

ADMINISTRATIVE PANEL DECISION

Waterland Private Equity Investments B.V. v. Emerson Alvarado, and
Paytotake, LLC
Case No. D2024-0666

1. The Parties

The Complainant is Waterland Private Equity Investments B.V., Belgium, represented by IP Hills NV, Belgium.

The Respondents are Emerson Alvarado, Costa Rica, and Paytotake, LLC, United States of America (“United States”) represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <waterland.com> is registered with Spaceship, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 13, 2024. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (PrivacyGuardian.org / PAYTOTAKE, LLC) and contact information in the Complaint. On the same day, the Center sent an email communication to the Complainant providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Complainant filed an amendment to the Complaint.

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 February 26, 2024. In accordance with the Rules, paragraph 5, the original due date for Response was March 17, 2024. In accordance with the Rules,

paragraph 5(b), the due date for Response was extended to March 21, 2024 at the request of the Respondent. The Response was filed with the Center on March 21, 2024.

The Center appointed Matthew Kennedy, Mireille Buydens, and Douglas M. Isenberg as panelists in this matter on April 17, 2024. 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.

4. Factual Background

The Complainant is a private equity investment group. It employs 180 professionals in 11 European countries and holds trademark registrations in multiple jurisdictions, including the following:

- Benelux trademark registration number 758483 for WATERLAND, registered on July 28, 2004, specifying services in classes 35, 36, and 42;
- International trademark registration number 842621 for WATERLAND, registered on December 22, 2004, designating Germany and Switzerland, specifying services in classes 35, 36 and 42, and designating the United States and other jurisdictions on November 24, 2023;
- Benelux trademark registration number 933752 for a semi-figurative mark in colors containing the textual elements WATERLAND PRIVATE EQUITY INVESTMENTS, registered on May 10, 2013, specifying services in classes 35, 36, and 42; and
- European Union trademark registration number 012701033 for WATERLAND, registered from September 4, 2014, specifying services in classes 35, 36, and 45.

The above trademark registrations are current. The Complainant also registered the domain name <waterland.nu> on April 20, 1999, that now redirects to the domain name <waterlandpe.com>, which it registered on January 9, 2017, and uses in connection with a website in multiple languages, including English, where it provides information about itself and its services.

The Respondent is a trader in domain names based in Costa Rica and the sole proprietor of Paytotake, LLC of the United States. According to evidence presented by the Respondent, his company successfully defended a previous complaint under the Policy regarding a domain name that was identical to a trademark and a Spanish dictionary word. See *Intocable, Ltd. v. Paytotake LLC*, WIPO Case No. [D2016-1048](#).

The disputed domain name was previously registered by a third party named Waterland Design LLC, which failed to renew the registration. On June 19, 2019, a domain industry blog included the disputed domain name in a report on hot domain auctions. On July 2, 2019, the Respondent company Paytotake LLC acquired the disputed domain name at auction; on July 5, 2019, the Respondent paid the purchase price of USD 6,733; and on July 8, 2019, the registration was transferred to the Respondent. The disputed domain name now resolves to a webpage that offers it for sale, lease, rent, or joint venture.

According to evidence submitted by the Respondent, during the period 2019 to 2021, he received enquiries from third parties about acquisition of the disputed domain name, including for use in connection with a water park, a non-profit project concerning water, and an aquarium. According to evidence submitted by the Complainant, an individual contacted the Respondent on June 22, 2021, indicating that he was interested in buying the disputed domain name. The Respondent replied on the same day, asking about the individual's intended purpose for the disputed domain name, and referencing a Global Water Intelligence report on the world's top 50 water businesses. The Respondent sent another email on the following day, indicating that he also owned the domain name <waterland.org> and would be willing to sell it for USD 500,000, adding that "After the .COM, the best extension is the .ORG".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its WATERLAND trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no evidence of the Respondent's use of the disputed domain name since he acquired it in 2020. In 2020, the Complainant made an investment in the United States via its portfolio company Global Equestrian Group, announced on January 25, 2020, which could have triggered the Respondent's registration of the disputed domain name. The disputed domain name has been for sale since January 29, 2020. "Waterland" is not a word that a trader would rightly choose. There is no legitimate reason why the Respondent should choose the Complainant's mark.

The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name without performing any due diligence. The Complainant has owned and used the WATERLAND trademarks in commerce for more than 24 years. At the time the Respondent acquired the disputed domain name in 2020, he should have undoubtedly been aware of the Complainant's prominence. The top results of a Google search for "Waterland" refer to the Complainant. The Respondent, especially as a professional in the domain name business, had a duty to determine whether registration of a domain name would infringe or otherwise violate the rights of any third party. These actions furthermore indicate willful blindness. The Respondent has registered hundreds of domain names. A reverse Whois search identified 17 domain names currently and visibly registered by his company Paytotake, LLC. None of them is being used. It is very likely that the Respondent has other privacy-protected domain name registrations. Paytotake, LLC is currently selling more than 200 domain names through a broker's website. Its domain names include <weebo.com> (a town), <jafz.ae> (a misspelling of "jafza"), and <bancometropolitano.com>. The Respondent acquired the disputed domain name in an attempt to extract significant payment from the Complainant.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name.

