

## **ADMINISTRATIVE PANEL DECISION**

Eastman Chemical Corporation, Eastman Chemical HTF GmbH v. Rodun International B.V.

Case No. DNL2022-0032

### **1. The Parties**

The Complainants are Eastman Chemical Corporation, United States of America and Eastman Chemical HTF GmbH, Germany (together referred to as the “Complainant”), represented by Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, United States of America.

The registrant of the disputed domain name is Rodun International B.V., Netherlands (the “Respondent”), represented by VDT Advocaten Tilburg B.V.

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

The disputed domain name <marlotherm.nl> (the “Disputed Domain Name”) is registered with SIDN through AutoDNS.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2022. On July 27, 2022, the Center transmitted by email to SIDN a request for registrar verification in connection with the Disputed Domain Name.

On July 28, 2022, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details of the Respondent.

The Center verified that the Complaint satisfies 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 July 29, 2022. In accordance with the Regulations, article 7.1, the due date for Response was August 18, 2022. The Response was filed with the Center on August 10, 2022.

On August 11, 2022, SIDN commenced the mediation process. On September 14 and October 17, 2022, SIDN extended the mediation process, in second instance until November 16, 2022. On October 20, 2022, SIDN informed the Parties that the dispute had not been solved in the mediation process.

On September 13 and October 24, 2022, the Center received additional email communications from the Respondent. On August 16 and October 25, 2022, the Center received email communications from an individual apparently related to the company Rodun B.V.

On October 16, 2022, the Center received a further submission from the Complainant, and on October 18, 19, and 30, 2022, it received further email communications from the Complainant.

The Center appointed Moïra Truijens as the panelist in this matter on November 14, 2022. 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.

On November 30, 2022, the Panel informed the Parties that the date for the Decision was extended until December 12, 2022.

#### **4. Factual Background**

The Complainant is engaged in the global manufacture and sale of chemicals, fibers, and plastics and is a USD 9.3 billion business with around 14,000 global employees, more than 50 manufacturing locations, and offices around the globe serving customers in around 100 countries. In April 2019, it acquired the Marlotherm heat transfer fluids manufacturing assets, intellectual property, and customer contracts from Sasol, a global chemical and energy company. “Marlotherm” is a synthetic organic heat transfer fluid used in heating and cooling in various industrial applications.

The Complainant is the owner of trademark registrations for MARLOTHERM in connection with industrial chemicals and heat transfer fluids in various jurisdictions, including the following that cover the Netherlands (the “Trademarks”):

- European Union trademark MARLOTHERM, with registration number 003491941, registered on August, 30, 2005, for goods and services in class 1;
- International trademark MARLOTHERM, with registration number 286333, registered on July, 13, 1964, for goods and services in class 1.

SIDN informed the Center that the Disputed Domain Name was first registered on October 7, 2019, and the date of its current registration was January 10, 2022, by change of registrant. At the time the Complaint was filed, the website to which the Disputed Domain Name resolved displayed the Complainant’s Marlotherm- logo, selling Marlotherm-branded products and services. At the time of the Decision, the Disputed Domain Name resolved to a website which shows the logo and tradename used by the Complainant “Marlotherm, heat transfer fluids by Eastman”, as well as a message that the website is no longer in use.

#### **5. Parties’ Contentions**

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

As demonstrated in the Complaint, the Complainant in July 2019 entered into a distribution agreement with a company called Rodun Benelux B.V. (which is no named party to these proceedings) to sell the Complainant’s Therminol-branded products. Without amending the agreement, at some point the Complainant began also supplying Marlotherm products to Rodun Benelux B.V. to distribute.

In October 2019 and without authorization, Rodun Benelux B.V. registered the Disputed Domain Name as well as the domain names <marlotherm.be> and <marlotherm.eu>. The Complainant contacted Rodun Benelux B.V. asking to transfer the domain names to the Complainant, while Rodun Benelux B.V. would be allowed to continue to use them. By March 2021, Rodun Benelux B.V. had still not confirmed it would transfer these domain names, according to the Complainant.

