

DECISION OF THE THIRD-PARTY DECIDER

Eastman Chemical Company & Eastman Chemical HTF GmbH / Rodun International BV

Case no. 444170 / marlotherm.be

1. The Parties

1.1. Complainants:

Eastman Chemical HTF GmbH
Paul-Baumann-Stra ße 1
45772 Marl, Marl
Germany

Eastman Chemical Company
200 South Wilcox Drive
Kingsport, TN 37660
USA

Represented by:

Antje Brambrink
Outside counsel – Finnegan Europe (Germany) LLP
Thierschplatz 6
80538 Munich
Germany

Margaret A. Esquenet and Jonathan Uffelman
Outside counsel – Finnegan, Henderson, Farabow, Garrett &
Dunner, LLP
901 NewYork Ave., NW
Washington DC 20001-4413
USA

1.2. Domain Name Holder:

Rodun International BV
Roland BORSBOOM
Productieweg 8
3481MH Harmelen
The Netherlands

Represented by:

Koen Donkers
Lawyer – VDT Advocaten
Hart van Brabantlaan 500
5038 JA Tilburg
The Netherlands

2. The Domain Name

Domain name: marlotherm.be
Registered on: 7 October 2019

Hereafter referred to as "the Domain Name".

3. The proceedings

On 5 May 2022, the Complainant filed a complaint concerning the Domain Name ("Complaint") with the Belgian Centre for Arbitration and Mediation ("CEPANI"), in accordance with the CEPANI rules for domain name dispute resolution (the "Rules") and the dispute resolution policy of DNS Belgium, incorporated in article 10 of its Terms and conditions for .be domain name registrations (the "Policy").

Given that the language indicated upon registration of the Domain Name is Dutch but that the Complainants claim that the proceedings should be held in English, the Complaint was filed both in Dutch and English.

On 8 September 2022, CEPANI appointed the undersigned, Mr. Tom Heremans, as the third-party decider (the "Third-Party Decider") to settle the dispute about the Domain Name, and set the date for closure of the deliberations on 15 September 2022.

On 13 September 2022 the Domain Name Holder asked for a suspension of the proceedings until 30 September 2022. As the Complainants did not oppose against such stay of the proceedings, the proceedings were suspended, and the deliberations were closed on 3 October 2022.

The Domain Name Holder did not file a response to the Complaint.

In accordance with article 6.4. of the Rules, this decision is based on the Complaint alone, including the exhibits attached to the Complaint.

4. Factual Background information

Eastman Chemical Company ("Eastman") is an American Fortune 500 company, engaged in the global manufacture and sale of chemicals, fibers, and plastics.

Eastman's major markets include transportation, building and construction, consumables, consumer durables, industrials and chemicals processing, food, feed and agriculture, and health and wellness.

Eastman was founded in 1920 when George Eastman (Eastman Kodak's founder) sought an independent supply of chemicals for his photographic processes. The company has grown continuously in the following years.

Today, Eastman is a \$9.3 billion business with around 14,000 global employees, more than fifty manufacturing locations, and offices around the globe serving customers in around 100 countries.

In April 2019, Eastman announced it was adding to its portfolio of specialty businesses by acquiring the Marlotherm heat transfer fluids manufacturing assets and intellectual property. "Marlotherm" is a synthetic organic heat transfer fluid used in heating and cooling in various industrial applications.

When Eastman acquired the Marlotherm assets, including the MARLOTHERM trademark registrations, the MARLOTHERM brand already had at least 50 years of history in the industry.

Since the acquisition, Eastman has extensively promoted its MARLOTHERM products and services on its <eastman.com> website. Eastman uses the following logo at the top of its related webpages ("the MARLOTHERM logo"):



The Complainants, and in particular Eastman Chemical HTF GmbH, own *inter alia* the following trademark registrations ("the MARLOTHERM Trademarks"):

- EU Trademark No. 003491941 MARLOTHERM, which was filed on 31 October 2003 and registered on 30 August 2005 covering goods in Class 1 ("chemical products for industrial purposes; heat transfer fluids (synthetic and mineral oil-based)");
- International Registration No. 286333 MARLOTHERM, registered on 13 July 1964 covering goods in International Class 1 ("industrial chemicals");
- US Registration No. 1598020 MARLOTHERM, filed on 29 August 1989 and registered on 29 May 1990 covering goods in Class 1 ("chemical products used in industry, namely organic liquids for use as heat-transfer media in industry") (asserted first-use date 18 December 1953, asserted first-use in commerce 7 September 1983).

