

ADMINISTRATIVE PANEL DECISION

Andreas Stihl AG & Co. KG and Stihl Pty Ltd v. Benjamin Ansell
Case No. DAU2023-0018

1. The Parties

The Complainants are Andreas Stihl AG & Co. KG, Germany (the “first Complainant”), and Stihl Pty Ltd, Australia (the “second Complainant”), represented by King & Wood Mallesons, Australia.

The Respondent is Benjamin Ansell, Australia.

2. The Domain Name and Registrar

The disputed domain name <stihl.au> is registered with Synergy Wholesale Accreditations Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2023. On April 5, 2023, the Center transmitted by email to Synergy Wholesale Accreditations Pty Ltd a request for registrar verification in connection with the disputed domain name. On April 6, 2023, Synergy Wholesale Pty Ltd transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 12, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was May 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 5, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on May 30, 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 first Complainant is the registrant of the <stihl.com> domain name and multiple Australian registered trade marks for the STIHL name, including Australian Registered Trade Mark No. 296127 for STIHL in class 4, registered from April 21, 1976; No. 806691 for STIHL logo in classes 4, 7, 8, 9, 25, 35, and 37, registered from September 13, 1999; and No. 859547 for STIHL in classes 7 and 8, registered from December 7, 2000. The STIHL group of companies was founded by Andreas Stihl in Germany in 1926, and develops, manufactures, and distributes power tools for professional forestry and agriculture, landscape maintenance, the construction sector and private users, and provides related services.

The first Complainant is a company incorporated in Germany and the registrant of the <stihl.com> domain name and the second Complainant is a company incorporated in Australia and the registrant of the <stihl.com.au> domain name. The Complainants are related companies within the Stihl Group and have a common interest in the STIHL trademark and name in Australia. The Complaint seeks transfer of the disputed domain name to the second Complainant as the party eligible to register and hold the disputed domain name by virtue of its status as a company registered under the Australian Corporations Act 2001 (Cth).

The disputed domain name was registered on October 4, 2022, and does not resolve to an active website or web page.

5. Parties' Contentions

A. Complainant

The Complaint states that the STIHL group develops, manufactures, and distributes power tools for professional forestry and agriculture, landscape maintenance, the construction sector and private users, and provides related services. It says that since 1971, STIHL-branded chainsaws have been the best-selling such brand in the world. The Group achieved revenues of over EUR 5 billion in 2021; had more than 20,000 employees worldwide as at December 31, 2021; and has a sales network consisting of 42 sales and marketing companies, approximately 120 importers, and more than 55,000 authorised dealers in over 160 countries. The second Complainant is part of the STIHL group and sells STIHL-branded products in Australia. It joined the STIHL group in 1971, with responsibility for marketing and distribution in Australia and the Pacific Islands. The second Complainant has had annual sales revenue of more than AUD 200 million each year from 2020 to 2022, with total sales of STIHL-branded product exceeding 400,000 units in each of those years. It has expended more than AUD 50 million in advertising the STIHL brand and STIHL-branded goods and services in Australia from 2018 to 2022, including on television, in newspapers, and in trade/consumer magazines.

The second Complainant also operates the Australian STIHL website located at "www.stihl.com.au" which has been accessible by Australian web users since 1996. The second Complainant has an extensive presence on social media in Australia and promotes the STIHL brand via the Timbersports Series, wood chopping competitions held all over the world including in Australia. The Complainants have featured in the media and attracted various awards for products. The Complainants maintain that the STIHL trade mark has an overwhelming reputation around the world and is a well-known trade mark.

The word "stihl" has no meaning in the English language. The Complainant points out that the disputed domain name is identical in appearance, pronunciation, meaning, and overall commercial impression with the Complainants' trade mark as registered *inter alia* in Australia, and with the trading name, STIHL.

The Complainants point out that they are only required to make out an initial *prima facie* case that the Respondent lacks rights or legitimate interests. To that end they say that the Respondent is not known by the disputed domain name and has not acquired any rights to, or interests in it or in any name consisting of or containing the name STIHL. The Complainants say that they have not licensed or otherwise permitted the Respondent to use the STIHL name or the STIHL trade marks, whether as a domain name or otherwise.

