

ADMINISTRATIVE PANEL DECISION

Akzo Nobel Coatings International B.V. v. Manlidy, GNN
Case No. D2023-1241

1. The Parties

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

The Respondent is Manlidy, GNN, Singapore.

2. The Domain Name and Registrar

The disputed domain name <duluxpainting.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2023. On March 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 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 (“WhoisSecure”) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 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 amendment to the Complaint on March 28, 2023.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 21, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on May 2, 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 Singapore trademark No. T39007801, registered on July 8, 1939 for goods in class 2 ICGS, and International Trademark Registration No. 853630, registered on September 16, 2004 for goods of classes 1, 3, 16, and 19 ICGS. The Complainant has also a large portfolio of flourish device marks and DULUX TRADE word mark and device.

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 Complainant is also the registered owner of a number of domain names with the words “dulux” and “trade” incorporated in them, <duluxtrade.com>, <duluxtrade.co.uk>, <duluxtrade.eu>, and <duluxtradepaintexpert.co.uk> to name a few.

The disputed domain name was registered on February 22, 2023, and resolves to a website where the Complainant’s trademarks DULUX, flourish device mark and DULUX TRADE word mark and device, interior images, product names, images of the Complainant are reproduced and where the Complainant’s products are purportedly offered for sale at discounted price.

5. Parties’ Contentions

A. Complainant

The Complainant contends as follows:

- (1) The disputed domain name is identical to the Complainant’s registered trademarks and domain name. The Respondent has added the descriptive term “painting”, which does not add to the distinctiveness of the overall disputed domain name.
- (2) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant is the registered proprietor of the name DULUX, wholly included in the disputed domain name that is subject of the Complaint. The Respondent thus has no *bona fide* reason or evidence in support to the contrary and it must be concluded the Respondent had no fair intention when registering the disputed domain name.
- (3) The Respondent registered and is using the disputed domain name in bad faith. The Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent’s website 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 the Respondent’s website or location or of a product or service on the Respondent’s website or location. The Respondent has created a website falsely claiming to be, or otherwise associated to, the Complainant. Thus, deliberately misleading the public into believing the disputed domain name is somehow affiliated to the Complainant, or worse that the disputed domain name is the genuine website of the Complainant. The Respondent not only uses the Complainant’s registered trademarks for DULUX, but also the flourish device mark and DULUX TRADE word mark and device. The Respondent has intentionally copied the Complainant’s entire layout from the Complainant’s actual website “www.duluxtradepaintexpert.co.uk”, including the trademarks, interior images, product names and images, to make the website look like it is the Complainant’s genuine website for financial gain. The contact address provided by the Respondent on the website at the disputed domain name is false. The Respondent’s conduct demonstrates the Respondent’s knowledge of the Complainant and the Complainant’s trademarks.

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

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

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

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated ownership of its DULUX trademarks. Therefore, the Panel is satisfied that the Complainant has registered trademark rights in the DULUX marks. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel is also of the view that the disputed domain name is confusingly similar to the Complainant's trademarks because it incorporates the trademark in its entirety, merely adding the term "painting".

Adding the term "painting" does not prevent a finding of confusing similarity between the disputed domain name and the mark under the Policy, paragraph 4(a)(i). Bearing that in mind, the Panel accordingly holds the disputed domain name is confusingly similar to the Complainant's trademark DULUX.

The addition of the generic Top-Level Domain ("gTLD") ".com" shall be disregarded for the purposes of assessing confusing similarity, as it is a standard requirement of registration. See [WIPO Overview 3.0](#), section 1.11.1.

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

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of “proving a negative”, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Complainant made sufficient statements in order to demonstrate that the Respondent would have no rights or legitimate interests in the disputed domain name. The Panel has found no evidence that the Respondent is a licensee of the Complainant or affiliated with the Complainant in any way. There is no information in the case file that the Complainant has ever granted any authorization for the Respondent to make use of its trademarks in a domain name or otherwise.

There is no relationship whatsoever between the parties and the Respondent has clearly modified the Complainant’s trademarks for its own use and incorporated them into the disputed domain name without the Complainant’s authorization.

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

Bearing in mind the content of the website to which the disputed domain name redirects, the Panels also finds that 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, reflecting an awareness of the Complainant and an intent to target the Complainant, which is not *bona fide* and cannot be deemed legitimate rights or interests 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

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Panel finds that the Complainant has demonstrated the Respondent’s bad faith registration and use of the disputed domain name.

The Complainant holds multiple trademark registrations for the trademarks DULUX that long predate the registration of the disputed domain name.

It has been clearly showed by the Complainant, that the Respondent has created a website falsely claiming to be, or otherwise associated to, the Complainant. The Respondent not only uses the Complainant’s registered trademarks for DULUX, but also the flourish device mark and DULUX TRADE word mark and device. The Respondent has intentionally copied the Complainant’s entire layout from the Complainant’s actual website “www.duluxtradepaintexpert.co.uk”, including the trademarks, interior images, product names, and images, to make the website look like it is the Complainant’s genuine website for financial gain. Considering the above, the Respondent could not be unaware of the Complainant’s trademark when registering the disputed domain name. The Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainant’s marks at the time it registered the disputed domain name. This clearly suggests that the Respondent acted with opportunistic bad faith in registering the disputed domain name in order to make an illegitimate use of it. Hence, the Panel finds that the Respondent

knew or should have known of the Complainant's trademark and deliberately registered the confusingly similar disputed domain name (see section 3.2.2, [WIPO Overview 3.0](#)).

Furthermore, the Panel is also of the view that the disputed domain name has been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion – or at least an impression of association – between DULUX trademarks and the disputed domain name.

As regards bad faith use, in the Panel's view, 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. Such use of the disputed domain name is detrimental to the valuable goodwill and reputation of the Complainant and its trademark. The Respondent's use of the Complainant's trademarks, images and information on the website at the disputed domain name is in view of the Panel further indicative of bad faith.

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that the Complainant has established its case under paragraph 4(a)(iii) of the Policy.

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

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: May 15, 2023