

ADMINISTRATIVE PANEL DECISION

KATIMEX Cielker GmbH v. Amwittools BV
Case No. DNL2024-0013

1. The Parties

The Complainant is KATIMEX Cielker GmbH, Germany, represented by Brinkmann & Partner, Germany.

The registrant of the disputed domain name is Amwittools BV, Netherlands (Kingdom of the) (the “Netherlands”), represented by Moree Gelderblom advocaten, the Netherlands (the “Respondent”).

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 5, 2024. On March 6, 2024, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name.

On March 7, 2024, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details of the Respondent.

The Center verified that the Complaint 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 the Respondent of the Complaint, and the proceedings commenced on March 7, 2024. In accordance with the Regulations, article 7.1, the due date for Response was March 27, 2024. The Response was filed with the Center on March 27, 2024.

On April 4, 2024 SIDN commenced the mediation process. On June 18, 2024 SIDN extended the mediation process until July 18, 2024. On July 31, 2024, the Center received a supplemental filing from the Respondent. On August 13, 2024 SIDN extended the mediation process until September 12, 2024. On September 13, 2024 SIDN extended the mediation process until October 12, 2024. On October 15, 2024 SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Willem J. H. Leppink as the panelist in this matter on November 8, 2024. 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

The Complainant, located in Jünkerath, Germany, is an international manufacturer and distributor of cable laying products and accessories.

The Complainant is the owner of the European Union Trade Mark for KATIMEX (word) with number 003760857, registered on January 18, 2006 inter alia for goods 6, 7, and 8 (“Trademark”).

This trademark registration predates the registration of the disputed domain name on June 13, 2008.

At the time of this decision, the disputed domain name redirects to the domain name <amwittools.nl>. On the website to which the latter domain name resolves (the “Website”), a wide range of products of different trademarks are being offered for sale, including products under the KATIMEX trademark.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied the each of the elements required under the Regulations for a transfer of the disputed domain name.

Notably, the Complainant contends the following.

The disputed domain name is identical to the Trademark as it incorporates the Trademark in its entirety. Moreover, the Trademark is being used to sell identical goods as for which the Trademark is registered.

The Respondent has no rights or legitimate interest in the disputed domain name. The Respondent was an intermediary of the Complainant in the Netherlands. However, this cooperation was terminated in 2022. The Complainant has exclusive rights to the KATIMEX sign in the course of trade. The Respondent itself has no such rights. The Complainant has never consented to the registration of the disputed domain name or subsequently authorized it. No rights to the trademark were granted or transferred in favor of the Respondent.

The disputed domain name is being used to intentionally attract for commercial gain, Internet users to the Respondent’s website by means of redirecting the disputed domain name to the Website. And therefore, creates a likelihood of confusion with the source of the Website and the Trademark.

B. Respondent

The Respondent denies the Complainant’s contentions.

The Respondent contends the following.

The Respondent and the Complainant have in the past entered into an agreement under which the Respondent markets products under the Trademark in the Netherlands through distribution (“Agreement”). This Agreement has been going on for many years.

The Respondent has therefore represented the Complainant at domestic and foreign trade fairs. The Complainant's products are sold by the Respondent. The Respondent ensured that the Complainant received additional customers. The Complainant in turn referred Dutch customers to the Respondent which follows from an email dated November 10, 2014.

The Respondent has never received compensation from the Complainant for these distribution activities. The Parties worked together to their full satisfaction. Various actions were coordinated at management level. The Respondent has informed the Complainant that, in the framework of this distribution agreement, it had a website to which the disputed domain name resolved. The Complainant through its management, agreed to this from the start. In the year 2023, the Respondent noticed that the Complainant had requested a second distributor in addition to the Respondent. This behavior surprised the Respondent, but did not alter the fact that there was an agreement between the parties and that the website was hosted under the Agreement. The Respondent submits an email sent on June 19, 2018 to the Complainant which includes the following:

"[...] We have been using the name for a very long time, in fact from the moment of cooperation in 2008. In the meantime, Katimex made grateful use of our services as a stock holding agent/distributor to sell the Katimex products and build up the name Katimex in the Netherlands[.] Katimex never acted against using the domain and in discussions with [...] this was discussed at the time. [L]egally this is equivalent to a permission by Katimex. Of course it is about selling Katimex products together in the Netherlands and legal matters would only be a wedge between parties and that is not what we are after. We have no difficulty in referring Katimex.nl to your new website and can also take care of the translations. Please send the available texts so that we can start translating. [...]"

The Respondent continues to contend as follows.

The Complainant agreed to allow the Respondent to have this site. Furthermore, the Respondent has indicated from the outset that it would immediately enter into negotiations if the Complainant wishes to formally terminate the Respondent's distributorship. At the moment, the Respondent only hears reports that the Complainant may want to do this. In that context, the Respondent is of course also prepared to reach a settlement and transfer the website in question for reasonable compensation. However, the Complainant has no response on that point. The Respondent therefore firmly takes the position that it has hosted the website in question by agreement, or at least by permission of the Complainant. The Respondent therefore does not intend to voluntarily discontinue use of the Website, let alone transfer the Website.

During the mediation process the Respondent sent another letter to the Center, which will be discussed below.

