

## **ADMINISTRATIVE PANEL DECISION**

AKAPOL S.A. v. Ehren Schaiberger

Case No. D2023-2284

### **1. The Parties**

The Complainant is AKAPOL S.A., Argentina, represented by Moeller IP, Argentina.

The Respondent is Ehren Schaiberger, United States of America (“U.S.”) self-represented.

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

The disputed domain name <plasticol.com> (the “Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2023. On May 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 1, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (UNKOWN (private)) and contact information in the Complaint.

The Center sent an email communication to the Complainant also on June 1, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 13, 2023.

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 June 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2023. The Response was filed with the Center July 7, 2023.

The Center appointed Nick J. Gardner, Georges Nahitchevansky, and Diane Cabell as panelists in this matter on August 14, 2023. The Panel finds that it was properly constituted. Each member of 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 an Argentine company which has been in business since 1962. It manufactures and sells a range of adhesive and associated products under a number of brand names. It acquired in 2022 and 2023 a portfolio of trademarks for the term “PLASTICOLA” – see discussion below as to the evidence in this regard. These trademarks are referred to collectively in this decision as the “PLASTICOLA trademark”. The Complainant registered the domain name <plasticola.com.ar> in 2014, and registered the domain name <plasticola.com> in around May 2023.

The Disputed Domain Name was registered on February 7, 2017. It resolves to a page hosted at “dan.com” which indicates it is for sale for USD 6,995.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant’s principal contentions can be summarized as follows.

The Complainant says that the previous owners of the PLASTICOLA trademark had been a company called H.B. Fuller Company (or in some cases subsidiary or associated companies thereof). Assignments in 2022 or 2023 transferred to the Complainant all rights in the PLASTICOLA trademark together with any associated goodwill. Accordingly the Complainant has rights in the PLASTICOLA trademark dating back to when the relevant trademark was registered. The Complainant also says that the domain name <plasticola.com.ar> has been used in connection with the PLASTICOLA trademarks since 2014.

The Complainant says that the Disputed Domain Name is confusingly similar to the PLASTICOLA Trademark. It differs only by the omission of a single letter and remains visually and aurally very similar.

The Respondent has no rights or legitimate interests in the term “plasticola” or “plasticol”. The Complainant acknowledges that the Respondent’s business is the buying and selling of domain names comprising descriptive and generic terms, and combinations thereof. However it says that it does not follow that a person conducting such a business will have rights or legitimate interests in every domain name it buys and sells. It says that in the six years that the Respondent has been the registrant, the Respondent does not appear to have made any other active use of the Disputed Domain Name, nor is there any evidence of demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. It argues that the Respondent cannot establish a legitimate interest where it must have known of the Complainant and/or its PLASTICOLA trademark when he registered the Disputed Domain Name (see below).

In consequence the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. It says the Complainant’s acquisition of the Disputed Domain Name was primarily for the purpose of selling it for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the Disputed Domain Name, which can be fairly assumed that it has been registered without any *bona fide* reason. It also says that “the Complainant owns several ‘PLASTICOLA’ marks around the world, which have been duly granted and in continuous use since the 90’s by the previous owners, long before the date of application for the domain name by the Respondent. Therefore, the Respondent knew or should have known of the Complainant’s exclusive rights in the mark prior registering them [sic]”.

The Complainant goes on to say that:

“A basic search before any trademark database, including WIPO Global Brand Database, disclose a number of live trademark registrations for marks comprising or including PLASTICOLA, dated years earlier than the acquisition of the disputed domain name in various territories referable to the Complainant. Furthermore, a Google search against the term PLASTICOLA produces numerous pages of results which appear to refer

exclusively to the Complainant and its products. As such, the Respondent either knew or should have known of the Complainant's marks when registering the disputed domain names or have exercised "the kind of willful blindness that numerous panels have held support a finding of bad faith" (see *eBay Inc. v. Renbu Bai*, WIPO Case No. [D2014-1693](#); WIPO Case No. [D2011-0874](#))".

It also says that the Respondent concealed his identity through the use of a privacy service and this is indicative of the Respondent's bad faith given that the Disputed Domain Name is confusingly similar to the PLASTICOLA trademark and given the other indicia of bad faith (above).

