

WIPO Arbitration and Mediation Center
Case No.: DNL2020-0015
Date: 16 June 2020

1. The Parties

Complainant is Rothy's, Inc., United States of America, represented by Brinkhof Advocaten, the Netherlands.

Respondent is [X], China.

2. The Domain Name and Registrar

The disputed domain name <rothys.nl> (the "Domain Name") is registered with SIDN through 1API GmbH (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 20, 2020. On March 20, 2020, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On March 23, 2020, SIDN transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on March 25, 2020, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 26, 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 Respondent of the Complaint, and the proceedings commenced on April 3, 2020. In accordance with the Regulations, article 7.1, the due date for response was April 23, 2020. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on April 30, 2020.

The Center appointed Remco M.R. van Leeuwen as the panelist in this matter on May 25, 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

Complainant is a San Francisco-based direct-to-consumer shoe and handbag company, founded in 2012 by Stephen Hawthornthwaite and Roth Martin. The company was launched in 2016. Complainant's products are made from sustainable materials, including 100% recycled fibers from plastic water bottles and carbon-free rubber. According to the website linked to Complainant's domain name <rothys.com>, Complainant is known for transforming eco-friendly materials into stylish, wear- everywhere products.

Complainant is the proprietor of various European Union Trade Mark registrations for:

- the figurative mark ROTHY'S, registered on October 14, 2015, with registration number 014267405, for goods in class 25 (the "Trademark"); and

- the word mark ROTHY'S, registered on January 9, 2019, with number 017936583, for goods in class 35; and

- the word mark ROTHY'S, registered on October 4, 2019, with number 018065985, for goods in class 25.

The Domain Name was registered on March 28, 2017.

The Panel accessed the website linked to the Domain Name on June 9, 2019, which resolved to a pay-per-click ("PPC") parking page advertising scheme showing hyperlinks referencing, amongst others, "Lady Shoes", "Brown Dress Shoes", "Sandal Shoes" and variations thereof (the "Website"). The hyperlinks redirect visitors to a second page with advertising links to websites of other companies active in the shoe business, as also evidenced by Complainant. The Website also includes a link on the top that states "The domain rothys.nl may be for sale. Click here to inquire about this domain." which link leads to a web page containing a form to submit a sales enquiry to the owner of the Domain Name: "the owner of Rothys.nl has chosen to receive offer inquiries regarding this domain name."

5. Parties' Contentions

A. Complainant

Complainant states that it has rights in the Trademark and that the Domain Name is identical or at least confusingly similar to the Trademark.

Complainant notes that the Trademark predates the registration of the Domain Name, and that while the Trademark includes design elements, its dominant part is the term ROTHY'S.

Complainant further contends that the brand ROTHY's, as such, was created by combining the names of the founders: Roth Martin and Stephen Hawthornthwaite, whose long-time nickname is "Hawthy", and has no dictionary meaning at all.

Complainant asserts that there is a considerable risk that the trade public will perceive the Domain Name as owned by Complainant, or that there is some kind of commercial relationship with Complainant. According to Complainant, the Domain Name is identical, or at least confusingly similar to the Trademark.

Complainant argues that Respondent, who is unknown to Complainant, has no rights or legitimate interest in the Domain Name since Respondent is not sponsored by or affiliated in any way with Complainant nor has Respondent been given any permission to use the Trademark in any manner. Complainant further argues that Respondent solely registered the Domain Name to derive commercial benefit from Complainant's Trademark and attached goodwill.

Complainant argues that the Domain Name has been registered in bad faith. Respondent has never had any intention of using the Domain Name. The sole purpose of the registration of the Domain Name is to sell the Domain Name to Complainant for a significant price, or to intentionally attempt to attract, for commercial gain, Internet users to the Domain Name. Complainant supports this argument by submitting an email communication from Complainant's domain name broker stating that the Domain Name was for sale at the price of USD 12,000. This amount is significant and by far exceeds any valuable consideration for reasonable costs associated with the registration of the Domain Name.

Complainant concludes that it can thus be assumed that Respondent registered, or is using, the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name to Complainant, or to intentionally attempt to attract, for commercial gain, Internet users to its website, thus supporting a finding of bad faith intent. In Complainant's view, such a finding is further supported by Respondent having chosen to hide its identity.

