

ADMINISTRATIVE PANEL DECISION

Carl Mahr Holding GmbH v. ALEKSANDR GRIGOREV
Case No. D2022-0461

1. The Parties

The Complainant is Carl Mahr Holding GmbH, Germany, represented by Ruger | Abel, Germany.

The Respondent is Aleksandr Grigorev, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <mahr-service.com> (the “Domain Name”) is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2022. On February 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 22, 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 February 25, 2022.

The Registrar confirmed that the language of the Registration Agreement for the Domain Name is Russian. On February 22, 2022, the Center sent an email communication to the Parties in both English and Russian regarding the language of the proceeding. On February 24, 2022, the Complainant requested an extension of the time limit for submitting the arguments regarding the language of the proceedings for two weeks.

On February 28, 2022, the Center confirmed that the deadline was extended until March 14, 2022. The Complainant did not submit further arguments regarding the language of the proceedings in addition to those already included in the Complaint accompanying the request that English be the language of this proceeding. The Respondent did not comment on the language of the proceeding.

On February 25, 2022, the Respondent sent an email communication in English to the Center and the Complainant regarding the procedural guidance. On March 7, 2022, the Center informed the Respondent

about the procedural steps to be taken in the present proceedings. No further communication was received from the Respondent.

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 in both English and Russian of the Complaint, and the proceedings commenced on March 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Parties with the Commencement of Panel Appointment Process on April 20, 2022.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on May 10, 2022. 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

Carl Mahr Holding GmbH, the Complainant in the present proceeding, is a company focused on developing, manufacturing and selling production metrology, metering and mixing pumps and ball-bearing guides. The Complainant has been operating its business for almost 160 years now.

The Complainant is the owner of numerous MAHR trademark registrations, including:

- the International Registration MAHR No. 661813 registered on December 20, 1995 in International Classes 7, 9, 16, 37, 41, and 42.
- the German Registration MAHR No. 39525836 registered on December 20, 1995 in International Classes 9, 16, 37, 41, and 42.

The Complainant's official domain name incorporating its MAHR trademark is <mahr.com>.

The Respondent registered the Domain Name on June 5, 2019.

As of the date of filing the Complaint and as of the date of this Decision, the Domain Name resolves to a website displaying the MAHR trademark and promoting Mahr Service, which allegedly provides services for the maintenance, repair, calibration, and modernization of the measuring equipment of several companies, including "Mahr GmbH (Germany)".

5. Parties' Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is confusingly similar to the MAHR trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits arguments showing that the Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. On February 25, 2022 the Respondent sent an informal email regarding the procedural guidance. No further communication was received from the Respondent.

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A. Language of the Proceeding

The language of the Registration Agreement for the Domain Name is Russian. Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainant has submitted a request in the Complaint and Amended Complaint that the language of the proceeding be English.

The Complainant contends in the Complaint that the Registrant is an English-speaking organization as an international company with places of business in English speaking countries such as the United States. Moreover, the Complainant submits that English is the international business language. Furthermore, the Complainant notes that the content of the Website is partly in English.

The Panel acknowledges the Complainant's arguments and further finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment on the language of the proceeding, even though the Respondent was notified in English and Russian regarding the language of the proceeding. In addition, the Respondent sent an email communication in English on February 25, 2022.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the Domain Name is identical or confusingly similar to the trademark in the Complainant has rights.

The Complainant holds valid MAHR trademark registrations, which precede the registration of the Domain Name.

The Domain Name incorporates the Complainant's MAHR trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term "service" does not prevent confusing similarity between the Domain Name and the Complainant's trademark. UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8, [WIPO Overview 3.0](#).

The generic Top-Level Domain ".com" in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant's trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it intends to make a legitimate, noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's MAHR trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case file that the Complainant has licensed or otherwise permitted the Respondent to use the MAHR trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence in the record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, as well as it does not make a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain.

On the contrary, the Respondent uses the Domain Name to attract Internet users to the Website where it promotes Mahr Service. It is allegedly a company providing services for the maintenance, repair, calibration, and modernization of the measuring equipment of several companies, including “Mahr GmbH (Germany)”, which in all likelihood refers to the Complainant. The Panel notes that the disputed domain name does not adequately disclose the relationship, or rather the lack thereof, between the Respondent and the Complainant. The criteria as set forth in *Okidata* is not fulfilled in the present case. The Respondent is trying to create the false impression that it is an authorized repair service for the Complainant’s products while it also offers the services to other companies apart from the Complainant. Such use of the Domain Name does not constitute a *bona fide* offering of goods and services, as well as does not qualify as a legitimate, noncommercial or fair use without intent for commercial gain.

Finally, the Panel finds that the nature of the Domain Name suggests an affiliation with the Complainant and its MAHR trademark, as the Domain Name incorporates this trademark in the entirety with the term “service” related to the Complainant’s business. See section 2.5.1, [WIPO Overview 3.0](#).

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant’s *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

The third requirement the Complainant must prove is that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name were registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant’s rights in the MAHR trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant’s trademark at the time of registration of the Domain Name. This finding is supported by the content of the Website suggesting affiliation with the Complainant. Moreover, it has been proven to the Panel’s satisfaction

that the Complainant's MAHR trademark is unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products and services under the MAHR trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's trademark.

Moreover, the Complainant presented evidence that the Domain Name is used in bad faith by the Respondent to attract Internet users to the Website offering the services identical or highly similar to those offered by the Complainant. Thus, this Panel finds that the Respondent uses the Domain Name in an attempt to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion with the MAHR trademark as to the source, sponsorship, affiliation, or endorsement of the Website or the activity carried out through this Website by the Respondent.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements 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 Domain Name <mahr-service.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: May 23, 2022