

## **ADMINISTRATIVE PANEL DECISION**

### **Bergverlag Rother GmbH v. Vnhdeh Cgde**

### **Case No. D2023-1868**

#### **1. The Parties**

The Complainant is Bergverlag Rother GmbH, Germany, represented by Natlacen Walderdorff Cancola Rechtsanwälte GmbH, Austria.

The Respondent is Vnhdeh Cgde, China.

#### **2. The Domain Name and Registrar**

The disputed domain name <bergverlagrother.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 April 26, 2023. On April 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 28, 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 May 2, 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 May 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 26, 2023.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on June 5, 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 company that sells hiking guides.

Among other registrations, the Complainant owns the following trademark registrations:

- European Union trademark registration for BERGVERLAG ROTHER No 18025128, registered on August 31, 2019, in classes 9, 16, 18, 25, 28, 39, 41, 42, 43; and
- European Union trademark registration for BERGVERLAG ROTHER MÜNCHEN SEIT 1920 & design No 18025131, registered on August 31, 2019, in classes 9, 16, 18, 25, 28, 39, 41, 42, 43.

The disputed domain name was registered on May 16, 2022.

At the time of filing of the Complaint, the disputed domain name resolved to a website reproducing the Complainant's trademarks and logos and purportedly offering for sale the Complainant's hiking guides.

The "About us" section of such website featured a text – referring to a corporate office in Alabama – that is identical to a description found in numerous other websites, at least of two which were listed as fraudulent websites on the website "www.scamwatcher.com".

#### **5. Parties' Contentions**

##### **A. Complainant**

According to the Complainant, the disputed domain name is confusingly similar to its trademark BERGVERLAG ROTHER as it identically reproduces its trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is not commonly known by the disputed domain name and because the use of the Complainant's trademarks clearly does not fall under any fair use exceptions.

Finally, the Complainant contends that the Respondent has used and registered the disputed domain name in bad faith. According to the Complainant, the disputed domain name is being intentionally used to host a website that conveys the misleading impression that it is an official website of the Complainant, or is otherwise officially authorized, sponsored or endorsed by the Complainant. Furthermore, the Complainant suspects that the disputed domain name is part of a larger scam network.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

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

## **A. Identical or Confusingly Similar**

The disputed domain name is identical to the Complainant's BERGVERLAG ROTHER trademark.

UDRP panels accept that a generic Top-Level Domain ("gTLD"), such as ".com", may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#))).

The Panel finds accordingly that the Complainant has successfully established the requirement under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Based on the information submitted by the Complainant, the Complainant has not granted to the Respondent an authorization to use the disputed domain name. Moreover, there is no evidence indicating that the Respondent is commonly known by the disputed domain name.

The Panel notes the Complainant's claims that the disputed domain name resolves to a website that has the appearance of the official Rother website or the website of an authorized affiliate. The Panel also notes the Complainant's claims on the website being part of a larger scam and that the website is used to promote the Complainant's products.

If the website at the disputed domain name is a copycat website, with a likely fraudulent purpose behind it, such use would not confer rights or legitimate interests on the Respondent (section 2.13 of the [WIPO Overview 3.0](#)).

For the sake of completeness, noting the Complainant's allegations regarding the website having a commercial nature, the Panel will consider if the Respondent could be a reseller or distributor.

UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name (section 2.8 of the [WIPO Overview 3.0](#)). Outlined in the "Oki Data test" (*Oki Data Americas Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (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.

In the present case, the Respondent appears to be using the disputed domain name in connection with a commercial website offering for sale the Complainant's hiking guides. Whether the Respondent actually did sell genuine guides of the Complainant is unknown. This being said, the screenshot of the home page of the website to which the disputed domain name resolved did not feature any disclaimer concerning the (lack of) relationship between the Respondent and the Complainant. Furthermore, the logo of the Complainant was displayed at the top of the home page of the Respondent's website, creating the impression of an official website, operated or at least endorsed by the Complainant.

By failing to accurately disclose the relationship, or rather lack thereof with the Complainant, the Respondent conveyed the false impression that the Respondent is the Complainant itself, or an authorized retailer of the

Complainant, where such is not the case. The Panel finds accordingly that the requirements of the “Ok! Data test” are not satisfied in the present case.

In addition, the Panel finds that the disputed domain name, which incorporates the Complainant’s trademark in its entirety, falsely suggests affiliation with the Complainant, such that the Respondent’s use of the disputed domain name may not be considered fair.

Finally, the Respondent did not file a response to the Complaint. The Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b). The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Therefore, the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Respondent used the disputed domain name in connection with an active website purporting to be an official website of the Complainant and displaying the Complainant’s trademarks and logos. There is no doubt accordingly that the Respondent was aware of the Complainant’s trademarks at the time of registration of the disputed domain name. The Panel therefore accepts that the disputed domain name was registered in bad faith.

The use of the disputed domain name by the Respondent was apt to mislead Internet users into believing that the website at issue was the official website of the Complainant, and that they could contact the Complainant by means of the contact form available on the website.

By using the disputed domain name in such manner, the Respondent intentionally attempted to attract, for the purposes of commercial gain, Internet users to his or her website by creating a likelihood of confusion with the Complainant’s mark as to the source and affiliation of this website. Such behavior constitutes use in bad faith under paragraph 4(b)(iv) of the Policy.

Furthermore, given the fact that other websites with similar content were found to be fraudulent, the Panel considers it likely that the Respondent intended to use the disputed domain name as a support for a potential fraudulent scheme, namely to impersonate the Complainant and extract personal or financial data from Internet users visiting his website. Previous UDRP panels have found that such behavior amounts to use of a domain name in bad faith (see *Marriott International, Inc., Marriott Worldwide Corporation and The Ritz-Carlton Hotel Company, LLC v. Van C Bethancourt Jr., Andre Williams*, WIPO Case No. [D2018-2428](#) and *Accor v. Sangho Heo, Contact Privacy Inc.*, WIPO Case No. [D2014-1471](#)).

For the reasons set out above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith, and that the Complainant has satisfied the condition set forth in 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 <bergverlagrother.com> be transferred to the Complainant.

/Anne-Virginie La Spada/

**Anne-Virginie La Spada**

Sole Panelist

Date: June 20, 2023