

Alternative Dispute Resolution Proceeding

Case No. DSE2023-0019

1. Petitioner

The Petitioner is Amcol International Corporation, United States of America, represented by SafeNames Ltd., United Kingdom.

2. Domain Holder

The Domain Holder is O.W., 10 Digital AB, Sweden.

3. Domain Name and Procedural History

This Alternative Dispute Resolution proceeding relates to the domain name <cetco.se>.

This Petition was filed under the Terms and Conditions of registration (the “.se Policy”) and the Instructions governing Alternative Dispute Resolution proceeding for domain names in the top-level domain .se (the “.se Rules”).

The WIPO Arbitration and Mediation Center (“the Center”) verified that the Petition satisfied the formal requirements of the .se Policy and the .se Rules. The Center sent an invitation to amend the Petition on July 17, 2023. The Petitioner submitted an amended Petition on July 19, 2023. In accordance with Section 13 of the .se Rules, the Center formally notified the Domain Holder of the Petition on July 27, 2023. The Domain Holder submitted a response on July 31, 2023.

The Center appointed Johan Sjöbeck as the sole Arbitrator in this matter on August 3, 2023. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with Section 1 of the .se Rules.

4. Factual Background

The Petitioner is a resource and technology company and the owner of a number of trademark registrations, including CETCO (word), European Union registration No. 000335588 with registration date June 14, 1999, for classes 1, 4, 11, and 42.

The disputed domain name <cetco.se> was registered by the Domain Holder on May 23, 2022, and resolves to a page displaying links and articles for various topics, including some related to the Petitioner’s activity.

5. Claim

The Petitioner claims that the disputed domain name shall be transferred to the Petitioner.

6. Parties' Contentions

A. Petitioner

The Petitioner, Amcol International Corporation, is the parent company to Minerals Technologies Inc., a resource and technology-based company that develops, produces, and markets worldwide a broad range of specialty mineral, synthetic mineral products, and related systems and services since 1968. The Petitioner is the holder of a number of CETCO registered trademarks. The Petitioner, its subsidiaries, and affiliates offer solutions for commercial, industrial, and infrastructure construction challenges worldwide. They are experts in transforming minerals and polymers into technologies that improve productivity and enhanced performance. As a result, the Petitioner's operations have achieved significant reputation and acclaim.

The Petitioner operates in the chemicals, mining, construction, and technology industries. Colloid Environmental Technologies Co., commonly known as the CETCO mark, is the construction technologies business unit of the Petitioner and is a worldwide leader in bentonite (clay), specializing in transforming ordinary minerals into technology. The Petitioner has used its main website "www.cetco.com" since 1995, to offer its products and services. Headquartered in Illinois, United States of America, the Petitioner has approximately 4,000 employees from offices across 35 countries. The Petitioner has 158 production locations and 12 global research development centers. The Petitioner operates internationally with a significant presence in Sweden, with its subsidiary CETCO (Europe) Ltd operating from offices including its branch in Sweden. Further, the Petitioner's products are available from distributors such as Desert Cart that receives over 3 million visits monthly, and its Swedish site is accessed by over 30,000 users monthly.

The Petitioner's registered European Union trademark CETCO covers the jurisdiction of Sweden and predates the disputed domain name <cetco.se> by 22 years. The CETCO trademark is not generic or commonly understood by any other meaning other than its' relationship with the Petitioner's goods and services. Given that the disputed domain name encompasses the CETCO trademark in its entirety with no adornment or addition, the Petitioner submits that the disputed domain name is identical to the Petitioner's registered trademark. The country code Top-Level Domain ("ccTLD") ".se". is a technical requirement for domain names registered in Sweden and not sufficient to avoid a finding of confusing similarity.

Prior to the Domain Holder's registration of the disputed domain name, between 2010 and 2022, the Petitioner was the holder of the disputed domain name. In March/April 2022, the Petitioner accidentally failed to renew the disputed domain name due to an administrative oversight and the Domain Holder took advantage of it by registering it. On January 23, 2023, the Petitioner sent a cease-and-desist letter to the Domain Holder who responded that the disputed domain name was registered with no commercial purpose and not intended to compete, resemble, or imitate the Petitioner. The disputed domain name currently resolves to a site that purports to be "Ceteris & Co", offering Swedish operations, goods, and services that are similar to the Petitioner's CETCO offerings, including "Construction", "Manufacturing", "Industry", and "Drilling". Prior to the Petitioner's cease-and-desist letter, the Domain Holder's website displayed "CETCO" in full rather than "Cet & Co". The Petitioner submits that such change was an attempt by the Domain Holder to hide its true motives regarding the disputed domain name. The Petitioner notes also that, to the best of its knowledge, there are no registered businesses in Swedish company database using the names "Cet & Co" or "Ceteris & Co". This further highlights the Domain Holder's bad faith intentions and use of the disputed domain name.

