

ADMINISTRATIVE PANEL DECISION

Ralf Bohle GmbH v. Wanfu Yu

Case No. D2023-0794

1. The Parties

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

The Respondent is Wanfu Yu, China.

2. The Domain Name and Registrar

The disputed domain name <schwalbepneus.com> is registered with Name.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 22, 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 23, 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 (Whois Agent, Domain Protection Services, Inc.) 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 amended Complaint on February 28, 2023.

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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 24, 2023. The Center received an informal email from the Complainant on March 24, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on April 3, 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. The company is headquartered in Reichshof, Germany since 1995. The predecessor company started as family business in 1922. The Complainant started manufacturing bicycle tires in 1973 under its brand name SCHWALBE, which brand name became renowned in the field of pneumatic tires and parts for bicycles and wheelchairs. The Complainant is with its SCHWALBE products present in the market in more than 40 countries around the world, and, besides Germany, it has international affiliates in the United Kingdom, Netherlands, France, Italy and the United States of America.

The Complainant is the owner of the trademark SCHWALBE ("SCHWALBE trademark"), including:

- International Registration SCHWALBE (combined) No. 719983, registered on May 19, 1999;
- International Registration SCHWALBE No. 1171528, registered on July 17, 2013;
- European Union Trade mark registration SCHWALBE No. 011061322, registered on December 18, 2012;
- United States of America Registration SCHWALBE (combined) No. 2482677, registered on August 28, 2001; and
- German Trademark registration SCHWALBE No. 39822240, registered on June 17, 1998.

The Complainant is also owner of numerous domain names including the SCHWALBE trademark, *inter alia* the domain names <schwalbetires.us>, <schwalbe.nl>, <schwalbe.it>, <schwalbe.eu>, <schwalbe.fr>, and <schwalbe.bike>.

The Respondent registered the disputed domain name on December 13, 2022. At the time of decision and when the Complaint was filed, it resolved to a website that promotes SCHWALBE-branded products at heavily discounted prices.

5. Parties' Contentions

A. Complainant

The arguments put forward by the Complainant can be summarized as follows:

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the Complainant's SCHWALBE trademark. The earliest SCHWALBE trademark predates the disputed domain name by 24 years. Further, the disputed domain name includes the entire SCHWALBE trademark, with only the addition of the term "pneus", which is the plural form for "tyre" in French, and the generic Top-Level Domain ("gTLD") ".com". The addition of a term, such as "pneus", does not distinguish the disputed domain name from the SCHWALBE trademark.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use and register its

SCHWALBE trademark or to seek registration of any domain name incorporating said mark. Based on all available information, the Respondent did not demonstrate use of the disputed domain name in connection with a *bona fide* offering of goods or services. Furthermore, ever since the Complainant became aware of the disputed domain name, it has resolved to an active website seemingly offering the Complainant's products and representing the Complainant's logo at the top of the webpage. The Complainant has never concluded any agreement, gave any license, or otherwise authorized or allowed the Respondent to use its SCHWALBE trademark and logo in any way. To the best of the Complainant's knowledge, the Respondent has not been commonly known by the name "schwalbe" nor "schwalbepneus". Also, the Complainant is not familiar with any trademark registrations made by the Respondent for "schwalbe" or "schwalbepneus" trademarks. Further, 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 counterfeit products with the Complainant's mark through the website under the disputed domain name. Additionally, all products on the website had been offered for sale at a heavily discounted price, and the Respondent had masked its identity, which circumstances suggest the Respondent's illegal activity in the form of selling counterfeit goods. These circumstances clearly indicate that the Respondent has been using the disputed domain name for commercial activity, and it certainly cannot be considered as legitimate noncommercial use of the disputed domain name.

