

ADMINISTRATIVE PANEL DECISION

Akzo Nobel N.V. v. Registration Private, Domains By Proxy, LLC / Name Redacted
Case No. D2022-2556

1. The Parties

The Complainant is Akzo Nobel N.V., Netherlands, internally represented.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America / Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <akzonobel1.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 14, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 15, 2022, 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 amendment to the Complaint on July 18, 2022.

The Center verified that the Complaint together with 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”).

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2022. On July 20, 2022, the Center received communications from a third party, claiming that their GoDaddy account has been hacked, and that their hacked account was used to create the disputed domain name without their knowledge. The Center notified Commencement of Panel Appointment Process on August 12, 2022.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on August 19, 2022. 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 company, incorporated in 1911, dealing in paints and coatings internationally.

The Complainant states that it is the owner of the following trademarks:

AKZONOBEL, Benelux trademark, filed August 19, 2008, and registered August 20, 2008, registration number 849141, in classes 1, 2, 3, 5, 7, 9, 16, 17, 19, 30, 37, 40, 41, and 42;

AKZONOBEL, United Kingdom Intellectual Property Office (UKIPO) trademark, filed June 25, 2010, and registered December 13, 2011, registration number 801064677, in classes 1, 2, 3, 5, 7, 9, 16, 17, 19, 37, 40, 41, and 42;

AKZONOBEL, International trademark, filed and registered June 25, 2010, registration number 1064677, in classes 1, 2, 3, 5, 7, 9, 16, 17, 19, 30, 37, 40, 41, and 42.

The Complainant is also the owner of the domain name <akzonobel.com>, which has been used for its website since 1995.

No background information is available about the Respondent except for the purported and allegedly inauthentic name and contact details provided for the purpose of registration of the disputed domain name on April 13, 2022. The disputed domain name does not appear to have resolved to a substantive website but has been in use as the basis of an email address used to send fraudulent emails.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has rights in the trademarks listed in section 4 above, and also in its registered company name which is the same as its trademark. The disputed domain name reproduces the Complainant's trademark with the addition of the digit "1" (the number one). This represents a misspelling that readers may overlook. The disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant says the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has used its name and trademark historically and consistently. The Respondent has no *bona fide* reason to have used the Complainant's trademark and has not offered any evidence to the contrary.

The Complainant further contends that the disputed domain name was registered and is being used in bad faith. The Respondent has used the disputed domain name with intent to attract Internet users to the

Respondent's website or other online location by confusion with the Complainant's trademark for the purpose of the Respondent's commercial gain.

In particular, the Complainant alleges that the Respondent, having knowledge of emails flowing between the Complainant and its customers, has sent fraudulent invoices from an email address incorporating the disputed domain name, so looking like they came from the Complainant, with the intention of diverting payments to the benefit of the Respondent.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Respondent is required to submit to a mandatory administrative proceeding in the event that the Complainant asserts to the applicable dispute-resolution provider, in compliance with the Rules, that:

“(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.”

The Complainant has made the relevant assertions as required by the Policy. The dispute is properly within the scope of the Policy and the Panel has jurisdiction to decide the dispute.

A. Identical or Confusingly Similar

The Complainant has listed the details of three trademarks but has not provided any documentary evidence of its being the registrant of these.

Section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) notes the consensus interpretation of paragraphs 10 and 12 of the Rules, to the effect that the Panel may undertake limited factual research into matters of public record, including trademark registration databases. In the interests of expediency (Rules, paragraph 10(c)), the Panel has verified the Complainant's ownership of UKIPO trademark number 801064677 for AKZONOBEL, filed June 25, 2010, registered December 13, 2011.

The disputed domain name incorporates the entirety of the Complainant's trademark, followed by the digit “1”. The Panel finds the disputed domain name to be confusingly similar to the Complainant's trademark and that the additional digit “1” does not prevent a finding of confusing similarity. The generic Top-Level Domain (“gTLD”) “.com” need not be taken into account. Accordingly the Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has asserted, *prima facie*, that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has no *bona fide* reason to have used the Complainant's trademark.

