

## **ADMINISTRATIVE PANEL DECISION**

Vorwerk International AG v. elie madret

Case No. D2022-2095

### **1. The Parties**

The Complainant is Vorwerk International AG, Switzerland, represented by Moeller IP, Argentina.

The Respondent is elie madret, France.

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

The disputed domain name <thermomix-coupon.com> is registered with Register.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 15, 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 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 amended Complaint on June 16, 2022.

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 June 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2022.

The Center appointed James Bridgeman SC as the sole panelist in this matter on July 13, 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 engaged in the direct selling of multifunctional kitchen appliances on which it uses the THERMONIX mark.

The Complainant owns a portfolio of active trademark and service mark registrations for, or including, the THERMOMIX mark, the earliest of which, according to the evidence adduced, is:

- Spanish registered trademark VORWERK-THERMOMIX, registration number M2969544, registered for goods and services in classes 21, 35 and 37, for which application was made on October 16, 1980.

The earliest registration for the THERMOMIX mark standing alone is:

- French registered trademark THERMOMIX, registration number 1461124, registered for goods and services in classes 7 and 11, for which application was made on April 20, 1988.

The Complainant has an established Internet presence, and its parent corporation holds almost 400 Internet domain names that expressly incorporate the THERMOMIX mark.

The disputed domain name was registered on May 24, 2022 and resolves to a website that describes itself in the French language as a “Thermomix validation site” that prominently displays kitchen utensils, offering Internet users the opportunity to purchase a delivery coupon and makes use of the THERMOMIX mark including on the images of the goods that are purported to be on offer.

In the absence of a Response, the only information available about the Respondent is that provided in the Complaint, the Registrar’s WhoIs, and the information provided by the Registrar to the Center in response to the Center’s request for verification of the registration details of the disputed domain name in the course of this proceeding.

#### **5. Parties’ Contentions**

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

The Complainant states that it is the business division of the Vorwerk group, engaged in direct selling operations, with a reputation in 70 countries.

The Complainant has its own subsidiaries in a total of 16 countries in Europe, Asia, and North America, with more than 30 distributors engaged in selling multifunctional kitchen appliances, and claiming to have generated EUR 1,584 million in sales, having an average of 59,900 self-employed sales advisors and 5,900 employees.

The Complainant’s parent corporation is the owner of more than 1,500 domain names of which almost 400 expressly contain the THERMOMIX mark.

Relying on its registered trademark rights and its extensive use of the mark in its direct selling operations described above, the Complainant submits that the disputed domain name is confusingly similar to the THERMOMIX mark in which it has rights.

The Complainant argues that the disputed domain name fully reproduces THERMOMIX mark, the only difference being the addition of the word “coupon”.

The Complainant contends that the undeniable phonetic and graphic identity of the disputed domain name with its THERMOMIX mark, will lead to errors and confusion among consumers.

In addition, the Complainant submits that panels established under the Policy have found that domain names in issue to be confusingly similar to a complainant's trademark in cases where, as here, the disputed domain name consists of the complainant's mark plus an additional term.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name, submitting that the registrant of the disputed domain name was aware of the Complainant's ownership of the THERMOMIX mark, and by registering the disputed domain name, intended to take advantage of the Complainant's reputation.

In support of this argument, the Complainant submits that it owned registrations for the THERMOMIX trademark in many jurisdictions around the world well in advance of the date on which the disputed domain name was registered.

It is further contended that the Respondent does not own any trademark registrations that would create a legitimate interest and the Complainant adds that the Respondent has no known connection or affiliation with the Complainant, nor has it received no authorization of any sort from the Complainant to use the THERMOMIX trademark or include it in any domain name.

Therefore, the Complainant contends, the Respondent must have chosen to incorporate the THERMOMIX trademark in the disputed domain name intentionally, in order to attract Internet users, including customers and potential customers of the Complainant.

The Complainant adds that such acts demonstrate that the Respondent is free-riding on the Complainant's reputation and goodwill to mislead unsuspecting Internet users to the website to which the disputed domain name resolves, by creating a false impression that the Respondent is affiliated with, and an authorized distributor or reseller of the Complainant, when the Complainant's THERMOMIX products are mainly distributed through official and authorized stores.

The Complainant further submits that the use by the Respondent of the disputed domain name that is confusingly similar to the Complainant's trademarks in order to attract Internet users looking for the Complainant by original channels, and to offer by them products by unauthorized means instead, is a strategy that lacks *bona fides* and does not give rise to rights or legitimate interests under the Policy.

Previous panels established under the Policy have held that use of a domain name for illegal activities of this nature cannot confer rights or legitimate interests on a respondent.

Additionally, the Complainant contends that the nature of the disputed domain name, consisting of the Complainant's THERMOMIX trademark, with the addition of the word "coupon", which carries a risk of implied affiliation, cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith on the website to which it resolves.

Previous panels established under the Policy have found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant adds that this particularly so in relation to domain names comprising typos or incorporating the mark in issue, plus a descriptive term.

Furthermore, the Complainant contends that the registrant selected the disputed domain name which incorporates the Complainant's identical THERMOMIX mark to sell suspicious products bearing THERMOMIX trademark.

The Complainant adds that by reproducing the Complainant's copyright content without authorization, as shown by the screen captures of pages on the website to which the disputed domain name resolves, which

have been adduced in evidence in an exhibit annexed to the Complaint, the Respondent is creating an implicit risk of confusion by association.

The Complainant adds that the risk of confusion can be even more damaging to the Complainant as the suspicious products sold on this site probably do not comply with the safety and quality rules of the Complainant's original products, which can cause considerable damage not only to the Complainant's reputation, but also to health and safety of the misled consumer public.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving, on the balance of probabilities, each of the following three elements:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant holds rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith by the Respondent.