## **B. Respondent**

The Respondent has filed a detailed Response which makes a large number of points. It is supported by a signed declaration by the Respondent. The most relevant of the points made are as follows.

The Respondent says he is in the business of buying and selling domain names. He says that over the course of more than eleven years, he has built a domain name portfolio of tens of thousands of domain names. He provides evidence that he is well known and respected in this business field. He says that he has only been the respondent to a handful of prior Policy disputes. In two, both parties amicably reached a satisfactory agreement. In the others that went to decisions, all Panels decided unanimously in the Respondent's favor.

The Respondent says that the Disputed Domain Name expired and "dropped" on February 7, 2017. The Respondent while scanning the daily expiry and drop lists, identified it as a good descriptive keyword and brandable domain name to add to his stock-in-trade to offer to a new entrant. He says that he had no prior knowledge of the Complainant whatsoever before the registration of the Disputed Domain Name on February 7, 2017. The first time he became aware of the Complainant was not until after the Complaint was filed.

The Respondent goes into considerable detail as to what he describes as the "meticulous process" by which he selects domain names of interest to him. He says that for domain names which might correspond to less famous trademarks, he will spot-check the United States Patent and Trademark Office and WIPO databases because he has not yet found a trademark database that allows searches of thousands of terms in bulk. However, in this case, the Respondent had no reason to search for "plasticola" because "plasticol" was the string that he would have been evaluating, and "plasticola" is not a famous mark, and because the Respondent had no idea the Complainant or its PLASTICOLA trademark even existed.

The Panel does not think it necessary to set out all the lengthy detail of the Respondent's general methodology. In the case of the Disputed Domain Name he says that it had various positive attributes making it attractive to the Respondent as follows:

It is just 9 characters long.

It had an age of 13 years old. Older domain names tend to be more desirable because they have not been available for the public to buy. And they are more likely to have SEO metrics.

It fitted an established naming convention as a type of "portmanteau" of keyword + the morpheme -ol:

a suffix used in the names of chemical derivatives, representing "alcohol" (glycerol; naphthol; phenol), or sometimes "phenol" or less definitely assignable phenol derivatives (resorcinol).

It is an "open vessel brandable" domain name that could be used for a variety of products or businesses.

The Respondent says that there are many businesses around the world (unrelated to the Complainant) that have independently conceived of the term "plasticol" itself and are using it and provides a list of examples.

He also says that he has previously registered <citol.com>, <colol.com>, <electricol.com>, <focusol.com>, <foxol.com>, <friendsol.com>, <foodplastics.com>, <fozol.com>, <frugol.com>, <gonol.com>, <internol.com>, <farmplastics.com>, <interplastics.com>, <nugol.com>, <plasticstrip.com>, <plastickingdom.com>, <prenol.com>, <prettyplastic.com>, <plastictime.com>, and <sisol.com>.

The Respondent says that the available evidence shows that the Complainant only recently registered <plasticola.com>. The Complainant was only recently assigned limited trademark rights (class and geography) in the term “plasticola”. The original “Plasticola” was a relatively small and recent start-up that had no presence in either the U.S. or in the Republic of South Korea, both countries with which the Respondent has ties, at any time prior to the Disputed Domain Name registration. There is no evidence of any media recognition of the Complainant.

The Respondent says that Internet historical records at “www.archive.org”, show that <plasticola.com.ar> was not in active use since 2014 as the Complainant asserts. It shows that <plasticola.com.ar> wasn't even a resolving website at the time the Respondent registered <plasticol.com> which was only shortly before the Complaint was filed.

The Respondent also says that the Complainant's rights in “Plasticola” were not assigned to them until between 2022 and 2023 which was after he registered the Disputed Domain Name. He appears to say that this precludes the Complainant succeeding, relying on the decision in *Oystershell Consumer Health, Inc. v. Titan Networks*, ADR.eu Case No. 103658.

