

## **ADMINISTRATIVE PANEL DECISION**

Akzo Nobel Coatings International B.V. v. Jesse Alex  
Case No. D2023-0821

### **1. The Parties**

The Complainant is Akzo Nobel Coatings International B.V., Netherlands, represented by Akzo Nobel NV, Netherlands.

The Respondent is Jesse Alex, Nigeria.

### **2. The Domain Name and Registrar**

The disputed domain name <duluxlogistics.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 23, 2023. On February 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 23, 2023, the Registrar 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 ("Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf") and contact information in the Complaint. The Center sent an email communication to the Complainant on February 27, 2023, providing the 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 and the amendment to the Complaint on February 27, 2023.

The Center verified that the Complaint, together with the amended Complaint and the amendment to the Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 21, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on March 27, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a Dutch multinational company which manufactures paints and performance coatings for both industry and consumers worldwide.

Headquartered in Amsterdam, the company has activities in more than 150 countries.

The Complainant has an extensive portfolio of trademarks consisting of or comprising the DULUX trademark including the International Trademark Registration (“IR”) No. 853630, registered on September 16, 2004 for goods of classes 1, 3, 16, and 19 of the Nice Agreement Concerning the International Classification of Good and Services for the Purposes of the Registration of Marks.

Since October 10, 1996, the Complainant owns the domain name <dulux.co.uk>, which links to its website related to Dulux products and related services.

The disputed domain name was registered on January 20, 2023 and has been resolving to a website of a business listing a United Kingdom address and offering transportation and logistics services.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to its DULUX trademark since it is composed of the trademark and the descriptive term “logistics”.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent registered the disputed domain name to take unfair advantage of the Complainant’s DULUX trademark and reputation attached to it.

The Complainant claims that the contact address provided by the Respondent on the website at the disputed domain name is false and the photos of the Respondent’s management team are in fact stock photos of individuals gathered from the Internet, which is additional evidence of the Respondent’s bad faith.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

##### **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

#### **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel’s decision be made “on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the DULUX trademark and for the purpose of this proceeding the Panel establishes that the IR No. 853630 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \("WIPO Overview 3.0"\)](#) the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's DULUX trademark is clearly recognizable in the disputed domain name. The only difference between the Complainant's trademark and the disputed domain name is the addition of the term "logistics" to the trademark in the disputed domain name, which in view of the Panel does not prevent a finding of confusing similarity.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

#### **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the DULUX trademark.

The Complainant has never authorized the Respondent to use its DULUX trademark, in a domain name, or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name.

The Respondent has been using the disputed domain name to divert Internet users presumably looking for the Complainant to its own website for commercial benefit, which is not *bona fide* and cannot be deemed legitimate for the purpose of the Policy.

The Respondent failed to respond, and by doing so failed to offer the Panel any explanation for its registration and use of the disputed domain name, or any type of evidence set forth in paragraph 4(c) of the Policy.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name and the Complainant has established paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

Search for the term "dulux" on Google reveals solely the Complainant's goods and services under its globally used DULUX trademark. In the absence of any response by the Respondent, the Panel accepts the Complainant's contention that the disputed domain name was registered and is being used with intent of exploiting the reputation behind the DULUX trademark without any authorization or rights.

In the Panel's view paragraph 4(b)(iv) of the Policy applies. By using the disputed domain name, which reflects the Complainant's distinctive DULUX trademark, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

In the absence of any response by the Respondent, the Panel accepts the Complainant's contentions that the contact information on the Respondent's website is false, and such are the photos of the supposed management team, which in fact appear to be stock photos of individuals obtained from the Internet. Such use of the disputed domain name is detrimental to the valuable goodwill and reputation of the Complainant and its trademark. The Respondent's provision and use of false information on the website at the disputed domain name is in view of the Panel further indicative of bad faith.

Noting the above discussed facts and circumstances the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <duluxlogistics.com> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: April 10, 2023