

ADMINISTRATIVE PANEL DECISION

Ralf Bohle GmbH v. Woyi Xiav

Case No. D2022-4478

1. The Parties

The Complainant is Ralf Bohle GmbH, Germany, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Woyi Xiav, Taiwan Province of China.

2. The Domain Name and Registrar

The disputed domain name <schwalbeparts.xyz> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 23, 2022. On November 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 24, 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 November 28, 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 December 2, 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 December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 24, 2022.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on January 6, 2023. 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 a German manufacturer of tires and other equipment and parts for bicycles and wheelchairs. It started manufacturing bicycle tires in 1973 under the trade mark SCHWALBE. The Complainant is present in over 40 countries.

As a basis for this Complainant, the Complainant relies of several trade marks, including the following:

- International trade mark SCHWALBE (below) no. 719983 registered since May 19, 1999, with effect in numerous countries;



- European Union trade mark SCHWALBE (word) no. 11061322 registered since July 23, 2012.

The Complainant also operates its activities online, through several domain names, including <schwalbe.com>, which was registered in 1995.

The disputed domain name was registered on June 7, 2022. The identity of the Respondent, an individual domiciled in Taiwan Province of China, was disclosed by the Registrar in the course of this proceeding.

For some time, the disputed domain name was used to host a commercial website which featured on top the trade mark of the Complainant, as registered with its logo, the slogan "cycling classic", and a picture below featuring a bicycle tire. The website displayed a number of products, all related to bicycle tires and related goods, and bearing the trade mark of the Complainant, and all subject to significant discounts. On the lower part of the website appeared the typical features of a commercial site, such as a cart, a section entitled "my account", and information relating to payments, shipment, etc.

When it became aware of the existence of this website, the Complainant took initiatives towards the Registrar and towards the contact details available in the Whois records, without success. However, the content of the website was disabled.

5. Parties' Contentions

A. Complainant

The arguments of the Complainant can be summarized as follows:

As a preliminary statement, the Complainant claims that its trade mark enjoys reputation, by virtue of its longstanding use and presence in numerous markets worldwide.

On the first element of the Policy, the Complainant notes that its trade mark SCHWALBE is reproduced identically in the disputed domain name and is clearly recognizable. The addition of the term "parts" relates to its activity, and therefore causes confusion.

On the second element of the Policy, the Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any authorization, license, or consent whatsoever to use the Complainant's trade marks in the disputed domain name or in any other manner. Also, the Respondent is not commonly known by the disputed domain name and does not hold any trade mark for the disputed domain name. The Complainant also indicates that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services, as it is deliberately creating

confusion with the Complainant's business. In this regard, the Complaint mentions that "the Complainant has never authorized the Respondent to offer for sale and sell the Complainant's products which gives the strong base for doubt that the Respondent had been offering and selling the counterfeit products of the Complainant through the website under the disputed domain name. Additionally, all products on the website had been offered for sale at the discounted price, with the discounts between 40% and 60% percent, and the Respondent had masked its identity, which circumstances suggest the Respondent's illegal activity in the form of selling the counterfeit goods".

On the third element of the Policy, the arguments of the Complainant are divided between bad faith registration and bad faith use:

On registration in bad faith, the Complainant highlights that the Respondent knew of its trade mark, which has been used for decades in many countries. In fact, the Respondent has reproduced it identically, with its logo, on its website. The Complainant also highlights that the Respondent is probably under the common control of the same individual, who registered over the same period several domain names incorporating its trade mark and that of another manufacturer of biking equipment.

On use in bad faith, the Complainant claims that the Respondent has sought to attract consumers for commercial gain, by creating a likelihood of confusion with its trade mark and activities. It has done so, possibly, by offering for sale counterfeit goods. In addition, the Complainant relies also on the doctrine of bad faith passive holding, as the content of the website hosted under the disputed domain name was disabled.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in this proceeding:

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

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trade mark or a service mark in which it has rights. As per the Center's practice, this first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds rights over the trade mark SCHWALBE, as registered in multiple jurisdictions.

The disputed domain name <schwalbeparts.xyz> includes the Complainant's trade mark in its entirety, combined with the term "parts". This addition does not prevent the Complainant's trade mark from being recognizable in the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive,

geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

As the disputed domain name includes the Complainant’s trade mark in its entirety combined with a term that does not prevent the Complainant’s trade mark from being recognizable, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trade mark.

Therefore, the first element of the Policy is satisfied.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production to demonstrate rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see [WIPO Overview 3.0](#), section 2.1).

In this case, the Respondent has not rebutted the allegations made by the Complainant. The Respondent has no rights, and no legitimate interests, in the disputed domain name.

Besides, the operation by the Respondent of a website which impersonates that of the Complainant, and which uses the trade marks of the Complainant, is likely to mislead Internet users and does not amount to a *bona fide* offering of goods or services under the disputed domain name. In this respect, determining whether the goods offered for sale by the Respondent were genuine or not is not essential: even assuming that these goods were authentic, in any event the Respondent did not disclose the nature of its relationship with the Complainant, and therefore the “Oki Data Test” fails. Indeed, section 2.8.1 of [WIPO Overview 3.0](#) requires that the website of a reseller of authentic goods accurately and prominently disclose the registrant’s relationship with the trade mark holder.

In addition, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of [WIPO Overview 3.0](#).

For this reason, and failing any specific allegation by the Respondent, the second element of the Policy is deemed to be satisfied.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances, which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant’s trade mark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the disputed domain name, [the respondent has] intentionally attempted 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.

Preliminary remark regarding the likely involvement of the Respondent in a series of cybersquatting activities

As a preliminary remark, the Panel notes that the Respondent may well have had control over other domain names which have also been subject of UDRP proceedings. In the parallel case *Ralf Bohle GmbH v. Whois Agent, Domain Protection Services, Inc. /Jgdg Ybdeg*, WIPO Case No. [D2022-4477](#), which likewise presents a number of similarities and thus leads the Panel to presume that the Respondents might be related. For instance, the disputed domain name is configured in a similar manner and reproduces the same Trademark SCHWALBE. Moreover, both disputed domain names were registered on the same day. Further, both domain names were used to host websites with a very similar layout (title, products, discounts, final sections, etc.), and were taken down after the Complainant sent inquiries. This presumption, adds to the Panel's belief that the Respondent acted in bad faith by entering into a pattern of registration of domain names and with the effect of disrupting the activities of competitors in the field of biking equipment.

Regardless of the above presumption, the Respondent has clearly registered and used the disputed domain name in bad faith, basically for the following reasons:

First, the Respondent specifically targeted the Complainant when it configured the disputed domain name, by combining the distinctive trade mark SCHWALBE and the term "parts", that can relates to the Complainant's business.

Second, the Respondent has used the disputed domain name to host a commercial site that impersonates that of the Complainant and is highly likely to create a likelihood of confusion to the detriment of consumers and of the Complainant.

The fact that the Respondent disabled the website hosted under the disputed domain name, probably when the Complainant attempted to contact him/her is implicit recognition of the wrongful conduct..

Finally, the Respondent provided false contact details, which is an additional factor characterizing bad faith.

The third element of the Policy is satisfied, and pursuant to the request of the Complainant, the disputed domain name should be transferred.

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, <schwalbeparts.xyz> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: January 19, 2023