

ADMINISTRATIVE PANEL DECISION

Arcadis N.V. v. Maybelline TE

Case No. DPH2022-0001

1. The Parties

The Complainant is Arcadis N.V, Netherlands, represented by Merkenbureau Knijff & Partners B.V., Netherlands.

The Respondent is Maybelline TE, Philippines.

2. The domain name and Registrar

The disputed domain name <arcadis.ph> is registered with DotPH (the “Registry”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 17, 2022. On January 19, 2022, the Center transmitted by email to Registry a request for registrar verification in connection with the disputed domain name. On January 20, 2022, Registry transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2022 providing the Registrant and contact information disclosed by the Registry and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on February 3, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .PH Uniform Domain Name Dispute Resolution Policy (“phDRP” or the “Policy”), the .PH Uniform Dispute Resolution Implementation Rules (the “Rules”), and the WIPO Supplemental Rules (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 3, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was March 23, 2022. The Respondent sent email communications on February 1, 3, and 18, 2022. The Center sent the Notification of Respondent’s Default on March 24, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on April 13, 2022. 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 well-known global design, engineering and management consulting company based in Amsterdam, the Netherlands. It currently operates in excess of 350 offices across 70 countries and generates approximately EUR 3.4 billion in revenue.

The company founded as the land reclamation specialist “Nederlandsche Heidemaatschappij” in 1888. Over the following decades, it became involved in various development projects, initially with a rural focus. During the second half of the 20th century, the company developed its international presence as well as its shift into urban development. It pursued a European expansion programmed immediately following the end of the Cold War. During 1993, the company merged with the North American business Geraghty & Miller, resulting in its listing on the NASDAQ index.

During 1997, the company adopted its current name, Arcadis; subsidiaries were similarly rebranded. Since 1990, the company has largely expanded itself via a series of acquisitions and mergers, which have allowed it to both expand its presence in existing markets as well as to enter new ones. It performs design and consultancy services on a wide variety of undertakings. The Complainant (either directly or via subsidiaries) has been involved in several high-profile construction projects, including London City Airport and the A2 motorway.

The Complainant is the owner of the following international registrations designating Philippines:

- No. 1149182 ARCADIS (word) applied for and registered on October 15, 2012, for services in Classes 35, 37, 40 and 42;
- No. 1338353 ARCACIS (figurative) applied for and registered on February 22, 2016 claiming priority of the Benelux application date of September 11, 2015, for services in Classes 35, 36, 37, 39, 40, 41, 42, 44, and 45.

The Complainant has the official website using the domain name <arcadis.com>.

The disputed domain name <arcadis.ph> was registered on November 3, 2021.

The disputed domain name resolves to an inactive website and has been used to send fraudulent emails.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its trademark ARCADIS in various jurisdictions included the Philippines. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent has sent email communications on February 1, 3, and 18, 2022 to request information on the proceeding.

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the Dispute is properly within the scope of the Policy. The Panel has the authority to decide the case reviewing the three elements in Paragraph 4(a) of the Policy, taking into consideration of the relevant evidence, annexed material and allegations. Furthermore, in the present case the Panel has made independent research under the powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

The Panel further wishes to note the similarities between the phDRP and the Uniform Domain Name Disputed Resolution Policy (“UDRP Policy”). Therefore, for the purpose of having interpretation criteria for the analysis on the present case, the Panel may take into consideration the WIPO Overview of the WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

In the present case, the applicable Policy is the phDRP. Paragraph 4 of the phDRP establishes the following:

“This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at [www.dot.ph](#) (each, a “Provider”).

a. Applicable Disputes.

You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- i. your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- ii. you have no rights or legitimate interests in respect of the domain name; and
- iii. your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.”

A. Identical or Confusingly Similar

The Panel is satisfied of the ownership of the trademark ARCADIS, due to the fact that the Complainant has established trademark rights in the Philippines. In order to establish confusing similarity, the panel must do a test that involves the comparison between the trademark and the domain name itself to establish if the domain name is identical or confusingly similar to the complainant’s trademark. The trademark would generally have to be recognizable within the domain name.

In this case, the disputed domain name is <arcadis.ph>, which consists of the entirety of the Complainant’s trademark and the country-code Top-Level Domain (“ccTLD”) “.ph”.

