

ADMINISTRATIVE PANEL DECISION

Kanthal AB v. GAOXIANG LIU, He Na An Di Gao Wen Zhi Pin You Xian
Gong Si

Case No. D2023-1637

1. The Parties

The Complainant is Kanthal AB, Sweden, represented by Westerberg & Partners Advokatbyrå AB, Sweden.

The Respondent is GAOXIANG LIU, He Na An Di Gao Wen Zhi Pin You Xian Gong Si, China.

2. The Domain Name and Registrar

The disputed domain name <kanthalsuper.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Andy Group) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 17, 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 April 20, 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 April 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. The Center received the Respondent’s email communications on May 4, 2023 and May 6, 2023, respectively. The Respondent did not submit any formal response. On May 12, 2023, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Karen Fong as the sole panelist in this matter on June 1, 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, established since 1931 and headquartered in Sweden, produces and supplies products and services in the area of industrial heating technology and resistance materials. Its products and services are marketed and sold under the trade mark KANTHAL. In 2022, the Complainant generated net revenue of SEK 4 billion.

The Complainant owns numerous KANTHAL trade mark registrations all over the world including in the European Union ("EU") and China. The trade mark registrations submitted in evidence includes China trade mark registration number 178023 registered on May 30, 1983, and EU trade mark registration number 000647693 registered on April 16, 1999 (the "Trade Mark"). The Trade Mark is an invented word which was derived from the combination of the founder's surname Kantzow ("Kant") and the Swedish town of Hallstahammar ("Hal") where the Complainant was founded. Since 1954, the word "super" has been used in combination with the Trade Mark – KANTHAL Super - for the Complainant's Molybdenum disilicide (MoSi₂) based heating elements.

The Complainant's primary website is found at the domain name <kanthal.com> which was registered in 1996.

The Respondent registered the Domain Name on March 22, 2020. The website connected to the Domain Name states that it is operated by Andy Group (河南安迪高温制品有限公司 in Chinese and He Nan An Di Gao Wen Zhi Pin You Xian Gong Si in Pinyin) of Henan, China, a "Leading Supplier In Advanced High Thermal Material And Equipment with high quality" (the "Website"). The type of products marketed on the Website are similar with the type of products produced and supplied by the Complainant. There is no information on the Website as to how the Andy Group is related to the Complainant. The Website contains "hidden links" to the Complainant's "www.kanthal.com" website. The links are not easily visible to Internet users as they are in white text on a white background. Such hidden links are usually used to affect search engine results. The Website also contain visible links to third party websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name has been registered and is being used in bad faith. The Complainant requests transfer of the Domain Name to the Complainant.

B. Respondent

The Respondent contends as follows:

- (a) Its products are unrelated to KANTHAL patented products;
- (b) Its product names do not contain any reference to Kanthal;
- (c) The Complainant's claims are unreasonable and bullying as it is claiming that no one can use the word Kanthal;

- (d) The Complainant's trade mark and website comprise of Kanthal whilst the Domain Name is Kanthalsuper which has more letters and has no substantive meaning;
- (e) The Respondent will not answer the lawsuit as its English proficiency is limited but will publish the entire process and results online for comments from people around the world.
- (f) The product range of the Respondent is different from those of the Complainant.

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name consists of the Trade Mark in its entirety together with the word "super" which is a word that the Complainant has been using in relation to its Trade Mark on a line of products for a long time. The addition of this word does not prevent a finding of confusing similarity. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") which in this case is ".com". It is viewed as a standard registration requirement (section 1.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

The Panel finds that the Domain Name is confusingly similar to the Trade Mark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable 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; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or

- (iii) the respondent 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 trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with appropriate allegations or relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent does not come forward with such allegations and relevant evidence of rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that there is no evidence that the Respondent is commonly known by the Domain Name nor has any trade mark rights to the Trade Mark. Further, it has not authorised, licensed, sponsored, or otherwise permitted the Respondent to use the Trade Mark in the Domain Name or for any other purpose.

The use of the Domain Name in connection with a website which markets and sells goods which compete with the Complainant does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use under the Policy.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent's explanation fails to show that it has any rights or legitimate interests in relation to the Domain Name. Its defence appears to be that the Complainant is not entitled to have trade mark rights to the name Kanthalsuper because the Complainant only uses Kanthal, and that in any event the Domain Name is different because it includes the word "super" so that the Domain Name as a whole has no meaning. The Respondent does not however provide any explanation as to why it picked the Domain Name which incorporates the Trade Mark together with a term related to the Complainant's products. Moreover, the Panel finds that the nature of the Domain Name is inherently confusing as it effectively impersonates or suggests sponsorship or endorsement by Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel finds that the Respondent has no rights or legitimate interests in the Domain Name, and therefore the second element is met.

D. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been registered and is being used in bad faith.

The Panel is satisfied that the Respondent was aware of the Trade Mark when it registered the Domain Name. The Trade Mark was registered long before the registration of the Domain Name. In addition, the word Kanthal Super has been used by the Complainant for a long period of time for its products. The fact that the Website contains links to the Complainant's website confirms the Respondent's awareness of the Trade Mark. Further, the Respondent admits to have knowledge of the Complainant's Kanthal products in the email communications sent to the Center. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the Domain Name. The Panel is satisfied that the Respondent was aware of the Trade Mark when it registered the Domain Name given the reputation of the Trade Mark in its field and the fact that it has no common dictionary significance other than that of the Trade Mark.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

"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."

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent's choice of the Domain Name (clearly targeting the Complainant's Trade Mark) is also a significant factor to consider (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Domain Name falls into the category stated above and the Panel finds that registration was in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The Respondent's business is one which competes with that of the Complainant. It is in the same field of activity. The Respondent's business name is completely different from the Domain Name. It is highly likely that Internet users when typing the Domain Name into their browser, or finding them through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. This is especially so given that the Website has hidden links to the Complainant's website. The Domain Name is likely to confuse Internet users trying to find the Complainant's website. Such confusion will inevitably result due to the fact that the Domain Name contains the Complainant's distinctive Trade Mark.

The Respondent employs the reputation of the Trade Mark to mislead Internet users into visiting the Website at the Domain Name instead of the Complainant's. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent's Website is that of or authorised or endorsed by the Complainant.

The Panel therefore concludes that the Domain Name was registered and is being used in bad faith under paragraph 4(b)(iv) of the Policy, and therefore the third element is 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 Domain Name <kanthalsuper.com> be transferred to the Complainant.

/Karen Fong/

Karen Fong

Sole Panelist

Date: June 22, 2023