

## ADMINISTRATIVE PANEL DECISION

Cordelco N.V. v. I. Overtoom

Case No. D2022-2554

### 1. The Parties

The Complainant is Cordelco N.V., Curaçao, represented by ICTRecht, Netherlands.

The Respondent is , Netherlands, represented by Lawfox Advocaten BV, Netherlands.

### 2. The Domain Name and Registrar

The disputed domain name <mambo-beach.info> (the “Domain Name”) is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint July 18, 2022.

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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2022. On July 20, 2022, the Respondent requested an extension of the Response due date. In accordance with the Rules, paragraph 5(e), the Response due date was extended to August 17, 2022. The Response was filed with the Center on August 15, 2022.

The Center appointed Willem J. H. Leppink, Charles Gielen, and Wolter Wefers Bettink as panelists in this matter on September 2, 2022. The Panel finds that it was properly constituted. Each member of 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.

On September 5, 2022, the Complainant submitted by email to the Center an unsolicited supplemental filing.

Subsequently, on September 7, 2022, the Respondent also submitted by email to the Center an unsolicited supplemental filing. A further unsolicited filing was submitted by the Complainant on September 12, 2022.

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

The Complainant exploits a shopping, leisure, and entertainment mall in Willemstad, Curaçao. The Complainant's mall is named "Mambo Beach" and is located in the area of the Seaquarium beach, in the South-west of Curaçao.

The Domain Name was registered on October 27, 2015. The Domain Name resolves to a website (the "Website"), providing information about Mambo Beach and surrounding facilities such as, hotels, beachclubs, and restaurants.

#### **5. Parties' Contentions**

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

In so far as relevant the Complainant contends the following:

The Complainant is the owner of the Curaçao trademark MAMBO BEACH (word mark), filed on November 15, 2002, and registered under number 08922 for goods and services in classes 35, 41, and 43 ("Trademark"), which registration was renewed on July 1, 2022. Furthermore, the Complainant is the owner of various other Curaçao trademarks including the word element MAMBO.

The Domain Name is identical or at least confusingly similar to the Trademark. More specifically, the Domain Name exists of the Trademark in its entirety, albeit with an additional hyphen between MAMBO and BEACH, which is of no significance.

The Respondent has no rights or legitimate interest in regard to the Domain Name. The Respondent does not use the Domain Name in connection with a *bona fide* offering of goods and services. The Respondent is not commonly known by the Domain Name. In addition to this, the Respondent is not making a legitimate, noncommercial or fair use of the Domain Name. The Domain Name falsely suggests affiliation with the Complainant. The Website informs visitors about hotels, resorts, restaurants, nightlife facilities, and shops in the same area as where the Mambo Beach mall is located. The beach is officially named the Seaquarium Beach, but has been also known as Mambo Beach over the years, due to the efforts and reputation of the Mambo Beach mall. As a result of the dominant presence of the mall in the area, the widespread publicity and efforts of the Complainant, the actual beach area is now also called "Mambo beach".

Furthermore, the Domain Name has been registered and used in bad faith, because the Website with information is incorrectly creating the suggestion of an affiliation with the Complainant. Subsequently, the Respondent is intentionally attempting to attract Internet users to the Website by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Website by the Complainant.

## **B. Respondent**

The Respondent submitted a comprehensive Response and contends – in so far as relevant – the following:

According to the Complainant, the Trademark would have been transferred to the Complainant but the trademark document from 2012 as submitted by the Complainant, shows the name of a different owner. As the trademark register of the Curacao Bureau for intellectual property is not publicly accessible, the Respondent cannot verify the current owner of the Trademark and, also as no deed of transfer has been submitted, therefore rebuts that the Complainant is the owner.

The Trademark and the other MAMBO trademarks of the Complainant are merely descriptive whereas the beach is popularly and locally known as Mambo Beach. Thus, the Complainant is trying to obtain rights regarding a term that is in the public domain.

The Respondent uses the Domain Name for exploiting the Website, on which Dutch tourists are informed about the beach “Mambo Beach” and the facilities around the beach, such as hotels, bed and breakfasts and restaurants. Mambo Beach is the popular and locally known name of Seaquarium Beach – a beach on Curaçao and comes from the name of the popular beach club “Mambo” that was located on the beach until 2012. This beach club was so popular that people started calling the beach “Mambo Beach”, which also follows from the annexes submitted by the Complainant, in particular one that mentioned (translated from Dutch): “The name Mambo Beach comes from the beach bar ‘Mambo’ that used to be located here centrally located on the beach. This beach club was so popular that everyone started calling the beach Mambo Beach.” The beach is also named “Mambo Beach” on Google Maps and in the 8th edition of Lonely Planet’s Caribbean Islands guidebook and it is clear that both Google and Lonely Planet refer to the beach and not to the Complainant’s mall.

As a result the Complainant failed to prove that the Respondent has no rights or legitimate interests. The Respondent uses the Domain Name in connection with a *bona fide* offering of services as the Respondent provides information to tourists seeking to reside in the Mambo Beach area and informs them about restaurants, bars, hotels, etc. in close proximity of the Mambo Beach.

For *inter alia* these reasons, the Respondent can also not have registered and cannot be using the Domain Name in bad faith.

## **6. Discussion and Findings**

### **6.1 Preliminary Matter**

Before entering into the merits of the case, the Panel addresses the matter of the unsolicited supplemental filings submitted by the Complainant and the Respondent.

