



DECISION

dmarcian, Inc. v. Martijn Groeneweg / dmarcian Europe BV

Claim Number: FA2102001933397

PARTIES

Complainant is **dmarcian, Inc.** (“Complainant”), represented by **Timothy D. Pecsénye** of **Blank Rome LLP**, Pennsylvania, USA. Respondent is **Martijn Groeneweg / dmarcian Europe BV** (“Respondent”), Netherlands.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<dmarcian-europe.com>**, **<dmarcian.app>**, and **<dmarcian.email>**, registered with **GoDaddy.com, LLC**.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Michael Albert, Jonathan Agmon, and Douglas M. Isenberg as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on February 24, 2021; the FORUM received payment on February 24, 2021.

On February 25, 2021, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the **<dmarcian-europe.com>**, **<dmarcian.app>**, and **<dmarcian.email>** domain names are registered with GoDaddy.com, LLC and that Respondent is the current registrant of the names. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC registration agreement and has

thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On February 26, 2021, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of March 18, 2021 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@dmarcian-europe.com, postmaster@dmarcian.app, and postmaster@dmarcian.email. Also on February 26, 2021, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on March 17, 2021.

On March 23, 2021, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed Michael Albert, Jonathan Agmon, and Douglas M. Isenberg as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant is the owner of the United States trademark registration DMARCIAN (Reg. No. 5,702,379, registered Mar. 19, 2019). Complainant also has common law rights in the DMARCIAN mark.

Complainant contends that Respondent's <dmarcian-europe.com>, <dmarcian.app>, and <dmarcian.email> domain names are identical or confusingly similar to Complainant's mark. Respondent fully incorporates Complainant's mark in each disputed domain name.

Complainant also alleges that Respondent has no rights or legitimate interests in the disputed domain names. Specifically, Complainant contends that Complainant did not license, authorize, or otherwise permit Respondent to use Complainant's mark. Complainant further argues that Respondent's use is not a bona fide offering of goods or services, nor a legitimate noncommercial or fair use, and that Respondent is not commonly known by the disputed domain names and is allegedly attempting to pass itself off as Complainant.

Furthermore, Complainant alleges that Respondent registered and uses the disputed domain names in bad faith because Respondent had actual or constructive knowledge of Complainant's mark at the time of registration. Complainant again contends that Respondent is attempting to pass itself off as Complainant to attract Internet users for commercial gain.

B. Respondent

Respondent responds that Complainant failed to disclose to the Panel that Respondent and Complainant have been collaborating with each other since 2016. The oral collaboration agreement, the existence of which is reflected in certain court rulings, granted Respondent a perpetual and exclusive license to sell Complainant's software in Europe, Russia, and Africa.

Respondent asserts that the disputed domain names were registered and used for the purpose of selling Complainant's software—and that it did so with the knowledge and consent of Complainant. Since Respondent was acting in accordance with the oral collaboration agreement, Respondent claims it has rights and legitimate interests in the disputed domain names. Respondent also asserts that it is commonly known by the disputed domain names.

Respondent also relies on the agreement as grounds to dispute Complainant's allegation that Respondent registered or uses the disputed domain names in bad faith. Respondent avers that Complainant consented to the registrations and that Respondent had a perpetual, exclusive license to use the disputed domain names in the respective territories. Until the agreement comes to an end, Respondent has asserted the right to associate itself with Complainant's names.

Furthermore, Respondent points to a default decision issued on Feb. 1, 2021 where the Interim Relief Judge of the Court of Rotterdam ruled that Complainant could not terminate the collaboration agreement and must comply with its terms. Respondent asserts that this, *inter alia*, implies that Respondent may continue to use the disputed domain names.

Finally, Respondent addresses several copyright issues not directly related to the disputed domain names.

FINDINGS

Complainant is an international software company that provides secure email ecosystems to clients. Complainant is the owner of the United States trademark registration DMARCIAN (Reg. No. 5,702,379, registered Mar. 19, 2019). Complainant also has common law rights in the DMARCIAN mark.

Respondent's <dmarcian-europe.com>, <dmarcian.app>, and <dmarcian.email> domain names are registered with GoDaddy.com, LLC, with registration dates of Dec. 9, 2019, May 8, 2018, and July 3, 2018, respectively.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

PRELIMINARY ISSUE: BUSINESS/CONTRACTUAL DISPUTE OUTSIDE THE SCOPE OF THE POLICY

Respondent asserts that the disputed domain names were registered in accordance with the oral collaboration agreement Respondent had with Complainant. Complainant has not acknowledged in the Complaint the existence

of any agreement with Respondent. Complainant has instead addressed the three elements covered in Paragraph 4(a) of the Policy without acknowledgment of the impact such agreement may have on those elements.

