

ADMINISTRATIVE PANEL DECISION

Grohe AG v. Jiao Shenghui
Case No. D2023-2737

1. The Parties

The Complainant is Grohe AG, Germany, represented by Wolpert Rechtsanwälte, Germany.

The Respondent is Jiao Shenghui, China.

2. The Domain Name and Registrar

The disputed domain name <grohesale.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 June 27, 2023. On June 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 8, 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 July 10, 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 July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2023.

The Center appointed Warwick Smith as the sole panelist in this matter on August 25, 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 corporation, specializing in the supply of bathroom solutions and kitchen fittings. According to the Amended Complaint, “Grohe” is one of the leading global brands in the market for the supply of those products.

The Complainant’s principal website is at “www.grohe.com”, which it uses to market its Grohe-branded products.

The Complainant is the registered proprietor of a number of “Grohe” trademarks. It is not necessary to mention them all. It is enough for the purposes of this decision to refer to the Complainant’s International registration of the word mark GROHE under number 1331201, and its United States of America (“United States”) registration of a GROHE figurative mark under number 1902412 (“the device mark”). The first of those marks was registered on September 8, 2016, and covers various goods, including “washroom and bath accessories” in International Class 21. The designated countries include China and the United States. The device mark consists of the word GROHE in bold dark lettering, immediately above three horizontal wavy lines. It was registered with the United States Patent and Trademarks Office on July 4, 1995. It also covers a variety of goods, including “washroom and bath accessories” in International Class 21.

The disputed domain name was registered on October 22, 2022. It resolves to an English language website (“the Respondent’s website”).

The Complainant produced with its Complaint a screenshot of the Respondent’s website that appears to have been taken on June 19, 2023. The Respondent’s website prominently featured the device mark near the top of each page, but there was no disclaimer or similar notice explaining that the Respondent’s website was not owned or authorized by the Complainant.

The Respondent’s website contained the following headings:

HOMES BATROOM FIXTURE HARDWARE PARTS BATHTUB & SHOWER TRIM SYSTEMS
CARTRIDGES FIXED SHOWERHEADS HANDHELD SHOWERHEADS

and

SHOWER ARMS & SLIDE BARS TOILET PAPER HOLDERS TOUCH ON KITCHEN SINK FAWCETS
TRIM & REPAIR KITS TUBING & HOSES SALE

The Respondent’s website contained pictures of various kitchen or bathroom fittings, many marked with discount price percentages. There was a business address in the state of Georgia, United States.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is highly similar to its GROHE company name and GROHE trademarks. It contends that the addition of the word “sale” in the disputed domain name only gives the impression that the advertised prices of the goods have a special discount. Overall, the disputed domain name gives the impression that it is the “sale”, or “discount”, version of the Complainant’s own website at “www.grohe.com”. This creates a clear likelihood of confusion for consumers.

The Complainant next contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a subsidiary of, or affiliated with, the Complainant, and he does not have the Complainant’s permission to use its GROHE trademark. The Respondent has no relevant trademark rights in the GROHE mark, but has been using the mark in the same field of commercial interest as the Complainant, in an attempt to appear to *be* the Complainant.

Finally, the Complainant contends that the Respondent registered and has been using the disputed domain name in bad faith. Without authority from the Complainant, the Respondent purports to sell sanitary goods on the Respondent's website under the name GROHE, using a figurative version of that mark that is identical or near-identical to the device mark. In this manner, the Respondent is intentionally trying to derive commercial gain by creating a likelihood of confusion with the Complainant's GROHE trademarks, taking advantage of the Complainant's good reputation in its GROHE marks in order to sell its sanitary goods.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a Complainant is required to establish each of the following:

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

A. Identical or Confusingly Similar

The Complainant has proved this part of the Amended Complaint.

The Complainant is the registered proprietor of the word mark GROHE under International registration No. 1331201. That registration is sufficient for it to establish rights in that mark for the purposes of paragraph 4(a) (i) of the Policy. The question under this part of the Policy is whether the disputed domain name is confusingly similar to the Complainant's GROHE mark.

The disputed domain name includes the Complainant's GROHE mark without alteration, followed by the word "sale".

The consensus view of UDRP panels on the issue of confusing similarity where a complainant's mark is incorporated within a disputed domain name, is described as follows in The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, third edition ("[WIPO Overview 3.0](#)"): ¹

"Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

In this case, the GROHE mark is clearly recognizable within the disputed domain name. The mark appears at the beginning of the disputed domain name, and it is followed by the word "sale". The confusing similarity between the disputed domain name and the Complainant's GROHE mark is clear.

