

ADMINISTRATIVE PANEL DECISION

Voith GmbH & Co. KGaA v. Whois Privacy Protection Service by
onamae.com / haibo lin, linhaibo
Case No. D2022-2113

1. The Parties

The Complainant is Voith GmbH & Co. KGaA, Germany, represented by Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is Whois Privacy Protection Service by onamae.com, Japan / haibo lin, linhaibo, China.

2. The Domain Name and Registrar

The disputed domain name <voithservices.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 8, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 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 14, 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 in English on June 20, 2022.

On June 14, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On June 20, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on June 21, 2022. In accordance with paragraph 5 of the Rules, the due date for Response was July 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 12, 2022.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on July 27, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant is a German based company founded in 1867, active in the markets of energy, oil and gas, paper, raw materials, and transport and automotive. Today the Complainant employs around 20,000 people, generates about EUR 4.3 billion in sales, operates in about 60 countries around the world and is one of the biggest family-owned companies in Europe.

The Complainant is the owner of several trademark registrations protecting the designation VOITH for a large variety of goods and services in the Complainant's business, in a large number of jurisdictions *inter alia*: Germany trademark registration Nos. 894632 (registered on June 26, 1972) and 989438 (registered on August 22, 1979), Japanese trademark registration Nos. 2007441 (registered on December 18, 1987) and 5613551 (registered on September 6, 2013), and international trademark Nos. 178950 (registered on August 20, 1954), 405353 (registered on December 7, 1973) and 447007 (registered on August 22, 1979).

The Complainant is the owner of the domain names: <voith.com>, <voith.co.jp>, <voithservice.info>, <voithservice.com>, <voithservice.net>, and <voithservice.org>.

The disputed domain name was registered on May 26, 2021. The disputed domain name previously resolved to a website offering pornographic and gambling content. The disputed domain name currently resolves to a website showing pay-per-click ("PPC") advertising links.

5. Parties' Contentions

A. Complainant

The disputed domain name combines the Complainant's VOITH mark with the element "services", which will be perceived as being clearly descriptive and non-distinctive. This additional element "services" will thus not be perceived by the relevant public as a difference and could not distinguish the Respondent or the goods and services offered under the disputed domain names from the Complainant's business and its goods and services. To the contrary, the relevant public might get the impression that the disputed domain name identifies the Complainant itself and its business or services. The descriptive element added to the Complainant's VOITH mark in the disputed domain name is not only non-distinctive, but also emphasizes the association between the Complainant's VOITH mark and the disputed domain name. Therefore, the disputed domain name is highly similar to the Complainant's VOITH mark.

The Complainant has not found that the Respondent has any registered trademarks corresponding to the designation VOITH or the disputed domain name. In addition, no license or authorization of any other kind has been given by the Complainant to the Respondent to use the disputed domain name. The mere registration of a domain name does not give the owner a right or legitimate interest in respect of the domain name.

The disputed domain name resolved to a website containing pornographic content. In addition, the linking of the disputed domain name with a pornographic website result in the tarnishing of the Complainant's VOITH mark, as Internet users looking for information on the Complainant and its services might be directed to the pornographic content on the website under the disputed domain name. It should be noted that, today, the content of the website under the disputed domain name has changed to a "sponsored links" page, created by SEDO, stating "This domain name has expired and may be renewed by the owner." But this does not alter the finding of bad faith. Hence, under these circumstances, there is no doubt that this is an obvious case of bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, 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 language of the Registration Agreements for the disputed domain names is Japanese.

However, the Complainant requests that English be the language of the proceeding with the reasons that the Complainant and its representatives are unable to communicate in Japanese and requiring the Complainant to submit documents in Japanese would lead to delay and cause the Complainant to incur inadequate translation expenses and that the disputed domain name combining the Complainant's VOITH mark with the English term "services" is, in itself, an indication that the Respondent is able to communicate in English.

Although the Respondent does not expressly agree with the Complainant on the language of the proceeding, the Respondent did not submit any objection to the Complainant's request that English be the language of the proceeding when the Center had sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese. Considering that the Respondent is located in China and, even assuming that the Respondent is conversant in Japanese, the Respondent's native language is presumed not to be Japanese, the necessity for conducting the proceeding in Japanese will not be so critical to justify the costs of translation and delay.

In view of these circumstances of the administrative proceeding, the Panel decides that English should be the language of the proceeding in the spirit of fairness and justice intended by the Policy.

6.2 Substantive Elements of the Policy

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

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

A. Identical or Confusingly Similar

The disputed domain name comprises the Complainant's VOITH mark in its entirety together with the word "services" and a generic Top-Level Domain ("gTLD") ".com".

The gTLD is a standard registration requirement and may be disregarded for assessing the confusing similarity. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Whereas the Complainant's VOITH mark is clearly recognizable within the disputed domain name, the addition of the word "services" to the Complainant's VOITH mark does not prevent a finding of confusing similarity (see *Western Logistics Inc. v. Great Emmanuel*, WIPO Case No. [D2021-0500](#) (<westernlogisticservices.com>); see also section 1.8 of the [WIPO Overview 3.0](#)).

Accordingly, the disputed domain name which wholly incorporates the Complainant's VOITH mark is confusingly similar to the Complainant's trademark and the Panel is convinced that the Complainant has sufficiently established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent has neither registered any trademarks corresponding to the designation VOITH or the disputed domain name, nor been given any license or authorization from the Complainant to use the disputed domain name. There is also no evidence to show that the Respondent is commonly known by the disputed domain name pursuant to paragraph 4(c)(ii) of the Policy.

The fact that the website to which the disputed domain name resolved displayed pornographic and gambling content indicates the Respondent's intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark pursuant to paragraph 4(c)(iii) of the Policy.

Consequently, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production on the second element shifts to the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)), but the Respondent failed to submit any response in this proceeding and there is no evidence of the existence of any rights or legitimate interests before the Panel.

Therefore, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant operates its business around the world and is well established and known worldwide, including China, where the Respondent resides. Thus, the Respondent was likely aware of the Complainant's VOITH mark at the registration of the disputed domain name, or knew or should have known that the disputed domain name was identical or confusingly similar to the Complainant's VOITH mark (see *Voith GmbH & Co. KGaA v. Guang Nian Chen, Chen Guang Nian*, WIPO Case No. [D2020-2099](#); see also section 3.2.2 of the [WIPO Overview 3.0](#)).

The Panel observes that the website to which the disputed domain name resolved offered pornographic and gambling content and now becomes a parking page showing pay-per-click ("PPC") advertising links. The Panel views that the Respondent's purpose of using the disputed domain name as a porn site or a PPC site is to intentionally attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the complainant's VOITH mark pursuant to paragraph 4(b)(iv) of the Policy (see *AXA SA v. Ruben Weiner*, WIPO Case No. [D2014-0458](#)), or to tarnish the complainant's VOITH mark (see section 3.12 of the [WIPO Overview 3.0](#)).

Therefore, the Panel concludes that such registration and use by the Respondent is deemed to have been in bad faith and the Complainant has proved the third element of paragraph 4(a) 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 disputed domain name <voithservices.com> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: August 10, 2022