The Domain Holder's website directs Internet users to engage with the Domain Holder's "Partners". Such use of the disputed domain name disrupts the Petitioner's appropriate use of its trademark, particularly in the Swedish market. By purporting to offer goods and services associated with the Petitioner's from a domain name that is identical to the Petitioner's CETCO trademark, the Domain Holder is exploiting the trademark by

creating increased traffic to its site due to the likelihood of confusion arising from the affiliation of the trademark, and its associated offerings within its sector. This disrupts the Petitioner's Swedish operations as Internet users will be accessing the site in the belief they are engaging with the Petitioner's offerings.

Such use of the disputed domain name, in offering goods and services similar to the Petitioner's offerings, as well as directing Internet users to alleged partners shows the Domain Holder's intentions to generate undue profit by exploiting the Petitioner's trademark is considered bad faith. Furthermore, the Petitioner notes that there are several activated Mail Exchange ("MX") records for the disputed domain name, something that may be used for fraudulent activities such as phishing through email distribution. On the Domain Holder's website, Internet users are directed to "Login" and insert their email address, username, and password. This shows the Domain Holder's intention to collect the personal information of Internet users accessing the disputed domain name in the belief they are engaging with the Petitioner's offerings.

The term CETCO has no generic or linguistic meaning other than to represent the Petitioner's "Colloid Environmental Technologies Co" operations. To the best of the Petitioner's knowledge, the Domain Holder holds no registered trademarks for CETCO, which is a distinctive identifier for the Petitioner's goods and services. There is also no evidence that the Domain Holder retains unregistered trademark rights to the term, or any similar term. The Domain Holder has not received any license from the Petitioner to use domain names featuring the trademark.

As mentioned, the Domain Holder is using the disputed domain name to purport to offer goods and services similar to the Petitioner's, as well as to direct Internet users to competing partners. Such operations are not sufficient to demonstrate a private operation that does not infringe on the Petitioner's rights. On the contrary, it is maintained in past decisions that such use of a domain name cannot confer rights or justified interest in a domain name. See, for example, *A. T. dba Chatroulette of Malta v. M. S.*, WIPO Case No. [DSE2018-0047](#) in which the Arbitrator held that: "[I]inking of the disputed domain name to a website featuring services similar to Petitioner's services without presenting any consent or motives for such use is not sufficient for the Arbitrator to consider the Domain Holder to have any right or justified interest in the disputed domain name".

The Domain Holder claimed in its previous correspondence with the Petitioner that its website has no commercial purpose and is solely for informational purposes. The Domain Holder also offered to park the disputed domain name, although this was never carried out. The Petitioner submits that either use is not sufficient to grant rights or justified interests to the Domain Holder. The use of an identical disputed domain name for the purposes of publishing information in direct relation to the Petitioner's sector is not a private operation that does not infringe on a petitioner's rights. Furthermore, if the Domain Holder had parked the disputed domain name, this would not have conferred rights or justified interest. On the contrary, owning a parked website that is identical to a petitioner's trademark blocks a petitioner from registering a domain name.

B. Domain Holder

The Petitioner contends that the CETCO trademark enjoys significant recognition globally. To ascertain the level of recognition of the Petitioner's trademark in Sweden, the Domain Holder has conduct a search using Google Trends. The search revealed "insufficient data" to present the number of searches for CETCO in Sweden. This search indicates that the trademark CETCO is not highly searched for and consequently the trademark is not well-established in Sweden. Expecting the Domain Holder to have knowledge of a trademark that lacks significant recognition within the Swedish market is unfounded. To claim rights based on global recognition without substantiating its recognition within the Swedish market is unreasonable.

It is essential to address the Petitioner's concern regarding the initial display of the term CETCO in the header on the Domain Holder's website. During the developmental phase, the term was automatically presented in the header as a temporary placeholder. The ultimate goal was to transition to the definitive identity and branding of "Ceteris & Co" as soon as the website's development was completed. The Domain Holder now uses "Cet & Co", an abbreviation of "Ceteris & Co", to identify its online blog, which is completely unrelated to the Petitioner's commercial activities. The Domain Holder's website provides informative

content. Although the Domain Holder's website contains hyperlinks to external third-party websites, it is crucial to understand that these links are for informational purposes only. The Domain Holder does not endorse or promote products or services offered via those websites and the Domain Holder has no control over their content. The Domain Holder cannot be held responsible for any third-party sites to which the Domain Holder links. Providing links to external websites for informational purposes does not imply affiliation, control, or ownership of those sites by the Domain Holder. The mere presence of links to other sites does not establish any intent by the Domain Holder to create confusion or exploit the Petitioner's trademark.

