

ADMINISTRATIVE PANEL DECISION

Villeroy & Boch AG v. Super Privacy Service LTD c/o Dynadot / DAOHON
ZHOU, GUANG DONG
Case No. D2022-2666

1. The Parties

The Complainant is Villeroy & Boch AG, Germany, represented by Taylor Wessing Partnerschaftsgesellschaft mbH, Germany.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America (“US”) / DAOHON ZHOU, GUANG DONG, China.

2. The Domain Name and Registrar

The disputed domain name <villeroyandboch.shop> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed 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 27, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint 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 of the Complaint, and the proceedings commenced on August 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 30, 2022.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on September 2, 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 the owner of numerous trademark registrations consisting of the designation VILLEROY & BOCH including:

European Union ("EU") trademark no. 001840362 for VILLEROY & BOCH (filing date September 6, 2000, registered on January 4, 2002), Classes 11, 20 and 21;

EU trademark no. 006825533 for VILLEROY & BOCH (filing date April 11, 2008, registered on January 7, 2009), Classes 18, 20,22 and 24;

EU trademark no. 009420779 for VILLEROY & BOCH (filing date October 4, 2010, registered on May 8, 2014), Classes 3, 4, 11, 14, 16, 25-28 and 35;

EU trademark no. 012020533 for VILLEROY & BOCH (filing date July 29, 2013, registered on December 26, 2013), Classes 2, 6, 8, 18, 19 and 32;

EU trademark no. 016482771 for VILLEROY & BOCH (filing date March 20, 2017, registered on August 22, 2017), Classes 9, 10, 17, 21, 23, 33, 34, 41 and 43;

German trademark no. 946093 for VILLEROY & BOCH (filing date August 22, 1975, registered on June 30, 1976), Classes 10, 11, 19-21 and 34;

United Kingdom trademark no. UK00001507251 for VILLEROY & BOCH (filing date July 18, 1992, registered on January 21, 1994), Classes 8 and 21;

US Trademark Registration no. 1339086 for VILLEROY & BOCH (filing date August 24, 1983, registered on June 4, 1985), Classes 11, 19 and 21;

US Trademark Registration no. 1946247 for VILLEROY & BOCH (filing date December 9, 1993, registered on January 9, 1996), Classes 8, 20, 21 and 24;

US Trademark Registration no. 2616889 for VILLEROY & BOCH (filing date November 2, 2000, registered on September 10, 2002), Classes 8, 11, 20 and 21;

US Trademark Registration no. 4899938 for VILLEROY & BOCH (filing date January 22, 2015, registered on February 16, 2016), Classes 20, 25 and 28;

Chinese trademark no. 11145584-8 for VILLEROY & BOCH (filing date July 2, /2012, registered on November 21, 2013), Class 8;

Chinese trademark no. 11145583-11 for VILLEROY & BOCH (filing date July 2, 2012, registered on December 14, 2015), Class 11;

Chinese trademark no. 11145580-19 for VILLEROY & BOCH (filing date July 2, 2012, registered on November 21, 2013), Class 19;

Chinese trademark no. 11145579-20 for VILLEROY & BOCH (filing date July 2, 2012, registered on November 21, 2013), Class 20;

Chinese trademark no. 11145578-21 for VILLEROY & BOCH (filing date July 2, 2012, registered on November 21, 2013), Class 21;

International Trademark Registration no. 586592 for VILLEROY & BOCH (dated March 2, 1992), designating Algeria, Austria, Azerbaijan, Benelux, Bulgaria, China, Croatia, Czech Republic, Egypt, France, Hungary, Italy, Liechtenstein, Monaco, Montenegro, Morocco, Poland, Portugal, Romania, Russian Federation, San Marino, Serbia, Slovakia, Slovenia, Spain, Switzerland, Tajikistan, and Viet Nam (Classes 6, 8, 11, 14, 19-21, 24 and 34);