Additionally, the Complainants own numerous trademark registrations and applications for MARLOTHERM in other countries around the world.

5. Position of the parties

5.1. Position of the Complainants:

The Complainants contend that:

- the Domain Name is identical to the MARLOTHERM Trademarks;
- the Domain Name Holder has no rights or legitimate interests to the Domain Name;
- the Domain Name Holder has registered and uses of the Domaine Name in bad faith.

The Complainants therefore request the transfer of the Domain Name <marlotherm.be>.

5.2. Position of the Domain Name Holder

The Domain Name Holder did not submit a response.

6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-Party Decider shall rule on domain name disputes with due regard for the Policy and the CEPANI Rules for domain name dispute resolution.

Pursuant to Article 10b (1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE (the "Policy"), the Complainant must provide evidence of the following:

- i. *"the registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the complainant has rights; and*
- ii. *the registrant has no rights or legitimate interests in the domain name; and*
- iii. *the registrant's domain name has been registered or is being used in bad faith."*

6.1. Language of the proceedings

The Complainants claim that the proceedings should be held in English, although the language indicated upon registration of the Domain Name in the WHOIS database is Dutch.

Pursuant to Article 12.1 of the Rules, “the language of proceedings shall be the language indicated upon registration or renewal of registration of the Domain Name in the WHOIS database of the Registration Authority” (...). In special circumstances the Third-Party Decider may change the language.”

According to settled case law in the comparable Uniform Dispute Resolution Policy proceedings, special circumstances justifying a change of the language of proceedings, include *inter alia*:

- evidence showing that the Domain Name Holder can understand the language of the Complaint;
- potential unfairness or unwarranted delay in ordering the Complainant to translate the Complaint;
- other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

In view of the similarities between the Uniform Dispute Resolution Policy and the Policy for the “.be” domain, the Third-Party Decider considers this UDRP case law relevant to decide on the preliminary procedural issue.

Accordingly, the Third-Party Decider agrees to change the language of the proceedings to English.

This change is justified from a practical point of view and does not prejudice the rights of the Parties, given that it has been shown that the Domain Name Holder understands English. It appears from the file that the Domain Name Holder has corresponded in English in the past. Moreover, the website under the Domain Name is in English. This indisputably shows that the Domain Name Holder masters this language.

In any event, the Domain Name Holder was entitled to object against conducting the proceedings in English, but he did not submit any substantive response.

6.2. The Domain Name is identical or confusingly similar to trademarks in which the Complainants have rights

The Domain Name is identical with the MARLOTHERM Trademarks.

The Domain Name incorporates the MARLOTHERM Trademarks in their entirety, adding only the non-distinguishing ccTLD extension “.be”.

The “.be” extension shall not be taken into account pursuant to the well-established case law of CEPANI (see *inter alia* CEPANI 5 March 2001, *Vlaamse Radio en Televisieomroep nv / Securax bvba*, Case No. 4002; CEPANI 11 April 2001, *Pernod Ricard sa. / Worldsites Internet Networks bv*, Case No. 4003).

The Third-Party Decider therefore finds that the first condition of Article 10 b) 1) of the Policy is met.

6.3. The Domain Name Holder has no right or legitimate interests in the Domain Name

According to article 10 b) 3) of the Policy, the Domain Name Holder's rights or legitimate interest to the Domain Name can be proved by certain circumstances.

Article 10 b) 3) of the Policy gives a non-exhaustive list of such circumstances:

- *"prior to any notice of the dispute, the registrant used the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or*
- *the registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if he has acquired no trademark; or*
- *the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers, for commercial gain or to tarnish the trademark, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue."*

The Complainants contend and the Third-Party Decider agrees that the Domain Name Holder's registration and use of a Domain Name that incorporates Complainants' MARLOTHERM Trademarks in their entirety, to impersonate the Complainants does not constitute a bona fide offering of goods or services or fair use.

The Complainants contend that the Domain Name Holder is not, and has not been, commonly known by the Domain Name. Nothing in the Domain Name Holder's WHOIS information or the record demonstrates that the Domain Name Holder is commonly known by the Domain Name, and the Complainants have not authorized the Domain Name Holder to use their MARLOTHERM Trademarks.

Third, the Domain Name Holder does not satisfy the *Oki Data Americas, Inc. v. ASD, Inc.*, Case No. D2001-0903 (WIPO 6 November 2021) criteria for resellers ("the Oki Data case"), which criteria were also reflected in CEPANI case *Meguiar's Inc. v. W3 Company*, No. 444140, of 26 October 2021 and in the appeal case decided on 21 February 2022.

