

ADMINISTRATIVE PANEL DECISION

TTS Tooltechnic Systems AG & Co. KG v. Wfcnej Ynbw, Xncsh Gvcaw
Case No. D2023-1374

1. The Parties

The Complainant is TTS Tooltechnic Systems AG & Co. KG, Germany, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Wfcnej Ynbw, Hong Kong, China and Xncsh Gvcaw, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <discountfestool.com> and <storefestool.com> are registered with Name.com, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2023. On March 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 1, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, 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 April 3, 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 April 6, 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 April 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on May 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 is the parent company of Festool GmbH, which was founded in 1925 under a different company name, becoming Festool GmbH in 2000. Since 2000, the FESTOOL brand is used for the production and commercialization of a wide range of high-end power tools and devices. Per the Complaint, the Complainant and its group owns over 350 patents and 80 awards in connection with the FESTOOL brand, this brand is present in 68 countries (with operating subsidiaries in 25 of them, including the United Kingdom, United States of America (“United States”), Russian Federation, and South Korea), and employs over 2,700 people.

The Complainant owns various trademark registrations for the FESTOOL brand, including:

- German Trademark Registration No. 39743235, FESTOOL, registered on October 2, 1998, in class 7;
- Mexican Trademark Registration No. 624172, FESTOOL, registered on September 22, 1999, in class 7;
- United States Trademark Registration No. 2511607, FESTOOL, registered on November 27, 2001, in classes 7, 8, 9, and 16;
- Australian Trademark Registration No. 804051, FESTOOL, registered on August 17, 1999, in classes 7, 8, and 9;
- European Union Trademark Registration No. 5561402, FESTOOL, registered on October 19, 2007, in classes 7, 8, 9, 11, 17, 20, and 35; and
- International Trademark Registration No. 1473385, FESTOOL, registered on March 6, 2019, in classes 7, 9, 11, 20, 35, 36, 37, 38, 41, and 42, (collectively hereinafter referred as the “FESTOOL mark”).

The Complainant and its group further own various domain names corresponding to the FESTOOL brand, including <festool.com> (registered on October 13, 1999), which is used since 1999 for the main official website for this brand, and various country code Top-Level Domains (“ccTLD”) that resolve to tailored sites for different jurisdictions, including <festool.de>, <festool.dk> and <festool.co.za>.

The disputed domain name <discountfestool.com> (“First Disputed Domain Name”) was registered on August 12, 2022, and the disputed domain name <storefestool.com> (“Second Disputed Domain Name”) was registered on August 15, 2022.

Both disputed domain names resolve to almost identical websites, in English language, that include the FESTOOL mark, in green capital letters (same graphic representation used by the Complainant’s group), at their headings, and purportedly commercialize discounted power tools and devices of this trademark. These websites reproduce the Complainant’s official website design and color combination, and display photographs of the FESTOOL products that are identical to the ones included in the Complainant’s site, claiming copyright in this material and the respective websites. These websites display a green capital letter “F” within their tap interface. These websites do not include any information related to their owner or that of the disputed domain names; the owner of these sites identifies itself as “discountfestool.com” or “storefestool.com” in their respective copyright note and “About us” sections, and these websites do not indicate their lack of relationship with the Complainant and its trademark.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The FESTOOL mark is well-known internationally. It has acquired up to 80 awards, the Complainant's group official websites for this trademark received an average of 283,000 visits per month during the period ranging December 2022 – February 2023. Similarweb.com ranks the website "www.festool.com" as the 114,274th most popular website in the United States, and the 737th in its sector.

The disputed domain names are confusingly similar to the FESTOOL mark. The disputed domain names incorporate the FESTOOL mark adding the terms "discount" and "store" to the beginning of the trademark, which does not avoid the confusing similarity. The generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. The use of the disputed domain names further contributes to the confusion.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not commonly known by the disputed domain names, has not been authorized to use the FESTOOL mark, and is not sponsored by or affiliated with Complainant. The use of the disputed domain names in connection to websites that attempt to duplicate the Complainant's official website, and display the Complainant's logo and images taken from the Complainant's official website, cannot be considered a *bona fide* offering of goods or services. The Respondent's websites attempt to deceive Internet users into believing that these sites are associated with the Complainant. The requirements of the "*Ok! Data* test" are not met, as the Respondent's websites do not contain any indication accurately disclosing the lack of relationship with the Complainant and by holding several FESTOOL domain names the Respondent is attempting to corner the market.

The disputed domain names were registered and are being used in bad faith. By the time the Respondent registered the disputed domain names, the Complainant and its group already had worldwide reputation in the FESTOOL mark. The use of the disputed domain names (to host websites that claim to offer the Complainant's products and use a copycat of the Complainant's official website, prominently displaying the FESTOOL mark and logo), corroborates the Respondent's bad faith. The disputed domain names are used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant and its trademark. The Respondent's conduct disrupts the Complainant's business and its relationship with its customers. The use of a privacy service to hide the Respondent's identity further corroborates its bad faith.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Preliminary Issue: Consolidation of the Complaint against Multiple Registrants

The Panel considers that the disputed domain names are subject to a common control, and the consolidation is fair and equitable to the Parties. In this respect, the Panel notes that the disputed domain names were registered with only three days of difference and though the same Registrar, they share almost identical content, and both disputed domain names are hosted on in the same servers (Cloudflare.com). The Panel also notes that the information provided in the WhoIs for the disputed domain names according to the Registrar verification, is almost identical, in particular sharing the same email address, telephone number, city and zip code, and the registrant's names revealed by the Registrar verifications consist for both disputed domain names of letters sequences. See section 4.11.2 of the [WIPO Overview 3.0](#).

