

ADMINISTRATIVE PANEL DECISION

Akzo Nobel Coatings International B.V. v. Manlidy, GNN
Case No. D2023-1265

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 <paintduluxtrade.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 23, 2023. On March 23, 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 28, 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 29, 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 April 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 28, 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 and DULUX TRADE trademarks, including in Singapore, where the Respondent is residing, namely:

- Singapore trademark DULUX No. T3900780I, registered on July 08, 1939 for goods in class 2 ICGS,
- International Trademark Registration DULUX No. 853630, registered on September 16, 2004 for goods in classes 1, 3, 16, and 19 ICGS, designating Singapore,
- International Trademark Registration DULUX TRADE No. 1286437, registered on January 12, 2016 for goods in class 2 ICGS.

The Complainant has also a large portfolio of flourish device marks.

Since October 10, 1996, the Complainant owns the domain name <dulux.co.uk>, and since November 26, 2012 also the domain name <duluxtradepaintexpert.co.uk> which links to the Complainant's websites related to Dulux products and related services.

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 and images of the Complainant are reproduced and where the Complainant's products are purportedly offered for sale at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

(1) The Complainant is the registered proprietor of the marks DULUX and DULUX TRADE. DULUX brand was introduced in 1931 in the United Kingdom and is now an internationally available brand of paint which has become a household name. The Respondent has added the terms "paint" and "trade" to the mark DULUX, which do not add to the distinctiveness of the overall domain name. The disputed domain name is almost identical to the Complainant's registered trademarks and 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 filed a UDRP complaint against <duluxpainting.com> on March 22, 2023. The disputed domain name and the <duluxpainting.com> domain name have the same registrant and the same website is linked to each of the domains. This is further evidence of the Respondent's deliberately and fraudulent conduct.

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

With the Complainant's rights in the DULUX TRADE trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

The first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". See [WIPO Overview 3.0](#), section 1.7. 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.

The Panel is of the view that the disputed domain name is confusingly similar to the Complainant's trademarks because it incorporates the trademark DULUX TRADE in its entirety, merely adding term "paint". Adding the term "paint" does not prevent a finding of confusing similarity between the disputed domain name and the trademark DULUX TRADE 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 TRADE.

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 resolves, the Panel 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, which is not *bona fide* and cannot be deemed legitimate for the purpose of the Policy.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

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 and DULUX TRADE that predate the registration of the disputed domain name.

It has been clearly shown 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 DULUX and DULUX TRADE in the disputed domain name, but also the respective trademarks and the flourish device mark on the website to which the disputed domain name resolves. Therefore, the Panel believes that 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 and DULUX TRADE 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 and DULUX TRADE trademarks, 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 provision and 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.

Furthermore, the Panel also took into consideration that the Complainant filed a UDRP complaint against another domain name <duluxpainting.com>, that has the same registrant, and very similar websites are linked to each of the domains (see the decision *Akzo Nobel Coatings International B.V. v. Manlidy, GNN*, WIPO Case No. [D2023-1241](#)). This is further evidence of the Respondent's bad faith conduct.

Furthermore, in the Panel's view, there is sufficient evidence to make a determination based upon paragraph 4(b)(ii) of the Policy, which provides that bad faith registration and use will be found where the Respondent has "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 [the Respondent has] ... engaged in a pattern of such conduct". Previous UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners (see [WIPO Overview 3.0](#), section 3.1.2). Bearing the above in mind, the fact of registering two domain names that incorporate the Complainant's trademark represents, in the Panel's assessment, a pattern of conduct directed against the Complainant, stopping it from reflecting

its trademark in the disputed domain name. The Panel concludes that paragraph 4(b)(ii) of the Policy is made out.

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.

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 <paintduluxtrade.com> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: May 15, 2023