Under the Oki Data case, use of manufacturer's trademark as a domain name by a reseller can be deemed a "bona fide offering of goods or services" only if all the following conditions are satisfied: (1) the Domain Name Holder must actually offer the goods and services at issue; (2) the website must sell only the trademarked goods; (3) the website must accurately and prominently disclose the Domain Name Holder's relationship with the trademark holder; and (4) the Domain Name Holder must not try to "corner the market" in domain names that reflect the trademarks.

Here, the Third-Party Decider agrees with the Complainants that the Domain Name Holder fails at least the third requirement because its website does not accurately and prominently disclose its lack of relationship with the Complainants.

Finally, the Complainants contend that any rights flowing from a distribution agreement between the Complainants and Rodun Benelux have long since ceased. The Domain Name Holder's use of the Domain Name for a website selling MARLOTHERM products and making statements suggesting it is affiliated with the Complainants do not constitute a bona fide offering or legitimate use of the Domain Name.

Since the Complainants reasonable assert that the Domain Name Holder does not have any rights or legitimate interests, the burden of proof lies on the Domain Name Holder, who must prove that he does have rights or legitimate interests in the Domain Name.

The Domain Name Holder did not demonstrate his rights or legitimate interests to the Domain Name by any of the abovementioned elements. The Domain Name Holder has indeed not filed any response and has therefore not provided any explanation or evidence to establish his rights and/or legitimate interests in the Domain Name, so that Complainants' contentions in this respect are not contradicted.

Therefore, it must be concluded that the second condition under article 10, b) 1) ii of the Policy is also fulfilled.

6.4. The Domain name holder's Domain Name has been registered or is being used in bad faith

Bad faith must be reasonably proven and may be proven by any means, including presumptions and circumstances that indicate with a reasonable degree of certainty the existence of bad faith.

According to article 10 b) 2) of the Policy, the evidence of such in bad faith registration or use of a Domain Name can *inter alia* be demonstrated by the following circumstances:

- the Domain Name was registered primarily for the purpose of disrupting the business of a competitor;
- the Domain Name was intentionally used to attract, for commercial gain, Internet users to the registrant's web site or other on-line location, by creating confusion with the complainant's trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of a geographical entity as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or location or of a product or service on his web site or location;
- the registrant has registered one or more personal names without the existence of a demonstrable link between the registrant and the registered Domain Names.

The Third-Party Decider finds that in this matter bad faith is demonstrated by such circumstances. First, bad faith is shown because the Domain Name Holder has attempted to commercially benefit by attracting internet users to its website by creating a likelihood of confusion with the Complainants' MARLOTHERM Trademarks as

to the source, sponsorship, affiliation, or endorsement of the Domain Name Holder's website. The Domain Name automatically redirects to a website under the .nl Domain Name "marlotherm.nl", which displays the Complainants' MARLOTHERM logo and contains statements that suggest it is an authorized distributor of MARLOTHERM-branded products with no disclaimer regarding its true relationship with the Complainants.

Second, even if Rodun Benelux arguably registered the Domain Name in good faith (but without the Complainants' authorization) under a distribution agreement at the time, Rodun Benelux transferred the Domain Name to the Domain Name Holder without the Complainants' authorization.

Under the Policy, bad faith may be established either by showing bad-faith *registration* or bad-faith *use*. The registration or use of the Domain name in bad faith are indeed alternative conditions (See CEPANI 9 October 2019, *COMUTO s.a. / FLIXMOBILITY GmbH*, Case No. 44471).

In this matter, after termination of the distribution agreement, neither Rodun Benelux, nor the Domain Name Holder were authorised by the Complainants to use their MARLOTHERM Trademarks and the Domain Name Holder's use of the Domain Name is in bad faith (cfr. CEPANI 4 October 2010, *S.P.R.L. LOOKHATME / Mr. Guido WALLASCH*.)

Without any response from the Domain Name Holder, it is sufficiently evidenced that the Domain Name is at least being used in bad faith. Therefore, the condition stated in Article 10 b))1 iii of the Policy is also fulfilled.

7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-Party Decider hereby rules that the domain name registration for the "**marlotherm.be**" domain name is to be transferred to the Complainant Eastman Chemical HTF GmbH.

Brussels, 14 October 2022.

DocuSigned by:

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Tom HEREMANS
The Third-Party Decider