B. Identical or Confusingly Similar

The Complainant indisputably has rights in the registered trademark FESTOOL, both by virtue of its trademark registrations and as a result of the continuous use of this mark since 2000.

The disputed domain names reproduce the FESTOOL mark with the addition in the terms "discount" or "store" respectively, and the gTLD ".com". The FESTOOL mark is recognizable in both disputed domain names, and the gTLD ".com" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8, and 1.11 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

C. Rights or Legitimate Interests

The Complainant's assertions and evidence effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the disputed domain names (providing the circumstances of paragraph 4(c) of the Policy, without limitation), in order to rebut the Complainant's *prima facie* case. See section 2.1, [WIPO Overview 3.0](#).

However, the Respondent has not replied to the Complainant's contentions, not providing any explanation and evidence of rights or legitimate interests in the disputed domain names.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that the Complainant has constructed a strong *prima facie* case evidencing that the Respondent has not been authorized to use the FESTOOL mark, there is no relationship between the Parties, and the disputed domain names have not been used in connection to a *bona fide* offering of goods or services.

The Panel notes that the Respondent's name revealed by the Registrar verifications in both disputed domain names consist of different sequences of letters that do not seem to be real names, and share no similarity with the respective disputed domain names or the term "festool".

The Panel further notes that the disputed domain names generate an affiliation with the Complainant's trademark. The fact that the disputed domain names incorporate the FESTOOL mark adding dictionary terms ("discount" or "store") that may refer to the commercialization of the Complainant's products generates an implied affiliation that suggests that the disputed domain names may be owned or sponsored by the Complainant.

The Panel has further corroborated that the disputed domain names resolve to almost identical websites that reproduce the Complainant's official website at "www.festool.com" using an identical design, colors, and look

and feel. The Respondent's websites further prominently display the Complainant's FESTOOL mark and its logo with the same graphic representation, as well as various Complainant's official product images and other copyrighted material allegedly taken from the Complainant's official website at "www.festool.com", claiming copyright on this material and the websites linked to the disputed domain names. The Respondent's websites further omit any reference to their respective owners or that of the disputed domain names, and their lack of relationship with the Complainant, its group, and its FESTOOL mark.

The Panel further notes that the Respondent's websites display a green capital letter "F" within their tap interface, identical to the one included in the Complainant's official website tap interface.

The Panel has further corroborated that the Respondent's websites are commercial sites or online stores that purportedly commercialize discounted FESTOOL products, offering various methods of payment (including credit cards, PayPal, stripe, and cash on delivery).

All these circumstances constitute on the Panel's view a clear attempt to impersonate that Complainant or generate a false affiliation to the Complainant and the FESTOOL mark, to increase the traffic of the websites linked to the disputed domain names for a commercial gain. These circumstances do not fulfil the cumulative requirements outlined in the "Oki Data test" by *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), for resellers or distributors using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods or services, and cannot be considered a *bona fide* offering of goods or services under the Policy. See section 2.8, [WIPO Overview 3.0](#).¹

Furthermore, the unauthorized use of copyrighted material allegedly obtained from the Complainant's official website and the attempt to impersonate the Complainant through websites that are copycat versions of the Complainant's official website, constitute illegal activities that can never confer rights or legitimate interests on the Respondent. See section 2.13, [WIPO Overview 3.0](#).

It is further remarkable that the Respondent has chosen not to reply to the Complaint, not providing any evidence of any rights or legitimate interests in the disputed domain names.

Therefore, the circumstances of this case lead the Panel to conclude that nothing in the case file gives any reason to believe that the Respondent has any rights or legitimate interests in respect of the disputed domain names, and the second element of the Policy under paragraph 4(a)(ii) has been established.

D. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain names have been registered and are being used in bad faith.

The applicable standard of proof is, likewise, the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain names:

- (i) the FESTOOL mark has a strong presence over the Internet and it is internationally used;
- (ii) the disputed domain names incorporate the FESTOOL mark preceded by terms ("discount" or "store") that may relate to the commercialization of the Complainant's products and may contribute to generate

¹These cumulative requirements are the following: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

a risk of confusion or implied association, creating the impression that the disputed domain names are affiliated to the Complainant or its group;

- (iii) the websites linked to the disputed domain names reproduce the Complainant's official website, and prominently display the FESTOOL mark and logo (with the same graphic representation used by the Complainant) at their headings and within their tap interface, as well as various copyrighted official product images of the Complainant's products, claiming copyright on this material;
- (iv) the Respondent has used a privacy service and, according to the Registrar verifications, in both disputed domain names, the Respondent has provided different sequences of letters instead of its real name for the registration of the disputed domain names; and
- (v) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain names and has not come forward to deny the Complainant's assertions of bad faith, choosing not to reply to the Complaint.

Therefore, on the balance of probabilities, taking into consideration all cumulative circumstances of this case, the Panel considers that the disputed domain names were registered targeting the Complainant and its FESTOOL mark with the intention of generating a false affiliation and passing off for commercial gain. The disputed domain names were registered and are used seeking to mislead Internet users to believe that there is a connection between the disputed domain names and the Complainant to increase the traffic of the Respondent's websites for a commercial gain, which constitutes bad faith under the Policy.

All of the above-mentioned circumstances lead the Panel to conclude that the disputed domain names were registered and are being used in bad faith. Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the Respondent registered and is using the disputed domain names in bad faith under the third element 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 names, <discountfestool.com> and <storefestool.com> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: June 7, 2023