

WIPO Arbitration and Mediation Center**ADMINISTRATIVE PANEL DECISION****ID Group v. SmartServer Technologies****Case No. DNL2018-0010****1. The Parties**

The Complainant is ID Group of Roubaix, France, represented by ORDIPAT, France.

The Respondent is SmartServer Technologies of Nieuwegein, the Netherlands, self-represented.

2. The Domain Name and Registrar

The disputed domain name <jacadi.nl> is registered with SIDN through SmartServer Technologies B.V..

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2018. On the same day, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On March 5, 2018, SIDN 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 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 6, 2018. In accordance with the Regulations, article 7.1, the due date for Response was March 26, 2018. The Response was filed with the Center on March 26, 2018. Further email communications were received from the Respondent on April 12 and 17, 2018 and from the Complainant on April 23, 2018. On May 11, 2018 the Respondent sent another email communication to the Center.

On March 29, 2018, SIDN commenced the mediation process. On April 17, 2018, SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Alfred Meijboom as the panelist in this matter on April 23, 2018. 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 is active in the field of ready to wear fashion and children’s toys and perfumes under different brands, including “Jacadi”. The Complainant sells products under the trademark JACADI in 273 stores worldwide and on its website at “www.jacadi.com”. The Complainant owns several trademarks (together and individually

referred to as the “JACADI Trademark”), which are, *i.a.*, designated in the Benelux, including:

- International trademark for JACADI with registration number 484895, registered on April 26, 1984, for goods in class 25;
- International trademark for the stylized mark JACADI with registration number 492878, registered on May 10, 1985, for goods in classes 18, 20, 24 and 28; and
- International registration for the stylized mark JACADI with registration number 590413, registered on July 15, 1992, for goods in classes 3, 9, 12, 14, 16, 18, 20, 24, 25, 27, 28, 29, 30, 31 and 32.

The disputed domain name was first registered on June 20, 2000. The Respondent became the registrant of the disputed domain name on May 24, 2005. During the first years after its initial registration, the disputed domain name it resolved to a website picturing children and the JACADI Trademark. The disputed domain name is currently inactive and resolves to a web page stating “onze website www.jacadi.nl is nog niet beschikbaar” (“our website www.jacadi.nl is not yet available”).

5. Parties’ Contentions

A. Complainant

The Complainant alleges that the disputed domain name reproduces the JACADI Trademark in its entirety and is identical to the JACADI Trademark.

According to the Complainant the Respondent has no rights to or legitimate interests in the disputed domain name because the Respondent was never authorized to use the JACADI Trademark in the disputed domain name, the Respondent is not known under the disputed domain name, and has never made *bona fide* offerings of goods and services in connection with the disputed domain name.

Further, the Complainant considers the registration of the disputed domain name, as well as its use to be in bad faith. As the word “Jacadi” is not a common noun or name in any language the Complainant believes that the Respondent knew or should have known of the JACADI Trademark when it registered the disputed domain name. According to the Complainant, the Respondent’s current passive holding of the disputed domain name constitutes use in bad faith, as the JACADI Trademark is well-known in Europe, including in the Netherlands. Furthermore, the Respondent used the JACADI Trademark on its website without consent of the Complainant and it never replied to the Complainant’s cease and desist letter of November 14, 2017, for which reasons the Complainant considers the Respondent’s use of the disputed domain name to be in bad faith.

B. Respondent

The Respondent did not reply in substance to the Complainant’s contentions. The Respondent did send the Center an email on March 26, 2018 claiming that the Complainant had not registered “jacadi” in the Dutch trade register, that the Respondent had already registered the domain name on July 24, 2005, and that it “did not change anything recently and did not receive any complaints or requests before”. The Respondent registered the disputed domain name for one of the Respondent’s IT

services. Since the JACADI Trademark is not registered for IT services, the Respondent does not infringe the Complainant's rights.

6. Supplemental Filings

Both the Complainant and the Respondent sent unsolicited submissions to the Center several weeks after the due date for filing the Response, on the day the Panelist was appointed, and thereafter.

Article 11.2 of the Regulations provides that the panel in its sole discretion shall determine the admissibility of unsolicited submissions. Notwithstanding a panel's power to decide otherwise, it is well established that unsolicited submissions normally are admissible only in demonstrated exceptional circumstances that made it impossible for a party to file such submission before the deadline of the proceedings provided such exceptional circumstances are explained in the supplemental filing (e.g., *Formula One Licensing B.V. v. Louis Theunisse*, [WIPO Case No. DNL2009-0033](#); *BIC Graphic Europe S.A. and Société BIC v. Alpha Holding B.V.*, [WIPO Case No. DNL2015-0059](#)).

In this matter the Complainant and the Respondent filed their unsolicited submissions without express or implied explanation of exceptional circumstances which would justify such late submissions. The Panel considers them inadmissible.

