

ADMINISTRATIVE PANEL DECISION

Stichting YPIP v. M Kalkan, InterIP Networks B.V.
Case No. D2022-3978

1. The Parties

Complainant is Stichting YPIP, Netherlands, represented by Eversheds Sutherland (Netherlands) B.V., Netherlands.

Respondent is M Kalkan, InterIP Networks B.V., Netherlands.

2. The Domain Name and Registrar

The disputed domain name <degoudengids.com> (the “Domain Name”) is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2022. On October 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 27, 2022, the Registrar 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 October 27, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 31, 2022.

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 Respondent of the Complaint, and the proceedings commenced on October 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2022. Respondent did not submit any formal response, but sent an email to the Center on November 1, 2022. Accordingly, the Center notified the Commencement of Panel Appointment Process on November 21, 2022.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on November 23, 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

Complainant owns and manages the intellectual property rights for its participants, Youvia Holding B.V. and FCR Media Belgium N.V. (the "Participants"). Complainant and the Participants own trade mark rights in relation to DE GOUDEN GIDS and GOUDEN GIDS, such as Benelux trademark GOUDEN GIDS, filed on November 24, 1987, and published on June 1, 1988 with registration number 155004 for amongst others, services in classes 35 and 42, and European Union trademark DE GOUDEN GIDS, filed on April 1, 1996, and registered on May 29, 1998 with number 000155051 for goods and services in classes 9, 16, 35, and 38 (the "Trademarks"). The Trademarks are being used by the Participants to operate the official business directories of the Netherlands and Belgium. The commercial activities under the Trademarks consist of collecting and (digitally) making available the contact details of companies.

The Domain Name was registered on January 29, 2000. Shortly after registration, the Domain Name resolved to a website which was used for services that relate to collecting and (digitally) making available of contact details of companies, under the sign "Gouden Gids" (the "Website"). The Domain Name currently resolves to a parked page of InterIPNetworks.

5. Parties' Contentions

A. Complainant

Complainant's contentions can be summarized as follows.

The Domain Name is identical to the well-known Trademarks owned by Complainant or the Participants. The Domain Name consists of the Trademarks in their entirety.

Respondent has registered the Domain Name without any right or legitimate interest in the Domain Name. The Trademarks are registered years before the registration of the Domain Name. The Domain Name resolved to the Website where identical services were offered under an identical sign as Complainant's Trademark GOUDEN GIDS. This use by Respondent does not constitute a *bona fide* offering of goods and services. The Website was misleading as it contained, amongst others, identical signs, identical theme fonts and color schemes as Complainant's original webpage at "www.goudengids.nl" during the same period of time and gave the impression that the services offered, originated from Complainant. Respondent tried to impersonate Complainant by using almost an identical website for the offering of its services as Complainant. Respondent tried to create the impression that the Website was the official business directory of the Netherlands and Belgium under the Trademarks.

The Domain Name was registered and is being used in bad faith. Respondent registered the Domain Name with the sole intention to run an illegal business and to commit trademark infringement. The Domain Name is used by Respondent to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Trademarks, as to the source, affiliation or endorsement of the Website. Furthermore, the Trademarks are well known and with the use of a Domain Name identical to the Trademarks, Respondent is taking an unfair advantage of Complainant's promotional activity.

B. Respondent

Respondent did not submit a formal response, but informed the Center via email dated November 1, 2022, and contends – in so far as relevant – the following.

The archive photo (*i.e.*, of the Website), presented by Complainant, shows that the Domain Name is forwarded neatly in frame to Complainant's official website namely, "www.degoudengids.nl". This free referral to Complainant can only be seen as a gesture, rather than something negative. Moreover, from November 29, 2001, until the filing of the Complaint, the frame forwarding has stopped and the Domain Name merely resolves to a parked page and that no other activity has taken place.

Furthermore, Complainant has – in the past 22 years – never indicated an interest in the Domain Name. Complainant has lost its rights in the Domain Name, because they never took any action against the Domain Name.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, Complainant must prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Preliminary issue

Respondent contended that Complainant has lost its right to claim the Domain Name after 22 years of taking no action, which could be interpreted as a forfeiture of rights or prescription defense. The Policy does not contain provisions for such forfeiture of rights or prescription. Further, UDRP panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. As provided in section 4.17 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") that:

"Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases."

B. Identical or Confusingly Similar

Complainant must demonstrate that it has rights in the Trademarks and, if so, that the Domain Name is identical or confusingly similar to the Trademarks. It should be noted that the first element serves as a standing requirement.

Complainant has proven that it has rights in the Trademarks. Furthermore, the Domain Name is identical or confusingly similar to the Trademarks, as the Domain Name consists of the Trademarks in their entirety.

The Panel therefore finds that the Domain Name is identical or confusingly similar to the Trademarks and that the first element is satisfied.

C. Rights or Legitimate Interests

Complainant in its Complaint, and as set out above, has established a *prima facie* case that Respondent has no rights or legitimate interests in the Domain Name.

The Panel could not find any evidence by referring to the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel might conclude that Respondent has rights or legitimate interests in the Domain Name, such as:

- (i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to notice of the dispute; or
- (ii) being commonly known by the Domain Name (as an individual, business or other organization) even if Respondent has not acquired any trademark or service mark rights; or
- (iii) making 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.

The *prima facie* case presented by Complainant is enough to shift the burden of production to Respondent to demonstrate that it has rights or legitimate interests in the Domain Name. However, Respondent has not presented any evidence of any rights or legitimate interests it may have in the Domain Name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

On the contrary, Respondent used the Domain Name to impersonate Complainant and its activities. In its email communication, Respondent also acknowledged that the Domain Name resolved to the Website which included in a frame of Complainant's website. According to section 2.5 of the [WIPO Overview 3.0](#), the impersonation of the trademark owner cannot constitute fair use if it falsely suggests affiliation with the trademark owner. This is the case in which the Domain Name incorporating the Trademarks in their entirety is inherently misleading, and carries a risk of an implied affiliation. Complainant has never given consent to Respondent for the use of the Trademarks in connection with the Domain Name.

The Panel does not follow Respondent's contention that the inclusion of Complainant's website in a frame of the Website, was a gesture. Rather, the evidence shows that Respondent tried to mimic Complainant's website during the same period of time by using identical color schemes and similar website layout under the sign "Gouden Gids", which would mislead visitors of the Website into believing that the Website was related to the Complainant.

The Domain Name currently resolves to a parked page of InterIPNetworks.

Hence, Respondent's use of the Domain Name cannot be considered a legitimate noncommercial or fair use of the Domain Name nor a *bona fide* offering of goods or services.

The Panel, therefore, finds that the second element has been satisfied.

D. Registered and Used in Bad Faith

In the present circumstances, the fact that the Domain Name was used to link to the Website, which impersonated Complainant and which was misleading in nature leads the Panel to conclude the registration and use are in bad faith.

Under paragraph 4(b) of the Policy, a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(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, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The Domain Name was registered after the registration of the Trademarks. Respondent was clearly aware of the existence of Complainant and its well-known Trademarks. In its email communication, Respondent even stated that Complainant should thank them for the free referral. This clearly indicates that Respondent knew Complainant and by impersonating the website of Complainant it is beyond any doubt that it has registered and used the Domain Name in bad faith. The fact that Respondent changed the Website to the parked page, does not change this finding.

Therefore, the Panel is satisfied that the third element of the Policy is met and that the Domain Name has been registered and is being used in bad faith.

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 Domain Name, <degoudengids.com>, be transferred to Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: December 7, 2022