

ADMINISTRATIVE PANEL DECISION

Theodoor Gilissen Bankiers N.V. v. AbdulBasit Malaani
Case No. D2013-1229

1. The Parties

The Complainant is Theodoor Gilissen Bankiers N.V. of Amsterdam, the Netherlands represented by SOLV Samen, the Netherlands.

The Respondent is AbdulBasit Malaani of Karachi, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <gilissen.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 July 9, 2013. On July 9, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Later that day, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 12, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was August 1, 2013. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 2, 2013.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on August 14, 2013. 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 Respondent registered the disputed domain name on November 24, 2012 (the domain name was originally registered, though not by the Respondent, on July 3, 1997). The Respondent's registration will expire on July 2, 2017. A copy of the Whois record for the disputed domain name appears in Annex 4 to the Complaint and the hosting history for that domain name appears in Annex 11 to the Complaint.

A. Complainant's GILISSEN Marks

The Complainant owns two Benelux trademark registrations for marks that either solely contain the term GILISSEN or include that term as a formative. In Annexes 6 to 7 to the Complaint, the Complainant has provided a hard-copy printout of the corresponding entries for each of these marks from the online Benelux trademark register. Pertinent details of these registrations are as follows:

1. GILISSEN (block letters)
Benelux registration No. 0861026
registered: July 10, 2009; filing date: April 1, 2009

This mark is registered in international classes 35, 36 and 45, and principally for banking, trust, insurance, accounting and related financial services. Annex 6 to the Complaint.

1. THEODOOR GILISSEN (block letters)
Benelux registration No. 0741587
registered: March 1, 2004; filing date: September 24, 2003

This mark is registered in international classes 35 and 36, and principally for banking, trust, insurance, accounting and related financial services. Annex 7 to the Complaint.

B. The Parties

The Complainant ("Gilissen"), founded in 1881, is a company domiciled in Amsterdam, the Netherlands. It provides financial services to private customers and is one of the oldest private banks in the Netherlands. Gilissen currently has offices in Amsterdam, Rotterdam and Eindhoven and has approximately 200 employees. Presently, Gilissen provides asset management services to some 25,000 different entities.

Gilissen previously owned the disputed domain name <gilissen.com>. Like the other domain names it uses, specifically <theodoorgilissen.nl> and the <theodoorgilissen.com>, Gilissen actively used the disputed domain name <gilissen.com>, to redirect its Internet visitors to its registered domain name <gilissen.nl>. During 2012, Gilissen's web hosting provider accidentally let the disputed domain name lapse. Gilissen intends to reacquire this domain name through the present proceeding and use it to once again link Internet visitors to its main domain name <gilissen.nl>.

The Respondent owns the domain name <abdulbasit.com> (as shown by copies of the Whois record provided in Annexes 8 and 9 to the Complaint). According to the Respondent's web site, he is in the business of monetizing and selling domain names, and characterizes himself as a "professional domain name investor". His site states that, on April 1, 2013, he sold his first domain name through <domainnamesales.com> (a hard-copy screen shot of the corresponding page of his web site appears in Annex 10 to the Complaint).

Currently, the disputed domain name resolves to the Respondent's landing page that along the top edge of the page states: "This GREAT Domain Name May be Available for Lease or Sale. Click here to inquire", followed by prominently displaying the name "Gilissen.com" in an upper left portion, and thereafter followed by two lists, vertically oriented along the remainder of the page, of sponsored third-party links. These links direct Internet visitors not to the Complainant's web site, but to those of its competitors. A copy of that web

page as it appeared on June 11, 2013 and May 2, 2013 is respectively provided in Annexes 15 and 16 to the Complaint. A print-out of the source code for the page as it existed on June 11, 2013 showing the title of the page as “The Leading Gilissen Site on the Net” appears in Annex 17 to the Complaint.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical to its registered mark GILISSEN simply because the name incorporates that mark in its entirety, while the “.com” generic Top-Level Domain (gTLD) is ignored.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, or in a fair use or legitimate noncommercial manner. In that regard, using a domain name that contains a distinctive mark of another to direct Internet users to a page containing sponsored third-party links to the websites of competitors of the owner of the mark is illegitimate and as such does not amount to a *bona fide* offering of goods or services, a fair use, or a legitimate noncommercial use.

