

ADMINISTRATIVE PANEL DECISION

Tau Ceramica Solutions, S.L.U. v. Wyatt Miller
Case No. D2023-3996

1. The Parties

The Complainant is Tau Ceramica Solutions, S.L.U., Spain, represented by DEMARKS&LAW, Spain.

The Respondent is Wyatt Miller, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <ascale.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 September 25, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 29, 2023, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains by Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 2, 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 October 6, 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 October 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 27, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 1, 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

According to the Complaint, the Complainant is Europe's leading ceramics group with over a century of carrying on its business. The Complaint claims that the Complainant's products, including in particular floor and wall tiles, are available under the trademark ASCALE in more than 150 countries.

Amongst other things, the Complainant promotes its products under the trademark ASCALE from a website at "www.ascale.es".

The Complaint includes evidence that the Complainant owns a number of registered trademarks for a stylized representation of ASCALE:



including:

- (a) European Union Trademark No. 015822109 which was filed on September 13, 2016 and formally registered on February 7, 2017;
- (b) United States Registered Trademark No. 6,120,005 which was registered in the Principal Register on August 4, 2020;
- (c) Chinese registered trademark (via International Registration No. 1477335) which was registered on May 20, 2019,

each of which is registered in respect of a wide range of goods in International Class 19 comprising tiles, floor and wall coverings and such like.

The disputed domain name was created on September 18, 2009. It is not apparent from the materials in the record on what date the Respondent became the registrant of the disputed domain name.

So far as the record in this proceeding shows, the disputed domain name does not resolve to an active website. However, the Whois report states that the disputed domain name is offered for sale at the price of EUR 90,832.47 + EUR 19.99 (which the Panel assumes is the annual registration fee).

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademark ASCALE (in a stylised form).

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.

In making that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.1.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10. The figurative elements of the Complainant's trademarks are not so dominating that the verbal element cannot be considered an essential or important part of the trademarks in this case. Accordingly, it is appropriate to apply the usual rule.

Disregarding the ".com" gTLD, therefore, the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

B. Registered and Used in Bad Faith

In the circumstances of this case, it is appropriate next to consider the requirement under the Policy that the disputed domain name has been registered and is being used in bad faith.

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Complainant contends that the Respondent has registered the disputed domain name with knowledge of the Complainant's prior use of and rights in the trademark ASCALE and is offering the disputed domain name for sale at a price far in excess of the Respondent's out of pocket costs. Accordingly, the Complainant contends that the circumstances of registration and use in bad faith identified in paragraph 4(b)(i) apply:

"circumstances indicating that the respondent registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the disputed domain name".

As already noted, the price at which the disputed domain name is being offered for sale is likely far in excess of the applicable registration fee.

However, the disputed domain name (being a combination of "a" and "scale") is arguably not inherently distinctive.

Moreover, the record shows that the disputed domain name was first registered in 2009; many years before the Complainant registered the earliest of its registered trademarks.

The Panel accepts that, if the Respondent became the registrant after the date the disputed domain name was first registered, the assessment of registration and use falls to be assessed when the Respondent became the registrant. See [WIPO Overview 3.0](#), section 3.9.

The Complainant has been unable to ascertain when the Respondent became the registrant of the disputed domain name. As noted above, the disputed domain name was registered on September 18, 2009. The Complainant contends that the disputed domain name subsequently became registered in the name of the current Privacy Service. It is not clear from the Complaint why the Complainant contends the disputed domain name was subsequently transferred to the Privacy Service after initial registration or what date that may have happened. The Complainant also contends it is not clear when the Respondent became the registrant.

While a change in the registrant to a Privacy Service may indicate a change in the underlying registrant, that is not necessarily the case. That there has been such a change might be more confidently inferred if there were evidence that there had been a change in the nature of the use of the disputed domain name when the registration was changed to identify the Privacy Service as the registrant. There is no evidence in the record in this proceeding of that kind.

The Complainant does claim that it has "over a century of experience in the ceramic industry for decorating lifestyles and designing ambiances, with the brand 'ASCALE' and that "it is present in more than 150 countries".

Those allegations, if accepted, could arguably support an inference that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark and has sought to take advantage of that trademark significance opportunistically.

Ordinarily, where a complainant wishes to claim its trademark has achieved widespread use, sales and reputation such that an inference of knowledge on the part of the respondent may be inferred, the complainant should provide specific evidence supporting the claim. Mere assertion is not sufficient. See e.g., [WIPO Overview 3.0](#), section 1.3 (in the context of proving rights in an unregistered trademark). A similar course is necessary in the present circumstances where the Complainant contends that the Respondent knew of the Complainant's prior rights.

The Complaint, however, does not include such evidence. Accordingly, it is not appropriate for the Panel to act on the mere assertions especially having regard to the nature of the Complainant's asserted trademark.

The Policy is intended to provide an efficient and expeditious process to deal with clear cases of cybersquatting. To that end, it lays down a two stage process of “pleading” or briefing – the filing of a Complaint and the filing of a Response. Generally, further pleadings or supplemental filings are not expected. See e.g., [WIPO Overview 3.0](#), sections 4.6 and 4.7. In some cases, a supplemental filing may be permitted especially where it corrects some error in the record or is directed to something in a response which could not reasonably have been anticipated. (These are not the only reasons why a supplemental filing may be requested or accepted.)

That is not the case here. The Complainant was well aware when it filed the Complaint that the disputed domain name was registered before the date of the Complainant’s registered trademarks and of the nature of its trademark (including that it has been registered in a stylized or fancy form). In such circumstances, it was incumbent on the Complainant to include in its Complaint and place before the Panel evidence corroborating its claim that it had been using its trademark before the disputed domain name was registered (by the Respondent) and on a sufficient scale that an inference could be drawn that the Respondent was likely aware of the Complainant’s trademark.

In the absence of evidence supporting the claimed use, or the date the Respondent became the registrant, therefore, the Panel is unable to accept the Complainant’s contention that the disputed domain name has been registered with knowledge of the Complainant’s trademark and to take advantage of the resemblance of the disputed domain name to that trademark.

Accordingly, the Complainant has failed to prove that the disputed domain name was registered in bad faith and the Complaint must fail as the third element under the Policy cannot be established.

C. Rights or Legitimate Interests

As the Complaint must fail, no good purpose would be served by considering this element under the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: November 20, 2023