

ADMINISTRATIVE PANEL DECISION

Forbo Management SA v. AG van Oosten Holding
Case No. DNL2023-0013

1. The Parties

The Complainant is Forbo Management SA, Switzerland, represented by Weinmann Zimmerli, Switzerland.

The registrant of the disputed domain name is AG van Oosten Holding, Netherlands (“Respondent”).

2. The Domain Name and Registrar

The disputed domain name <marmoleumvloer.nl> (the “Domain Name”) is registered with SIDN through team.blue nl B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2023. On April 17, 2023, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name.

On April 18, 2023, SIDN transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named respondent and contact information in the Complaint.

The Center sent an email communication to Complainant on April 25, 2023, providing the information disclosed by SIDN, and inviting Complainant to amend the Complaint in this light. Complainant filed an amended Complaint on Wednesday April 26, 2023.

The Center verified that the Complaint as amended satisfies the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified Respondent of the Complaint and the proceedings commenced on April 26, 2023. In accordance with the Regulations, article 7.1, the due date for Response was May 16, 2023. The Center did not receive any response. Accordingly, the Center notified Respondent’s default on May 17, 2023.

The Center appointed Dinant T. L. Oosterbaan as the panelist in this matter on May 26, 2023. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

According to the information provided in the Complaint, Complainant is part of the Forbo group of companies, which is a global player in high-quality commercial floor coverings. With a market share of over 65 percent, Forbo is world leader in linoleum, which is sold under the trademark MARMOLEUM in rolls as well as modular tile formats. In the Netherlands, the Forbo group owns a large manufacturing facility and its market share in the linoleum market is higher than in other countries

According to the evidence submitted, Complainant owns a large number of trademark registrations, including International trademark MARMOLEUM with number 683531, registration date September 11, 1997, also applicable in the Benelux/the Netherlands.

SIDN informed the Center that the Domain Name was first registered on May 19, 2009, and that the date of the current registration by change of registrant is January 24, 2017.

The Domain Name resolves to a website promoting the products of a company associated with Respondent.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar to Complainant's registered trademark MARMOLEUM. The Domain Name entirely incorporates the trademark MARMOLEUM, and only adds the term "vloer" - the Dutch noun for "floor". This additional term directly describes the products that are offered by Complainant under the trademark MARMOLEUM and, therefore, lacks any distinctive character.

According to Complainant, Respondent has no rights of legitimate interest in the Domain Name. Respondent holds no trademark or name rights in the term MARMOLEUM and is, in particular, not commonly known by this term/the Domain Name. There is no license or any other agreement allowing Respondent to use this term or the Domain Name. Complainant submits that Respondent has registered and uses the Domain Name solely in bad faith and not in connection with a *bona fide* offering of goods or services. Accordingly, Complainant concludes that Respondent has no rights or legitimate interests in the Domain Name.

Complainant asserts that the Domain Name has been registered and is being used in bad faith. According to Complainant, at the time of registration of the Domain Name, Respondent was affiliated with a company offering flooring solutions; as a competitor of Complainant, Respondent was thus well aware of Complainant's famous MARMOLEUM trademark. Tellingly, on the website to which the Domain Name resolves, Respondent compares Complainant's Marmoleum products with its own competing products as follows:

"Marmoleumvloer te beperkt?

Kies dan voor een gietvloer op maat!

Een marmoleumvloer kan een hele goede oplossing zijn als u een vloer zoekt die er strak uitziet en daarnaast slijtvast, krasvast, vochtbestendig, isolerend, veerkrachtig en anti statisch is. Het nadeel van een marmoleumvloer is echter, dat u met marmoleum vastzit aan een beperkt aantal kleuren en dessins. Wilt u echt een vloer op maat, die dezelfde voordelen biedt als marmoleumvloeren, dan kunt ook overwegen een gietvloer te kiezen. Op deze site vertelt Coating Vloer Company u meer over de

mogelijkheden die u met een gietvloer hebt en de verschillen en overeenkomsten tussen een marmoleumvloer en een gietvloer.”

(Translation: “Marmoleum flooring too confined?
Then opt for a custom cast floor!

Marmoleum flooring can be a very good solution if you are looking for a floor that looks sleek and is also hard-wearing, scratch-resistant, moisture-resistant, insulating, resilient and anti-static. The disadvantage of a marmoleum floor, however, is that with marmoleum you are tied to a limited number of colors and designs. If you really want a custom-made floor that offers the same advantages as marmoleum flooring, you may also consider choosing a cast floor. On this site, Coating Vloer Company tells you more about the options available to you with a cast floor and the differences and similarities between a marmoleum floor and a cast floor.”)