No provision concerning supplemental filings is made in the Rules or Supplemental Rules, except for paragraphs 10 and 12 of the Rules, from which it follows that the panel, in its sole discretion, may determine the admissibility, relevance, materiality, and weight of the evidence, insofar as both parties are treated with equality and are given a fair opportunity to present their case.

Both the Complainant and the Respondent submitted unsolicited supplemental filings which is generally discouraged, as is described in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). However, when the Complainant proves that the supplemental filing is of utmost importance to the case and it could not have provided the information within its prior complaint panels may find it justified to accept an unsolicited supplemental filing. The Respondent will then be allowed to respond the Complainant's unsolicited filing.

The Panel is not satisfied that such exceptional circumstances exist and, therefore, decides that the first unsolicited supplemental filing by the Complainant will not be admitted. As a general principle, a complainant has "one bite at the apple" and the Complainant could have easily foreseen the defenses as raised by the Respondent. The Respondent's unsolicited supplemental filing is filed in case the Panel would allow the first unsolicited filing by the Complainant. As the Panel does not admit this, as set out above, the Respondent's unsolicited filing will also not be admitted. Likewise, the second unsolicited filing by the Complainant, which responds to the Respondent's unsolicited filing, will not be admitted.

The Panel, nonetheless, makes an exception for the Certificate of Renewal of the Trademark submitted by the Complainant with its first unsolicited filing, as the Panel would have otherwise issued a Panel Order requesting recent owner details of the Trademark as the trademark register of the Curaçao intellectual property office is not publicly online accessible.

## **6.2 Substantive Matter**

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

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

The Complainant must demonstrate that it has rights in the Trademark and, if so, that the Domain Name is identical or confusingly similar to the Trademark. It should be noted that the first element serves as a standing requirement.

The Complainant provided sufficient evidence proving its rights in the Trademark. Although the Respondent rebutted the ownership by the Complainant as a copy of the deed of transfer to the Complainant was not submitted, the Panel is, based on the submitted certificate of trademark renewal from the Curacao Bureau for intellectual property and lacking a more substantiated rebuttal by the Respondent, satisfied that the Complainant is the owner of the Trademark.

The Domain Name is comprised of the Trademark in its entirety, with a hyphen instead of a space between the two word elements.

In accordance with section 1.11.1 of the [WIPO Overview 3.0](#), the Top-Level domain is in principle disregarded under the first element. For technical reasons, a space between words cannot be reflected in a domain name and are usually either omitted or replaced by a hyphen.

The Panel therefore finds that the Domain Name is confusingly similar to the Trademark and that the first element is satisfied.

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

For the Complaint to be successful, the Complainant needs to satisfy the second requirement and, thus, prove that the Respondent has no rights or legitimate interests regarding the Domain Name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has no rights or legitimate interests in the Domain Name:

- (i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to notice of the dispute; or
- (ii) being commonly known by the Domain Name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or
- (iii) making legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The onus of proving this requirement falls on the Complainant. The Complainant can refer to the aforementioned circumstances, however, this list of circumstances is by no means exhaustive. Instead, the Complainant must raise a *prima facie* case against the Respondent in order to shift the burden of production to the Respondent who in turn will need to rebut the *prima facie* case.

The Respondent has sufficiently demonstrated to the Panel, by references to Google Maps and a Lonely Planet guide, that the Sea Aquarium Beach on Curaçao is popularly and also commonly known as Mambo Beach. Also simple search engine searches for “Mambo Beach” result in a hotel and booking website with accommodation in that area. Therefore, Mambo Beach has become a geographical term and it is irrelevant whether that term originates in the presence (until 2012) of the popular Mambo Beach Club, as suggested by evidence submitted by the Complainant and pointed out by the Respondent, or in the presence of the Complainant’s Mambo Beach mall, as stated by the Complainant.

Where the goods or services offered on a website specifically relate to the generic or descriptive meaning of the domain name, the registrant is making the very kind of *bona fide* offering that is sufficient to establish legitimate interests under the Policy. See, e.g., *EAuto, L.L.C. v. EAuto Parts*, WIPO Case No. [D2001-1208](#) (April 9, 2000) (finding domain name <eautoparts.com> to be legitimate for a site that sells auto parts). That principle is particularly appropriate in the context of a domain name that consists solely of a geographical term if, as in this case, the website to which it resolves contains information about that geographical area. See *Brisbane City Council v. Joyce Russ Advertising Pty Ltd.*, WIPO Case No. [D2001-0069](#) (May 14, 2001) and *Commune of Zermatt and Zermatt Tourismus v. Activelifestyle Travel Network*, WIPO Case No. [D2007-1318](#) (October 29, 2007).

Moreover, nothing on the Website, which provides information about this beach, would mislead Internet users into believing that it is the official site of the Complainant’s mall or any affiliation with such mall, the Complainant or the Trademark.

The Complainant has thus failed to show that the Respondent lacks a legitimate interest in its Domain Name.

Therefore, the Panel concludes that the second element of the Policy has not been met.

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

Because the Complainant has failed to meet the second element, the Panel need not extensively analyze the issue of bad faith. That said, the Panel briefly notes that the Respondent appears to be using the Domain Name openly and notoriously, without any indicia that suggest an affiliation with the Complainant or the Trademark, or that would support a finding that the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent’s website or other on-line location, by creating a

likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Thus, it appears that the Complainant has been unable to establish bad faith registration and use.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Willem J. H. Leppink/*

**Willem J. H. Leppink**

Presiding Panelist

*/Charles Gielen/*

**Charles Gielen**

Panelist

*/Wolter Wefers Bettink/*

**Wolter Wefers Bettink**

Panelist

Date: September 14, 2022