The Respondent denies that the fact he used a privacy shield is indicative of bad faith. He says that after General Data Protection Regulation European policy, nearly every major domain registrar in the world updated their default privacy settings to have Whois registrant data remain private. In any event because the Respondent owns tens of thousands of domain names, keeping the default privacy setting is necessary to control the immense amount of spam he would otherwise receive. He also says the Complainant could readily have contacted him had it wished to via the details and links on the webpage where the Disputed Domain Name was listed for sale. The Respondent also points out that the Complainant's contact information from the Whois from domain name <plasticola.com> is itself subject to a privacy shield.

Finally, the Respondent says that rather than negotiating in good faith, the Complainant submitted the Complaint without any of honest evidence of targeting or awareness by the Respondent of the Complainant at the time that the Disputed Domain Name was registered. The Complainant should have known its case was weak due to the lack of any evidence of targeting the Complainant, RDNH may be found (See *Zenni Optical, LLC. v. DNS Administrator / Cykon Technology Limited* (WIPO Case No. [D2009-1594](#)).

## 6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

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

### A. Identical or Confusingly Similar

In principle the Panel finds that the Disputed Domain Name is confusingly similar to the PLASTICOLA trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a

confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662). The Panel considers that “plasticol” is a confusingly similar approximation to PLASTICOLA given it involves the omission of a single letter and results in a term which remains visually and aurally similar.

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

However the Panel has not found it easy to understand exactly what rights the Complainant has in the PLASTICOLA trademark. It has produced a number of trademark assignments which appear to relate largely if not entirely to Argentina and Chile and which are in Spanish. These in the main seem to include assignments of existing registered trademarks for PLASTICOLA, but the Panel is not altogether clear as to the full details of the relevant underlying trademarks. The Panel further notes the issue the Respondent has raised as to whether the Complainant’s rights can apply prior to the date of the assignments in question, but also notes that as a matter of trademark law a successor interest who acquires *bona fide* ownership rights in a trademark typically stands in the shoes of a predecessor in interest with regard to an acquired trademark. These issues, however, would require further consideration by the Panel if the question of the Complainant’s rights in the PLASTICOLA trademark was in fact determinative. However given the Panel’s findings on legitimate interest and bad faith (see below) the Panel does not need to reach a decision on these issues.

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

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the Disputed Domain Name:

- (i) before any notice to the Respondent of the dispute, 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 the Respondent has acquired no trademark 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 trademark or service mark at issue.

None of these apply in the present case. However this list is non-exhaustive. As a general principle the Panel considers that resellers of domain names are entitled to register dictionary words, acronyms and common phrases and have a legitimate interest in so doing. That is subject to the provision this is not done with the intent to target a specific trademark holder.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 2.1 addresses this issue as follows “For example, generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not per se illegitimate under the UDRP”.

The Panel agrees with this view and considers the same principles apply where a domain name reseller registers a “portmanteau” word simply because it considers that word is attractive and likely to be of value. Again this must be done without intent to target a specific trademark holder.

For reasons discussed below the Panel considers that the Respondent has simply registered a “portmanteau” word he considered attractive and likely to be of value, and did so without knowledge of the Complainant or the PLASTICOLA trademark.

The Panel sees no reason to disbelieve the Respondent when he says that he had never heard of the Complainant prior to this dispute. The Complainant has not established that its PLASTICOLA Mark was so well known so as to cast doubt on the Respondent's account. Whilst the Complainant asserts that the PLASTICOLA trademark is famous and well-known there is no evidence to that effect. There is no evidence of it having any reputation anywhere except possibly Argentina. The Panel accordingly accepts that the Respondent acquired the Disputed Domain Name because of its value as a "portmanteau" term combining the dictionary word "plastic" with the common suffix "ol" and has never targeted the Complainant or its PLASTICOLA Mark. The Respondent's motivation in registering or selling the Disputed Domain Name was not to profit from or exploit the Complainant or its trademark.

Accordingly, the Panel finds that the Complainant has failed to establish the second element of Paragraph 4(a) of the Policy.

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

Given the Panel's finding on the issue of rights and legitimate interests, *supra*, it is unnecessary to consider the issue of bad faith registration or use. The Panel, nevertheless, thinks it appropriate to explain its conclusion that the Respondent did not register or use the Disputed Domain Name in bad faith.