Complainant submits that Respondent not only uses the Domain Name for the promotion of its own products, which are identical to the flooring products offered under Complainant’s trademark. Respondent also directly targets the fame and outstanding reputation of the MARMOLEUM trademark and the products offered thereunder by highlighting the alleged advantages of Respondent’s solution. In other words, the only reason for the registration and use of the Domain Name was and is to attract, for commercial gain, Internet users searching for Complainant’s MARMOLEUM products to Respondent’s website and to disrupt Complainant’s business. There is no doubt that Respondent has registered and uses the Domain Name in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Based on article 2.1 of the Regulations, a claim to transfer a domain name must meet three cumulative conditions:

- a. the domain name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the complainant has rights, or other name mentioned in article 2.1(a) under II of the Regulations; and
- b. the respondent has no rights to or legitimate interests in the domain name; and
- c. the domain name has been registered or is being used in bad faith.

As Respondent has not filed a Response, the Panel shall rule based on the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or in fact.

A. Identical or Confusingly Similar

Complainant has established that it is the owner of the International trademark MARMOLEUM, also applicable in the Netherlands.

The Domain Name incorporates the MARMOLEUM trademark in its entirety, the only difference being the addition of the word “vloer” (translation: “floor”). Previous panels under the Regulations have found that a domain name is confusingly similar or identical to a complainant’s trademark where the domain name incorporates a dominant feature or entirety of such trademark. See also sections 1.7 and 1.8 of the WIPO

Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).¹
The addition of the word “vloer” does not prevent a finding of confusing similarity.

The country code Top-Level Domain (“ccTLD”) “.nl” may be disregarded for purposes of article 2.1(a) of the Regulations, see *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. [DNL2008-0008](#).

The Panel finds that the Domain Name is confusing similar to Complainant’s MARMOLEUM trademark for purposes of the Regulations.

B. Rights or Legitimate Interests

As stated in [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 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 Panel’s opinion, Complainant has made out a *prima facie* case that Respondent lacks rights to or legitimate interests in the Domain Name.

According to the undisputed submissions and evidence provided by Complainant, by using the Domain Name, Respondent through the incorporation of the entirety of Complainant’s trademark in the Domain Name diverts Internet users to a website comparing in a rather negative manner the products offered by Complainant with the cast floor products offered by Respondent or by a company associated with Respondent.

The Panel at the time of the decision accessed the website under the Domain Name and confirmed that the website includes the language mentioned above under 5.A., comparing marmoleum and cast floor products. The Panel does not consider such use a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name as Respondent on its website uses the trademark of Complainant to promote its own products.

In addition, there is no evidence before the Panel that Respondent has acquired any relevant trademark or other rights corresponding to the Domain Name, nor of any business relationship between Complainant and Respondent. There is also no indication that Respondent is commonly known by the Domain Name. Moreover, the Panel finds that the composition of the Domain Name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

No Response to the Complaint was filed and Respondent has not rebutted Complainant’s *prima facie* case.

On the record before it, the Panel finds that Respondent has no rights to or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

The Panel finds that the Domain Name has been registered and is being used in bad faith.

¹ In view of the fact that the Regulations are substantially similar to the Uniform Domain Name Dispute Resolution Policy (“UDRP”), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#), may be relevant to the determination of this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

SIDN informed the Center that Respondent became the registrant of the Domain Name in January 2017, thus many years after Complainant acquired relevant trademark rights. It is well established that the date Respondent as the current registrant acquired the Domain Name is used to assess bad faith registration (see [WIPO Overview 3.0](#), section 3.9).

Noting the status of the MARMOLEUM trademark, the reputation of Complainant and its large manufacturing facility in the Netherlands, and the overall circumstances of this case, the Panel finds it highly likely that Respondent knew, and further finds that Respondent in any event should have known, Complainant's trademark at the time Respondent became the current registrant of the Domain Name, especially in view of the fact that the Domain Name includes the entirety of Complainant's trademark and that the Domain Name resolves to a website which is used to unfavorably mention the products of Complainant and to promote its own cast floor products.

In light of these circumstances, the Panel concludes that Respondent has attempted or is attempting to attract Internet users, for commercial gain, to the website of Respondent through the likelihood of confusion which may arise with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of the website of Respondent, which constitutes registration and use in bad faith.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name, <marmoleumvloer.nl>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Panelist

Date: June 9, 2023