

## **ADMINISTRATIVE PANEL DECISION**

Nordic Storage AB v. Hoster ADMIN

Case No. D2022-4044

### **1. The Parties**

The Complainant is Nordic Storage AB, Sweden, represented by BrandIT GmbH, Switzerland.

The Respondent is Hoster ADMIN, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <nordicstoragealborg.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 28, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 3, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent an informal communication to the Center on November 3, 2022. The Complainant filed an amended Complaint on November 8, 2022.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on November 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 1, 2022. The Respondent did not submit any response. The Center proceeded to Panel appointment on December 2, 2022. On December 8, 2022, the Center granted the Respondent a five-day period, *i.e.* through December 13, 2022, to indicate an intention to participate in this proceeding. The Respondent did not reply to the Center’s communication.

The Center appointed Karen Fong as the sole panelist in this matter on January 12, 2023. 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 one of the largest storage companies for liquid bulk in Scandinavia with storage terminals located in Sweden and Denmark. One of the Complainant's subsidiaries is Nordic Storage Aalborg Holding ApS ("NSAH"). NSAH is located in Aalborg, Denmark.

The Complainant uses the brand NORDIC STORAGE in connection with its goods and services. NORDIC STORAGE is registered as a trade mark in many jurisdictions, including in the European Union under European Union Trade Mark No. 003571461, registered on May 18, 2005, (collectively, the "Trade Mark"). The Complainant's official website is found at the domain name <nordicstorage.se>.

The Domain Name was registered on August 15, 2022. On August 22, 2022, the Domain Name resolved to a website which prominently displayed the Trade Mark as well as the NSAH name (the "Website"). The Website purported to be NSAH and provided information about the Complainant's products and services. In the "Contact Us" section of the website, an email address associated with the Domain Name was provided. At the time of the filing of the Complaint, the Website was inactive. It remains inactive.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name was registered and is being used in bad faith. The Complainant requests transfer of the Domain Name.

##### **B. Respondent**

On November 3, 2022, the Respondent emailed the Center to say that its notification to the Respondent was wrong, as the Respondent had nothing to do with the Domain Name. No formal response was filed to reply to the Complainant's contentions. While the Respondent claims to be unconnected to the Domain Name, in the broader circumstances of this case – including the fact the Respondent's communication was received from the email address associated with the registration of the Domain Name and the absence of any evidence or further explanation to support such claim – the Panel considers it more likely than not that the Respondent is the holder of the Domain Name registration, and accordingly is properly considered the Respondent for the purposes of this proceeding.

#### **6. Discussion and Findings**

##### **A. General**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to the trade marks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name was registered and is being used in bad faith.

## **B. Identical or Confusingly Similar**

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is identical or confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name consists of the Trade Mark in its entirety and the addition of the word “alborg”, which is a misspelling of the city Aalborg, with one of the letters ‘a’ is missing. This is a city where NSAH, a subsidiary of the Complainant is based and the name Aalborg is also part of the company name of NSAH. The addition of the term “alborg” to the Trade Mark does not prevent a finding of confusing similarity between the Trade Mark and the Domain Name. The Trade Mark remains clearly recognizable in the Domain Name.

For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”), which in this case is “.com”. It is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”))

The Panel finds that the Domain Name is confusingly similar to the Trade Mark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

## **C. Rights or Legitimate Interests**

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

- (i) before any notice to it 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 trade mark 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 trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a 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 a *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with such relevant evidence of 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 commonly known by the Domain Name. It has not authorised, licensed, or otherwise permitted the Respondent to use the Trade Mark in the Domain Name or for any other purpose. Further, the unauthorised use of the Trade Mark and impersonation of the Complainant and/or its subsidiaries on the Website does not constitute a *bona fide* offering of goods or

services or legitimate noncommercial or fair use of the Domain Name as the Website effectively impersonated or suggested sponsorship or endorsement by the Complainant (also noting the Website did not accurately and prominently disclose the lack of relationship between the Parties). The fact that there was an email address connected to the Domain Name on the Website indicated the possibility of the Respondent engaging in an email scam or phishing scheme by sending fraudulent emails to third parties. This again does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial fair use of the Domain Name.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for a reply from the Respondent. The Respondent has not responded 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 Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. The fact that the Domain Name does not currently resolve to an active website does not obviate the Panel's finding of lack of rights or legitimate interests.

#### **D. Registered and Used in Bad Faith**

To succeed under the Policy, the Complainant must show that the Domain Name has been both registered and used in bad faith. It is a double requirement.

The Panel is satisfied that the Respondent must have been aware of the Trade Mark when it registered the Domain Name given that the Domain Name comprises the Trade Mark in its entirety and includes the misspelt name of the city which forms part of the name of the Complainant's subsidiary and is also where the Complainant has a physical presence. The fact that the Website prominently displayed the Trade Mark and the name of the Complainant's subsidiary and purports to be the subsidiary and connected to the Complainant demonstrates the Respondent's knowledge of the Complainant.

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent's choice of the Domain Name (clearly targeting the Complainant's Trade Mark) is also a significant factor to consider (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Domain Name falls into the category stated above and the Panel finds that registration is in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The Website was one which was set up to impersonate the Complainant and/or its subsidiary for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the Domain Name into their browser, or finding them through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. The Domain Name was likely to confuse Internet users trying to find the Complainant's website. Such confusion will inevitably result due to the fact that the Website suggested that it is that of the Complainant or is sponsored or endorsed by it. In addition, the Website displayed an email address which could potentially have been used to engage in an email scam.

The Respondent employs the reputation of the Trade Mark to mislead Internet users into visiting the Website instead of the Complainant's website. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by creating likelihood of confusion with the Trade Mark and misleading Internet users into believing that the Website is that of or authorised or endorsed by the Complainant. The Panel therefore concludes that the Domain Name is being used in bad faith under paragraph 4(b)(iv) of the Policy.

The current non-use of the Domain Name does not change the Panel's finding of the Respondent's bad faith under paragraph 4(a)(iv) of the Policy. Section 3.3 of the [WIPO Overview 3.0](#) states that:

"[f]rom 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 this case, the Domain Name has clearly been selected to target the Trade Mark. The Respondent has already demonstrated that when the Domain Name was active it was not put to any good faith use. Further, the Respondent has failed to file a formal Response. This is also a situation where in the absence of any arguments to the contrary, given the fame of the Trade Mark in the area of activity where it operates, it is implausible that there can be any good faith use to which the Domain Name may be put. Considering the circumstances, the Panel considers that the Domain Name is also being used in bad faith. Accordingly, the Complaint has satisfied the third element of the UDRP, *i.e.*, the Domain Name was registered and is being used in bad faith under paragraph 4(b)(iv) of the Policy.

## **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 <nordicstoragealborg.com> be transferred to the Complainant.

*/Karen Fong/*

**Karen Fong**

Sole Panelist

Date: January 30, 2023