The Domain Holder's website does not engage in any form of competition with the Petitioner. The assertion that the Domain Holder's website generates increased traffic due to affiliation with the CETCO trademark appears tenuous when juxtaposed with the data obtained from the search in Google Trends, which resulted in "insufficient data" to present the number of searches for the trademark within Sweden. The fact that the Petitioner's CETCO products are available through distributors with over 30,000 monthly users does not substantiate the Petitioner's argument that the trademark has a significant presence in Sweden.

The Petitioner contends that the Domain Holder is engaging in fraudulent activities using activated MX records for the disputed domain name. It is not uncommon for legitimate website administrators to configure MX records to facilitate email communication. Such an ordinary technical practice cannot, by any reasonable interpretation, be construed as evidence of fraudulent activity. Furthermore, the website's login feature, which the Petitioner attempts to portray as a tool for malicious purposes, is a login portal that exists for all WordPress websites.

The mere ownership of a trademark does not inherently grant exclusive rights to every single TLD in existence. Domain names may differ from a brand to accommodate technical constraints while still maintaining a recognizable association with the brand. The Domain Holder's use of the disputed domain name <cetco.se> for "Ceteris & Co" is a logical and acceptable abbreviation. This does not infringe upon the Petitioner's trademark rights. Furthermore, the absence of evidence demonstrating the Domain Holder's possession of registered or unregistered trademark rights, or any licensing agreement from the Petitioner, does not automatically imply a lack of legitimate interests in the disputed domain name. The Domain Holder's website operates as an online blog and informational website and it is not engaged in activities related to the sale of physical goods. The Domain Holder's website covers a diverse array of topics and is not limited to presenting information exclusively related to the Petitioner's sector. The website encompasses an array of diverse topics, including but not limited to news, lifestyle, technology, culture, and more. The presence of links to other websites does not establish any intent on the part of the Domain Holder to create confusion with or exploit the Petitioner's trademark and the Domain Holder cannot be held responsible for any third-party websites to which the Domain Holder may choose to link.

The Domain Holder's offer to park the disputed domain name was left unresolved due to the Petitioner's refusal to engage constructively. Had the Petitioner genuinely found the website or its content to be misleading or infringing upon the trademark rights, the Petitioner would eagerly have accepted the Domain Holder's offer to park the disputed domain name.

In conclusion, the Domain Holder maintains that the Petitioner's claims are not founded on established rights in Sweden and that the Domain Holder's use of the disputed domain name falls within the realm of legitimate, noncommercial use.

7. Discussion and Findings

A domain name may, in accordance with the .se Policy Paragraph 7.2, be deregistered or transferred to the party requesting dispute resolution proceedings if all of the following three conditions are fulfilled:

1. The disputed domain name is identical or similar to a name which is legally recognized in Sweden and to which the party requesting dispute resolution can prove its rights, and

2. The disputed domain name has been registered or used in bad faith, and
3. The Domain Holder has no rights or justified interest in the disputed domain name.

All three conditions must be met in order for a petitioner to succeed in its action.

A. The Domain Name is identical or similar to a name which is legally recognized in Sweden and to which the Petitioner can prove its rights

According to the submitted evidence in the case, the Petitioner is the owner of the registered trademark CETCO which is legally recognized in Sweden. The disputed domain name <cetco.se> incorporates the trademark in its entirety. It is common practice to disregard the ccTLD “.se” when comparing a domain name and a trademark.

Having the above in mind, the Panel concludes that the disputed domain name <cetco.se> is identical to the Petitioner’s trademark CETCO and that the Petitioner has proven the first requirement under Paragraph 7.2 of the .se Policy.

B. The Domain Name has been registered or used in bad faith

The Petitioner’s CETCO trademark predates the registration of the disputed domain name <cetco.se> as the trademark was registered on June 14, 1999, and the disputed domain name was registered on May 23, 2022. The Petitioner has not licensed, approved or in any way consented to the Domain Holder’s registration or use of the trademark in the disputed domain name.

