

## **ADMINISTRATIVE PANEL DECISION**

Vorwerk International AG v. Dean Mastroianni  
Case No. D2022-4493

### **1. The Parties**

The Complainant is Vorwerk International AG, Switzerland, represented by Moeller IP, Argentina.

The Respondent is Dean Mastroianni, Australia.

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

The disputed domain name <thermomixdirect.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 24, 2022. On November 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 29, 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 amended Complaint on November 29, 2022.

The Center verified that the Complaint, together with the amended 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 December 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 30, 2022.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on January 11, 2023. 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 is a German company in the business of household appliances founded in 1883, which has around 590,000 collaborators, including independent sales partners and employees.

The Complainant is the owner of several trademark registrations around the world, among others, the following:

Trademark	No. Registration	Jurisdiction	Date of Registration
	1300139	Australia	April 6, 2009
THERMOMIX	1599284	Australia	September 6, 2013
THERMOMIX	1461124	France	September 30, 1988
THERMOMIX	0000830470	Italy	January 10, 2001
	000537332	European Union	October 9, 2001
	006289607	European Union	July 2, 2008

The Complainant owns, among others, the domain name <thermomix.com>, which resolves to the Complainant's official website.

The Respondent registered the disputed domain name <thermomixdirect.com> on December 3, 2019, which redirects to a parked website that indicates that the disputed domain name might be for sale.

#### 5. Parties' Contentions

##### A. Complainant

##### I. Identical or Confusingly Similar

That the disputed domain name is identical to the point of creating confusion concerning the Complainant's trademark THERMOMIX.

That there is an undeniable phonetic and graphic identity between the disputed domain name and the Complainant's trademark.

That the disputed domain name entirely incorporates the THERMOMIX trademark, with the addition of the term "direct", which is not sufficient to prevent a finding of confusing similarity with the Complainant's trademark.

That the addition of the generic Top-Level Domain ("gTLD") ".com" should be disregarded, as it has no impact on the analysis of whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

That previous UDRP panels appointed under the Policy have found that the addition of other terms to a disputed domain name would not prevent a finding of confusing similarity under the first element of the Policy.

That prior UDRP panels have found that the fact that a domain name that incorporates the entirety of Complainant's trademark is enough to establish identity or confusing similarity.

## **II. Rights or Legitimate Interests**

That the Respondent knew or should have known of the Complainant's exclusive rights in the THERMOMIX trademark before registering the disputed domain name.

That the Respondent does not have any rights to or legitimate interests in the disputed domain name as he does not own any trademark registration.

That the Respondent does not have any known connection with the Complainant, nor has he received any authorization or license of any kind to resell or use the THERMOMIX trademark in any domain name.

That the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, nor is he using it in connection with a *bona fide* offering of goods and services. That, rather, the disputed domain name resolves to an inactive website which notably says, "this domain name may be for sale".

That the inactive status of the disputed domain name does not amount to a *bona fide* offering of goods and services.

That there is no evidence that the Respondent has made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services.

That, under the Policy, it is well established that registering a domain name for nothing more than advertising it for sale, does not support a Respondent's claim of legitimate interests.

That even if the Respondent made some active use of the disputed domain name, it is unlikely that it would be regarded as legitimate or fair, given the fact that the disputed domain name is confusingly similar to the Complainant's trademark and thus would inevitably create a false impression of an association with the Complainant.

That previous UDRP panels under the Policy have found that a disputed domain name identical to a Complainant's trademark carries a high risk of implied affiliation, and that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

That the Respondent is free-riding on the Complainant's reputation and goodwill in order to mislead unsuspecting Internet users to the website to which the disputed domain name resolves, and that he chose the Complainant's trademark THERMOMIX for commercial gain by creating a likelihood of confusion with said trademark as to source or affiliation.

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

That the disputed domain name has been used in bad faith by the Registrant, considering that the Complainant's trademarks and domain names were registered well before the date of registration of the disputed domain name.

That THERMOMIX is not a generic term, and that the search engine Google directs Internet users to the Complainant's products and services, which indicates a connection between the Complainant and the THERMOMIX trademark.

That the Respondent's choice to register the disputed domain name was deliberate to benefit from the reputation and goodwill of the Complainant's trademark, which denotes bad faith.

That previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated party can in itself create a presumption of bad faith.

That, under the doctrine of passive holding, panels have found that the non-use of a domain name would not prevent a finding of bad faith. That, in addition, the offering for sale of the disputed domain name amounts to bad faith registration and use under the Policy.

That the disputed domain name causes an implicit risk of confusion by association.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

- (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 was registered and is being used in bad faith.

