration No. 1415150 for BACK MARKET, registered on January 17, 2018, with priority date September 22, 2017, designating the European Union and thus the Netherlands (hereinafter also referred to as the “Trademark”).

The Domain Name was first registered on November 23, 2017. The Respondent acquired the Domain Name on January 6, 2020. At the time of filing of the Complaint, the Domain Name was inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends the following.

The Domain Name is identical to the Complainant's Company Name, its domain names and the Trademark, since the Domain Name consists of these terms in which Complainant has earlier rights.

The Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not authorized or permitted to use the Trademark, nor is the Respondent associated with the Complainant. Furthermore, the Respondent is not using the Domain Name in connection with a *bona fide* offering of goods and services.

The Domain Name was registered and is being used in bad faith. The Complainant is well-known, it is therefore inconceivable that the Respondent was not aware of the Complainant's business when registering the Domain Name. The Complainant contacted the Respondent several times, thus the Respondent had actual knowledge of the Complainant, but it never responded. This actual knowledge of the Complainant indicates a bad faith registration and use of the Domain Name. Furthermore, the Domain Name is not active and has never been used. Taking the reputation of the Complainant into consideration, such passive holding of a domain name suggests that the Respondent acquired the Domain Name for the purpose of selling the Domain Name to the Complainant.

B. Respondent

On March 25, 2020 the Respondent sent a short informal response: "I acquired the domain to start a website for backpacking related things. I don't understand."

With the Respondent's communication of April 20, 2020, it sought further clarification of the process, which the Center provided by email on April 23, 2020.

On April 29, 2020, after the deadline for filing an official response and after a failed mediation attempt by SIDN, the Respondent conveyed the following, in so far as relevant:

- 1) "I am just a normal person that want[s] to do a site with backpacks, that's it." 2) "I hope you can forgive me and I can keep the site."
- 3) "Also, I want to start with the site fast, can you please open it for me."

The Panel has decided to take the submitted communications into consideration.

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.

A. Identical or Confusingly Similar

Pursuant to article 2.1(a) 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 established that it has rights in the Trademark in, amongst others, the European Union and thus in the Netherlands.

The Domain Name is identical to the Trademark and only adds the country code Top-Level Domain “.nl”. It is however accepted under “.nl” case law that this suffix may be disregarded for purposes of article 2.1(a) of the Regulations.

The Panel finds that the Domain Name is identical to the Trademark.

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

B. Rights or Legitimate Interests

Consistent with earlier decisions under the Regulations, the Complainant must *prima facie* demonstrate that the Respondent has no rights to or legitimate interests in the Domain Name. If the Complainant succeeds in making out this *prima facie* case, the burden of production shifts to the Respondent, who will then have to come forward with appropriate allegations or evidence demonstrating a right to or legitimate interests in the Domain Name (see *Auto 5 v. E. Shiripour*, WIPO Case No. DNL2008-0027).

The Respondent may demonstrate such rights or legitimate interests *inter alia* through any of the following circumstances based on 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; or
- b. the Respondent as an individual, business or other organization is commonly known by the Domain Name; or
- 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 Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests. The record before the Panel contains no indication that the Respondent has rights or legitimate interests in the Domain Name.

The Respondent does not appear to be affiliated with the Complainant in any way. There is no evidence that the Respondent is, or has ever been, a licensee of the Complainant or that the Respondent has ever been permitted in any way by the Complainant to register or use the Trademark, or to apply for or use any domain name incorporating the Trademark. There is also no evidence that the Respondent is commonly known as “BACKMARKET”.

The Respondent claims that it has the intention to use the Domain Name for “backpacking related things” in the near future. The Respondent should thus be in a position, and had the responsibility, to evidence this intention. However, the Respondent has not demonstrated any use of, or preparation to use, the Domain Name in connection with a *bona fide* offering of goods or services. If the Respondent indeed intended to start

using the Domain Name soon, as the Respondent has contended, presumably it could at least have demonstrated preparations for this purpose.

In the circumstances of this case, the Panel finds that the Respondent's lack of rights or legitimate interests in the Domain Name may also be inferred from the Respondent's failure to file a substantive Response in this case and to reply to the Complainant's communications. See in this connection *GA Modefine S.A. and Giorgio Armani S.p.A. v. Yoon-Min Yang*, WIPO Case No. D2005-0090; and *Pomellato S.p.A. v. Richard Tonetti*, WIPO Case No. D2000-0493.ⁱ

The Panel finds it established that the Respondent has no rights or actual 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 finds that the Domain Name was registered and is being used in bad faith. The Panel refers to its considerations under section 6.B and adds the following.

In light of the extensive evidence filed by the Complainant, the Panel finds that the Trademark, as well as the activities of the Complainant, are well-known throughout the European Union. In addition, the first and following search results in Google for 'Backmarket' concern the Complainant. In the Panel's view, the Respondent must have been aware of the Complainant's existence and rights at the time of registering the identical Domain Name. The Respondent also has not rebutted that it was aware of the Complainant and its activities.

The Panel finds that the Respondent's informal reaction lacks credibility. Its limited scope and the asserted lack of understanding of the current proceeding do not reasonably match the Respondent's claimed business plans.

Panels have consistently held that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition. The present circumstances, including the reputation of the Trademark and the failure of the Respondent to submit a substantive response or to provide any evidence of actual or contemplated good-faith use, support a finding of bad-faith registration and use in this sense; in particular, considering the reputation of the Trademark, it is hard to conceive of a plausible circumstance in which this Respondent could legitimately use the Domain Name.

The circumstances of this case suggest that the Respondent has registered or acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to the Complainant in excess of the Respondent's documented out-of-pocket costs directly related to the Domain Name.

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 <backmarket.nl> be transferred to the Complainant.

Willem J. H. Leppink
Panelist

ⁱ In view of the fact that the Regulations are to an extent based on the Uniform Domain Name Dispute Resolution Policy (“UDRP”), it is well established that 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).