

ADMINISTRATIVE PANEL DECISION

Munters Israel Ltd. v. Tom Yu / 于龙飞 (Yu Long Fei), 青岛达克思农业科技有限公司 (Qingdao DKS Agri Tech Co., Ltd)

Case No. D2022-4811

1. The Parties

The Complainant is Munters Israel Ltd., Israel, represented by Zacco Sweden AB, Sweden.

The Respondent is 于龙飞 (Yu Long Fei), 青岛达克思农业科技有限公司 (Qingdao DKS Agri Tech Co., Ltd), China.

2. The Domain Name and Registrar

The disputed domain name <rotem-china.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 15, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent and contact information in the Complaint. On the same day, the Center sent an email communication to the Complainant providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Complainant filed an amendment to the Complaint in English.

On December 16, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On the same day, 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 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 December 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2023. A third party sent informal emails on December 27, 2022, December 29, 2022 and January 4, 2023, respectively, claiming to have been an accountant for the Respondent's company until June 2017 and asking not to receive any further correspondence in this proceeding. The Respondent did not submit any response. Accordingly, the Center notified the commencement of the Panel appointment process on January 17, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on January 24, 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 was founded as Rotem Israel Limited in 1981 and specializes in computerized control and management systems for agricultural applications. Following a joint venture that began in 2011, it was fully acquired by the Munters Group in 2016 and renamed Munters Israel Limited. Since that time, the Complainant has identified itself as "ROTEM – a Munters company" and used both ROTEM and MUNTER branding. The Complainant holds multiple trademark registrations for ROTEM, including the following:

- European Union trademark registration number 003457322, registered from April 21, 2005, specifying goods in class 9; and
- Chinese trademark registration number 4939321, registered from September 14, 2018, specifying goods in class 9.

The above trademark registrations remain current. The Complainant registered the domain name <rotem.com> in 1997, which it used in connection with its own website until at least 2017. Its website prominently displayed the ROTEM mark with a figurative element (the "ROTEM logo") and provided information about the Complainant and its products and services. The domain name <rotem.com> now redirects to <munters.com>, where the Munters Group provides information about itself, its products and services.

The Respondent is an individual resident in China (Yu Long Fei) and a Chinese company (Qingdao DKS Agri Tech Co., Ltd). According to the website associated with the disputed domain name, Yu Long Fei served as the chief representative in the Complainant's China office for over 11 years from 2008. According to evidence provided by the Complainant, Yu Long Fei worked for a Munters Group company named 蒙特空气处理设备（北京）有限公司 (Munters Air Treatment Equipment (Beijing) Co., Ltd) from 2017 but resigned with effect from August 15, 2018.

The disputed domain name was registered on October 21, 2018. It resolves to a website promoting the Complainant's products and offering after sales service and maintenance for them. The website prominently displays the ROTEM logo above the words "Control & management" as they appeared on the Complainant's website prior to its acquisition by the Munters Group. Otherwise, the website reproduces the layout and design of the Complainant's website homepage as it looked in 2017 with the title "Take Control" and most other text in Chinese. Alongside the title there appears the following text in small font: "北京九州卓越科技发展有限公司全国经销 ROTEM 品牌相关产品" which may be translated as "Beijing Jiuzhou Excellent Technology Development Co., Ltd distributes ROTEM brand-related products nationwide". The website provides news about ROTEM and information about its activities. As recently as 2021, the company presentation tab stated that this company was established by Yu Long Fei and that one of its main businesses is the distribution and sale of ROTEM Israel's products in China, as well as the provision of after sales service and technical support. The site set out the corporate history of the Complainant and the ROTEM brand up until 2015. It added that in 2019, Yu Long Fei and another former employee of the Complainant set up a product technology, after sales service and maintenance center in Qingdao and

continued to provide all kinds of service to former customers.

The Complainant's Chinese legal representative sent a cease-and-desist letter dated May 20, 2021 to Beijing Jiuzhou Excellent Technology Development Co., Ltd and a follow-up email on June 7, 2021, in which it requested a transfer of the disputed domain name. The Respondent replied by email on June 11, 2021, denying trademark infringement but offering to close the website and transfer the disputed domain name for CNY 25,000.

5. Parties' Contentions

A. Complainant

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

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent was an employee of the Complainant/Munters Group until August 15, 2018. No license or authorization has been given by the Complainant or the Munters Group to the Respondent to use the ROTEM trademark. The Respondent is not an authorized dealer in the Complainant's products or services and was not affiliated with the Complainant or the Munters Group at the point when the disputed domain name was registered. The Respondent has intentionally chosen the disputed domain name based on another party's trademark to generate traffic and income through a website selling products and services in direct competition with the Complainant. The Respondent has prominently included the Complainant's logotype and similar website design in order to create the impression that his website is somehow connected to the Complainant.

The disputed domain name was registered and is being used in bad faith. The disputed domain name was registered subsequent to the Complainant's registration of its ROTEM mark in China and after the Respondent left his employment with the Complainant/Munters Group. The Respondent was fully aware of the Complainant and its ROTEM trademark at the time of registration. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to his own 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. The Respondent has also registered the disputed domain name for the purpose of selling, renting or otherwise transferring it to the Complainant for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name.

B. Respondent

The Respondent did not submit any response in this proceeding.

