

ADMINISTRATIVE PANEL DECISION

Arcadis N.V. v. YAN JIAFAN MR, SF Express (Germany) GmbH
Case No. DEU2023-0029

1. The Parties

The Complainant is Arcadis N.V., Netherlands (Kingdom of the), represented by Merkenbureau Knijff & Partners B.V., Netherlands (Kingdom of the).

The Respondent is YAN JIAFAN MR, SF Express (Germany) GmbH, Germany.

2. The Disputed Domain Name, Registry and Registrar

The Registry of the disputed domain name <arcadisgen.eu> is the European Registry for Internet Domains ("EURid" or the "Registry"). The Registrar of the disputed domain name is Ledl.net GmbH.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 20, 2023. On July 24, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On July 26, 2023, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing its contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the "Supplemental Rules").

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 31, 2023. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was August 20, 2023. A communication from a third party was received by the Center on August 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 21, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on August 30, 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complainant, founded in 1888 and based in Amsterdam is a global company active in, among others, design, engineering and management consulting. The Complainant adopted its current company name, Arcadis, during 1997 and, since 1990 the company has largely expanded itself via a series of acquisitions and mergers and has been involved in several high profile construction projects, such as Dublin Airport Authority (Ireland), or Evonet (Denmark). Currently the Complainant operates more than 350 offices across 70 countries and generates approximately EUR 3.4 billion in revenue.

The Complainant owns trademark rights for ARCADIS, including for ARCADIS GEN, in various jurisdictions worldwide as well as in Europe, such as the following:

- the International trademark registration number 5589114 for ARCADIS GEN (word), registered on June 2, 2020, covering goods and services in Nice Classes 9, 42; and
- the Benelux Trade Mark registration number 01407138 for the mark ARCADIS GEN (word), filed and registered on December 3, 2019, covering goods and services in Nice Classes 9 and 42.

The Complainant owns domain names comprising the marks ARCADIS and ARCADIS GEN such as <arcadis.com>, registered on February 25, 1996 and <arcadisgen.com>, registered on December 3, 2019.

The disputed domain name was registered on November 1, 2022, and, at the time of filing the Complaint, it was offered for public sale on a website, first for EUR 3.900 then for EUR 2.899.

A third party email communication was received by the Center on August 7, 2023 claiming that such third party received a letter from the Center but it has no connection/affiliation with the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name to it and contends the following: the disputed domain name reflects the entirety of its trademark and therefore it is identical to its ARCADIS GEN mark; the Respondent has no rights or legitimate interests in the disputed domain name; and the Respondent is using the disputed domain name intentionally in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to Article 4 of the Regulation (EU) 2019/517 (hereinafter, the "Regulation"), an ADR procedure may be initiated by any party where the registration is speculative or abusive. Article 4(4) of the Regulation, provides that a registered domain name shall be subject to revocation (and where necessary subsequently transferred to another party) where it is identical or confusingly similar to a name in respect of which a to a name in respect of which a right is established by Union or national law, and where it:

(a) has been registered by its holder without rights or legitimate interests in the name; or

(b) has been registered or is being used in bad faith. According to Paragraph B(11)(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedy requested by the Complainant if the latter proves in the ADR proceeding that:

- (i) The Disputed Domain Name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law and; either
- (ii) The Disputed Domain Name has been registered by the Respondent without rights or legitimate interest in the name; or
- (iii) The Disputed Domain Name has been registered or is being used in bad faith.

In the present ADR proceeding, the Complainant has pleaded the cumulative existence of the circumstances provided by the Regulation and ADR Rules (points (a) and (b) above). The Panel notes that the Regulation and ADR Rules list the issues under points (a) and (b) in the alternative, but nevertheless the Panel will examine both of these issues in order to reach its decision in the present ADR proceeding.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

Paragraph (B)(1)(b)(9) of the ADR Rules contains a list of rights which may fulfill the definition of “name in respect of which a right is recognized or established” provided in Paragraph (B)(11)(d)(1)(i) of the ADR Rules. Said list includes, *inter alia*: “copyright, trademarks and geographical indications or designations of origin, and, insofar as they are protected under national law in the Member States where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.” It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.¹

Paragraph B(11)(d)(1)(i) of the ADR Rules requires that the disputed domain name be “identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a member State and/or European Union law”.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the trademark ARCADIS GEN protected in various jurisdictions in the European Union. The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the ADR Rules.

The Panel therefore finds that the disputed domain name is identical to the ARCADIS GEN trademark as per the purpose of the Paragraph B(11)(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

Paragraph B(11)(e) of the ADR Rules provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Under the ADR Rules, the burden of proof for the lack of rights or legitimate interests of the Respondent lies with the Complainant. However, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant

¹ Considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Panel also refers to UDRP case law and analysis, where appropriate.

evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the ADR Rules or otherwise.

Prior UDRP panels have held that where a domain name consists of a trademark, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). Furthermore, the disputed domain name was offered for public sale on a third party website and such fact, together with the other circumstances in this case, do not amount to a *bona fide* or legitimate use.

Accordingly, in the absence of any evidence to support a possible basis on which the Respondent may have rights or legitimate interests in respect of the disputed domain name, and having in view the other circumstance of this case, the Panel accepts the Complainant's unrebutted *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and that the Complainant has satisfied the condition set out at Paragraph B(11)(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

Under Article 4(4) of the Regulation and Paragraph B(11)(d)(1) of the ADR Rules, lack of rights or legitimate interests and registration or use in bad faith are considered alternative requirements for a successful complaint. As the Panel has found that the Respondent lacks rights or legitimate interests in the disputed domain name no further discussion on bad faith registration or use is necessary.

Nevertheless, noting the well-known recognition of the Complainant's trademark and the identically composition of the disputed domain name, the Panel finds it likely that the Respondent was aware of the Complainant's ARCADIS GEN trademark at the registration of the disputed domain name. The Complainant has submitted evidence showing that the Respondent registered the disputed domain name well after the registration of the ARCADIS GEN trademark and corresponding company name and domain names.

At the time of filing the Complaint, the disputed domain name was not connected with an active webpage and it was offered for public sale.

Panels 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. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. 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. [WIPO Overview 3.0](#), section 3.3.

In this case, the Panel notes the distinctiveness and international reputation of the Complainant's trademark; the composition of the disputed domain name; the Respondent's failure to provide a response in this procedure; the Respondent's provision of inaccurate contact details in the Whols, and finds the the circumstances of the case, support a finding of bad faith.

Also, the disputed domain name was offered for public sale on a third party's website. Consequently, the Panel deems applicable the circumstances listed under paragraph (B)(11)(f)(1) of the ADR Rules providing that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting or

otherwise transferring the domain name registration to the holder of the name, in respect of which a right is recognized or established by national and/or European Union law, *i.e.* the Complainant.

In the present proceeding, based on all elements in particular the composition of the disputed domain name, the Panel finds another evidence of bad faith the Respondent's offering for sale of the disputed domain name for an amount which very likely exceeds the documented out-of-pockets costs related to the registration of the disputed domain name.

The Panel therefore finds that the Respondent has both registered and used the disputed domain name in bad faith and that the condition set out at Paragraph B(11)(d)(1)(iii) of the ADR Rules has also been satisfied.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <arcadisgen.eu> be transferred to the Complainant².

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: September 11, 2023

² (i) The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.

(ii) As the Complainant, Arcadis N.V., is established in the Netherlands (Kingdom of the), a Member State of the European Union, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 3 Regulation (EU) 2019/517.