

ADMINISTRATIVE PANEL DECISION

Ebara Corporation v. mehdi maalki

Case No. D2022-0592

1. The Parties

The Complainant is Ebara Corporation, Japan, represented by Yuasa and Hara, Japan.

The Respondent is mehdi maalki, Denmark.

2. The Domain Name and Registrar

The disputed domain name <ebarashop.com> is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2022. On February 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Complainant filed an amended Complaint on February 24, 2022.

On February 26, 2022, the Respondent sent an informal email.

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 February 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2022. The Respondent did not submit any Formal response. Accordingly, the Center informed the Parties that it will proceed to Panel Appointment on March 22, 2022.

The Center appointed John Swinson as the sole panelist in this matter on March 24, 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 is a manufacturer of infrastructure and industrial machinery. The Complainant was founded in 1912 as pump manufacturer in Japan, and currently does business in many countries throughout the world.

The Complainant owns registered trademarks for EBARA, including Iranian Trademark No. 59618 registered on August 19, 1985.

The Respondent did not file a formal response, and so little is known about the Respondent. In an email from the Respondent addressed to the Complainant, that was sent to the Center, the Respondent states: "Our company has been selling Ebara products online in the store for 12 years and we are very satisfied with the good quality of your products."

The disputed domain name was registered on September 20, 2015.

The website at the disputed domain name is not in English, includes the Complainant's trademark in logo format, and advertises the Complainant's products. It appears to be directed at buyers of pumps in Iran. Text on the website states:

شرکت صنایع پمپ ابارا در سال 1373 در ایران تاسیس گردید و فعالیت خود را به صورت عملی آغاز کرد. هدف از تاسیس این شرکت در ایران به طور کلی: ارائه خدمات و محصولات مرتبط با صنعت آب، فاضلاب و تاسیسات ساختمان در سطح د.کشور و کشورهای همجوار می باشد

According to Google Translate, in English this is:

"Abara Pump Industries Company was established in 1994 in Iran and started its activity in practice. The purpose of establishing this company in Iran in general: to provide services and products related to the water, sewage and building facilities in the country and neighboring countries"

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant is a famous manufacturer of pumps. The Complainant owns many longstanding trademark registrations for EBARA in both word and logo format, including in Iran, that cover goods and services including pumps.

The website at the disputed domain name advertises pumps.

The disputed domain name includes the Complainant's trademark and the word "shop". The term "shop" has no distinctiveness.

Consumers are likely to think that the website at the disputed domain name is operated by the Complainant.

The Respondent is not its official distributor of the Complainant's products in Iran. The Complainant has not

licensed the Respondent to use the Complainant's trademark. The Respondent's trading name ("Abara Pump Industries Company") as set out on the website at the disputed domain name has not been registered with the corporate registrar in Iran, and that accordingly the Respondent is using a fictitious company name to take a free ride on the Complainant's goodwill.

The Respondent has registered and used the disputed domain name in bad faith.

B. Respondent

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

In an email addressed to the Complainant but sent to the Center, the Respondent states, in part:

"Our company is looking for a suitable and legal solution to continue selling your products online and we are very pleased to use your guidance and advice in this regard to improve our performance. ... We welcome any kind of suggestion and solution to solve the problems and misunderstandings that have occurred and we are ready to solve the problems in this field."

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

(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.

The *onus* of proving these elements is on the Complainant, even where the Respondent does not file a formal response.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for EBARA.

The disputed domain name is confusingly similar to the EBARA trademark. The addition of the word "shop" to the Complainant's trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark under the Policy. See, for example, *Skechers U.S.A., Inc. II v. shen dong, XIA MEN BAISHILAI WANGLOU*, WIPO Case No. [D2022-0258](#).

Where the relevant trademark is recognizable within the disputed domain name, the addition of other letters or terms does not prevent a finding of confusing similarity under the first element. *Hostelworld.com Limited v. Contact Privacy Inc. / Shamlee Pingle*, WIPO Case No. [D2021-1849](#).

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the Respondent is not its official distributor of the Complainant's products in Iran. The Complainant also asserts that the Complainant has not licensed the Respondent to use the Complainant's trademark.

Further, the Complainant asserts that the Respondent's trading name ("Abara Pump Industries Company") as set out on the website at the disputed domain name has not been registered with the corporate registrar in Iran, and that accordingly the Respondent is using a fictitious company name to take a free ride on the Complainant's goodwill.

The Respondent made a commercial use of the disputed domain name by promoting products that compete with the Complainant's products. The Complainant asserts that such use is not *bona fide*, but rather, it is use that misleads consumers into believing that the disputed domain name is associated with the Complainant.

The Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

In an email sent to the Center, the Respondent made statements that it was selling the Complainant's products, but provided no evidence to support this or any other statement made by the Respondent in this email. The Respondent's unsubstantiated email statements are not sufficient to overcome the *prima facie* case established by the Complainant.

The Panel has considered whether the well-known principles set out in the *Oki-Data case (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903)* apply here. The Panel finds that they do not. This is because the Respondent is using the Complainant's logo without permission, the Respondent has provided no contact details to the Registrar in respect of the disputed domain name, and appears to be hiding its true identity. There is no evidence that the Respondent is selling genuine EBARA products, and there is no evidence that website at the disputed domain name discloses the true nature of any relationship between the Complainant and the Respondent. The evidence suggests that the website at the disputed domain name uses a fictitious company name. It is also curious that the Respondent's email to the Center was from a Yahoo email account rather than from a business email account, and provided no contact details. According to LinkedIn, a person with the same name as the Respondent is an "Engineering Project Manager at Metro Line 3 of Mashhad" in Iran and specializes in pumps – maybe this person is the Respondent, or maybe the Respondent is impersonating this person.

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that none of the circumstances listed in paragraph 4(c) of the Policy apply in the present circumstances.

For the reasons set forth above, the Panel concludes the Respondent has no rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

In the present circumstances, the fact that the disputed domain name include the Complainant's famous EBARA trademark, and resolves to a website which misleads Internet users as to the Respondent's relationship with the Complainant, leads the Panel to conclude the registration and use of the disputed domain name is in bad faith.

The Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and the Complainant's trademark. By using the Complainant's EBARA logo and referring to the Complainant's products on the Respondent's website makes it clear beyond doubt that the Respondent specifically knew of and targeted the Complainant. See *Fédération Française de Tennis (FFT) v. Daniel Hall, dotCHAT, Inc., WIPO Case No. D2016-1941*.

The Whois details for the disputed domain name provide no or false contact details of the Respondent. Given the covert nature of the Respondent's conduct and the lack of any response to the Complainant's claims, the inference of bad faith is strengthened.

The Respondent has not filed a formal Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists. *Regal Funds Management Pty Limited v. WhoisGuard Protected, WhoisGuard, Inc. / John Clerk, WIPO Case No. D2020-2773*.

The Panel finds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website under paragraph 4(b)(iv) of the Policy. The Respondent's websites also could disrupt the business of the Complainant.

The Panel finds that the Respondent has both registered and used the disputed domain name in bad faith.

The Complainant succeeds on the third element of the Policy in relation to the disputed domain name.

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 <ebarashop.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: April 7, 2022