International Trademark Registration no. 715818 for VILLEROY & BOCH (figurative, registered on February 23, 1999), designating Albania, Antigua and Barbuda, Armenia, Australia, Azerbaijan, Belarus, Bhutan, Bonaire, Saint Eustatius and Saba, Bosnia and Herzegovina, Botswana, Croatia, Cuba, Curacao, Egypt, Estonia, Georgia, Ghana, Iceland, Israel, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lesotho, Liberia, Lithuania, Madagascar, Moldova, Mongolia, Montenegro, Mozambique, Namibia, North Macedonia, Norway, Oman, Serbia, Sierra Leone, Singapore, Sint Maarten, Slovakia, Slovenia, Sudan, Sao Tome and Principe, Swaziland, Tajikistan, Turkmenistan, Türkiye, Ukraine, Uzbekistan, and Zambia (Classes 6, 8, 11, 19-21 and 24);

International Trademark Registration no. 758823 for VILLEROY & BOCH (dated January 17, 2001), designating Albania, Algeria, Antigua and Barbuda, Armenia, Austria, Azerbaijan, Belarus, Benelux, Bhutan, Bosnia and Herzegovina, Bulgaria, China, Croatia, Cuba, Czech Republic, Denmark, Egypt, Estonia, Finland, France, Georgia, Greece, Hungary, Iceland, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lesotho, Liberia, Liechtenstein, Lithuania, Moldova, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Democratic People's Republic of Korea, North Macedonia, Norway, Poland, Portugal, Romania, Russian Federation, San Marino, Serbia, Sierra Leone, Singapore, Slovakia, Slovenia, Spain, Sudan, Swaziland, Sweden, Switzerland, Tajikistan, Türkiye, Turkmenistan, Ukraine, United Kingdom, Uzbekistan, and Viet Nam (Classes 11, 20);

International Trademark Registration no. 1250183 for VILLEROY & BOCH (from January 22, 2015), designating Armenia, Australia, Azerbaijan, Belarus, Bosnia and Herzegovina, China, Egypt, Georgia, Iceland, India, Iran, Japan, Kazakhstan, Kyrgyzstan, Liechtenstein, Mexico, Moldova, Monaco, Montenegro, Morocco, Namibia, New Zealand, North Macedonia, Norway, Russian Federation, San Marino, Serbia, Singapore, Republic of Korea, Switzerland, Tajikistan, Tunisia, Türkiye, Turkmenistan, Ukraine, US, Uzbekistan, and Viet Nam (Classes 20, 25, 28).

The Complainant started out as a manufacturer of ceramics in 1748 and has around 7,000 employees and operates production facilities in 13 countries in Europe and Asia. Its products are sold in 125 countries worldwide which generated revenue of EUR 945 million in 2021.

The Complainant is the owner of various domain names incorporating its trademarks, such as <villeroy-boch.com>, <villeroy-boch.de>, and <villeroy-boch.us>.

The disputed domain name was registered on July 7, 2022. It resolves to an online shop allegedly offering for sale the Complainant's trademarked goods for a price below market value.

5. Parties' Contentions

A. Complainant

With 270 years of history, the Complainant's brand "Villeroy & Boch" is one of the oldest European brands. Over the years, the premium brand has accrued tremendous goodwill and reputation. The Complainant has produced tiles for the Titanic, the Holland Tunnel in New York City and developed tableware for the Vatican and the British royal family. More recently, the Complainant has been awarded numerous accolades by independent organizations, such as the German Design Award (2016, 2018, 2020, 2022), Kitchen Innovation

Awards 2018 and 2021, "Lieblingsmarke GOLD" (favorite brand) by Initiative LifeCare 2020, German Innovation Award 2019, German Brand Award 2017, interior innovation award 2011, reddot design award (multiple times in 2006 - 2021), iF Design Award (multiple times in 2006 - 2017), as well as The Chicago Athenaeum's GOOD DESIGN award 2015.

In light of the global repute as well as the longstanding and intensive use of the VILLEROY & BOCH mark, it is evident that the Complainant and its trademarks are well known not only in Germany, but also internationally. The disputed domain name reproduces the Complainant's well-known trademark VILLEROY & BOCH, the only difference being that the ampersand is written out as the word "and". This difference is, however, negligible. As the sign "&" cannot technically be included in a domain name, it is often replaced by the word "and".

The Respondent has no rights or legitimate interests in the disputed domain name . Before the Complainant became aware of the conflict, the Respondent had not been using either the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Moreover, there is no indication that the Respondent has made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use.

