

## **ADMINISTRATIVE PANEL DECISION**

Sennheiser electronic GmbH & Co. KG v. Registration Private, Privacy Protect, LLC / Nguyen Thi Lien  
Case No. D2022-0464

### **1. The Parties**

The Complainant is Sennheiser electronic GmbH & Co. KG, Germany, represented by Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is Registration Private, Privacy Protect, LLC, United States of America (“US”) / Nguyen Thi Lien, Viet Nam.

### **2. The Domain Name and Registrar**

The disputed domain name <microsennheiser.com> (the “Disputed Domain Name”) is registered with Nhan Hoa Software Company 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 Disputed Domain Name. On February 11, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On February 11, 2022, the Center transmitted an email communication to the Parties in English and Vietnamese regarding the language of the proceeding. On February 14, 2022, the Complainant submitted its request that English be the language of the proceeding. The Center received two emails from the Respondent on February 12, 2022 and February 15, 2022, respectively, in the second email of which, the Respondent requested for communications to be in Vietnamese.

The Center verified that 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 in English and Vietnamese of the Complaint, and the proceedings commenced on February 23, 2022. In accordance

with the Rules, paragraph 5, the due date for Response was March 15, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties on March 16, 2022 that it would commence the panel appointment process.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on April 5, 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**

The Complainant, Sennheiser electronic GmbH & Co. KG, is a Germany-based company founded in 1945 and specializes in designing and producing a wide variety of audio products. Since its incorporation, the Complainant has expanded its business with more than 2,800 employees and three manufacturing plants in Germany, Ireland, and the US, as well as sales subsidiaries and research laboratories worldwide.

The Complainant's trademarks SENNHEISER have been registered for goods in class 9 in a variety of countries, including in Viet Nam, where the Respondent resides, under a number of trademark registrations, including but not limited to International registration No. 590780, registered on August 10, 1992, and No. 670839, registered on March 6, 1997.

In addition, the Complainant owns domain names featuring the SENNHEISER trademarks, notably the domain name <sennheiser.com> registered on April 24, 1996.

The Respondent registered the Disputed Domain Name on January 5, 2022. As of the date of this Decision, the Disputed Domain Name is resolving to an inactive website. However, the Disputed Domain Name used to resolve to a web shop of the Respondent, via which audio products under the Complainant's SENNHEISER trademarks were advertised and offered for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

First, the Complainant contends that its SENNHEISER trademarks are the subject of various registrations in jurisdictions worldwide, including in Viet Nam. These trademark registrations predate the date of registration of the Disputed Domain Name. In addition, the Complainant owns several domain names incorporating the SENNHEISER, which is also the company name of the Complainant found in 1945.

Second, the Complainant asserts that the Disputed Domain Name is confusingly similar to its trademarks since SENNHEISER is present in the Disputed Domain Name in its entirety. The addition of the element "micro" – a common abbreviation for "microphones" that fall into the Complainant's business core scope, not only does not serve to eliminate the confusion that this causes, but also emphasizes the association between the SENNHEISER trademarks and the Disputed Domain Name.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant contends that the name of the Respondent is in no way related to the term

“sennheiser”, and the Complainant can find no evidence to suggest that the Respondent is known by the Disputed Domain Name through registered trademarks or trade name or personal names corresponding to the designation “sennheiser” or the Disputed Domain Name. Besides, the Respondent is neither licensed nor authorized by the Complainant to use the SENNHEISER trademarks or the Disputed Domain Name.

Second, the Complainant applies the “*Oki data* test” to assert that the Respondent’s use of the Disputed Domain Name does not constitute a *bona fide* offering of goods or services. To the Complainant’s knowledge, there are no direct contractual relationships between the Complainant and the Respondent. Further, the Respondent does not accurately disclose its relationship with the Complainant on the website associated with the Disputed Domain Name despite not being a “genuine” or authorized sales agent of the Complainant in Viet Nam, via which the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the SENNHEISER trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

#### Registration in bad faith

The Complainant contends that the Respondent is fully aware of the Complainant’s rights over the SENNHEISER trademarks at the time of registration of the Disputed Domain Name for the following grounds. First, the Complainant had SENNHEISER trademarks registered in Asia, including Viet Nam, before the Disputed Domain Name was registered. Second, the Respondent’s website offered SENNHEISER products such as microphones and audio goods. Third, the Respondent also used the SENNHEISER trademarks on its website.

#### Use in bad faith

The Complainant argues that the Respondent used the Disputed Domain Name to direct Internet users to its website by creating a likelihood of confusion with the SENNHEISER trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website. The Complainant also contends that the Respondent registered the Disputed Domain Name to exploit the reputation and prestige of the well-known SENNHEISER trademarks to gain undue advantage thereof.

Based on the above assertions, the Complainant requests transfer of the Disputed Domain Name.

## **B. Respondent**

The Respondent did not formally reply to the Complaint, except for the emails dated February 12, 2022 and February 15, 2022. In the former, the Respondent asserts that the Disputed Domain Name is used for trading SENNHEISER products in Viet Nam and not being in conflict with the Complainant. In the latter, the Respondent informs that the website under the Disputed Domain Name has been taken down and is being offered for sale.

## **6. Discussion and Findings**

### **A. Procedural Issue: Language of the Proceeding**

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement was Vietnamese.

