

ADMINISTRATIVE PANEL DECISION

Sandvik Intellectual Property AB (SIP AB), Seco Tools AB, Walter AG v.
Domain Admin, Whois Privacy Corp. / shen Jie, EVRAZ-ENGINEERING LTD
Case No. D2022-1946

1. The Parties

The Complainants are Sandvik Intellectual Property AB (SIP AB), Sweden, Seco Tools AB, Sweden, and Walter AG, Germany, represented by SILKA AB, Sweden.

The Respondent is Domain Admin, Whois Privacy Corp., Bahamas / shen Jie, EVRAZ-ENGINEERING LTD, China.

2. The Domain Names and Registrars

The disputed domain names <pramet.express> and <walter-tools.company> are registered with TLD Registrar Solutions Ltd (the “Registrar”).

The disputed domain name <sandvik-coromant.net> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 28, 2022. On May 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 15, 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 amendment to the Complaint on June 16, 2022.

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 June 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 13, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on August 4, 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 Complainants, Sandvik Intellectual Property AB ("Sandvik"), Seco Tools AB ("Seco"), and Walter AG ("Walter"), together referred to as the "Complainant", are part of the Sandvik Group.

Sandvik Group is a global, high-tech global engineering group specialized in mining and rock excavation, rock processing, metal cutting and materials technology, providing optimized products and solutions based on digitalization, innovation and sustainable engineering. According to its 2021 report, Sandvik Group has approximately 44,000 employees, an international network of 200 companies in 130 countries and a portfolio of 3,700 patents.

Sandvik was founded in 1986 to provide services, including intellectual property consultancy services, and is a subsidiary of Sandvik AB.

Seco is one of the world's largest providers of comprehensive metal cutting solutions for milling, stationary tools, hole making and tooling system. In 2012, Seco became a wholly owned part of the Sandvik Group.

Walter is a leading player in the international metalworking industry with seven production units and over 3,500 employees worldwide.

The Complainant holds trademark rights for PRAMET, SANDVIK-COROMANT, and WALTER in many jurisdictions worldwide such as the following:

- the International word trademark registration for PRAMET No. 367748A registered on April 6, 1970, for goods in International Classes 3, 6, 7, 8, 9, 17;
- the International figurative trademark registration for SANDVIK-COROMANT No. 1160354 registered on January 14, 2013, for goods and services in International Classes 6, 7, 8, 9, 35, 37, 40, 41, 42; and
- the International figurative trademark registration for WALTER No. 561986 registered on October 5, 1990, for goods in International Class 9.

The Complainant owns domain names reflecting its PRAMET, SANDVIK-COROMANT, and WALTER marks, including <dormerpramet.com> (registered on June 30, 2014), <coromant.com> (registered on September 23, 1996), and <walter-tools.com> (registered on February 26, 2004).

The disputed domain names <pramet.express> and <sandvik-coromant.net> were registered on January 18, 2022, and the disputed domain name <walter-tools.company> was registered on May 25, 2021.

At the time of filing the Complaint, all the disputed domain names hosted websites, in Russian language, that displayed information about the Complainant and its activities, reproduced the Complainant's marks together with third parties' trademarks, purportedly offering Complainant's products for sale, and included certain information, copyright claims, and images aimed at misleading Internet users into thinking that the websites are operated by or affiliated with the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its distinctive trademarks PRAMET, SANDVIK-COROMANT, and WALTER, that the Respondent has no rights or legitimate interests in the disputed domain names, and that the Respondent registered and is using the disputed domain names in bad faith.

The Respondent Evraz-Engineering was involved in another UDRP proceeding involving one trademark of the Complainant, see *Seco Tools AB v. Evraz-Engineering Ltd.*, WIPO Case No. [D2019-2594](#).

The Complainant requests the transfer of the disputed domain names to it.

B. Respondent

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

6. Discussion and Findings

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will further analyze the concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Complainant holds rights in the PRAMET, SANDVIK-COROMANT, and WALTER trademarks.