The Respondent did not register or use the Disputed Domain Name in bad faith since the Respondent legitimately registered the Disputed Domain Name because of its likely value as a portmanteau term and the Respondent did not target the Complainant or its PLASTICOLA Mark in so doing. See *Montane Ltd. v. Orion Global Assets*, WIPO Case No. [D2017-0309](#) where the panel said "Similarly, there is no evidence before the Panel that the Respondent's use of the disputed domain name sets out to target the Complainant or its MONTANE mark. The Respondent is making a general offer of sale of a domain name consisting of a term which might be of interest to a variety of entities. This is not an activity that is condemned by the Policy unless it is accompanied by some indicia of bad faith and in the Panel's view there is no such indicia to be found on the present record". The fact that the Respondent offered the Disputed Domain Name for sale cannot in itself be deemed to indicate that the Disputed Domain Name was registered, or is being used, in bad faith.

Moreover, the Respondent has credibly denied that he had any knowledge of the Complainant or the PLASTICOLA trademark when the Respondent acquired the Disputed Domain Name. In accepting the Respondent's account the Panel takes note of the following

There is no evidence of any reputation in the term PLASTICOLA except possibly in Argentina.

The Complainant did not register <plasticola.com> until 2023.

The evidence appears to suggest that the domain name <plasticola.com.ar> has not been used to any significant degree until recently.

The term "plasticol" is used by a number of third parties – for example Walmart in the U.S. offers for sale a machine cover it describes as being "plasticol coated" and Amazon in the U.S. offers for sale a "plasticol coated" infant spoon.

If the Respondent had been targeting the Respondent it would seem likely that he would have registered <plasticola.com> which would appear to have been available at the relevant time. He did not do so.

The range of other domain names the Respondent has registered involving the word "plastic" or ending in "ol" corroborates the Respondent's account of his reasons for registering the Disputed Domain Name.

Any searches the Respondent might have carried out at the time he registered the Disputed Domain Name would likely have been in respect of the term "plasticol". Absent actual knowledge of a third party using a variation of that term it cannot be the case that the Respondent ought to have searched for variations of the

term formed by adding an additional letter to the term. Failure to carry out such a search is not “willful blindness”.

The Panel does not accept the Respondent’s use of a privacy service is indicative of bad faith. Such use is common nowadays for a variety of reasons including those set out by the Respondent (see above). As the Respondent points out the Complainant itself makes use of this arrangement.

Accordingly, the Panel finds that the Complainant has failed to establish the third element of Paragraph 4(a) of the Policy.

## 7. Reverse Domain Name Hijacking

Reverse Domain Name Hijacking (“RDNH”) is defined under the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

As set out in the [WIPO Overview 3.0](#) section 4.16, reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the Whois database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant’s failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence”.

The Panel does not consider the Complainant’s conduct warrants a finding of RDNH. The case the Respondent cites – *Zenni Optical, LLC. v. DNS Administrator / Cykon Technology Limited* WIPO Case No. [D2009-1594](#) is one where the complainant’s case was fatally flawed from the outset in that the domain name registration relied upon predated the complainant’s trademark rights. The Panel considers the present case to be weak but not flawed in that manner. The Complainant owns the PLASTICOLA trademark which appears to predate the date of registration of the Disputed Domain Name. The Disputed Domain Name is confusingly similar to the PLASTICOLA trademark. The Complainant has overstated its case and failed to appreciate the Respondent would likely have a case of innocent independent derivation. However the Complainant did not know that for certain until the Response was filed. It could of course have sought to establish the facts before commencing the Complaint by communicating with the Respondent. Its failure to do so, assuming it could make contact, may be regrettable but does not in the Panel’s opinion fall within the above guidelines nor does it warrant the censure of a finding of RDNH.

## 8. Decision

For the foregoing reasons, the Complaint is denied.

*/Nick J. Gardner/*  
**Nick J. Gardner**  
Presiding Panelist

*/Georges Nahitchevansky/*  
**Georges Nahitchevansky**  
Panelist

*/Diane Cabell/*  
**Diane Cabell**  
Panelist  
Date: August 24, 2023