

ADMINISTRATIVE PANEL DECISION

Pfeifer Holding GmbH v. Domain Administrator
Case No. D2023-1660

1. The Parties

The Complainant is Pfeifer Holding GmbH, Austria, represented by Lutzker & Lutzker LLP, United States of America (the “United States”).

The Respondent is Domain Administrator, United States.¹

2. The Domain Name and Registrar

The disputed domain name <pfeiferholdinggmbh.com> is registered with NameSilo, 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 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 17, 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 (Domain Administrator, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 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 20, 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 25, 2023. In accordance with the Rules, paragraph 5,

¹ The Panel notes that the Registrar in its first reply to the Request for Registrar Verification stated that the registrant name is “NameSilo LLC”, while providing an email address without any apparent connection to the Registrar. In a further communication, the Registrar stated that “Domain is not under our ownership, please see only info user has provided (given they have not completed their required account details)”, and provided the same “Gmail” email address, with the name “Shumbe Fabrice Neba”.

the due date for Response was May 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 16, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on May 22, 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 Pfeifer Holding GmbH, an Austrian company, one of the largest and a leader in the timber and wood processing industry in Europe. The Complainant manufactures and processes timber products under the trademark PFEIFER.

The Complainant owns trademark registrations for PFEIFER worldwide, such as the following:

- the German trademark registration number 30057974 for the stylized word PFEIFER, filed on August 3, 2000 and registered on January 10, 2001, and covering goods and services in International Classes 6, 7, 8, 9, 19, 20, 22, 23, 37, and 42; and
- the United States trademark registration number 2799638 for the word PFEIFER, filed on February 1, 2001 and registered on December 30, 2003, and covering goods and services in International Classes 6, 7, 9, 22.

The Complainant promotes its PFEIFER products on the website "www.pfeifergroup.com".

The disputed domain name <pfeiferholdinggmbh.com> was registered on October 17, 2022 in the name of a privacy service. At the time of filing the Complaint, the disputed domain name was connected to a commercial website having a very similar content as the Complainant's website, displaying the trademark PFEIFER, the same material, content and images; and was displaying a copyright claim "@ Copyright 2022 by Pfeifer Holding GMBH. All rights reserved". However, when the Internet user was clicking the "our products" button, it was redirected to a third party's website, a competitor of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its famous trademark PFEIFER and identical to its company name, that the Respondent has no rights or legitimate interests in the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the PFEIFER trademark.

The disputed domain name <pfeiferholdinggmbh.com> incorporates the Complainant's PFEIFER trademark with additional terms, "holding" and "gmbh". However, such additions do not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity, where the relevant trademark is recognizable within the domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the Top-Level-Domain ("TLD") (e.g., ".com", ".shop", ".info", ".net") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark PFEIFER, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark PFEIFER, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

In line with the case law, "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". See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent has made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

In fact, at the time of filing the Complaint, the disputed domain name resolved to a commercial website copying the Complainant's website and diverting Internet users to the website of a third party, a competitor of the Complainant.

UDRP panels have categorically held that the use of a domain name for illegal activity (e.g. impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

Furthermore, UDRP panels have found that domain names that consist of a trademark plus certain additional terms such as a geographic term or a term with an inherent Internet connotation cannot constitute fair use as these suggest sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). Here, the Panel notes that the disputed domain name comprises the Complainant's trademark in its entirety together with the terms "holding" and "gmbh" (which refers to the Complainant's company name), cannot be considered fair use as it falsely impersonate the Complainant. The Panel further notes that the website at the disputed domain name replicates the Complainant's website, which affirms the impersonation.

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds registered trademark rights for PFEIFER since 2001.

The disputed domain name was created in October 2022 and reproduces the Complainant's company name and incorporates its PFEIFER trademark. Furthermore, it is used in connection with a website that copies the official website of the Complainant.

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark. The Respondent is using without permission the Complainant's distinctive trademark in order to get Internet traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, and the content on the website provided thereunder which includes the Complainant's trademark, logo, images and texts from the Complainant's official website.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark, reproduces exactly the Complainant's company name and the website operated under the disputed domain name copied the look-and-feel of the Complainant's website, displays the Complainant's trademark, logo, pictures and texts and is diverting the Internet users to competing websites, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain. This activity is also causing disruption of the Complainant's activity.

Further, the Respondent registered the disputed domain name under a privacy service, failed to provide a response to the Complainant's allegations and the physical address listed in the Whois was inaccurate or incomplete. Along with other circumstances in this case, such facts constitute further signs of bad faith. See section 3.6 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <pfeiferholdinggmbh.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: May 31, 2023