As at the date of the Complaint, the Complainants say that the disputed domain name does not resolve to an active website, and the Respondent has thus made no *bona fide* use of the disputed domain name in connection with an offering of goods or services, and there is also no evidence of the Respondent's demonstrable preparations to use the disputed domain name in connection with an offering of goods or services. Consequently, the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainants say that it follows from the above-mentioned that the Respondent registered and used the disputed domain name in bad faith. Furthermore, the Complainants say that the registration of the disputed domain name is part of a pattern of conduct of registering more than 30 domain names that are identical to the names of other brands and trademarks used by established and well-known businesses in Australia. The Complainants make this submission not on the basis of UDRP Panel decisions to that effect but by pointing to a number of .au domain name registrations of the Respondent that incorporate trademarks that the Complainants say belong to unrelated parties, as demonstrated by the trade mark register in Australia, in circumstances where the Respondent has no legitimate basis for owning the domain names concerned. The .au domain names registered by the Respondent resolve either to parking pages with links or where the domain name concerned is offered for sale; the Complainants cite <masterfoods.au>; <cenovis.au>; <hovex.au>; <hickstransportgroup.au>; <ustoreit.au>; <farmershomehotel.au>; <offbroadwayhotel.au>; <goldenfleeceliverpool.au>; and <thelocabin.au>.

In each case the Whois database shows the respective trade mark owners as registrants of the .com.au domain names and the Respondent as the registrant of the corresponding .au domain names. The Complainants further say that they are not aware of the respective trade mark owners authorizing the registration of the .au domain names; and that this pattern of conduct demonstrates the Respondent's bad faith, all the more so because he collected .au domain names in particular industries, thus demonstrating the deliberate and calculating nature of his conduct.

B. Respondent

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

6. Discussion and Findings

A. Consolidation of Multiple Complainants

The principles to assess a request to consolidate multiple complainants are set forth in the Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0"), section 4.11.1.

Noting the circumstances of the case, the Panel finds that the Complainants have a specific common grievance against the Respondent, and that it would be equitable and procedurally efficient to permit the consolidation. The Panel finds that the Complainants have a common legal interest, as both Complainants belong to the same group of companies, namely the STIHL group, and the first Complainant is the proprietor of the STIHL trademark whereas the second Complainant is using this mark in Australia.

Accordingly, the Panel accepts the Complainants' request to consolidate the present proceedings pursuant to the Rules, paragraph 10(e).

B. Identical or Confusingly Similar

The Complainants holds valid trademark rights for the STIHL trademark, which satisfies the initial requirement under the first element that the Complainant hold rights for purposes of the Policy. As regards the actual comparison between the disputed domain name and the Complainants' trade mark, it is clear that the disputed domain name incorporates the Complainants' STIHL trade mark in its entirety, with the ".au" Top-Level Domain being disregarded as a standard registration requirement in the Domain Name System.

Therefore, the Panel holds that disputed domain name is identical to the STIHL trade mark of the Complainants.

C. Rights or Legitimate Interests

The Respondent is not known by the disputed domain name, nor has he received any authorization in relation to the use of the distinctive STIHL trademark of the Complainants. The trademark STIHL has a very extensive reputation in Australia and elsewhere and is highly distinctive. The Respondent has demonstrated no rights or interests in the word STIHL by any legitimate use of it, nor has he activated the disputed domain name so that it resolves to a website that could possibly legitimize his registration of the disputed domain name. The disputed domain name does not in fact resolve to any active website. Given the fame and distinctive nature of the STIHL trademark, and the identical composition of the disputed domain name, it is difficult to envisage and use that the Respondent could make of it that would be arguably legitimate.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

D. Registered or Subsequently Used in Bad Faith

Given the distinctive nature of the trade mark STIHL, which has no meaning in the English language (in Australia) and the fact that the Complainants are the possessors of a very extensive reputation in that mark, it is difficult to imagine that the Respondent was unaware of the exclusive rights vesting in STIHL to the benefit of the Complainants. A simple Google search would in any case identify that STIHL is a proprietary mark and also the extent of the goodwill attaching to it. The Respondent has then also not made any use of the disputed domain name, identical to the Complainants' trademark, that could found an argument of good faith registration or use.

The more persuasive inference is that the Respondent saw an opportunity of some sort to turn his registration of the disputed domain name in the .au domain space to his advantage at the expense of the Complainants. The latter has also tendered evidence that could be sufficient to persuade the Panel that the Respondent's registration of the present disputed domain name is part of a pattern of abusive registrations of domain names in the .au sphere that incorporate trade marks in which the Respondent has no rights. This apparent pattern of conduct further reinforces the inference that the Respondent made the present registration with an eye to some sort of financial advantage he might gain from possession of multiple trademark registrations of identical domain names in the .au sphere. Since that financial advantage would be derived from the acquisition of domain names that are identical to trademarks owned by other parties, and can only be used in a manner that is either deceptive or abusive, there is little doubt that the registration of the disputed domain name was tainted by bad faith.

Therefore, the Panel holds that the disputed domain name was registered in bad faith.

7. Decision

For all 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, <stihl.au>, be transferred to the second Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: June 13, 2023