

ADMINISTRATIVE PANEL DECISION

DPDgroup International Services GmbH & Co. KG v. Mike Ross
Case No. D2023-3646

1. The Parties

The Complainant is DPDgroup International Services GmbH & Co. KG, Germany, represented by Fidal, France.

The Respondent is Mike Ross, United States of America.

2. The Domain Name and Registrar

The disputed domain name <dpgroupepress.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 August 30, 2023. On August 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 2023, 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 (No information provided, Registration Private, DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 4, 2023, 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 on September 5, 2023.

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 September 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 3, 2023.

The Center appointed Mladen Vukmir as the sole panelist in this matter on October 26, 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

- (i) the Complainant is a German company, an international parcel delivery service provider;
- (ii) the Complainant is the owner of a numerous registered DPD trademarks (“DPD trademarks”), notably:

Trademark	Trademark Scope	Reg. no. / Status	Date of registration
DPD Dynamic Parcel Distribution (word)	European Union	6159487/ registered	August 19, 2009
dpd (figurative)	International	1217471/ registered	March 28, 2014
	International	761146/ registered	May 26, 2001
	International	1214203/ registered	March 12, 2014
	International	1271522/ registered	August 25, 2015

(iii) the Complainant operates its official website under the domain name <dpd.com> registered on March 20, 1991. The Complainant is the registrant of numerous domain names, notably: <dpd.asia>, <dpd.ch>, <dpd.net>, <dpd.eu>, <dpdgroup>, etc.;

(iv) the Respondent is the registrant of the disputed domain name, as disclosed by the Registrar;

(v) the disputed domain name was registered on April 24, 2023. It resolves to a website that promotes complementary services to those offered by the Complainant and reproduces the Complainant's  trademark the subject of International Registration No. 1271522.

5. Parties' Contentions

A. Complainant

The Complainant, essentially, asserts that:

(i) it is one of the world's leading parcel delivery service providers, it has been operating since 1977, and has 32,000 pickup points in 230 different countries around the world;

(ii) the Complainant is the owner of numerous DPD trademarks in various countries;

(iii) the disputed domain name is confusingly similar to the Complainant's earlier DPD trademark as it is combining the Complainant's DPD trademark in its entirety with the additional words “group” and “express”, neither of which is enough to distinguish the disputed domain name from the Complainant's DPD trademarks. The word “group” refers to the existence of the affiliates of the Complainant's company, while the word “express” refers to the delivery services;

(iv) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known under the disputed domain name, nor does the Respondent offer a *bone fide* offer of products or services. The Respondent does not make any use of a business name which includes the DPD trademarks, nor does the Respondent have any rights on any of the Complainant's DPD trademarks. The Complainant emphasizes this fact as it has monitored its DPD trademarks worldwide for years and has never noticed any of its trademarks bear any connection to the Respondent. The Complainant has not authorized, licensed, permitted or otherwise consented to the Respondent's use of the DPD trademarks in the disputed domain name, and has no relationship to the Respondent. The Complainant states that the Respondent is attempting to confuse Internet users who arrive at its website into believing that such a website is the Complainant's website or is associated with the Complainant, which is not the case;

(v) the disputed domain name was registered and is being used in bad faith. The website created under the disputed domain name reproduces, without any authorization, the Complainant's DPD trademarks, and it contains very confusing imitation of the Complainant's corporate website. Thus, the Respondent is using the identity of the Complainant and aims to create confusion with the Complainant's identity in order to give credibility to its scams and phishing operations. Consequently, the Respondent is reproducing the Complainant's DPD trademarks with intent to take advantage of the Complainant's brand reputation and give credibility to its scams and phishing operations. The Respondent is using the disputed domain name to resolve to a website that promotes the complementary services to those offered by the Complainant. The Respondent must have known of the Complainant's reputation, as the Complainant is well-known within its respective industry.

B. Respondent

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

6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the Policy, the Rules, the Supplemental Rules, and any rules and principles of law that it deems applicable pursuant to paragraph 15(a) of the Rules.

Paragraph 4(a) of the Policy provides that the Complainant must prove, with respect to the disputed domain name, each of the following:

- (i) the disputed domain name is confusingly similar to a trademark 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.

A. Identical or Confusingly Similar

As provided in section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), it is generally accepted that ownership of a registered trademark by a complainant is sufficient to satisfy the threshold requirement of having the trademark rights for purposes of standing to file a UDPR case.

The Complainant has submitted evidence to show that it is the holder of a number of DPD trademarks registered before the competent authorities worldwide. As such, these trademarks provide to the Complainant all the exclusive rights that are granted with such trademark registrations.

It is well established that the threshold test for confusing similarity under the UDRP involves a comparison between the complainant's trademark and the disputed domain name to determine if it is identical or confusingly similar. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name, with the addition of descriptive or geographical terms typically being disregarded as insufficient to prevent a finding of confusing similarity. Application of the confusing similarity test under the UDRP typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the trademark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see sections 1.7 and 1.8 of [WIPO Overview 3.0](#)).

After performing the side-by-side comparison of the disputed domain name and the DPD trademark, it is evident to the Panel that the disputed domain name incorporates the Complainant's DPD trademark in its entirety, with the addition of words "group" and "express".