In May 2021, the Complainant informed Rodun Benelux B.V. that it would not be renewing the distribution agreement but agreed to permit Rodun Benelux B.V. to continue to do business under its terms through December 31, 2021, to which Rodun Benelux B.V. agreed, according to the Complainant.

According to the Complainant, Rodun Benelux B.V. then transferred the Disputed Domain Name as well as the domain names <marlotherm.be> and <marlotherm.eu> to the Respondent without Complainant's authorization and in violation of the distribution agreement between Rodun Benelux B.V. and the Complainant.

The Complainant contends that the Disputed Domain Name is confusingly similar to the Trademarks as it reproduces these in their entirety adding only the non-distinguishing country code Top-Level Domain ("ccTLD") ".nl".

It further claims that the Respondent has no rights to or legitimate interest in the Disputed Domain Name, as it is not, and has not been, commonly known by the Disputed Domain Name and the Complainant has not authorized the Respondent to use the Trademarks.

The Complainant argues that the Respondent's registration and use of a domain name that incorporates the Trademarks in their entirety to impersonate the Complainant and operate a website that displays the Complainant's Marlotherm-logo, selling Marlotherm-branded products and services, does not constitute a *bona fide* offering of goods or services or fair use. The Complainant also asserts that the Respondent does not satisfy the *Okidata* criteria for resellers. It states that under *Okidata*, use of manufacturer's trademark as a domain name by a reseller can be deemed a "*bona fide* offering of goods or services" only if all the following conditions are satisfied: 1) the respondent must actually offer the goods or services at issue; (2) the respondent must use the site to sell only the trademarked goods; (3) the site itself must accurately disclose the respondent's relationship with the trademark owner; and (4) the respondent must not try to "corner the market" in all relevant domain names. Here, the Complainant contends that the Respondent fails the third requirement, because its website does not accurately disclose its lack of relationship with the Complainant.

The Complainant asserts that the Respondent's registration and use of the Domain Name also meet the grounds of bad faith outlined in Article 3.2 of the Regulations, as well as additional grounds of bad faith defined in previous UDRP ("Uniform Domain Name Dispute Resolution Policy") decisions. First, the Respondent's registration and use of the Domain Name constitute bad faith because the Respondent has attempted to commercially benefit by attracting Internet users to its website by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The Respondent's website displays the Complainant's Marlotherm-logo and contains statements that suggest it is an authorized distributor of Marlotherm-branded products without disclaimer regarding its lack of relationship with the Complainant. Additionally, the Respondent owns multiple domain names using the Trademarks, including <marlotherm.eu> and <marlotherm.be>.

## **B. Respondent**

The Respondent states it purchased the Disputed Domain Name from Rodun Benelux B.V.

According to the Respondent, the website linked to the Disputed Domain Name is an informative website, describing Marlotherm products. When potential consumers contact the Respondent, it refers them either to the Complainant's website or to a local distributor, but the Respondent itself handles requests within Europe. The Response notes that [as translated from Dutch], "We live in a free Europe where Rodun International BV can purchase and may sell. Unfortunately Eastman has decided not to deliver directly to us. The local distributors do not deliver to us either, forcing us to look for Marlotherm on the free market. Rodun International BV is a specialist in heat transfer fluids. Rodun International BV has continued the activities of Rodun Benelux BV."

The Respondent points out that the bottom of the homepage linked to the Disputed Domain Name displays the message “Marlotherm.nl is a domein from www.Rodun-int.com”.

## 6. Language of the proceedings

Article 17 of the Regulations provides that “[w]henver the complainant or the respondent neither resides nor is registered in the Netherlands, proceedings shall be conducted in the English language. In exceptional circumstances however (such as when both parties appear to have full command of the Dutch language), the Center (subject to the panel’s determination) or panel may decide that proceedings are to be conducted in Dutch, or that the complainant or the respondent may make submissions in Dutch”.

Being based in the United States of America the Complainant correctly filed the Complaint in the English language, as the language of the proceedings. The Respondent wrote its email communication of August 10, 2022 in Dutch, whereby the Complainant did not request the submission of an English translation.

In all the circumstances, the Panel accepts the Response in the Dutch language.