6. Discussion and Findings

6.1. Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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 Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the disputed domain name contains an English word and resolves to a website partly in English; the Respondent is an ex-employee of the Complainant with whom the Complainant communicated in English prior to this dispute; and translation would be cumbersome, costly and delay the process.

Paragraph 10(b) and (c) of the Rules requires the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that in this proceeding the Complaint and the amendment to the Complaint were filed in English. The website associated with the disputed domain is partly in English and pre-Complaint correspondence between the Parties or their representatives was in Chinese. However, despite the Center having sent the notification of the Complaint and an email regarding the language of the proceeding in both Chinese and English, the Respondent has not commented on the issue of language nor expressed any interest in otherwise participating in this proceeding, while a third party who replied asked not to be included in further correspondence. Therefore, the Panel considers that requiring the Complainant to translate the Complaint, as amended, would create an undue burden and delay, whereas accepting it as filed without translation will not cause unfairness to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed.

6.2. Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the ROTEM mark.

The disputed domain name wholly incorporates the ROTEM mark. It adds the country name "China", separated from the mark by a hyphen. The addition of this geographical term does not avoid a finding of confusing similarity because the ROTEM mark remains clearly recognizable in the disputed domain name.

The only additional element in the disputed domain name is a generic Top-Level Domain ("gTLD") extension, ".com". As a standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the Complainant's mark.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (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 trademark 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 trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name incorporates the Complainant's ROTEM mark and the country name "China", which may imply that it will resolve to the website of the Complainant's Chinese affiliate. The website to which the disputed domain name resolves prominently displays the Complainant's ROTEM logo, reproduces the layout and images on the Complainant's former website, promotes the Complainant's products and offers after sales service and maintenance for them. Although the website displays the name of the Respondent's company, and the corporate history page clarifies that the Respondent is a former employee of the Complainant, the clear overall impression is that the website and the services offered on it are affiliated with, or endorsed by, the Complainant. However, the Complainant submits that neither it nor its group has given any license or authorization to the Respondent to use the ROTEM trademark, that the Respondent is not an authorized dealer in its products or services, and that the Respondent is no longer affiliated with the Complainant or its group. In view of these circumstances, the Panel considers that the Complainant has made a *prima facie* case that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, nor is it making a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance set out above, the Respondent individual is identified in the Registrar's Whois database as "于龙飞" and "Yu Long Fei", while his email user name is "Tom Yu". The Respondent company is identified in the Registrar's Whois database as "青岛达克思农业科技有限公司" and "Qingdao DKS Agri Tech Co., Ltd", while his company is identified on the website associated with the disputed domain name as "北京九州卓越科技发展有限公司" which may be translated as "Beijing Jiuzhou Excellent Technology Development Co., Ltd". None of these names is "Rotem China". There is no evidence that the Respondent has been commonly known by the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent did not file a response in this proceeding but in prior correspondence with the Complainant's legal representative, the Respondent Yu Long Fei alleged that the website associated with the disputed domain name stated clearly and prominently on the homepage that his company was only an agent and distributor of the relevant products, which he considered normal advertising and commercial practice. However, the Panel observes that the statement identifying the Respondent's company is unclear, as it appears in small type in white letters on a pale blue background, albeit in a prominent position. In any case, the statement fails to clarify that the Respondent's company is not an authorized agent, distributor or service center for the Complainant's products. On the contrary, the website gives the false impression that it is affiliated with, or endorsed by, the Complainant. Therefore, the Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (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.

As regards registration, the disputed domain name was registered in October 2018, after the registration of the Complainant's ROTEM mark. The Respondent individual was aware of the Complainant's mark because he was a former employee of the Complainant or a related company and his website displays the Complainant's ROTEM logo, promotes the Complainant's products and offers service for them. According to evidence presented by the Complainant, the Respondent individual terminated his employment with the company in the Complainant's corporate group in August 2018, which was two months prior to the registration of the disputed domain name. The Complainant submits that the Respondent individual was not affiliated with the Complainant or its corporate group at the point when the disputed domain name was registered. Nothing suggests that the Respondent company Qingdao DKS Agri Tech Co., Ltd has ever been affiliated with the Complainant; in fact, the Respondent's website confirms that its Qingdao-based company was formed after Yu Long Fei left the Complainant's corporate group. In view of these circumstances, the Panel finds that the Respondent registered the Complainant's ROTEM trademark in the disputed domain name with full knowledge of the Complainant but without authorization.

As regards use, the disputed domain name incorporates the Complainant's ROTEM trademark, combined with the country name "China", and resolves to a website promoting the Complainant's products and offering service for them. The website reproduces the layout and images on the Complainant's former website, including the Complainant's ROTEM logo, and presents the Complainant's corporate history and news, giving the false impression that the Respondent's website and the services offered on it are affiliated with, or endorsed by, the Complainant, despite the identification of the Respondent's company. Given the Panel's findings in section 6.2B above, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's ROTEM mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the services offered on that website within the terms of paragraph 4(b)(iv) of the Policy.

The Panel takes note that the Respondent offered to sell the disputed domain name to the Complainant for CNY 25,000 in 2021. However, given the use to which he has put the disputed domain name in connection with his website, it does not seem likely that his primary purpose in registering the disputed domain name was to sell it.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in 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 <rotem-china.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: February 7, 2023