

ADMINISTRATIVE PANEL DECISION

Marinus Petrus Jongenelis, trading under the name Smaragd Music v.
Benson and Partner Ltd
Case No. DNL2012-0059

1. The Parties

The Complainant is Marinus Petrus Jongenelis, trading under the name Smaragd Music of Etten-Leur, the Netherlands, represented by QuestIE advocatuur B.V., the Netherlands.

The Respondent is Benson and Partner Ltd of Houston, Texas, United States of America.

2. The Domain Name and Registrar

The disputed domain name <smaragdmusic.nl> (the "Domain Name") is registered with SIDN through webagentur.at internet services gmbh.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 24, 2012. On September 24, 2012, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On September 25, 2012, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied 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 September 28, 2012. In accordance with the Regulations, article 7.1, the due date for Response was October 18, 2012. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 19, 2012.

The Center appointed Remco M.R. van Leeuwen as the panelist in this matter on October 31, 2012. 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.

After reviewing the case file, the Panel issued the Administrative Panel Procedural Order No. 1 (the "Procedural Order") on November 12, 2012, inviting the Complainant to submit further information, and providing the Respondent with an opportunity to submit a brief reply to any such Complainant submission.

The text of the Procedural Order is attached as Appendix 1 to this Decision. On November 18, 2012, the Complainant responded to the Procedural Order. On November 19, 2012, the parties were informed that the Respondent had seven calendar days to submit a reply to the Complainant's submission. The Respondent did not submit any reply. Accordingly, the Center notified the parties on November 29, 2012, that no reply from the Respondent was received. On December 3, 2012, the Center informed the parties that the revised due date for the Decision in this case would be December 14, 2012, ultimately leading to the present date of the Decision.

4. Factual Background

The Panel will proceed on the facts and circumstances as stated by the Complainant and will take into account the information provided by the Center and by SIDN.

The Complaint is based on the Benelux figurative trademark SMARAGD MUSIC, registered on December 15, 2005, under number 792984, for products in class 9 and services in classes 35 and 41; the Benelux word mark SMARAGD MUSIC, application for registration filed on September 11, 2012, under number 1254174, for products in class 9 and services in classes 35 and 41 (hereafter the "Trademarks"); and the trade name "Smaragd Music".

The Domain Name was registered by the Respondent on July 17, 2012. However, according to the Complainant, the Domain Name was registered in the name of the Complainant before that date, and "grabbed" by the Respondent after the Domain Name was put in quarantine by the Complainant's hosting provider.

5. Parties' Contentions

A. Complainant

A trademark or trade name protected under Dutch law

The Complainant claims that he is the owner of the Trademarks and the trade name "Smaragd Music". According to the Complainant, he uses the Trademarks and this trade name for the exploitation of his record label. The Domain Name is identical to the Trademarks and the trade name "Smaragd Music" as the Domain Name contains the Trademarks and this trade name in its entirety, according to the Complainant.

No rights or legitimate interests

According to the Complainant, the Respondent lacks rights to and has no legitimate interests in the Domain Name, since the Respondent is not known by the Domain Name and is not making (a legitimate) use of the Domain Name. The Respondent does not produce and offer (recording) studio services for/to the Dutch (speaking) market, according to the Complainant.

Registration or use in bad faith

According to the Complainant, the Domain Name was registered in bad faith with the aim to sell, rent or transfer it to the Complainant's competitors for valuable consideration in excess of the costs of registration, considering the prior date of registration of the figurative trademark SMARAGD MUSIC and use of the trade name "Smaragd Music", and the fact that the Domain Name was "grabbed" by the Respondent after the Domain Name was put in quarantine by the Complainant's hosting provider. Where the Complainant aims for the Dutch market, the Respondent is an Austrian/American company with no trading activities in the Netherlands, according to the Complainant.

B. Respondent

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

6. Discussion and Findings

In accordance with article 10.3 of the Regulations, since no Response has been filed by the Respondent, the Panel will have to decide on the basis of the Complaint. Based on this article, the Panel will have to grant the Complaint unless it seems unlawful or without merit. Therefore, the Panel will review the Complaint on this basis.