Second, the Respondent is not and has not been commonly known by the disputed domain name. Owing the long-standing reputation of the GILISSEN marks, it is quite likely that the Respondent was aware of the Complainant’s marks when he registered the disputed domain name, and thus could not and did not use the name to refer to himself or his own business. In that regard, the Respondent expressly characterizes himself as a professional domain name investor and does not use the disputed domain name other than as an address of his landing page. Further, the Respondent does not own any trademark or any unregistered rights in the name “Gilissen”.

Third, the Complainant has neither licensed nor authorized the Respondent to use the GILISSEN marks in any manner, including inclusion of either of those marks in a domain name. Further, the Respondent is not an authorized reseller of any of the Complainant’s goods and/or services.

Lastly, the parking page clearly states that the Respondent is offering the disputed domain name, which includes the Complainant’s mark GILLISEN, for sale or lease. When the facts are viewed in totality, the underlying purpose of the Respondent’s website is merely to park the disputed domain name until it can be sold and, pending that event, obtain some measure of financial compensation through confusion of Internet visitors engendered by the sponsored third-party links - all of which is inconsistent with the Respondent having any rights or legitimate interests in the disputed domain name.

(iii) Registered and Used in Bad Faith

The Complainant contends that, for various reasons, the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

First, the disputed domain name was primarily (if not solely) registered for the purpose of selling it. This is apparent from the Respondent's web site which expressly states that the disputed domain name is available for lease or sale. Furthermore, the Respondent states he is a professional domain name investor in the business of monetizing and selling domain names. Hence, the Respondent intentionally registered the disputed domain name to generate a sufficient financial return by eventually selling it to the Complainant for a sum that exceeds the Respondent's cost of registration.

Second, the Respondent has engaged in a pattern of conduct through which he registers domain names that include marks owned by others. In that regard, his website acknowledges that he acquires domain names for resale, thus preventing those owners from reflecting their marks in corresponding domain names.

Third, the Respondent is disrupting the Complainant's business. In spite of the fact that there is no connection between the parties whatsoever, the Respondent's use of the disputed domain name creates a false impression in the minds of Internet visitors that some commercial relationship exists between the parties, thus, in turn, causing confusion. By capitalizing on this confusion, the Respondent is opportunistically exploiting the disputed domain name to his own financial benefit by intentionally attracting users to his own web site and, once there, presenting them with sponsored third-party links to the Complainant's competitors, through which the Respondent ultimately derives click-through revenue.

Fourth, given the distinctiveness of the GILISSEN marks and the Complainant's very long use of the Gilissen name in conjunction with the Complainant's business - let alone the comparative rarity of that name as a Dutch family name, it is very likely that the Respondent was well aware of the Complainant's marks when he registered the disputed domain name.

Lastly, the Respondent registered the disputed domain name shortly after the Complainant, which had previously owned the domain name, had a dispute with its web hosting service during which the Complainant's registration expired and the Complainant inadvertently failed to renew its registration. Prior UDRP panels have previously found that a respondent's registration of a domain name after a complainant's registration lapsed is in itself evidence of bad faith. See *Athletica, Inc. v. Steven R. Wilson*, NAF Case No. FA2000093764 (bad faith found when respondent registered <bordercontrol.com> shortly after the complainant's registration lapsed); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, and *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304 (where the respective panels found that the corresponding respondents, who carried out businesses of registering multiple domain names and purchasing lapsed domain names, were not entitled to shield their conduct by "closing its eyes" to whether the domain names each registered were identical or confusingly similar to a third party's trademark rights.)

B. Respondent

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's mark GILISSEN.

From a simple comparison of the disputed domain name to the Complainant's mark GILISSEN, no doubt exists that the disputed domain name is identical to the Complainant's mark.

