

ADMINISTRATIVE PANEL DECISION

Voith GmbH & Co. KGaA v. Channel Factory
Case No. D2023-0780

1. The Parties

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

The Respondent is Channel Factory, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <voith.online> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 21, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 24, 2023, 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 on February 24, 2023.

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 February 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2023. On March 8, 2023, the Center received an email from a third party indicating that it received notice of the Complaint in its office. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 21, 2023.

The Center appointed Andrea Mondini as the sole panelist in this matter on March 23, 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 based company, active in the energy, oil and gas, paper, raw materials, and transport and automotive fields. Founded already in 1867, the Complainant today employs more than 20,000 people, operates in about 60 countries around the world and is today one of the largest family-owned companies in Europe.

The Complainant owns numerous registrations of the trademark VOITH, *inter alia*, the International Trademark Registrations (“IR”) No. 405353 registered on December 7, 1973, IR No. 178950 registered on August 20, 1954, and IR No. 447007 registered on August 22, 1979.

The Complainant also holds several domain names, including the domain names <voith.com> and <voith.de>.

The disputed domain name was registered on December 9, 2022.

The disputed domain name resolves to a sponsored links / pay-per-click (PPC) site, linking and redirecting to goods and services in the Complainant’s business fields.

5. Parties’ Contentions

A. Complainant

The Complainant contends as follows:

The disputed domain name is confusingly similar to the VOITH trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, with the addition of the generic Top-Level Domain “.online”.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not known by the disputed domain name and has not been licensed or otherwise authorized by the Complainant to use this trademark.

The disputed domain name was registered and is being used in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its well-known trademark VOITH at the time it registered the disputed domain name and is using the disputed domain name to host sponsored PPC links. Furthermore, it must be expected that the Respondent is or at least might be using the disputed domain name for email communication, impersonating the Complainant by using email addresses with a similar/identical domain name, because there are active MX records available for the disputed domain name.

B. Respondent

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

On March 8, 2023, the Center received an email from a third party (an international law firm with offices at the address provided by the Registrar as the Respondent’s address) stating that it received notice of the Complaint in its office but that they were not representing the Respondent in this matter.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the 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 Panel is satisfied that the Complainant owns trademark registrations for its VOITH trademark.

The Panel notes that the disputed domain name incorporates the VOITH trademark in its entirety.

The addition of the Top-Level Domain “.online” in the disputed domain name is a standard registration requirement and as such is disregarded under the confusing similarity test under Policy, paragraph 4(a)(i). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11.

For these reasons, the Panel concludes that the disputed domain name is identical to the Complainant’s mark VOITH.

The first element of paragraph 4(a) of the Policy has been met.

B. Rights or Legitimate Interests

The Complainant states it has not authorized or licensed the Respondent to use the trademark VOITH and that the Respondent is not known by the disputed domain name. The Panel does not see any contrary evidence from the record.

In the view of the Panel, the Complainant has succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. For its part, the Respondent failed to provide any explanations as to any rights or legitimate interests. Moreover, the identical disputed domain name carries a high risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use, particularly given its use for sponsored links. Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The second element of paragraph 4(a) of the Policy has been met.

C. Registered and Used in Bad Faith

The Complainant has shown to the satisfaction of the Panel that its VOITH trademark is well-known.

In the view of the Panel, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant’s well-known trademark, particularly considering that the disputed domain name resolves to a sponsored links / pay-per-click site, linking and redirecting to goods and services related to those provided by the Complainant. In the circumstances of this case, this is evidence of registration in bad faith.

By using the disputed domain name for a sponsored links /pay per click site, the Respondent is misleading Internet users to its website, for commercial gain, only by profiting of the Complainant’s mark and its reputation. The Panel thus 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 as to the source, sponsorship or affiliation of its website in the sense of paragraph 4(b) (iiv) of the Policy.

Furthermore, the communication received by the Center from a third party shows that the Respondent furnished false contact information when registering the disputed domain name, which is further evidence of bad faith. Similarly, it appears that the Respondent may have engaged in the use of a privacy service, seeing as the previously named Respondent was “Privacy service provided by Withheld for Privacy ehf”, to which the Center’s written communication was unable to be delivered – the courier reporting that the related contact details were a “bad address”.

The Panel thus finds that the disputed domain name was registered and is being used in bad faith.

The third element of paragraph 4(a) of the Policy has been met.

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 <voith.online> be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: April 6, 2023