Based on article 2.1 of the Regulations, a request to transfer a domain name must meet three cumulative conditions:

- a. The domain name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the complainant has rights, or other name by means of article 2.1(a) under II of the Regulations; and
- b. The respondent has no rights to or legitimate interests in the domain name; and
- c. The domain name has been registered or is being used in bad faith.

Considering these conditions, the Panel rules as follows:

A. Identical or Confusingly Similar

The print-outs from the Benelux Trademarks Register of the Trademarks, filed as annexes to the Complaint and the response to the Procedural Order, show that the Benelux figurative trademark SMARAGD MUSIC has been registered in the name of Ronald J. Visch and Manfred P. Jongenelis (the latter of whom, the Panel notes, does not have the same first name as the Complainant) and that the application for registration of the Benelux word mark SMARAGD MUSIC has been made in the name of the aforementioned Manfred P. Jongenelis. Therefore, neither of these trademarks is in the name of the Complainant. Further, the Complainant did not clarify the relationship, if any, between him and Manfred P. Jongenelis and/or Ronald J. Visch, nor did it so in the response to the Procedural Order.

As a consequence, the Panel is of the opinion that the Complainant has not sufficiently demonstrated his rights in the Trademarks.

The Complainant has, however, sufficiently established that he is the sole proprietor of a business with the trade name "Smaragd Music" and that this trade name has been and is used for the exploitation of his record label.

It is established case law that the top level domain ".nl" may be disregarded in assessing the similarity between the relevant trade name on the one hand, and the domain name on the other hand (see: *Caterpillar Inc. v. H. van Zuylen Materieel*, WIPO Case No. DNL2011-0073; *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

The Panel finds that the Domain Name is identical to the Complainant's trade name within the meaning of article 2.1(a) under I of the Regulations. As the Complainant's trade name rights are sufficient to fulfill the first requirement of the Regulations, the Panel rules that Complainant has met the first ground of the Regulations.

B. Rights or Legitimate Interests

The Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name. The Respondent did not file any Response and the Panel has not found any rights or legitimate interests that the Respondent may have in the Domain Name in the record, and will have to presume it has none.

The Panel therefore rules that the Complainant has met the second ground of the Regulations as set out in article 2.1(b).

C. Registered or Used in Bad Faith

Pursuant to article 2.1(c) of the Regulations, the Complainant must assert and establish that the Domain Name has been registered or is being used in bad faith.

The Complainant states that the Domain Name was registered in bad faith with the aim to sell, rent or transfer it to the Complainant's competitors. The Complainant further contends that the Respondent does not use the Domain Name for legitimate purposes.

The Respondent did not file any Response. The Panel considers it likely, as asserted by the Complainant, that the Respondent was able to snap up the Domain Name in a situation where the Complainant had previously registered and used the Domain Name for his business.

The Complainant has furthermore submitted evidence that the Domain Name is being used for a website containing sponsored links mainly relating to music products and services. The Panel therefore finds that the Domain Name is being used for commercial gain, by attracting Internet users to a website of the Respondent or other online location through the likelihood of confusion which may arise with the Complainant's trade name as to the source, sponsorship, affiliation or endorsement of such website or other online location.

The Panel therefore rules that the Complainant has met the third ground of the Regulations as set out in article 2.1(c).

7. Decision

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

Remco M.R. van Leeuwen

Panelist

Date: December 13, 2012

Procedural Order No. 1

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The Panel finds that the Complainant has not filed sufficient evidence to establish that the Complainant has rights in a trademark or a trade name protected under Dutch law as prescribed by article 2.1(a) under I of the Regulations. The Complainant states that it is trading under the name "Smaragd Music". However, no evidence of this fact, such as an extract from the trade registry of the Chamber of Commerce has been filed with the Complaint. Moreover, the Complainant also bases its Complaint on two trademark registrations. However, from Annex 2 it follows that neither of these registrations are in the name of the Complainant.

The Panel therefore invites the Complainant to submit additional evidence within seven (7) calendar days from the date of this Procedural Order that sufficiently shows the Complainant's rights in both the trade name and the trademarks which form the basis for this Complaint. The Respondent will have seven (7) calendar days after receipt of the Complainant's submission to submit a brief reply.

Remco M.R. van Leeuwen

Panelist

Date: November 12, 2012