The Respondent declares that he became aware of the disputed domain name in June 2019 when it was in the process of being auctioned. He became interested in acquiring it as a two-word combination of "water" and "land" that could mean many things. His searches informed him that it was a place in the Netherlands, a surname, and was used for many things by many people and businesses for waterparks, water projects, real estate, and so on. No one in particular stood out to him as having a single claim to the disputed domain name, and everything for which the name could be used. He does not recall having ever been specifically aware of the Complainant prior to purchasing the disputed domain name, and he first became aware of the Complainant when he received the Complaint in this dispute.

"Waterland" is the name of a region of the Netherlands, the name of a region of Belgium, and a surname. The Dutch Chamber of Commerce lists over 678 search results for businesses with "Waterland". The Belgian government database lists 22 "Waterland" companies. The Benelux Office of Intellectual Property lists some 16 trademarks consisting of or comprising "waterland" registered by third parties. EUIPO lists over 96 pending and registered WATERLAND marks. LinkedIn lists over 300 persons with the surname "Waterland". More than 300 registered domain names begin with "waterland". Traders in all sorts of goods and services have "rightly" chosen to use "Waterland". This is not a case where bad faith may be presumed merely by the registration and public offer for sale of an inherently distinctive term, or a term that is uniquely

associated with a single entity. This is a generic geographic term, a surname, and is perfectly marketable to a wide variety of potential end users having nothing to do with investments.

The Respondent registered the disputed domain name in July 2019, not 2020. The timing of the registration was determined entirely by the domain expiration and deletion cycle, and could not have been timed to coincide with any news about the Complainant. It is well established by now that the mere offering for sale of dictionary words and geographic place names capable of a wide range of potential meanings and uses, is not itself an illegitimate activity, absent evidence of targeting of a particular mark owner. The mere general offer for sale of a non-exclusive and non-distinctive term does not implicate or violate the Complainant's limited rights. Certainly, the Respondent has made no infringing or illegitimate use of the disputed domain name. The Respondent's registration of the disputed domain name is consistent with the prior UDRP decision in *Intocable, Ltd. v. Paytotake LLC, supra*, and the Respondent's registration of at least 12 geographic words, including <walloon.com> and at least 20 personal names and surnames, including <marilyn.com>. The Complainant chose a mark for its business based on a clear geographical and historical association for which West Flanders and Holland are famous and which the Complainant sought to leverage. The Complainant's choice comes with the inherent fact that the scope of its rights in the term "waterland" will not ever amount to a monopoly in any and all commercial uses of it. The Respondent reasonably believes this word to have commercial value as a non-exclusive term independent of the Complainant. The Respondent has subsequently offered the name for public sale for any that might want to use it for purposes having nothing to do with the Complainant.

Attempting to sell a generic geographic domain name is not *per se* illegitimate. The Complainant provides no evidence either that the Respondent's primary purpose in acquiring the disputed domain name was driven by the Complainant's mark or that its purpose was to sell the disputed domain name to the Complainant in particular. The Respondent has never offered the Complainant anything and never corresponded with the Complainant. Not reaching an agreement on an invitation to negotiate a price is not bad faith.

The Complainant has cited various cases dealing with inherently distinctive marks, and notions of constructive notice. Even the Complainant admits its business to have been confined to Europe until 2020 – a year after the Respondent acquired the domain name. The Google rank of the Complainant in a search in Belgium in 2024 does not show what it might have been in the United States or Costa Rica in 2019. Of course, the Complainant will rank highly as a local business in a search conducted by its attorney. The Respondent has no duty of constructive notice of European trademarks and, even if a search were conducted of these resources, the results would have shown that "waterland" is principally a generic geographic term which many businesses use in different fields. The Complainant is not prominent among them. The Respondent denies having heard of the Complainant prior to this dispute.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The above elements apply cumulatively, hence failure to demonstrate any one element will result in denial of the Complaint. The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a WATERLAND trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name wholly incorporates the WATERLAND trademark. Its only additional element is a generic Top-Level Domain ("gTLD") extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.11.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Given the Panel's findings below regarding the third element of paragraph 4(a) of the Policy, it is unnecessary to consider the second element.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy sets out two conjunctive requirements. The Complainant must show both that the disputed domain name has been registered in bad faith, and also that the disputed domain name is being used in bad faith. Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant's mark. See WIPO Overview, section 3.1.

