

ADMINISTRATIVE PANEL DECISION

AGFA-Gevaert N.V. v. gao xi an
Case No. D2023-2302

1. The Parties

Complainant is AGFA-Gevaert N.V., Belgium, represented by Novagraaf Belgium NV/SA, Belgium.

Respondent is gao xi an, China.

2. The Domain Names and Registrars

The disputed domain name <agfa1.com> “Domain Name 1” is registered with Gname 038 Inc (the “Registrar”), and the disputed domain name <agfa2.com> “Domain Name 2” is registered with Gname 024 Inc. (the “Registrar”). Domain Name 1 and Domain Name 2 will hereinafter be referred to collectively as the “Domain Names”.

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 26, 2023. On May 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On May 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on May 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English on May 31, 2023.

On May 30, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On May 31, 2021, Complainant confirmed its request that English be the language of the proceeding. Respondent did not comment on the language of the proceeding.

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 Respondent of the Complaint, and the proceedings commenced on June 6, 2023. In accordance with the Rules, paragraph 5, the due date

for Response was June 26, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 6, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on July 17, 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

Complainant is in the photographic, medical imaging and medical software industries. It was formerly known in the photography industry as a manufacturer of cameras and film.

Complainant owns several registered trademarks worldwide with the AGFA mark, including:

- European Union Trade Mark registration No. 003353463 for AGFA word mark, registered on January 24, 2005;
- European Union Trade Mark registration No. 008133167 for AGFA word and design mark registered on February 17, 2010;
- European Union Trade Mark registration No. 009440801 for AGFA word mark, registered on March 20, 2011;
- European Union Trade Mark registration No. 011649803 for AGFA word mark, registered on August 7, 2013;
- European Union Trade Mark registration No. 013086251 for AGFA word and design mark, registered on March 2, 2015;
- European Union Trade Mark registration No. 015553662 for AGFA word and design mark, registered on January 6, 2017; and
- European Union Trade Mark registration No. 015598113 for AGFA word and design mark, registered on February 27, 2017.

Complainant also owns several domain names containing the AGFA mark.

The Domain Names were each registered on February 25, 2023, each with registrars with slightly different names and ID numbers, but with the same Abuse Contact e-mail, abuse contact phone number and each registered by the same registrant, gao xi an, with the same email and physical address. The Domain Names each revert to inactive sites.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) each of the Domain Name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and is using the Domain Names in bad faith.

In particular, Complainant contends that it has trademark registrations for AGFA and that Respondent registered and is using the Domain Names with the intention to confuse Internet users looking for *bona fide* and well-known AGFA products and services.

Complainant notes that it has no affiliation with Respondent and contends that Respondent is using the Domain Names as a tool to exploit Complainant's reputation for its own commercial gain, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Names other than trademark infringement. Further, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Names, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Procedural Issue: Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the 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.

According to the information received from the Registrar, the language of the Registration Agreement for each of the Domain Names is Chinese.

Complainant submitted its original Complaint in English. In its original Complaint, email dated May 31, 2023, and its amended Complaint, Complainant submitted a request that the language of the proceeding should be English. Complainant contends that it does not communicate in Chinese and submitting all the documents in Chinese would involve substantial expense, causing significant and undue burden on Complainant. Complainant also contends that English is one of the most popular languages in the world, is commonly used in international communication; that the Domain Names are composed entirely of Latin characters, and thus indicates that Respondent knows English.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Names, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that each of the Domain Names is composed of Complainant's trademark AGFA plus the numeral "1" in the case of Domain Name 1 <agfa1.com> and the numeral "2" in the case of Domain Name 2 <agfa2.com>. In addition, the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of commencement of the proceeding and indicated that Respondent may file a Response in either Chinese or English. Respondent did not comment on the language of the proceeding, nor did Respondent choose to file a Response in this proceeding.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese while conducting the proceeding in English would not cause unfairness to either Party in this case.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; and a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence of its rights in the AGFA trademarks, as noted above under section 4. Complainant has also submitted evidence, which supports that the AGFA trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the AGFA trademarks.

With Complainant's rights in the AGFA trademarks established, the remaining question under the first element of the Policy is whether each of the Domain Names, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case is, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, each of the Domain Names is confusingly similar to Complainant's AGFA trademarks. The AGFA trademarks are recognizable in the Domain Names. In particular, each of the Domain Names' inclusion of Complainant's trademark AGFA in its entirety, with the addition of the numeral "1" in the case of Domain Name 1 <agfa1.com> and the numeral "2" in the case of Domain Name 2 <agfa2.com> after "agfa" does not prevent a finding of confusing similarity between the Domain Names and Complainant's AGFA trademarks. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its AGFA trademarks, and does not have any rights or legitimate interests in the Domain Names. In addition, Complainant asserts that Respondent is not an authorized reseller and is not related to Complainant. Respondent is also not known to be associated with the AGFA trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of filing of the Complaint, the Domain Names each reverted to an inactive website. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Names. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Names. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Names in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.”

The Panel finds that Complainant has provided ample evidence to show that registration and use of the AGFA trademarks long predate the registration of the Domain Names.

Complainant is also well established and known. Indeed, the record shows that Complainant's AGFA trademarks and related products and services are widely known and recognized. The evidence provided by Complainant with respect to the extent of use and global fame of its AGFA mark combined with the absence of any evidence provided by Respondent to the contrary, suggests to the Panel that, at the time each of the Domain Names was registered, Respondent was likely aware of the AGFA trademarks and should have known that each of the Domain Names is confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; and see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

The fact that each of the Domain Names does not resolve to an active website and is in effect being passively held does not prevent a finding of bad faith. When a domain name is being passively held, the question of bad faith use does not squarely fall under one of the non-exhaustive factors set out in paragraph 4(b) of the Policy. However, section 3.3 of the [WIPO Overview 3.0](#), instructs that UDRP panels should examine the totality of the circumstances in each case and that the following factors that have been considered relevant in applying the passive holding doctrine: "(i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

Here Complainant has submitted evidence that its fanciful AGFA mark has been used for many years globally before Respondent's registration of the Domain Names. Respondent has not offered any evidence to rebut this conclusion, nor has he provided any evidence of his intended good faith use of the Domain Names. Given these circumstances, the Panel finds that the Domain Names have been used in bad faith by Respondent.

Accordingly, the Panel finds that Respondent registered and used the Domain Names in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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, <agfa1.com> and <agfa2.com>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: July 27, 2023