The disputed domain names <pramet.express> and <sandvik-coromant.net> reproduce the Complainant's marks PRAMET, respectively SANDVIK-COROMANT exactly.

The disputed domain name <walter-tools.company> incorporates the Complainant's trademark WALTER in its entirety with an additional term, "tools". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether descriptive or geographic term, pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to escape a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Further, it is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".express", ".net", ".company") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name.

Given the above, the Panel finds that the disputed domain names <pramet.express> and <sandvik-coromant.net> are identical to the Complainant's trademarks PRAMET and SANDVIK-

COROMANT, and the disputed domain name <walter-tools.company> is confusingly similar to the Complainant's trademark WALTER, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the trademarks PRAMET, SANDVIK-COROMANT, and WALTER, that the Respondent is not commonly known by the disputed domain names, and that the Respondent has not used the disputed domain names in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain names. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain names or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain names.

According to the evidence provided in Annex 19 to Complaint, the Respondent has used the disputed domain names in connection with commercial websites offering PRAMET, SANDVIK-COROMANT, and WALTER branded goods as well as competing goods of third parties.

In certain cases, UDRP panels have recognized that resellers, distributors using a domain name containing a complainant's trademark to undertake sales related to a complainant's goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Accordingly, in this case, the key question under this element is whether the Respondent's use of the disputed domain names amounts to a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

The current state of UDRP panel consensus in relation to this issue is helpfully summarized in the section 2.8 of the [WIPO Overview 3.0](#), based on panel decisions such as *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). According to the "Oki Data test", several cumulative requirements will be applied in the specific conditions of a UDRP case, including the fact that the site must accurately and prominently disclose the registrant's relationship with the trademark holder (the complainant) and that the respondent must use the site to sell only the trademarked goods or services. In this case, according to the available record, on the websites corresponding to the disputed domain names there was no indication regarding the relationship between the Parties and the Respondent was using the sites to promote third parties' goods as well.

This is not an activity falling under the circumstances listed by paragraph 4(c) of the UDRP as demonstrating the Respondent's rights or legitimate interests in the disputed domain names.

In addition, and without prejudice to the above, the nature of the disputed domain names, comprising the Complainant's trademark alone or in combination with a generic term, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Consequently, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark rights for PRAMET, SANDVIK-COROMANT, and WALTER for decades, and its trademarks are distinctive and have gained reputation in their industry.

The disputed domain names were created in May 2021, respectively in August 2022 and incorporate the Complainant's mark alone or together with a descriptive term closely related to the Complainant's business. The websites at the disputed domain names also feature the Complainant's trademark and depict images of the Complainant's products.

For the above, the Panel finds that the disputed domain names were registered in bad faith, with knowledge of the Complainant, its business, and particularly targeting its PRAMET, SANDVIK-COROMANT, and WALTER trademarks.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant's trademarks and the websites operated under the disputed domain names display the Complainant's trademarks, product images and do not provide any disclaimer, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademarks.

Paragraph 4(b)(ii) of the Policy provides a circumstance of bad faith scenario when a respondent registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registrations. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners. See section 3.1.2 of the [WIPO Overview 3.0](#).

The Respondent registered three disputed domain names reflecting the Complainant's trademarks. Additionally, the Respondent has been the subject of adverse decisions in previous UDRP proceedings. See WIPO Case No. [D2019-2594](#) *supra* and *Compagnie Générale des Etablissements Michelin v. 沈洁 (shen Jie)*, WIPO Case No. [D2017-0645](#)¹.

The Respondent has not participated in the present proceedings in order to put forward any arguments in its favor and provided false contact details in the Whols. Such facts, together with all the other elements in this case, constitute, in the eyes of this Panel, further evidence of bad faith behavior.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

¹ See section 4.8 of the [WIPO Overview 3.0](#) regarding Panel's powers to conduct limited searches.

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 names <pramet.express>, <sandvik-coromant.net> and <walter-tools.company> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: August 15, 2022