

ADMINISTRATIVE PANEL DECISION

Demag IP Holdings GmbH v. Philson Intelligent Equipment (Jiangsu) Co., Ltd (菲尔森智能装备(江苏)有限公司); Kun Feng Zhong Gong Su Zhou You Xian Gong Si (昆峰重工(苏州)有限公司)
Case No. D2022-2657

1. The Parties

The Complainant is Demag IP Holdings GmbH, Switzerland, represented by Moser Götze & Partner Patentanwälte mbB, Germany.

The Respondent is Philson Intelligent Equipment (Jiangsu) Co., Ltd (菲尔森智能装备(江苏)有限公司); Kun Feng Zhong Gong Su Zhou You Xian Gong Si (昆峰重工(苏州)有限公司), China.

2. The Domain Name and Registrar

The disputed domain name <demag-drs.com> is registered with West263 International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 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 Center sent an email communication to the Complainant on July 26, 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 July 27, 2022.

On July 26, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On July 27, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center received three identical email communications from the Respondent on July 27, 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 in English and Chinese of the Complaint, and the proceeding commenced on August 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2022. The Respondent did not submit any formal response. On August 23, 2022, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Sebastian M.W. Hughes as the sole panelist in this matter on September 1, 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

A. Complainant

The Complainant is a company incorporated in Switzerland and part of a group of companies based in Germany that designs and manufactures industrial cranes and components, marketed and sold worldwide under the trade mark DEMAG (the “Trade Mark”).

The Complainant is the owner of numerous registrations in jurisdictions worldwide for the Trade Mark, including International registration No. 873164, with a registration date of August 18, 2004; and Chinese registration No. 1187255, with a registration date of June 28, 1998.

The Complainant’s products marketed and sold under the Trade Mark include its DRS wheel block system (“DRS” being an acronym for “DEMAG Radblock System”; and “rad block” meaning “wheel block” in German).

The Complainant promotes and sells its goods under the Trade Mark via its website at “www.demag.com”.

B. Respondent

The Respondent is a company incorporated in China and a manufacturer of industrial wheels, wheel block systems and components.

C. The Disputed Domain Name

The disputed domain name was registered on April 17, 2020.

D. The Website at the Disputed Domain Name

Prior to the filing of the Complaint, the disputed domain name resolved to a predominantly Chinese language website of a company called “Philson Intelligent Equipment (Jiangsu) Co., Ltd (菲尔森智能装备(江苏)有限公司)”, promoting its industrial wheels and wheel block systems, including with reference to DRS (the “Website”).

As at the date of this Decision, the disputed domain name is not being used.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Trade Mark; the Respondent has no rights or legitimate interests in respect of the disputed domain name; and the disputed domain name has been registered and is being used in bad faith.

B. Respondent

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

In its emails to the Center dated July 27, 2022, the Respondent asserted that it is the legal owner of the disputed domain name, that it incurred a lot of costs in registering the disputed domain name, and that these would need to be paid to the Respondent in return for the cancellation of the disputed domain name.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the Parties, or unless specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement.

Paragraph 11(a) of the Rules allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the Parties and undue delay to the proceeding (see [WIPO Overview 3.0](#)), section 4.5.1).

The Complainant has requested that the language of the proceeding be English, for several reasons, including the following:

- (i) conducting the proceeding in English would enable the Parties to communicate fairly as neither Party's mother tongue is English - the Complainant is a Swiss company represented by a German patent attorney firm, whereas the Respondent is a Chinese company;
- (ii) the Respondent is familiar with the English language, as the Website contains some English language expressions; and
- (iii) it would disadvantage the Complainant if the proceeding were to be conducted in Chinese.

The Respondent did not file a response and did not file any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time and costs (see [WIPO Overview 3.0](#), section 4.5.1)..

Although there is insufficient evidence before the Panel to support a conclusion that the Respondent is conversant in English, the Panel also notes that the Respondent has taken no part in this proceeding (except for sending three identical emails as mentioned above which do not touch on the merits of the Complaint nor the language of the proceeding); and that all of the Center's communications with the Parties have been sent in English and Chinese.

The Panel is also mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner.

In all the circumstances, the Panel therefore finds it is not foreseeable that the Respondent would be prejudiced, should English be adopted as the language of the proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Elements of the Policy

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Mark acquired through use and registration.

The disputed domain name incorporates the entirety of the Trade Mark (see [WIPO Overview 3.0](#), section 1.7), followed by a hyphen and the word "DRS" – the name of the wheel block system manufactured, marketed and sold by the Complainant for many years under the Trade Mark.

The Panel therefore finds that the disputed domain name is confusingly similar to the Trade Mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a 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 trade mark 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 trade mark or service mark at issue.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Mark. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that it has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in connection with a *bona fide* offering of goods or services. To the contrary, the Respondent is a direct competitor of the Complainant in the industrial wheel and wheel block industry, and the Respondent has previously used the disputed domain name, without the authorisation or approval of the Complainant, for commercial gain in order to promote the

Respondent's competing wheels and wheel block products, including by making direct reference to DRS on the Website.

The Panel further finds that the Respondent's act of taking down the Website, at some stage after the filing of the Complaint and without the Respondent having filed any Response in this proceeding, underscores the Respondent's lack of rights or legitimate interests in the disputed domain name.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name.

There has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

In all the circumstances, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In light of the evidence of the Respondent's use of the Website in the manner described above, the Panel finds the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy.

The Panel also finds that the Respondent's act of taking down the Website in the manner described above provides further support for a finding of bad faith.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith.

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 <demag-drs.com> be cancelled.

/Sebastian M.W. Hughes/

Sebastian M.W. Hughes

Sole Panelist

Dated: September 15, 2022