From the submitted evidence in the case, it is clear that the disputed domain name, which is identical to the Petitioner’s registered CETCO trademark, was registered by the Domain Holder following the expiry and unintentional failure by the Petitioner to timely renew the disputed domain name which the Petitioner had used for a Swedish website between 2010 and 2022. On its own, registering a previously used domain name does not necessarily indicate bad faith; it is rather other circumstances regarding the Domain Holder’s registration and subsequent use that may be indicative of bad faith. The Domain Holder has argued that the disputed domain name <cetco.se> is an abbreviation of “Ceteris & Co” and that “Cet & Co” would become the brand of the Domain Holder’s new website. Given that the Domain Holder choose a new brand and registered the disputed domain name as a result of the Petitioner’s failure to renew it, it is reasonable to infer that the Domain Holder would have undertaken some form of basic due-diligence as to who had previously been the holder of the disputed domain name and how it had been used. A simple search would also have provided the information that the CETCO trademark registration is valid in Sweden since 1999. Thus, based on the evidence and circumstances in the case, the Arbitrator finds, on the balance of probabilities, that the Domain Holder should have known of the Petitioner and the Petitioner’s business when registering and using the disputed domain name. This is further demonstrated by the circumstance that the disputed domain name resolves to a website providing information regarding services that are similar to the Petitioner’s offerings in connection with the trademark.

In addition to the above, the Domain Holder’s website, to which the disputed domain name resolves, displays a number of links to third-party websites, named as partners of the Domain Holder and offering services similar to the Petitioner including “Construction”, “Manufacturing”, “Industry” and “Drilling”. The Domain Holder claims that it is not attempting to take advantage of the Petitioner’s trademark because the Domain Holder’s research indicates that not many Internet users based in Sweden search for the Petitioner’s trademark CETCO. However, the Domain Holder’s reasoning above does not eliminate the fact that the Petitioner is the owner of the trademark registration for CETCO, which is valid in Sweden, and by displaying a number of hyperlinks to the Domain Holder’s partners, the Domain Holder is attempting to take advantage of the Petitioner’s trademark, irrespective of the number of searches made by the Internet users in Sweden. In addition, the Domain Holder’s registration of the disputed domain name hinders the Petitioner from reflecting its trademark in a corresponding domain name in the ccTLD “.se”.

The Arbitrator concludes that the Petitioner has also proven the second requirement under Paragraph 7.2 of the .se Policy and that the disputed domain name <cetco.se> has been registered and used in bad faith.

C. The Domain Holder has no rights or justified interest in the Domain Name.

The Petitioner maintains that the Domain Holder lacks rights or justified interest in the disputed domain name <cetco.se> and that the Petitioner has not licensed or consented to the Domain Holder's registration or use of the registered CETCO trademark in the disputed domain name.

The Petitioner claims that there is no registered company name or trademark in Sweden with the name "Cet & Co" or "Ceteris & Co" and that the CETCO trademark does not have any generic or linguistic meaning. This has not been challenged by the Domain Holder. There is no evidence in the case demonstrating that the Domain Holder is the owner of a company name, trademark, or any other right, similar to the disputed domain name. Although the Domain Holder maintains that the name CETCO is an abbreviation of "Ceteris & Co", the Domain Holder has not provided any evidence of this, and cannot establish that it is commonly known by the disputed domain name or any name similar to the disputed domain name.

Although the Domain Holder argues that it has a legitimate interest through non-commercial informational use, the submitted evidence in the case indicates that the Domain Holder's website is commercial, given that it displays a number of commercial advertisements for third-party companies. The evidence establishes that the commercial hyperlinks on the Domain Holder's website are provided in a collaboration with a company specializing in commercial online affiliate- and influencer marketing. In view of the above, the Arbitrator finds on balance that the Domain Holder is attempting to take advantage of the Petitioner's CETCO trademark by creating a likelihood of confusion in order to increase the exposure of the Domain Holder's sponsored hyperlinks for commercial gain. The Domain Holder has not explained why he used the name "Ceteris & Co" or "Cet & Co" for its website.

Based upon the above specific circumstances, the Arbitrator concludes on balance that the Domain Holder has failed to invoke any circumstances, which could demonstrate pursuant to Section 7.2 of the .se Policy, any rights or justified interests in respect of the disputed domain name and the Arbitrator concludes that the Petitioner has also proven the third requirement under Section 7.2 of the .se Policy.

8. Decision

For the foregoing reasons, in accordance with Section 7.2 of the .se Policy, the Arbitrator orders that the disputed domain name <cetco.se> shall be transferred to the Petitioner.

9. Summary

The Arbitrator concludes that the disputed domain name <cetco.se> is identical to the Petitioner's trademark CETCO and that the Petitioner has proved the first requirement of the .se Policy. Furthermore, the Arbitrator concludes that the Petitioner has proved that the disputed domain name has been registered and used in bad faith in accordance with the second requirement of the .se Policy. Finally, the Arbitrator finds that the Domain Holder has failed to invoke any circumstances, which could demonstrate pursuant to the .se Policy, any rights or justified interests in respect of the disputed domain name.

Johan Sjöbeck

Date: August 23, 2023