In particular, the dispute domain name <gilissen.com>, apart from its inclusion of the “.com” gTLD, is otherwise identical to the mark. The addition of the gTLD is typically irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. See, e.g., *Zija International, Inc. v. Deep Frontier*, WIPO Case No. D2013-0107; *Side by Side, Inc. d/b/a Sidetrack v. Alexander Lerman*, WIPO Case No. D2012-0771; *Kayak Software Corporation v. KAYAK.travel, KAYAK.travel Corporation, Kayak Las Vegas, LLC*, WIPO Case No. D2011-0425; and *Photo Tour Books, Inc. d/b/a PhotoSecrets v. Beate Chelette*, WIPO Case No. D2010-1373.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Respondent is using the disputed domain name in an illegitimate manner, specifically the name, which contains the Complainant's mark, directs Internet users to the Respondent's web site which presents a landing page containing a list of sponsored third-party links to the Complainant's competitors. Such a use does not constitute a *bona fide* offering of goods or services, a fair use or a legitimate noncommercial use under either paragraph 4(c)(i) or 4(c)(iii) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's registered mark GILISSEN nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's registered marks or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *Debbie Morgan Macao Commercial Offshore Limited, Missguided Limited v. Samir Vora*, Case No. D2013-0737; *We Sell Businesses, Inc. v. Paul Yates*, WIPO Case No. D2013-0584; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Amy Stran v. EzDomainSearch.com, Juan Curtis*, WIPO Case No. D2011-1710; *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc., supra; Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between himself and the Complainant's registered mark GILISSEN or even any mark similar thereto, at least for the services provided by the Complainant under its marks as well as those sufficiently related thereto to cause purchaser confusion.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark GILISSEN. Nor could the Respondent likely ever become commonly known by that name or the mark without possibly infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to at least 2003 and most likely much farther back in time to 1881 when the Complainant's business was founded. These dates predate by many years, and quite likely well over a century, the date on which the Respondent registered the disputed domain name. See, e.g., *Debbie Morgan Macao, We Sell, National Westminster, Amy Stran, Starline Publications, and Treeforms, Inc.*, all cited *supra*. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

As such, based on the evidence before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraphs 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions with respect to the disputed domain name constitute bad faith registration and use.

The Panel believes that the Respondent was well aware of the Complainant and its mark GILISSEN when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the disputed domain name to opportunistically exploit its potential to generate purchaser confusion for the Respondent's eventual pecuniary benefit. This is evident by the fact that the Respondent registered the disputed domain name shortly after the Complainant's original domain name registration expired - which the Complainant owing to a dispute with its hosting provider inadvertently failed to renew, coupled with the subsequent posting to the Respondent's web site of a page that includes a list of sponsored third-party links to the Complainant's competitors.

The Respondent, having effectively misappropriated the Complainant's goodwill and reputation in its marks, intentionally caused confusion in the mind of Internet users, who likely sought the Complainant's website, by falsely suggesting to those users that the Respondent had some type of an affiliation or relationship with the Complainant - when in fact the Respondent did not and then profiting from that confusion by receiving financial compensation, whether click-through or other referral based revenue, whenever such a user clicked on one of the sponsored links. Furthermore, the Respondent, having described himself as a professional domain name investor, continued to offer the disputed domain name for sale or lease with the expectation that eventually, if only to stop further user confusion and continuing injury and disruption to the Complainant's reputation and business, the Complainant would acquiesce and purchase the disputed domain name from the Respondent at a high enough cost that would yield a sufficient profit to the Respondent.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy including specifically paragraphs 4(b)(i) and 4(b)(iv) thereof.

Moreover, the Panel, consistent with the panels in *Athletica, Inc. v. Steven R. Wilson*, NAF Case No. FA2000093764 and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, and *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304, views that the Respondent committed bad faith registration and use when it intentionally registered the disputed domain name, shortly after the original registration of which had lapsed, knowing that the disputed domain name includes the mark of the Complainant and is thus identical to that mark so as to cause confusion with it. Thus, the Respondent's conduct also reflects bad faith registration and use under the general bad faith provisions of paragraphs 4(a)(iii) and 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <gilissen.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: August 28, 2013