Given the Respondent's failure to submit a formal Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations, in accordance with paragraphs 5(f), 14(a), and 15(a) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

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

The disputed domain name is confusingly similar to the Complainant's trademark THERMOMIX, as it incorporates the entirety of the trademark, with the addition of the term "direct", which does not prevent a finding of confusing similarity (see sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The addition of the gTLD ".com" to the disputed domain name constitutes a technical requirement of the Domain Name System. Therefore, it has no legal significance in the present case (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); and *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues*, WIPO Case No. [D2019-0578](#)).

In light of the above, the first element of the Policy has been met.

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

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services;
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it did not acquire trademark or service mark rights; or
- (iii) the respondent is making a 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 Complainant has proven to be the owner of several registrations for the THERMOMIX trademark in different jurisdictions, including Australia, where the Respondent has declared to reside.

The Complainant has asserted that there is no relationship or affiliation between the Complainant and the Respondent, that it has not granted any license or authorization to the Respondent to use its trademark, and that the Respondent has not been commonly known by the disputed domain name (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#); and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)). The Respondent did not contest these allegations.

The case file contains no evidence that demonstrates that the Respondent has used or has made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services (see *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#); and *Associated Newspapers Limited v. Manjeet Singh*, WIPO Case No. [D2019-2914](#)).

Moreover, the Panel finds that the composition of the disputed domain name can carry a risk of implied affiliation with the Complainant.

In sum, the Complainant made a *prima facie* case asserting that the Respondent lacks rights to or legitimate interests in the disputed domain name. Therefore, the burden of production to demonstrate rights to or legitimate interests in the disputed domain name falls on the Respondent, who in this case has failed to ascertain them (see sections 2.1 of the [WIPO Overview 3.0](#), see also *Harpo, Inc. and Oprah's Farm, LLC v. Robert McDaniel*, WIPO Case No. [D2013-0585](#); *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#)).

Therefore, the second element of the Policy has been fulfilled.

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

Bad faith under the Policy is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 or location or of a product or service on its website or location.

The Complainant has proven to be the owner of several registrations for the THERMOMIX trademark in different jurisdictions, including Australia, where the Respondent has declared to reside.

Given the fact that THERMOMIX is a fanciful trademark, which is not a dictionary word, this Panel finds that the Respondent knew or should have known the Complainant at the time of registration of the disputed domain name, considering that the Complainant has been in business since 1883, and that the Complainant and its trademark THERMOMIX have a widespread market presence internationally. Therefore, the registration of the disputed domain name, which entirely comprises said trademark THERMOMIX, constitutes bad faith registration under the Policy. (See section 3.2.2 of the [WIPO Overview 3.0](#), see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#): "The Panel infers, in the absence of any submissions, explanation or evidence to the contrary, that Respondent knew or must have known of Complainant's Trade Mark at the time it registered the Domain Name. The MONEYCORP trade mark has been in public use since approximately 1979 and Complainant has previously registered Complainant's Trade Mark in at least the United Kingdom and the United States of America. It is therefore reasonable to infer that Respondent knew or must have known of Complainant's Trade Mark.").

The fact that the Respondent registered the disputed domain name which entirely reproduces the Complainant's trademark THERMOMIX, suggests that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); and *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#)).

The Panel finds that Internet users would be misled by the disputed domain name into the expectation that they would reach a website operated by the Complainant.

Notwithstanding the fact that the disputed domain name redirects to an inactive parked website, the consensus view amongst panels appointed under the Policy is that the fact that a domain name is not active does not prevent a finding of bad faith (see section 3.3 of the [WIPO Overview 3.0](#), "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding"; see also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and "*Dr. Martens*" *International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. [D2017-0246](#)).

In the present case, the following facts have been found:

- That the Complainant's trademark THERMOMIX has been widely used by the Complainant internationally and enjoys considerable reputation and goodwill,
- That said trademark refers directly and specifically to the Complainant and its business,
- That the Complainant was founded in 1883, has around 590,000 collaborators, including independent sales partners and employees, and operates under several different domain names, including <thermomix.com>.
- That the Respondent has not filed any evidence or arguments to explain why he registered the disputed domain name, which incorporates the THERMOMIX trademark in its entirety.

In light of the above, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate under the Policy (see *Telstra, supra*, and *CBS Broadcasting Inc. v. Dennis Toeppen*, WIPO Case No. [D2000-0400](#) "The significance of the

distinction is that the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.”).

Therefore, the third element of the Policy has been met.

## **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 disputed domain name <thermomixdirect.com> be transferred to the Complainant.

*/Kiyoshi Tsuru/*

**Kiyoshi Tsuru**

Sole Panelist

Date: January 25, 2023