The disputed domain name is being used for the offer of tableware and cutlery and therefore the Complainant's core products. In fact, the products shown on the website at the disputed domain name are not only identical as a category; the Respondent is using hundreds of (copyrighted) photographs of the Complainant's products to imitate an offer of genuine "Villeroy & Boch" products at a reduced price on the website. The trademark VILLEROY & BOCH is not only used in the disputed domain name, but also prominently featured in the header of the website in the form of the Complainant's logo.

The overlap of goods and overall design of the website at the disputed domain name clearly shows the Respondent's intent to gain illegitimate commercial benefit by using a domain name which fully incorporates the Complainant's well-known trademark and by prominently using the Complainant's trademarks on the website under the disputed domain name. Evidently, the aim of the Respondent is to mislead and divert costumers who, upon arriving at the site under "www.villeroyandboch.shop" may mistakenly believe that the site either offers genuine products of the Complainant, or that it is affiliated with/endorsed by the Complainant.

There is no evidence that the Respondent or anyone not connected to the Complainant has ever been commonly known by the disputed domain name or by the mark VILLEROY & BOCH, nor could they become commonly known by either the disputed domain name or the mark VILLEROY & BOCH, at least with respect to the goods and services provided by the Complainant, without infringing upon the Complainant's exclusive trademark rights.

There is no evidence that the Respondent owns any prior rights in the name or trademark VILLEROY & BOCH. The Complainant has not licensed or otherwise permitted the Respondent to use its well-known and distinctive trade name or trademark VILLEROY & BOCH, or to apply for the registration of the disputed domain name.

Given the reputation and recognition of the VILLEROY & BOCH trademarks due to their longstanding, intensive and widespread use, the Respondent had to be fully aware of the existence of the Complainant and its marks when registering the disputed domain name. The Respondent could not have been unaware of the fact that the disputed domain name can attract Internet users in a manner that is likely to create confusion for such users. By using the well-known mark VILLEROY & BOCH as a second-level domain, the Respondent is evidently targeting the Complainant in order to take advantage of the reputation and notoriety of the Complainant's trademark.

The Respondent has used the disputed domain name with the intention to attract Internet users to a website, where identical products are offered, by creating a likelihood of confusion with the Complainant's VILLEROY

& BOCH trademarks and by taking an illegitimate advantage of the high reputation and distinctiveness of the Complainant's brand.

The facts that the Respondent is using a privacy service points to the existence of an underlying beneficiary to the disputed domain name not currently known to the Complainant. In light of the commercial and trademark-infringing activities conducted under the disputed domain name, the use of a privacy service adds to the evidence of bad faith

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the famous VILLEROY & BOCH mark and has shown that no other entity has rights in or uses the Complainant's mark. The substitute of "and" instead of "&" does not prevent the Complainant's trademark from being recognizable in the disputed domain name. The disputed domain name remains phonetically identical to the Complainant's trademark. The top-level domain ("TLD") ".shop" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has not been commonly known by the disputed domain name. The fact that the Respondent obtained the disputed domain name hundreds of years after the Complainant had begun using its VILLEROY & BOCH mark indicates that the Respondent sought to piggyback on the VILLEROY & BOCH mark for illegitimate reasons.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. Moreover, the evidence provided by the Complainant shows that the disputed domain name resolves to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the disputed domain name as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Irrespective of the disputed domain name satisfying the so-called *Oki Data* test, the phonetically identical nature of the disputed domain name to the Complainant's trademark carries a high risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain name,

and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

While circumstantial, the lack of authorization and the severely discounted prices found at the disputed domain name suggest that, should any products be sold at the disputed domain name, they are likely to be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a *bona fide* offering of goods or services or legitimate noncommercial or fair use (see section 2.13 of the WIPO Overview 3.0). Rather, such illegal use can never confer rights or legitimate interests upon a respondent.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the disputed domain name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the renown and uniqueness of the VILLEROY & BOCH mark, it is inconceivable that the Respondent registered the disputed domain name (phonetically identical to the Complainant's mark) in the TLD ".shop" without knowledge of the Complainant. The disputed domain name is used for a website that is allegedly selling products identical to those offered by the Complainant and bearing its trademarks, but the Complainant has established that the Respondent's use is not authorized, nor is affiliated with the Complainant in any way. The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the disputed domain name was registered and 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 <villeroyandboch.shop> be transferred to the Complainant.

/Colin O'Brien/

Colin O'Brien

Sole Panelist

Date: September 16, 2022