As the Complaint was filed in English, the Center, in its notification dated February 11, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a request for English to be the language of the administrative proceedings by February

14, 2022.

On February 14, 2022, the Complainant submitted a request that English be the language of the proceeding. On February 15, 2022, the Respondent requested communications in Vietnamese.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant and its representatives are unable to communicate in Vietnamese and requiring the submitted documents to be translated into Vietnamese would therefore lead to undue delay the proceeding and cause the Complainant to incur substantial expenses for translation;
- (ii) the English language is quite popular in Viet Nam, where the Respondent is located, especially in the trading context, and notably, the Respondent, in her email dated February 15, 2022, replied to the Center in English. Therefore, although the Respondent requested for communications to be in Vietnamese, the Panel finds evidence proving that the Respondent has knowledge of the English language and is able to communicate in English.

Therefore, for easy comprehension of the Complainant (the party majorly taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

## **B. Identical or Confusingly Similar**

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant has evidenced that it has registered trademark rights over the SENNHEISER in class 9 in numerous jurisdictions, including Viet Nam, well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name incorporates the entirety of the SENNHEISER trademarks, in which the Complainant has exclusive rights. In this present case, the Disputed Domain Name differs from the SENNHEISER trademarks only in the presence in the Disputed Domain Name of the term "micro", which is the common abbreviation in the field of audio technology for "microphone" and relates to the Complainant's main field of activity. This minor difference does not prevent a finding of confusing similarity caused by the presence in the Disputed Domain Name of the entire text of the SENNHEISER trademarks.

Third, the Panel finds, similarly to other UDRP panels, that the addition of the generic Top-Level Domain ("gTLD") ".com" to the Disputed Domain Name does not constitute an element to avoid confusing similarity for the Policy purposes (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No.

D2012-2066; *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the SENNHEISER trademarks, and paragraph 4(a)(i) of the Policy is established.

### C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

"(i) before any notice to you of the dispute, your use of, or demonstrable 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent's informal communications are insufficient to refute the Complainant's contentions, as discussed further below.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (See, e.g., *Documert Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios*, WIPO Case No. [D2001-0121](#)).

Regarding paragraph 4(c)(i) of the Policy, the Panel finds that the Respondent has no license, permission, or authorization to use the SENNHEISER trademarks in light of the Complainant's asserted facts. There is no evidence that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the SENNHEISER trademarks.

A reseller or distributor may be making a *bona fide* offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("Oki Data"), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

According to prior UDRP panels, the *Oki Data* criteria are appropriate even when the respondent is not an

authorized reseller.

In this case, it is well proven and evidenced by the Complainant that the Respondent used the website under the Disputed Domain Name to sell products identical to those sold by the Complainant. On such a website, the Panel finds that the Respondent used the SENNHEISER trademarks but did not place any statement or disclaimer disclosing accurately and prominently its relationship with the Complainant. Further, the Respondent claimed itself on the "About Us" section as "Đại lý phân phối và bán hàng MICRO SENNHEISER chính hãng tại Việt Nam" (in English: "Genuine MICRO SENNHEISER distribution and sales agent in Viet Nam"). Given the confusing similarity between the SENNHEISER trademarks and the Disputed Domain Name, the Panel is satisfied that the Respondent is using the Disputed Domain Name to deceive consumers, who have been familiar with the Complainant, into falsely believing in a connection or association between the Respondent and the Complainant, when this is not the case. The Respondent's claim (without supporting evidence) in its informal communication to be offering genuine SENNHEISER products is not sufficient to rebut the Complainant's claims and evidence in the context of *Oki Data*, in particular regarding the lack of a clear explanation of the lack of relationship between the Parties.

With such a view, the Panel finds that the unauthorized use of the Disputed Domain Name does not meet the *Oki Data* criteria and, thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that no evidence would suggest that the Respondent, as an individual, business, or other organization, has at any point been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence concerning the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the SENNHEISER trademarks and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Names in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's SENNHEISER trademarks have been registered in a variety of jurisdictions around the world. In addition, the Complainant's SENNHEISER trademarks have been put in use for a long period of time and gained a certain reputation in the sector of audio. The Complainant's SENNHEISER trademarks and its domain name <sennheiser.com> all predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the SENNHEISER trademarks in its entirety, adding the element "micro" at the beginning. Given the extensive use of the SENNHEISER trademarks for audio products by the Complainant, which occurs in numerous countries, and that the element "micro" directly refers to the products and business field of the Complainant, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its SENNHEISER trademarks when it registered the Disputed Domain Name, and the Panel considers the registration is an attempt by the Respondent as to take unfair advantage of the Complainant's goodwill.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it is resolving to an inactive website. However, it is well proven and evidenced by the Complainant that the website under the Disputed Domain Name used to offer the audio products branded with the Complainant's SENNHEISER trademarks. In addition to the adoption of the Complainant's SENNHEISER trademark as a uniquely distinctive part of the Disputed Domain Name, the Respondent used the Complainant's trademark on the website. Such use indicates the Respondent was intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of products on the Respondent's website. Moreover, the current inactive website does not prevent a finding of bad faith in these circumstances.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is 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 Name <microsenhheiser.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: April 19, 2022