Complainant requests the transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

As 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 fact.

Pursuant to article 2.1 of the Regulations, Complainant's request to transfer the 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

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) 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. Considering these conditions, the Panel rules as follows.

A. Identical or Confusingly Similar

Complainant has submitted a copy of the registration of the Trademark demonstrating that Complainant is the holder of the Trademark. The Trademark is a figurative mark, the verbal and dominant part of which is the term ROTHY'S. The Trademark is protected under Dutch law. The Panel assumes the validity of the Trademark and will review the Complaint on this basis.

The Panel notes that it is established ".nl" case law that the country code Top-Level Domain suffix ".nl" may be disregarded in assessing confusing similarity between the relevant trademark on the one hand, and the disputed domain name on the other hand (see, *Caterpillar Inc. v. H. van Zuylen Materieel*, WIPO Case No. DNL2011-0073; *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

The Domain Name includes the verbal elements of the Trademark with the exception of the apostrophe. The Domain Name is textually, visually and phonetically similar to this dominant part of the Trademark.

The Panel finds that the Domain Name is confusingly similar to the Trademark for purposes of the Regulations. Therefore, the first requirement of article 2.1(a) under I of the Regulations has been met.

B. Rights or Legitimate Interests

Article 2.1(b) of the Regulations requires Complainant to demonstrate that Respondent has no rights to or legitimate interests in the Domain Name. This condition is met if Complainant makes out a *prima facie* case that Respondent has no such rights or legitimate interests and if Respondent fails to rebut this with appropriate allegations or evidence demonstrating a right to or legitimate interests in the Domain Name (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, WIPO Case No. DNL2008-0002).

Complainant alleges that Respondent lacks rights to or legitimate interests in the Domain Name for the reasons set out in section 5.A above. Complainant has demonstrated that the Domain Name is currently linked to a website containing PPC links, among others relating to “Lady Shoes”, “Brown Dress Shoes” and “Sandal Shoes”. It is the consensus view under the Regulations that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 2.9.ⁱ Therefore Respondent’s use of the Domain Name incorporating the Trademark to host sponsored links associated with Complainant’s area of business cannot constitute a *bona fide* offering of goods or services.

Further, no commercial relationship exists between Complainant and Respondent. The Panel could not establish any indication that any of the circumstances as described in article 3.1 of the Regulations apply, nor that Respondent in any possible other way has rights to or legitimate interests in the Domain Name.

The Panel finds that Complainant has fulfilled the obligation to establish *prima facie* that Respondent has no rights to or legitimate interests in the Domain Name. As a result of its failure to submit a response, Respondent has not refuted the arguments of Complainant and/or shown rights to or legitimate interests in the Domain Name.

Consequently, the Panel is satisfied that Respondent has no rights or legitimate interests in Domain Name and concludes that Complainant has met the second requirement of article 2.1(b) of the Regulations.

C. Registered or Used in Bad Faith

When Respondent registered the Domain Name, the Trademark had already been registered and used in connection to Complainant’s activities.

By using the Domain Name to host a PPC parking page that offers for sale related products, Respondent creates a likelihood of confusion with the Trademark and it likely obtains revenue from this practice. In these circumstances, the Panel concludes that Respondent has targeted Complainant for profit. This constitutes bad faith under the Regulations, see, *Coöperatieve Raiffeisen- Boerenleenbank B.A. (Rabobank Nederland) v. Nguyet Dang, ND Dang*, WIPO Case No. DNL2010-0074; and *Scotch & Soda B.V. v. D-Max Ltd*, WIPO Case No. DNL2011-0058.

The fact that Respondent has no rights to or legitimate interests in the Domain Name and apparently also registered the Domain Name for the purpose of selling it to Complainant for valuable consideration in excess of Respondent’s costs directly related to the Domain Name, is also indicative of bad faith on the part of Respondent in its registration of the Domain Name.

In conclusion, the Panel finds that the requirement of registration or use in bad faith of the Domain Name pursuant to article 2.1(c) of the Regulations has been met.

7. Decision

For the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name <rothys.nl> be transferred to Complainant.

Remco M. R. Van Leeuwen
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 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).