6. Discussion and Findings

6.1. Preliminary Matter

Before entering into the merits of the case, the Panel addresses the matter of the unsolicited supplemental filing. Article 11.2 of the Regulations stipulates that that the Panel shall determine the admissibility of unsolicited filings.

Only the Respondent submitted an unsolicited filing, namely the letter send to the Center on July 31, 2024.

Unsolicited supplemental filings are generally discouraged, as is described in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").¹

¹In view of the fact that the Regulations are in large part based on 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](#), are relevant to this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

However, when the Party submitting or requesting to submit a unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response. The Panel is not satisfied that such exceptional circumstances exist and, therefore, decides that the unsolicited supplemental filing by the Respondent will not be admitted. The Respondent is reminded, that each party in principle has “one bite at the apple”. In any event, the Panel notes that this submission, if admitted, would not alter outcome of the dispute.

6.2. Substantive Matter

Pursuant to article 2.1 of the Regulations the Complainant must prove each of the following three elements:

a) the disputed domain name is identical or confusingly similar to:

I) a trademark or trade name protected under Dutch law in which the Complainant has rights; or

II) a personal name registered in the General Municipal Register (Gemeentelijke Basisadministratie) of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the Complainant undertakes public activities on a permanent basis; and

b) the Respondent has no rights to or legitimate interests in the disputed domain name; and

c) the disputed domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7

The Complainant has shown that it has rights in the Trademark, which is also protected under Dutch law.

The entirety of the Trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Complainant has thus established the first element of article 2.1 of the Regulations.

B. Rights or Legitimate Interests

Consistent with earlier decisions under the Regulations, the Complainant must prima facie demonstrate that the Respondent has no rights to or legitimate interests in the disputed domain name. If the Complainant succeeds in making out this prima facie case, the burden of production shifts to the Respondent, who will then have to come forward with appropriate allegations or evidence demonstrating a right to or legitimate interests in the disputed domain name. See *Auto 5 v. E. Shiripour*, WIPO Case No. [DNL2008-0027](#).

The Respondent may demonstrate such rights or legitimate interests inter alia through any of the following circumstances based on article 3.1 of the Regulations:

a) before having any notice of the dispute, the Respondent made demonstrable preparations to use the disputed domain name (or a name corresponding to the disputed domain name) in connection with a bona fide offering of goods or services; or

b) the Respondent as an individual, business or other organization is commonly known by the disputed domain name; or

c) the Respondent is making a legitimate noncommercial use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish or otherwise damage the relevant trademark, trade name, personal name, name of a Dutch public legal entity or name of an association or foundation located in the Netherlands.

The Complainant alleges that the Respondent has no rights or legitimate interest in the disputed domain name for the reasons referred to above in Section 5.A. The Respondent, however, alleges that there is an Agreement in place and/or that the Complainant has agreed for the disputed domain name to be registered and used by the Respondent.

Having reviewed the available record, the Panel concludes that the Respondent did not show any rights or legitimate interest in the disputed domain name. Despite the fact that there is or has been a relationship between the Parties and subsequent communications, the Respondent has failed to prove that the Complainant consented to registration and/or use of the disputed domain name. It follows from an email communication in 2018, that the Respondent said that the Complainant was aware of the disputed domain name, but as such that does not provide any evidence of consent by the Complainant for the registration of the disputed domain name. To the contrary, the Respondent in that email replied to an email sent by the Complainant to the Respondent in which the Complainant indicated that the Complainant protected its Trademark and that the Respondent is not allowed to use the disputed domain name without the Complainant's approval. The Complainant then suggested a possible solution of the arisen dispute, but there is no record of any settlement being achieved.

Furthermore, the Oki Data criteria (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), for showing a right or legitimate interest for the Respondent in the disputed domain name, are not met. An accurate and prominent disclosure of the relationship with the trademark holder is not displayed and the obligation under these criteria to only sell authorized trademarked goods or services is also not met. Moreover, there is a clear risk of implied affiliation that the disputed domain name, by nature of being identical to and solely comprised of the Trademark, is that of the Complainant.

In addition, the disputed domain name is anyway not being used for a website dedicated to products sold under the Trademark, but for a redirect to the Respondent's domain name and Website, which in these circumstances can also not be considered as a legitimate use under the Regulations.

The Complainant has thus established the second element of article 2.1 of the Regulations.

C. Registered or Used in Bad Faith

In light of the Panel's above considerations in Section 6.2.B, the facts presented by the Complainant, and the fact that the disputed domain name is currently used to redirect Internet's users from the disputed domain name to the Website, the Panel finds that the disputed domain name is being used to intentionally attract for commercial gain, Internet users to the Website by creating a likelihood of confusion with the Complainant's identical trademark.

In addition, the Panel finds that the Respondent is using the registration of the disputed domain name as leverage related to the termination of the relationship between the Parties.

The Complainant has thus established the third element of article 2.1 of the Regulations.

The Panel underlines that its above findings are based on the record of this case within the abbreviated framework of the Regulations, and that the Regulations leave open the possibility for parties to take their case to court for more extensive fact-finding options.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the disputed domain name <katimex.nl> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Panelist

Date: November 13, 2024