

ADMINISTRATIVE PANEL DECISION

Bostik SA v. Michael Bejach
Case No. D2023-1509

1. The Parties

The Complainant is Bostik SA, France, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America (“United States”).

The Respondent is Michael Bejach, United States.

2. The Domain Name and Registrar

The disputed domain name <bostikglue.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 April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 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 on April 25, 2023.

The Center verified that the Complaint together with the amended 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 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent sent an informal communication to the Center on April 9, 2023, stating: “Can you all please explain what the issue is?” The Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it would proceed with Panel Appointment on May 17, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on May 25, 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 the registered owner of several trademarks for the term BOSTIK, *e.g.*, United States Trademark Registration No. 0749972 BOSTIK (word) registered on May 28, 1963 for goods in class 1.

The disputed domain name was registered on February 12, 2023.

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name, at the time of filing of the Complaint, resolved to a parking page displaying Pay-Per-Click ("PPC") links.

5. Parties' Contentions

A. Complainant

It results from the Complainant's allegations that the Complainant is a manufacturer and distributor of adhesives and sealants for the construction, industrial and consumer markets. It employs 6,000 people circa and has a presence in more than 50 countries. Among the Complainant's many products are a number of BOSTIK branded glues and adhesives that are sold around the world.

The Complainant uses the domain name "www.bostik.com" in order to promote its products.

The Complainant contends that its trademark BOSTIK is distinctive and well known.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark, since it simply consists of the BOSTIK trademark, the non-distinctive term "glue", which describes the goods that the Complainant manufactures and sells under the BOSTIK trademark, and the ".com" generic Top-Level Domain ("gTLD") extension.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademark in domain names or in any other manner. The Respondent's only use of the disputed domain name is in connection with the parked website to which the disputed domain name resolves. Such use demonstrates neither a *bona fide* offering of goods or services nor a legitimate interest, particularly in the BOSTIK mark. The Respondent's email of April 12, 2023 to the Complainant's representative- offering to sell the disputed domain name to the Complainant for an unspecified amount - makes clear that the Respondent sought to profit from his registration of the disputed domain name by selling it to the Complainant at a profit. As such, the Respondent's registration and use of the disputed domain name fail to demonstrate a right or legitimate interest in the disputed domain name.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, since its BOSTIK trademarks are well known within the relevant industries and enjoy widespread international recognition, it is inconceivable that the Respondent was unaware of the BOSTIK trademark when he registered the disputed domain name, particularly given the fact that the Respondent added the term "glue" to the Complainant's trademark. In addition, the Respondent's attempt to sell the disputed domain name to the Complainant further demonstrates his bad faith registration and use of the disputed domain name.

B. Respondent

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

Apart from the Respondent's email of April 9, 2023, the Center did not directly receive any other email communications from the Respondent. However, the evidence submitted by the Complainant shows that the Respondent offered to sell the disputed domain name to the Complainant on April 12, 2023, and later on April 14, 2023, the Respondent requested the Complainant not to contact him again due to personal issues.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint 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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the owner of various trademark registrations for BOSTIK as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark BOSTIK is fully included in the disputed domain name, followed by the term "glue". Furthermore, it is the view of this Panel that the addition of the term "glue" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the gTLD ".com" of the disputed domain name may be disregarded under the first element confusing similarity test as it is viewed as a standard registration requirement (see [WIPO Overview 3.0](#) at section 1.11.1). In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must further establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark BOSTIK or the registration of the disputed domain name.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might have been commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name is clearly constituted with the Complainant's registered trademark BOSTIK and the term "glue", which clearly refers to the Complainant's core business, tending to suggest sponsorship or endorsement by the Complainant. Therefore, the disputed domain name carries a risk of implied affiliation. See [WIPO Overview 3.0](#) at section 2.5.1.

In fact, it results from the undisputed evidence before the Panel that the disputed domain name resolves to a parking website comprising PPC links that compete with or capitalize on the reputation and goodwill of the Complainant's trademark or otherwise mislead Internet users. Prior UDRP panels have found that the use of a domain name to host a parked page comprising PPC links does not represent *bona fide* offering of goods or services, 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 3.0](#) at section 2.9, with further references). This Panel shares this view. Therefore, such use can neither be considered as *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any relevant allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied 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, lastly, establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in its paragraph 4(b) may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand. The Complainant's trademarks have existed for many years. Further, the additional term "glue" in the disputed domain name refers to the Complainant's business. Therefore, this Panel has no doubt that the Respondent positively knew of the Complainant and its trademarks when the Respondent registered the disputed domain name. Registration of the disputed domain name by the Respondent in awareness of the BOSTIK mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith.

In addition, the Complainant has proven that the disputed domain name resolved to a parking website comprising PPC links that compete with or capitalize on the reputation and goodwill of the Complainant's trademark or otherwise mislead Internet users, so that the Panel is satisfied that the disputed domain name, incorporating the Complainant's trademark in its entirety followed by the term "glue", is being used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's 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 the Respondent's website or location, or of a product or service on the Respondent's website or location.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant's mark plus the addition of the term "glue", that corresponds to the complainant's area of activity);
- (ii) the Respondent offered to sell the disputed domain name to the Complainant for an unspecified amount, after receiving the Complaint;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

The Panel finds that the Complainant has therefore satisfied 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 <bostikglue.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: June 8, 2023