

ADMINISTRATIVE PANEL DECISION

Tyco Fire & Security GmbH v. Vivek Anil George, PMG Group Case No. D2023-3361

1. The Parties

The Complainant is Tyco Fire & Security GmbH, Switzerland, represented by BrandIT GmbH, Switzerland.

The Respondent is Vivek Anil George, PMG Group, United Arab Emirates.

2. The Domain Names and Registrar

The disputed domain names <sabroecompressors.com> and <yorkcompressors.com> are 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 4, 2023. On August 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 8, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on 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 August 14, 2023.

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 August 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 20, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on September 27, 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 subsidiary of Johnson Controls International plc, which, together with its affiliated and related companies employs approximately 105,000 people in 2,000 locations around the world, including locations in the United Arab Emirates.

The Complainant is one of the world's largest providers of heating, ventilation, air conditioning, and refrigeration products and services.

The Complainant owns numerous trademarks including YORK and SABROE registered in the following jurisdictions:

- EU Trademark Registration YORK No. 000169755 registered on July 24, 2001;
- EU Trademark Registration YORK No. 000169771 registered on February 22, 2001;
- EU Trademark Registration SABROE No. 000412809 registered on July 15, 1998;
- UAE Trademark Registration SABROE No. 089091 registered on June 2, 2008;
- UAE Trademark Registration YORK No. 002571 registered on October 9, 1993;
- UAE Trademark Registration YORK No. 3141 registered on November 29, 1995;
- International Trademark Registration SABROE No. 82005 registered on February 18, 2004.

The Complainant and its related companies has registered a number of domain names incorporating the trademarks YORK and SABROE e.g. <york.com> (created on May 28, 1995) and <sabroe.com> (created on November 13, 2001).

The disputed domain names were registered both on August 26, 2019. Both disputed domain names resolve to an active website reproducing the Complainant's respective trademarks in a prominent position of the website and displaying images with products including those bearing the Complainant's trademarks.

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 confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (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.

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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other generic terms like "compressors" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The disputed domain names contain two trademarks of the Complainant plus the generic term "compressors". Both disputed domain names resolve to active websites reproducing the Complainant's respective trademarks in a prominent position of the website and displaying images with products including those bearing the Complainant's trademarks. In these circumstances, the Panel finds the disputed domain names carry a risk of implied affiliation with the Complainant.

The Respondent has used the disputed domain names to offer and sell compressors. It is unclear on the evidence before the Panel whether the products are legitimate YORK and SABROE products. If the products sold on the Respondent's website are not genuine products produced by the Complainant (See [WIPO Overview 3.0](#), section 2.13.1).

Even if the Respondent is offering genuine YORK and SABROE products from the Respondent's Website, such use does not automatically grant it rights or legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"[...] Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Ok! Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark.

The 'Ok! Data test' does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

In this case, the Panel is of the view that the Respondent's content in the disputed domain names do not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant.

The Respondent has been using the disputed domain names that are confusingly similar to the YORK and SABROE trademarks to offer online products, be they genuine or otherwise, in competition with the Complainant and without the Complainant's approval and without meeting the Ok! Data test. Moreover, an individual viewing the disputed domain names may be confused into thinking that the disputed domain names refer to websites in some way connected to the Complainant.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that:

- the Respondent registered the disputed domain names several decades after the Complainant used the trademarks in commerce;
- the disputed domain names resolved to commercial websites purportedly offering the Complainant's products where the Complainant's trademark is prominently displayed on the websites;
- the Respondent added the term "compressors" to the Complainant trademark, which is a term related to a line of products of the Complainant; and

- the Respondent's failed to properly revert on any of the Complainant's cease and desist letters.

The Panel notes that in similar circumstances in another case against the same Respondent, the Panel had held that the disputed domain name <danfosscompressors.com> was confusingly similar the Complainant's trademark (See *Danfoss A/S v. Vivek Anil George, PMG Group*, WIPO Case No. [D2022-0691](#)).

Considering the above, the Panel finds that 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 the Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 names <sabroecompressors.com> and <yorkcompressors.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: October 11, 2023