As regards registration, the Panel will assess bad faith as at the time when the Respondent acquired the disputed domain name. See [WIPO Overview 3.0](#), section 3.9. In the present case, the evidence shows that the Respondent acquired the disputed domain name in July 2019, years after the Complainant obtained its trademark registrations listed in section 4 above. The disputed domain name is identical to the Complainant's WATERLAND trademark. However, the Parties disagree as to the distinctiveness of that mark.

The Complainant submits that "waterland" is not a word that a trader would rightly choose and that there is no legitimate reason why the Respondent should choose the Complainant's mark. In support, the Complaint annexes the results of a Google search for "Waterland" (conducted in Leuven, Belgium in 2024). The top result is indeed the Complainant, the second result is a non-profit collective that realizes water projects in Belgium, and all other search results are omitted.

The Respondent replies that he became interested in acquiring the disputed domain name as a two-word combination of "water" and "land" that could mean many things. He declares that he conducted searches prior to acquiring the disputed domain name that revealed that Waterland was a place in the Netherlands, a surname, and was used for many things by many people and businesses, including for water parks, water projects, and real estate. He declares that no particular result of his prior searches stood out to him. The Response annexes evidence showing that "Waterland" is included in the name of many businesses in the Netherlands and Belgium and that it is the surname of many individuals. Many of those businesses and entities may be located in the Waterland region.

The Panel observes that "waterland" is not only the Complainant's trademark, but also a combination of two English (and Dutch) dictionary words (i.e., "water" and "land"), as well as a geographical term, and a

surname. The Panel has verified that the Complainant ranks highly in the results of a Google search for “waterland” (conducted outside the Benelux, with results restricted to prior to July 2, 2019) but the results also refer to a variety of businesses with some connection to the dictionary meaning of “water”, including a wildlife sanctuary, water parks, an engineering company, an organizer of pool and spa awards, a hotel, and a marina resort, variously located in the Americas, Asia, and Europe; the results also refer to a region of the Netherlands, a municipality, a film and a novel.¹ In these circumstances, regardless of whether, as a professional in the domain name business, the Respondent knew or should have known of the Complainant, the Panel finds plausible that he acquired the disputed domain name without any intent to target the Complainant.

The Complainant alleges that the registration of the disputed domain name may have been triggered by an investment that the Complainant made in the United States, announced in January 2020. The Panel is unable to accept this allegation, as the evidence shows that the Respondent acquired the disputed domain name in July 2019, six months prior to the announcement of that investment. Even if the Complainant is well-known in Belgium, it does not allege that it had any activities in the Americas, where the Respondent is based, prior to his acquisition of the disputed domain name.

The Panel notes that nothing in the content of the webpage associated with the disputed domain name targets the Complainant or its business, nor does it link to other websites. The webpage offers the disputed domain name for sale, lease, rent, or joint venture but it is well settled that the registration of a domain name in order to sell it to a third party is not a violation per se of the Policy, provided that the Respondent is not seeking to capitalize on the goodwill created by the trademark owner, which is not the case here. See, for example, *5B Investments, Inc. v. RareNames, WebReg*, WIPO Case No. [D2008-0146](#).

Both Parties refer to an enquiry that the Respondent received in 2021 from a third party (presumably an undisclosed agent of the Complainant) regarding a possible purchase of the disputed domain name. The Respondent appears to have envisaged a price over USD 500,000 but, on the evidence, the Panel is ill-equipped to judge whether a price of that magnitude reflects the value of the disputed domain name aimed at the Complainant (or a competitor) rather than to other businesses with a potential interest in the disputed domain name as a combination of dictionary words. For example, the Complainant has not presented arguments or evidence to show that such a price likely targeted itself (or a competitor) as the only potential buyer with the financial capacity to pay such a price.

Both Parties also refer to the Respondent company’s domain name portfolio. The Complainant draws attention to one domain name that is identical to the name of a Cuban bank and two others that may in fact be a geographical term and a personal name but, from these instances, the Panel is unable to draw the inference that the disputed domain name forms part of a pattern of abusive registrations. On the other hand, the Respondent points out that he has registered dozens of domain names that, like the disputed domain name, are geographical terms and personal names, while the evidence shows that his portfolio also includes dictionary words.

Based on the evidence, the Panel is unable to find, on the balance of probabilities, that the Respondent’s aim in acquiring the disputed domain name was to profit from or exploit the Complainant’s trademark.

Therefore, the Panel finds the third element of the Policy has not been established.

¹The Panel notes its general powers articulated inter alia in paragraphs 10 and 12 of the Rules and has conducted searches for “Waterland” in the publicly available Google search engine in order to verify the search results submitted by the Complainant and evaluate the allegations of the Respondent regarding his prior searches. The Panel considers this process of verification and evaluation useful in assessing the case merits and reaching a decision. See [WIPO Overview 3.0](#), section 4.8.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/
Matthew Kennedy
Presiding Panelist

/Mireille Buydens/
Mireille Buydens
Panelist

/Douglas M. Isenberg/
Douglas M. Isenberg
Panelist
Date: April 25, 2024