7. Discussion and Findings

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

- a. the disputed 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 by means of article 2.1(a) under II of the Regulations; 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-established precedent that the Top-Level Domain ".nl" may be disregarded in assessing confusing similarity between the trademark on the one hand and the disputed domain name on the other hand (see, e.g., *Roompot Recreatie Beheer B.V. v. Edoco LTD*, [WIPO Case No. DNL2008-0008](#)).

The Panel finds that the disputed domain name is identical to the JACADI Trademark as it incorporates the JACADI Trademark in its entirety.

Consequently, the Panel finds that the Complainant has satisfied the requirement of article 2.1(a) of the Regulations.

B. Rights or Legitimate Interests

Article 2.1(b) of the Regulations requires the Complainant to demonstrate that the Respondent has no rights to or legitimate interests in the disputed domain name. This condition is met if the Complainant makes out a *prima facie* case that the Respondent

has no such rights or legitimate interests and if the Respondent fails to rebut this (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, [WIPO Case No. DNL2008-0002](#)).

The Panel is satisfied that the Complainant has made such a *prima facie* case, showing that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services before the Respondent had received the notice of the dispute, and that the Respondent was not commonly known by the disputed domain name.

More particularly the Respondent seems not to have actively used the disputed domain name for the last 13 years after it became the registrant on May 24, 2005, without providing a proper explanation. The Respondent did allege that it registered the disputed domain name for one of its IT services, but failed to show any evidence of preparations for a *bona fide* offering of goods or services using the disputed domain name.

The Panel finds that the Complainant has satisfied the requirement of article 2.1(b) of the Regulations.

C. Registered or Used in Bad Faith

Article 2.1(c) of the Regulations requires the Complainant to show that the disputed domain name was registered and/or is being used in bad faith.

The Complainant claims that the Respondent registered and used the disputed domain name in bad faith. In support of its claim, the Complainant relies on the fact that the disputed domain name resolved to a website which showed the JACADI Trademark together with a picture of children. However, the evidence from the Internet archive which the Complainant submitted shows that the last time the disputed domain name showed the JACADI Trademark was December 14, 2004, while the next available copy of the website under the disputed domain name dated from December 6, 2011, informing visitors that the website is under construction and not yet available. The Complainant has failed to demonstrate that the disputed domain name actually resolved to a website showing the JACADI Trademark when the Respondent became registrant of the disputed domain name on May 24, 2005. As it is established in this matter that the disputed domain name only resolves to a webpage mentioning that the website under the JACADI Trademark is not yet available, without an actual attempt to sell the disputed domain name to the trademark holder, the Panel shall consider the Respondent's use of the disputed domain name solely as passive holding by the Respondent, which as such however does not prevent a finding of bad faith (e.g. *Williams-Sonoma, Inc. v. E. Linders*, [WIPO Case No. DNL2013-0020](#)).

Panels in earlier cases under the Regulations have applied the criteria set forth in *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#) to determine the issue of bad faith in case of passive holding pursuant to article 2.1(c) of the Regulations (e.g. *Street One GmbH v. Webapply.nl*, [WIPO Case No. DNL2013-0021](#); *Groupe ADEO S.A. v. Bob Nonnekes*, [WIPO Case No. DNL2014-0059](#)).

In the *Telstra* case the circumstances which lead to the conclusion of use in bad faith were:

- i. the Complainant's trademark has a strong reputation and is widely known;

- ii. the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- iii. the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name;
- iv. the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement; and
- v. taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Complainant claimed that the JACADI Trademark is well-known and undisputedly refers to the facts that worldwide sales of products under the JACADI Trademark in 2017 had a value of EUR 144.4 million, and the Complainant's website received 32,000 visits from the Netherlands and 300,000 from the Benelux in that year. While reputation may also derive from sales outside of the narrower location of the Respondent party, the Panel finds the Complainant's above general claims insufficient for present purposes to consider that it has met the first part of the *Telstra* criteria.

Further, the Respondent did not conceal its identity in the registration agreement, thus not inhibiting the Complainant to send the Respondent a cease and desist letter before the Complainant initiated the administrative proceedings.

The Panel further notes however that the term "jacadi" does not have a specific meaning in Dutch or any other language which is spoken or understood by the average member of the Dutch public, and that the Respondent has not offered an explanation why it became the registrant of this disputed domain name or why it would want to use the term "jacadi" for IT services. As the Respondent did not originally register the disputed domain name but rather obtained it from the disputed domain name's previous registrant who had undisputedly linked the disputed domain name to a website showing the JACADI Trademark, the Panel considers it highly likely that the Respondent was aware of, if not indeed motivated by, the existence of the JACADI Trademark when it became registrant of the disputed domain name on May 24, 2005.

For these reasons the Panel finds that the Respondent registered the disputed domain name in bad faith so that the requirement of 2.1(c) of the Regulations has also been met.

8. Decision

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

Alfred Meijboom

Panelist

Date: May 11, 2018