Paragraph 4(c) of the Policy provides for the Respondent to contest the Complainant's *prima facie* case under paragraph 4(a)(ii) of the Policy and to establish rights or legitimate interests in a disputed domain name by demonstrating, without limitation:

“(i) before any notice to you of the dispute, your use of, or 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

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent has not responded and has not asserted any rights or legitimate interests in the disputed domain name. On the evidence, the Panel cannot foresee any basis on which the Respondent might be able to establish rights or legitimate interests in the disputed domain name with reference to paragraphs 4(c)(i), (ii) or (iii) of the Policy or otherwise. The Panel finds for the Complainant under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove under paragraph 4(a)(iii) of the Policy that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(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 web site or other on-line 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.”

The provisions of paragraph 4(b) of the Policy are without limitation and bad faith may be found alternatively by the Panel.

The disputed domain name does not appear to have been put to any substantive use as a website but, according to the evidence, has been used several times by the Respondent as an email address (bearing relation to the alleged full name that was not the same as Name Redacted in the intituling). The possibility exists that some recipients of emails may disregard the digit “1” appended after the Complainant's trademark in the sender's address as being innocuous or administrative. It may also be observed that the digit “1” can appear in some typefaces and computer fonts to be almost indistinguishable from the letter “l” (lower-case “L”), thereby imitating a spelling of the Complainant's trademark incorrectly as “akzonobell” rather than the

correct “akzonobel”, a difference that may be overlooked by some recipients.

An email produced in evidence is a communication dated May 4, 2022, in which the Respondent asked the recipient, the Complainant’s customer, whether a previous email had been received. The subject line referenced an Akzo Nobel statement of account by number. This email was above an extensive signature block naming the sender, “P”, as a purported credit analyst at the Complainant’s company “International Paint”, with the name of their team lead, the USA, Canadian and mobile telephone numbers, an apparently authentic email address of the Complainant, a website address of the Complainant, and certain general instructions about the payment of remittances that could also be authentic.

A second batch of emails produced in evidence showed legitimate correspondence from April 5, 2022 to April 22, 2022, between the Complainant and a customer, handled by the customer’s representative abbreviated in this proceeding as “J”, discussing invoice numbers and pricing details. On April 22, 2022, a message the Complainant states to be fraudulent was received by the customer, addressed to “J” in their personal name, stating, “Attached SOA [statement of account] as requested”. The message had the same extensive signature block as described in the paragraph above. On May 20, 2022, a further message to the customer, addressing them as “J” personally, from “P” at the email address of the disputed domain name and with the same signature block, said, “Would you please tell me whether you received my last email or not? Please let me know so that I can update you further”. On June 21, 2022, “P” sent another email to the customer, containing a DocuSign box marked “[P] sent you a Statement to review and sign”, with a button marked “REVIEW DOCUMENT” that would have led the customer to an HTTPS address.

A third set of correspondence, with most contact details redacted, begins with an authentic email dated March 29, 2022, in which the Complainant received a question relating to transactions. On May 31, 2022, “P”, using the disputed domain name, emailed the relevant customer saying “Would you please tell me whether you received my last email or not? Please let me know so that I can update you further”. It would appear the customer was actually confused by this email because they replied to “P” on June 1, 2022, saying “Can you please update me today if possible?” “P” replied on June 29, 2022, with an email that said “Please copy and paste the following link into your browser to view statement”, with a link to an HTTPS address that was the same as the one associated with the DocuSign box described in the paragraph above.

On the totality of the evidence in the above three sets of emails, it is apparent that the Respondent had gained information from emails passing between the Complainant and certain of its customers and had attempted to intervene with alternative instructions for the payment of accounts at opportune moments. In doing so the Respondent had relied on the expectation that in at least some instances a customer would be confused into believing the disputed domain name, as it appeared in the email address, belonged to the Complainant. In the terms of paragraph 4(b)(iv) of the Policy, on the evidence and on the balance of probabilities, the Respondent is found to have used the disputed domain name with intent to attract Internet users to the Respondent’s on-line location, namely its email address, by confusion with the Complainant’s trademark, and to have done so with the intention of commercial gain by the diversion of payments, constituting use in bad faith. On the same basis of evidence the disputed domain name is found to have been registered by the Respondent for the bad faith purpose for which it has been used. Registration and use of the disputed domain name in bad faith are found in the terms of paragraph 4(a)(iii) of the Policy.

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, <akzonobel1.com>, be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: August 30, 2022