

ADMINISTRATIVE PANEL DECISION

Villeroy & Boch AG v. OOO Aristos Riteyl

Case No. D2023-1261

1. The Parties

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

The Respondent is OOO Aristos Riteyl, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <villeroy-and-boch.store> (the “Domain Name 1”), <villeroy-boch.market> (the “Domain Name 2”) and <villeroy-boch.online> (the “Domain Name 3”) (collectively referred to as the “Domain Names”) are registered with RU-CENTER-MSK (Regional Network Information Center, JSC dba RU-CENTER) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 23, 2023. On March 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 24, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On March 28, 2023, the Center sent an email to the Parties in both English and Russian regarding the language of the proceedings. On March 28, 2023, the Complainant reconfirmed its request that English be the language of the proceedings. The Respondent did not provide any comments regarding the language of the proceedings.

The Center verified that 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 in both Russian and English, and the proceedings commenced on April 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2023. The Respondent did not submit a

response within this deadline. Accordingly, the Center notified the Respondent's default on May 4, 2023. On May 24, 2023, the Respondent submitted a late Response in English.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on May 16, 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 ceramics founded in 1748. Currently, the Complainant's products are sold in 125 countries worldwide.

The Complainant is the owner of numerous VILLEROY & BOCH trademark registrations, including:

- the International Trademark Registration VILLEROY & BOCH (figurative) No. 586592 registered on March 2, 1992;
- the International Trademark Registration VILLEROY & BOCH (word) No. 715818 registered on February 23, 1999; and
- the European Union Trade Mark Registration VILLEROY & BOCH (word) No. 001840362 registered on January 4, 2002.

The Complainant is also the owner of numerous domain names incorporating the VILLEROY & BOCH trademark, including <villeroy-boch.com>.

The Domain Names were registered on February 5, 2023.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Names have resolved to the Registrar's parking page.

5. Parties' Contentions

A. Complainant

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Names are confusingly similar to the VILLEROY & BOCH trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Names.

Third, the Complainant contends that the Domain Names were registered and are being used in bad faith.

B. Respondent

In its late Response, the Respondent submitted that it does not have any objections to the Complaint and agree to cancel the Domain Names "not later than 5 days after this response".

6. Discussion and Findings

6.1. Preliminary Matters

A. Language of the Proceeding

The language of the Registration Agreement for the Domain Names is Russian. 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 Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainant has submitted a request that the language of the proceeding be English. The Complainant notes that the Registration Agreement is available in both English and Russian. Moreover, the Complainant submits that the Respondent provided a contact information in the Whois which leads to the Registrar’s website available in English. Furthermore, the Complainant argues that the Domain Names include English words such as “market”, “online”, “store”, “and”. According to the Complainant, this confirms that the Respondent communicates in English.

The Panel considers that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment on the language of the proceeding, even though it was notified in English and Russian regarding the language of the proceeding. In addition, the Respondent submitted a late response in English, which indicates that he understands English.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

B. Consolidation of the multiple Domain Names

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In the present case, the Domain Names are registered by the same domain-name holder. Thus, this proceeding relates to all three Domain Names.

C. Late Response

The due date for the Response was May 2, 2023. The Response was filed with the Center on May 24, 2023.

Pursuant to paragraph 14(a) of the Rules, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint. The Panel may therefore consider the Respondent’s late Response in its discretion if it finds that exceptional circumstances are present.

Moreover, paragraph 14(a) of the Rules is counterbalanced by paragraph 10(b) of the Rules, which provides that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

In the present case, notwithstanding the fact that the Respondent has not claimed any exceptional circumstances, the lateness of the filing of the Response has not prejudiced the Complainant nor has it delayed the Panel's decision. The Panel therefore deems it appropriate to admit the Respondent's late Response.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

The first element requires that the Complainant must establish that the Domain Names are identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid VILLEROY & BOCH trademark registrations which precede the registration of the Domain Names. The Domain Names incorporate this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The Domain Name 1 differs from the Complainant's VILLEROY & BOCH trademark merely by the replacement of an ampersand separating the terms “villeroy” and “boch” with the term “-and-”. This does not prevent a finding of confusing similarity between the Domain Name 1 and the Complainant's VILLEROY & BOCH trademark. UDRP panels have consistently held that 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. See section 1.8, [WIPO Overview 3.0](#).

Moreover, the Domain Name 2 and the Domain Name 3 differ from the Complainant's VILLEROY & BOCH trademark merely by the replacement of an ampersand separating the terms “villeroy” and “boch” with a hyphen. It is well established that use or absence of punctuation marks, such as hyphens, does not alter the fact that a trademark is recognizable within the disputed domain name. See *Six Continents Hotels, Inc. v. Helen Siew*, WIPO Case No. [D2004-0656](#).

The generic Top-Level Domains (“gTLDs”) “.store”, “.market” and “.online” in the Domain Names are viewed as a standard registration requirement and as such are disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Names are confusingly similar to the VILLEROY & BOCH trademark in which the Complainant has rights. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second requirement, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Names.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate, noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's VILLEROY & BOCH trademark registrations predate the Respondent's registration of the Domain Names. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the VILLEROY & BOCH trademark or to register the Domain Names incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Names.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Names in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Names. On the contrary, at the time of submitting the Complaint and as of the date of this Decision, the Domain Names have resolved to inactive websites. In fact, it does not result from the case evidence that the Domain Names have been used in any active way to date.

Finally, the Panel acknowledges that in the late Response, the Respondent submitted that it does not have any objections to the Complaint and agree to cancel the Domain Names.

Given the above, the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Names have been registered and are being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (ii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or

- (iii) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the VILLEROY & BOCH trademark predate the registration of the Domain Names. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration, as it has been proven to the Panel's satisfaction that the Complainant's VILLEROY & BOCH trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products under this trademark. In sum, the Respondent in all likelihood registered the Domain Names with the expectation of taking advantage of the reputation of the Complainant's VILLEROY & BOCH trademark.

Furthermore, as of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Names have resolved to inactive websites. Considering the overall circumstances of this case, the Panel finds that the Respondent's passive holding of the Domain Names does not prevent a finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, would not prevent a finding of bad faith under the Policy. See section 3.3 of the [WIPO Overview 3.0](#). Here, given the well-known nature of the Complainant's trademark, the Respondent's failure to participate in the proceeding, and the implausible good faith use to which the Domain Names may be put, the Panel agrees with the above.

Finally, the Panel acknowledges again that in the late Response, the Respondent submitted that it does not have any objections to the Complaint and agree to cancel the Domain Names.

For the reasons discussed above, the Panel finds that the Complainants have proved the requirements under 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 Domain Names <villeroy-and-boch.store>, <villeroy-boch.market> and <villeroy-boch.online> be cancelled.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: May 26, 2023