As the Respondent did not file a Response or otherwise reply to the Complainant's contentions, the Panel shall decide the complaint on the basis of the Complainant's submissions and such inferences that can be reasonably drawn from the failure to submit a Response as the Panel considers applicable (Rules, paragraph 14(b)).

### **A. Identical or Confusingly Similar**

The Complainant has provided uncontested evidence of its claimed rights in the THERMOMIX mark, established by its ownership of its portfolio of trademark and service mark registrations described above.

The disputed domain name consists of the Complainant's THERMOMIX mark in its entirety, followed by a hyphen, the term "coupon", and the generic Top Level Domain ("gTLD") ".com".

The Complainant's THERMOMIX mark is clearly recognisable in the disputed domain name.

The hyphen has no significance in the disputed domain name and the word "coupon" is descriptive of a payment method. The presence of neither the hyphen nor word "coupon" prevent a finding that the disputed domain name is confusingly similar to the THERMOMIX mark.

Additionally, in the context of this Complaint, the gTLD ".com" is a necessary technical requirement for a domain name and therefore does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's THERMOMIX mark.

This Panel finds therefore that the disputed domain name is confusingly similar to the THERMOMIX mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy, paragraph 4(a)(i).

## **B. Rights or Legitimate Interests**

The Complainant has made out an uncontested *prima facie* case that the Respondent has no rights legitimate interests in the disputed domain name arguing that

- the Complainant owned registrations for the THERMOMIX trademark in many jurisdictions around the world well in advance of the date on which the disputed domain name was registered;
- the Respondent does not own any trademark registrations that would create a legitimate interest;
- the Respondent has no known connection or affiliation with the Complainant;
- the Respondent has received no authorization of any sort from the Complainant to use the THERMOMIX trademark or include it in any domain name;
- the Respondent was aware of the Complainant's ownership of the THERMOMIX mark, and by registering the disputed domain name, the Respondent intended to take advantage of the Complainant's reputation;
- the Respondent must have chosen to incorporate the trademark in the disputed domain name intentionally in order to attract Internet users, including customers and potential customers of the Complainant;
- the Respondent is free-riding on the Complainant's reputation and goodwill to mislead unsuspecting Internet users to the website to which the disputed domain name resolves, by creating a false impression that the Respondent is affiliated with and an authorized distributor or reseller of the Complainant when the Complainant's THERMOMIX products are mainly distributed through official and authorized stores.
- the use by the Respondent of the disputed domain name that is confusingly similar to the Complainant's trademarks, without any explanation of the lack of relationship between the Parties, in order to attract Internet users looking for the Complainant by original channels, and to offer by them products by unauthorized means instead, is a strategy that lacks *bona fides* and does not give rise to rights or legitimate interests under the Policy;
- previous panels established under the Policy have held that use of a domain name for illegal activities of this nature cannot confer rights or legitimate interests on a respondent.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy, paragraph 4(a)(ii).

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

The Complainant has adduced uncontested evidence that it owns and uses the THERMOMIX mark on the kitchen appliances produced by its group of companies and that the Complainant is the direct marketing branch of the group's operations.

The earliest registration for the mark which is relied upon by the Complainant is the Spanish registration for which application was made on October 16, 1980.

The uncontested evidence is that in recent years, the Complainant has generated EUR 1,584 million in sales with an average of 59,900 self-employed sales advisors and 5,900 employees in 70 countries and subsidiaries in a total of 16 countries in Europe, Asia, and North America, with more than 30 distributors are engaged in selling multifunctional kitchen appliances.

The THERMOMIX mark is distinctive, and given the extent of the Complainant's prior rights and reputation, it is implausible that the registrant chose and registered the disputed domain name without knowledge of the Complainant, its rights, and its mark.

The disputed domain name is in itself also a combination of the Complainant's mark, as its dominant feature, in combination with the word "coupon", which imputes the concept of retail sales.

On the balance of probabilities, this combination of elements must have been chosen and registered to target and take predatory advantage of the Complainant's mark and goodwill in the THERMOMIX mark.

This Panel finds therefore the disputed domain name was registered in bad faith.

In an annex to the Complaint, the Complainant has adduced in evidence screen captures of the website to which the disputed domain name resolves.

These show that the disputed domain name is being used to offer Internet users coupons to be used to purchase the Complainant's products. In uncontested evidence, the Complainant has alleged that it is the owner of the copyright in the images on the Respondent's website, and that the images and the THERMOMIX mark are being used by the Respondent without its consent.

This is not a case where the Respondent purports to be a re-seller of the Complainant's trademarked goods, but rather, the Respondent is purporting to sell coupons to be used to purchase the Complainant's products.

The Complainant has stated that it has no known connection or affiliation with the Respondent.

Additionally, the screen captures of the web pages submitted in the annex to the Complaint, show that the Respondent's website neither discloses the Respondent's identity or contact details, nor does the website content accurately disclose that the Respondent has no relationship with the trademark owner. On the contrary, the text and other content however misrepresent to the public that the website is owned by, has a connection with, or is endorsed by the Complainant.

Such intentional use of the disputed domain name in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the coupons purported to be offered by the Respondent on his/her website constitutes use of the disputed domain name in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded in the third element of the test in Policy, paragraph 4(a)(iii).

## **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 <thermomix-coupon.com> be transferred to the Complainant.

*/James Bridgeman SC/*

**James Bridgeman SC**

Sole Panelist

Date: July 27, 2022