## 7. Further submissions

The Panel notes that the further submissions made by the Parties referred to in 5. C above follow the respective submission of the Complaint and of the Response, as well as the mediation period. These reactive submissions were uninvited. While the Panel notes the Respondent’s statement in these submissions that it does not object to the transfer to the Complainant of the Disputed Domain Name, and the domain names <marlotherm.be> and <marlotherm.eu>, in the Panel’s view the Parties’ further submissions in any event do not materially add to the record of this case.

## 8. Discussion and Findings

According to article 2.1 of the Regulations, the requested remedy shall be granted if the Complainant asserts and establishes each of the following:

(a) the disputed domain name is identical or confusingly similar to:

(i) a trademark, or trade name, protected under Dutch law in which the complainant has rights; or

(ii) a personal name registered in the General Municipal Register (“gemeentelijke basisadministratie”) of a municipality in The Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in The Netherlands under which the complainant undertakes public activities on a permanent basis; 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 established case law that the ccTLD “.nl” may be disregarded in assessing the 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 Respondent has incorporated the Trademarks in their entirety in the Disputed Domain Name. The Panel finds that the Disputed Domain Name is therefore confusingly similar to the Complainant’s

Trademarks. Consequently, the Complainant has satisfied the requirement of article 2.1(a) of the Regulations.

## **B. Rights or Legitimate Interests**

Article 2.1 sub b. of the Regulations requires the Complainant to establish 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 takes note of the various contentions of the Complainant and the Respondent's failure to adequately challenge these on the record. The case file contains no indication that the Complainant has authorized the Respondent's registration of the Disputed Domain Name as including the Trademarks, nor does the record show that the Respondent is commonly known by the Disputed Domain Name.

On the basis of the facts submitted by the Parties, it appears that the Respondent is an unauthorized reseller of the Complainant's products. In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the panel set out four criteria in which an authorized sales or service agent of trademarked goods may use the trademark at issue in its domain name; subsequent panel decisions have also applied the *Oki Data* test in cases involving unauthorized resellers.<sup>1</sup> This decision has been confirmed to be relevant for the Regulations *inter alia* in *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. [DNL2010-0024](#), *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No. [DNL2011-0074](#), and *Bayerische Motoren Werke Aktiengesellschaft v. Quispel Motoren*, WIPO Case No. [DNL2013-0026](#). As the Respondent's message "Marlotherm.nl is a domein from www.Rodun-int.com" at the bottom of the homepage to which the Disputed Domain Name resolved does not accurately display the (lack of) relationship between the Respondent and the Complainant, the Panel finds that the Respondent does not meet the *Oki Data* criteria.

According to section 2.8 of [WIPO Overview 3.0](#), "[c]ases applying the *Oki Data* test usually involve a domain name comprising a trademark plus a descriptive term (e.g., "parts", "repairs", or "location"), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant's trademark." See also generally section 2.5 of [WIPO Overview 3.0](#). In the present case, the Disputed Domain Name only consists of the Trademarks and no descriptive term is added. The Panel therefore further finds that the Disputed Domain Name itself carries a high risk of implied affiliation.

Consequently, the Panel finds that the Complainant has satisfied the requirement of article 2.1 sub 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 Respondent registered the Disputed Domain Name, which includes the Trademarks in their entirety, for the purpose of attracting Internet users to a website associated with the Respondent, using a domain name which impersonates or suggests sponsorship or endorsement by the trademark owner as established in 8. B. above. Such impersonation or suggestion is reinforced by the Respondent's failure to include an accurate disclaimer. Therefore, the Panel is satisfied that the Disputed Domain Name was registered and/or is being used in bad faith.

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<sup>1</sup> In view of the fact that the Regulations are substantially similar to the UDRP, it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), may be relevant to the determination of this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

The Panel finds that the Complainant has satisfied the requirement of article 2.1 sub c. of the Regulations.

Finally, the Panel notes that the Parties' conflict concerning the Disputed Domain Name may form part of a larger controversy between them concerning past dealings. The present decision is limited to the status of the Disputed Domain Name under the Regulations and is without prejudice to any possible court litigation.

## **9. Decision**

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

*/Moira Truijens/*

**Moira Truijens**

Panelist

Date: December 12, 2022