The two parties have introduced to the Panel markedly different facts, and in particular, have sought resolution by this Panel of disputes that appear to already be pending before courts of competent jurisdiction. Complex cases involving the proper application of contractual agreements such as are at issue here are generally better decided by the courts. As set forth in *Love v. Barnett*, FA 944826 (FORUM May 14, 2007):

When the parties differ markedly with respect to the basic facts, and there is no clear and conclusive written evidence, it is difficult for a Panel operating under the Rules to determine which presentation of the facts is more credible. National courts are better equipped to take evidence and to evaluate its credibility.

There appear to be two lawsuits underway in the Netherlands related to the oral collaboration agreement, one before the Enterprise Court at the Amsterdam Court of the Appeal and another before the Rotterdam District Court. These courts are in a better position to consider the markedly different facts put forth by Complainant and Respondent, especially as the investigation ordered by the Enterprise Court on Sept. 7, 2020 is ongoing. The investigation is currently reviewing the policy and course of Respondent's actions from Jan. 1, 2016 to Aug. 20, 2020. While the case centers on copyright ownership rights, it also involves the scope and content of the oral collaboration agreement.

These two lawsuits are relevant for the further reason that their rulings (at least on an interim basis) suggest that Respondent may well have rights and legitimate interests in the disputed domain names. In the case before the Enterprise Court,

Complainant apparently acknowledged that the oral collaboration agreement granted Respondent the exclusive, perpetual license to use and sell Complainant's software. It is troubling that Complainant failed to disclose this agreement, or address its substance and impact, before this Panel. Such a collaboration agreement, even if focused on copyright issues, also has implications for the right to use Complainant's mark. As the majority shareholder of TDX, the director of Respondent, wrote (as quoted by the Amsterdam Court): the oral agreement allowed for "Both [Complainant] and [Respondent to] keep operating as separate entities under 1 brand." Assuming that statement to be correct (and we have no evidence before us disputing it), the right to operate "under one brand" would on its face appear to encompass the right to use corresponding domain names.

Similarly, the Rotterdam District Court's Writ of Summons suggests that Respondent has rights and legitimate interests in the disputed domain names. Issued on Feb. 29, 2021, that Court held that as long as the proceedings before the Enterprise Court had not been completed, the Complainant must comply with the terms of the parties' agreement. This includes Respondent being able to sell and use the software and access the computer systems necessary to service customers. The Court noted the "very close partnership" between the parties and the "highly intertwined" nature of the parties' business operations, "as evidenced by, among other things, the [domain] names used by the parties and the presence of a source code development platform."

This Panel need not enter a final adjudication as whether Respondent has rights or legitimate interests in the disputed domain names. As discussed in *Love*, when the parties have submitted to the UDRP panel markedly different facts, national courts are better equipped to evaluate evidence. The court decisions to date, at a minimum, imply that both Complainant and Respondent may each have at least a *prima facie case* for rights in the disputed domain names. When

both parties have a *prima facie case*, the case is not proper for action under the Policy. In *Love*, the Panel stated:

A dispute, such as the present one, between parties who each have at least a *prima facie case* for rights in the disputed domain names is outside the scope of the Policy ... the present case appears to hinge mostly on a business or civil dispute between the parties, with possible causes of action for breach of contract or fiduciary duty. Thus, the majority holds that the subject matter is outside the scope of the UDRP and dismisses the Complaint.

Like the case in *Love*, the dispute in front of the Panel centers on a business and/or contractual issue and is thus outside the scope of the UDRP. *See Everingham Bros. Bait Co. v. Contigo Visual*, FA 440219 (FORUM Apr. 27, 2005) (“The Panel finds that this matter is outside the scope of the Policy because it involves a business dispute between two parties. The UDRP was implemented to address abusive cybersquatting, not contractual or legitimate business disputes.”); *see also Fuze Beverage, LLC v. CGEYE, Inc.*, FA 844252 (FORUM Jan. 8, 2007) (“The Complaint before us describes what appears to be a common-form claim of breach of contract or breach of fiduciary duty. It is not the kind of controversy, grounded exclusively in abusive cyber-squatting, that the Policy was designed to address.”); *see also Frazier Winery LLC v. Hernandez*, FA 841081 (FORUM Dec. 27, 2006) (holding that disputes arising out of a business relationship between the complainant and respondent regarding control over the domain name registration are outside the scope of the UDRP Policy).

Based on the reasoning outlined in the record and the aforementioned cases, the Panel concludes that the instant dispute both contains and depends on resolving a question of business and/or contractual issue that is pending before national

courts of competent jurisdiction, and thus falls outside the jurisdiction of the Policy.

DECISION

Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED** and the case **DISMISSED**.

Accordingly, it is Ordered that the <**dmarcian-europe.com**>, <**dmarcian.app**>, and <**dmarcian.email**> domain names **REMAIN WITH** Respondent pending further adjudication by courts of competent jurisdiction.



Michael A. Albert, Esq.
Arbitrator

Michael Albert, Panelist and Chair

Jonathan Agmon, Panelist

Douglas M. Isenberg, Panelist

Dated: April 7, 2021