On the third element of the Policy, the Complainant asserts that the Respondent registered and used the disputed domain name in bad faith. The Respondent's bad faith registration and use of the disputed domain name are established by the fact that the disputed domain name incorporates the Complainant's entire SCHWALBE trademark, with only the addition of a descriptive term, and the disputed domain name was registered decades after the Complainant's SCHWALBE trademark became well-known. The Respondent's reproduction and display of the Complainant's logo leaves no doubt that the Respondent knew of the Complainant and its rights prior to registering and using the disputed domain name. In view of the extensive use of the Complainant's SCHWALBE trademark, and the fact that the Respondent has no rights in it, the Complainant reasonably believes that the Respondent registered and is using the disputed domain name not for any legitimate noncommercial or fair use purpose. The Respondent's bad-faith registration and use of the disputed domain name are also evidenced by the fact that the Respondent has intentionally attempted to attract Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's SCHWALBE trademark as to the source, affiliation, or endorsement of the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (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

The Complainant, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

The Complainant is registered as the owner of several trademarks containing SCHWALBE. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the SCHWALBE trademark.

The disputed domain name contains the SCHWALBE trademark entirely with the addition of the term “pneus”, which is the plural form for “tyre” in French, as well as the gTLD “.com”. Section 1.8 of [WIPO Overview 3.0](#) states: “Where the relevant trademark 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.” Further, section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable TLD in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” The gTLD “.com” will therefore be discounted in the Panel’s consideration of confusing similarity. The Panel finds that the relevant trademark SCHWALBE within the disputed domain name is recognizable, so that the additional elements do not prevent a finding of confusing similarity.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, “where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. Section 2.13 of [WIPO Overview 3.0](#) reads: “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.” Further, “panels have found that circumstantial evidence can support a complainant’s otherwise credible claim of illegal respondent activity. Evidence that the goods are offered disproportionately below market value, that the goods are only sold under license or through a prescription (especially with pharmaceutical products), that the images of the goods *prima facie* suggest (e.g., where the relevant logo is distorted) that they are not genuine, that the respondent has misappropriated copyrighted images from the complainant’s website, that the goods are extremely rare, that the goods have prompted consumer complaints, or that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant in this regard.”

According to the Complainant, the Complainant has not authorized the Respondent to use the Complainant’s trademarks, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with

a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered. In addition, the Panel finds that the composition of the disputed domain name, adding the descriptive term “pneus” to the Complainant’s SCHWALBE trademark, coupled with the use of the disputed domain name to resolve to a website in which the Respondent tries to impersonate the Complainant, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant as to the origin or affiliation of the website at the dispute domain name. Further, all products on the Respondent’s website are offered for sale at a heavily discounted price, which circumstance suggests the Respondent’s illegal activity in the form of selling counterfeit goods (as claimed by the Complainant).

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered or is using the disputed domain name in bad faith. Section 3.1 of [WIPO Overview 3.0](#) states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. Section 3.1 of [WIPO Overview 3.0](#) states, “given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith”. Further, section 3.2.2 of the [WIPO Overview 3.0](#) reads: “Noting the near instantaneous and global reach of the Internet and search engines and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

Considering the reputation and public presence of the Complainant, and the inclusion of the Complainant’s logo at the top of the website to which the disputed domain name resolves, it is highly unlikely that the Respondent had no knowledge of the SCHWALBE trademark. The Panel finds that the word “schwalbe” within the disputed domain name suggests, wrongly, that there is a connection between the Respondent and the Complainant. Consideration of the term “pneus” highlights a likelihood of confusion with the SCHWALBE trademark because it implies an indication of tires or similar goods offered under the SCHWALBE trademark. Further, at the time of decision and when the Complaint was filed, the disputed domain resolved to a website that promotes SCHWALBE-branded products. The Panel finds that the incorporation of the trademark SCHWALBE within the disputed domain name and its use for a website impersonating the Complainant concretely reflects the Respondent’s actual awareness of and intent to target the Complainant. Moreover, all products on the Respondent’s website are offered for sale at a heavily discounted price, which circumstance suggests the Respondent’s illegal activity in the form of selling counterfeit goods. In light of the lack of any rights to or legitimate interests in the disputed domain name of the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant’s trademarks.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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, <schwalbepneus.com>, be transferred to the Complainant.

/Christian Gassauer-Fleissner/

Christian Gassauer-Fleissner

Sole Panelist

Date: April 13, 2023