Prior UDRP Panels have found that where the trademark in question is recognizable within the disputed domain name, the addition of other terms (whether descriptive, etc.) does not prevent a finding of confusing similarity between the disputed domain name and trademark in question (section 1.8 of [WIPO Overview 3.0](#)). In this particular case, and following earlier UDRP panels decisions, added words "group" and "express" do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's DPD trademark.

Regarding the gTLD ".com" in the disputed domain name, as a standard registration requirement it should be disregarded under the confusing similarity test (see section 1.11.1. of [WIPO Overview 3.0](#)).

For all the foregoing reasons, the Panel holds that the disputed domain name is confusingly similar to the Complainant's DPD trademark within the meaning of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy. Those circumstances are:

"(i) Before any notice to [the respondent] of the dispute, [use by the respondent] of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) [Where the respondent] (as an individual, business, or other organization) [has] been commonly known by the disputed domain name, even if [the respondent has] acquired no trademark or service mark rights; or

(iii) [Where the respondent is] making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

As noted by previous UDRP Panels on the onus of proof under paragraph 4(a)(ii) of the Policy, and as summarized in section 2.1 of the [WIPO Overview 3.0](#): "[...]While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element [...]."

In this case, the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of Paragraph 4(a) of the Policy. The Respondent is not authorized by the Complainant to use the DPD trademarks, and there is no indication that the Respondent is known under the disputed domain name. There is no apparent relation from the records between the Respondent and the Complainant, nor does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its DPD trademarks, or to apply for or use any domain name incorporating the same trademark.

Furthermore, there is no evidence in the case file or otherwise apparent to the Panel that the Respondent has been using the disputed domain name in connection with a *bona fide* offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name.

As there is no evidence that the Respondent is in any way permitted by the Complainant to use the DPD trademarks, nor is there any evidence that the Respondent has made any *bona fide*, fair or otherwise legitimate use of DPD trademarks, the Panel concludes that the Respondent has no rights or legitimate interest to use the disputed domain name which includes the Complainant's DPD trademarks.

The Respondent has failed to provide any reply to the Complaint, and accordingly failed to prove that it has rights or legitimate interest in the disputed domain name.

The Panel finds that the requirements set forth in paragraph 4(a)(ii) of the Policy have been fulfilled by the Complainant making *the prima facie case that* the Respondent lacks rights or legitimate interests in the disputed domain name, and by the Respondent's failing to produce any arguments or evidence to the contrary.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

“(i) circumstances indicating that the holder 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 the holder's documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's website or location or of a product or service on the holder's website or location.”

The Panel accepts the Complainant's arguments that the Respondent has registered and used the disputed domain name in bad faith. The Complainant has pickup points in 230 different countries, the disputed domain name was registered 22 years after the Complainant's first DPD trademark was registered in 2001. The DPD trademarks are registered with competent authorities worldwide, and in this Panel's view they are highly distinctive. As determined in earlier UDRP cases, the Complainant's DPD trademarks are well known (see *DPDgroup International Services GmbH & Co v. Domain Administrator, See PrivacyGuardian.org / Benjamin Wills* WIPO Case No. [D2020-3198](#)).

Considering all the facts in the present case, the Panel finds that it is highly unlikely that the Respondent was unaware of the Complainant and its DPD trademarks when it registered the disputed domain name. In this Panel's view, the Respondent chose to register the disputed domain name that reproduces the Complainant's trademark to take advantage of the reputation of the Complainant's DPD trademark without any authorization or rights, and to divert Internet users to its own website (or website under its control).

Namely, the Panel has found that the Respondent's use of the disputed domain name, which directs to a website impersonating the Complainant, prominently displays the Complainant's DPD trademarks and is used by the Respondent to offer services complementary to services provided by the Complainant. Such establishment by the Respondent, of a website impersonating the Complainant at the disputed domain name, leads the Panel to believe that the primary use of the disputed domain name is the diversion of Internet users and false association of the Respondent with the Complainant.

The Panel concludes that the intention of the Respondent is one of bad faith, as it is more likely than not that the Respondent has registered and used the disputed domain name primarily due to its similarity and association with the Complainant's business and DPD trademarks.

Accordingly, this Panel has considered the relevant factors as the degree of distinctiveness of the disputed domain name, the reputation of the Complainant's DPD trademarks, the Respondent's illegitimate representation as being associated with the Complainant, the Respondent's establishing of a website impersonating the Complainant, the failure of the Respondent to provide any evidence of actual or contemplated good-faith use, the Respondent's concealing its identity, and the implausibility of any good faith use to which the disputed domain name may be put.

The Panel finds that the Respondent, by registering and using the disputed domain name, is attempting to take advantage of the Complainant's reputation by creating a likelihood of confusion with the Complainant's DPD trademarks due to their high similarity with the disputed domain name. Accordingly, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has fulfilled the third element under paragraph 4(a)(iii) of the Policy.

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, <dpdgroupexpress.com> be transferred to the Complainant.

/Mladen Vukmir/

Mladen Vukmir

Sole Panelist

Date: November 9, 2023