

## **ADMINISTRATIVE PANEL DECISION**

**Fun Promotion International B.V. v. Frank de Groot**  
**Case No. D2012-1858**

### **1. The Parties**

The Complainant is Fun Promotion International B.V. of Amsterdam, the Netherlands, represented by Kneppelhout & Korthals N.V., the Netherlands.

The Respondent is Frank de Groot of Veghel, the Netherlands, self represented.

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

The disputed domain name <magictwistyworm.com> (the "Domain name") is registered with eNom (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 18, 2012. On September 18, 2012, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 18, 2012, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on September 25, 2012.

The Center verified that the Complaint together with the amendment to the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 28, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was October 18, 2012. The Response was filed with the Center on October 18, 2012.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on October 25, 2012. 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

Rules, paragraph 7.

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

The Complainant has been active for over 40 years in the toy market in the Netherlands, more specifically but not limited to small toys which have a rather low consumer price.

The Complainant is the proprietor of a Benelux word mark TWISTY, registered under number 0526992 on March 18, 1993 and of a Benelux figurative trade mark MAGIC TWISTY, registered under number 0723620 on September 6, 2002. Both trademarks are registered for games, toys and more specific soft toys. These marks are hereafter referred to as the “Trademarks” and the figurative trademark as the “Trademark MAGIC TWISTY”.

The Domain Name has been created on March 22, 2010. The Domain Name resolves to a website which offers “Magic Twisty Worm Toys” for sale.

#### **5. Parties’ Contentions**

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

The Complainant contends that the Domain Name is identical or confusingly similar to the Trademarks.

The Complainant claims that the Respondent has no rights or legitimate interests in the Domain Name. According to the Complainant, the Respondent is not named “Twisty” or “Magic Twisty” nor has it ever asserted any rights or legitimate interests in that name. The Complainant states that the products shown on the website do not originate from the Complainant, nor is there or has there been any economic or commercial relation between the Complainant and the Respondent. Furthermore, according to the Complainant, the use of the Domain Name for commercial gain by misleading Internet users does not constitute a *bona fide* offering of goods or services.

The Complainant asserts that the Domain Name has been registered and is being used in bad faith, because the Respondent solely attempts to cause confusion amongst possible buyers of Magic Twisty products by creating the impression that the website offers for sale original Magic Twisty products. Furthermore, according to the Complainant, the Respondent has registered the Domain Name with the intention to trade under the Trademarks. According to the Complainant, the Respondent was aware of the Trademarks at the time of registration and first use of the Domain Name.

##### **B. Respondent**

In its Response, the Respondent states that the “worm toy” is sold worldwide under different names and that the Complainant has registered the Trademarks only in the Benelux. The Respondent claims it does not focus on the Benelux area, but worldwide. This is why its website is in the English language. Furthermore, the Respondent claims it was not aware of the Trademarks of the Complainant.

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

The Complainant has shown that it has rights in the Trademarks. The Panel finds that the words “magic twisty” are the dominant part of the Trademark MAGIC TWISTY. The applicable top-level suffix in the Domain Name (*i.e.*, “.com”) would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself

form part of the relevant trademark. The latter is not the case here.

The element “magic twisty”, is also the dominant part of the Domain Name. The word “worm” is generic, as the Respondent has itself confirmed. In the Panel’s view, the use of this descriptive word cannot prevent the Domain Name from being confusingly similar to the Trademark MAGIC TWISTY (see *Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil*, WIPO Case No. D2000-1409; and *F. Hoffman-La Roche AG v. Rudiger Meissner*, WIPO Case No. D2009-1127).

Therefore, the Panel concludes that the Domain Name is confusingly similar to the Trademark MAGIC TWISTY.

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

Once a complainant establishes a *prima facie* case against a respondent in relation to this element, the burden is on the respondent to provide concrete evidence of its rights or legitimate interests based on paragraph 4(c) of the Policy or other circumstances (*Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited*, WIPO Case No. D2004-0753).

The Complainant has claimed that the Respondent has no rights or legitimate interests in the Domain Name, as set out in the examples under paragraph 4(c) of the Policy. The Panel derives from the Response that the Respondent claims to have a legitimate interest because it sells the “original” worm toy and that it offers its products for sale worldwide and does not focus on the Benelux, as the Complainant would do. Apparently the Respondent asserts that it was using the Domain Name prior to notice of the dispute in connection with a *bona fide* offering of goods or services, as set out in paragraph 4(c)(i) of the Policy. From the documents submitted by the Complainant, the Panel concludes that the Complainant does not assert to have intellectual property rights in the worm toy itself. There is no mention of such rights in either the Complaint or in the cease and desist letter that the Complainant has submitted as part of its evidence. In fact, a Google search has shown the Panel that there are several producers of worm toys and none appear to claim to have any specific intellectual property rights in that product.

However, the Respondent offers no satisfactory explanation as to why it would have an own right or legitimate interest authorizing it to trade these products under the Domain Name, which includes the Trademark MAGIC TWISTY. Furthermore, it is incorrect that the Respondent’s website under the Domain Name would only be aimed at customers outside the Benelux. The Respondent’s website offers the opportunity to select Dutch as a language and announces “We ship worldwide”. Therefore, the Respondent’s website is also aimed at the public in the Netherlands where the Complainant’s Trademark MAGIC TWISTY applies. Considering also the findings under 6.C, the Panel finds it more likely than not that the Respondent intended to trade-off the Complainant’s rights in the “Magic Twisty” name.

In view of these circumstances the use of the Domain Name by the Respondent cannot be considered to be in connection with the *bona fide* offering of goods or services, nor could the Panel find any other circumstances that could give rise to rights or legitimate interests in the Domain Name.

The Panel concludes that the Respondent has no rights or legitimate interests in the Domain Name.

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

The Panel finds on the basis of the record that the Respondent was or should have been aware of the Trademarks when registering the Domain Name. The registrations of the Trademarks on which the Complainant relies predate the Domain Name registration by many years. Furthermore, the Respondent states that “Magic Twisty” has been used as a name for the worm toy since around 1970, that this name is registered in other countries as a mark by other companies and that the Complainant only registered the name as a mark for the Benelux. This indicates that the Respondent knows the market for worm toys and the trademarks used for the worm toy.

In addition, a simple trademark register search would have informed the Respondent of the existence of the Trademarks. A Google search on “Magic Twisty”, as carried out by the Panel, refers on the first page of the search results to the domain name <magictwisty.com>, which directs to the website of the Complainant’s licensee. Therefore, even if the Respondent did not have the market knowledge referred to above, and has not actually been aware of the Complainant’s rights when registering the Domain Name, a small effort on its part would have revealed those rights. If the Respondent has not made that effort, this is at its own risk, since that would imply that the Respondent has been willfully blind to the Complainant’s rights.

By using the Domain Name for a website offering a worm toy not originating from the Complainant, using the AdWord “Magic Twisty” to advertise its website to users of the Google search engine and – at least initially – displaying on its website a promotion video taken from the Complainant’s website, featuring the MAGIC TWISTY Trademark, it is likely that the Respondent is attempting to attract Internet users to its website, by creating a likelihood of confusion with the Trademarks as to the source, affiliation, or endorsement of the Respondent’s website.

The Panel concludes that the Domain Name has been registered and is being used in bad faith.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <magictwistyworm.com> be transferred to the Complainant.

**Wolter Wefers Bettink**

Sole Panelist

Date: November 12, 2012