For the purposes of assessing identity and confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the Top-Level Domain (“TLD”), irrespective of the particular TLD and the ordinary meaning ascribed to a particular TLD. It is viewed as a standard registration requirement. This is the case for the ccTLD “.ph”.

For all the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to you of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not referred to or commonly known by the disputed domain name. It has not authorized the Respondent to use the Complainant's trademark in any way including a domain name in the Philippines. According to the Complainant, the Respondent is not using the disputed domain name for *bona fide* offerings of goods or services or for making a legitimate noncommercial or fair use of the disputed domain name. Rather, according to the Complainant, the Respondent has used the disputed domain name to send out fraudulent emails to Parties outside of the Complainant to tout for interest in participating in a tender for properties in the Philippines, along with a request for payment – to a bank account that does not belong to the Complainant - required to obtain "RFP documents". These offers were sent out by the Respondent using an "@arcadis.ph" email address, using the name of Complainant's Technical Director and the company's address details.

The Complainant also contends that the disputed domain name does not display an active website. Even though there was no website active under the disputed domain name, and the disputed domain name showed the parking page of GoDaddy for a while, this did not prevent the Respondent from using the hosting services, such as email, for fraudulent purposes.

At the time of this Decision, the disputed domain name resolves to an inactive website. The Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The Panel finds that the conduct by the Respondent cannot not be interpreted as a legitimate noncommercial or fair use of the disputed domain name.

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 replied to the Complainant's contentions, 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.

For the foregoing reasons the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

C. Registered and Used in Bad Faith

To prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith. It is a double requirement.

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- ii. you have 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 you have engaged in a pattern of such conduct; or
- iii. you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name in bad faith, you have intentionally attempted to attract, Internet users to your web site, for commercial gain, or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Panel is satisfied that the Respondent must have been aware of the trademark when it registered the disputed domain name particularly since the disputed domain name was used to send fraudulent emails impersonating the Complainant. In addition, noting the disputed domain name incorporates the entirety of the Complainant's trademark ARCADIS with the addition of the ccTLD ".ph", it carries a high risk of implied affiliation with the Complainant.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith with actual knowledge of the Complainant's rights in its ARCADIS marks. The ARCADIS trademarks are well known in the Philippines, United States of America, Europe, and China. At the time of the registration of the disputed domain name (November 3, 2021), which long after the Complainant used and registered the marks ARCADIS in the Philippines. The Respondent's registration of the disputed domain name years after the Complainant's trademarks is sufficient to satisfy the bad faith requirement.

Further the use of the disputed domain name is also in bad faith, in the present case, the Panel finds that the Respondent's use of the disputed domain name and the use of the Complainant's trademark and logo on the letterhead and address/contact details, is uncontroverted evidence that the Respondent had actual knowledge of the Complainant's ARCADIS marks prior to registering the disputed domain name. The Respondent's use of the disputed domain name for financial gain also constitutes bad faith under the policy with the offerings sent by email pretending to be the Complainant, and requesting a financial compensation from interested parties to obtain the RFP documents. This creates confusion with the Complainant's own offering of services, which constitutes bad faith use of the disputed domain name.

At the time of this decision the disputed domain name does not resolve to any active website. It has been established in various UDRP decisions that passive holding under the appropriate circumstances falls within the concept of the domain name being used in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), in which it was found that in order to establish that the registrant was using a domain name in bad faith it was not necessary to find that it had undertaken any positive action in relation to the domain name. Indeed, in circumstances of inaction ("passive holding"), this behavior falls within the concept of the domain name "being used in bad faith". See also, section 3.3 of the [WIPO Overview 3.0](#). From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In the present case, the Panel also finds that the disputed domain name is used in bad faith due to the following factors: (i) the reputation of the Complainant's trademark, (ii) the failure of the Respondent to reply to the Complainant's contentions, and (iii) the fact that the disputed domain name resolves to an inactive website.

For all the above reasons, the Panel is of the opinion that the disputed domain name satisfy the requirement of paragraph 4(a)(iii) that the disputed domain name was registered and is used in bad faith by the Respondent.

7. Decision

For all 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 <arcadis.ph> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: April 27, 2022