For completeness, the Panel notes that generic top level domains ("gTLDs") such as ".com" are not normally taken into account in the comparison that is required by paragraph 4(a)(i) of the Policy. The gTLD is a technical requirement of registration, and is not normally considered to have legal significance in applying paragraph 4(a)(i). ²

¹ [WIPO Overview 3.0](#) at section 1.8.

² [WIPO Overview 3.0](#), section 1.11.1.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy set out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The circumstances are:

- (i) Before any notice to [the respondent] of the dispute, use by [the respondent] of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Where [the respondent] (as an individual business or other organization) [has] been commonly known by the disputed domain name, even if [the respondent has] acquired no trade mark or service mark rights; or
- (iii) Where [the respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly direct consumers or to tarnish the trade mark or service mark at issue.

[WIPO Overview 3.0](#) states the following on the burden of proof under paragraph 4(a)(ii) of the Policy:

“While the overall burden of proof in UDRP proceedings is on the Complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the [often impossible] task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.”

In this case, the Respondent has elected not to respond to the Complaint, and the issue is whether the Complainant has produced sufficient *prima facie* proof that the burden of production should shift to the Respondent. If the Complainant’s evidence does meet the *prima facie* case standard, the Respondent’s failure to file a Response will mean that the Complainant must succeed on this part of the Amended Complaint.

The Panel is satisfied that the Complainant has provided that *prima facie* proof.

First, the disputed domain name is confusingly similar to both the Complainant’s GROHE word mark and the device mark, and there is no suggestion that the Respondent has licensed or otherwise permitted the Respondent to use any of its trademarks, or to apply for or use any domain name incorporating any of its GROHE marks.

Nor is there anything to suggest that the Respondent might have a right or legitimate interest in the disputed domain name under any of the subparagraphs of paragraph 4(c)(ii) of the Policy.

The Respondent has clearly not been using the disputed domain name in connection with any *bona fide* offering of goods or services, within the meaning of paragraph 4(c)(i) of the Policy. The use of the device mark on the Respondent’s website (with no disclaimer advising that the Respondent had not been authorized to use the device mark, and had no connection with the Complainant) makes it clear that the Respondent (a) knew about the Complainant when he registered the disputed domain name, and (b) has been attempting to create the false impression that the Respondent’s website is owned by or associated with the Complainant. Such a use could never be a use in connection with a *bona fide* offering of goods or services (or the making of “demonstrable preparations for such use”).

Similarly, there is nothing to suggest that the Respondent is commonly known by the disputed domain name (paragraph 4(c)(ii) of the Policy), or that the Respondent has been making a legitimate noncommercial or fair

use of the disputed domain name, without intent for commercial gain (paragraph 4(c)(iii) of the Policy). The Respondent's use of the disputed domain name has been neither legitimate nor fair, and it is quite clear that he has been using the disputed domain name to derive commercial gain, in the form of profits on sales of products of the same kind that the Complainant markets under its GROHE marks.

Those matters in combination are sufficient to establish a *prima facie* case under paragraph 4(a) (ii) of the Policy. In the absence of any Response, the Complainant has therefore made out its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith:

- (i) Circumstances indicating that the holder has registered or has 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 trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) The holder has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) The holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the holder's website or location or of a product or service on the holder's website or location.

The Complainant has also sufficiently proved this part of the Amended Complaint.

The Panel is in no doubt that the Respondent was aware of the Complainant's GROHE marks when he registered the disputed domain name. At that time, the GROHE word mark was registered in both China (where the Respondent apparently resides) and the United States () at where the Respondent has claimed to have a contact address, suggesting that he has been targeting United States consumers among others). The prominent use of the device mark on the Respondent's website leaves no room for doubt that the Respondent was aware of the Complainant and both the GROHE word mark and the device mark, when he registered the disputed domain name.

As for the Respondent's use of the disputed domain name, the Panel notes that the device mark appears prominently on the Respondent's website, through which the Respondent markets discounted kitchen and bathroom fittings and products in apparent competition with the Complainant's commercial operations in that field. The Panel accepts the Complainant's submission that the word "sale" was probably added to the word "grohe" in the disputed domain name, to signal that any website established at the disputed domain name would offer the Complainant's products at discounted, or "sale", prices. Of course that is precisely what the Respondent has done.

In those circumstances, and in the absence of any Response to the Complaint, the only sensible inference is that the Respondent has registered and used the disputed domain name in an attempt to create the false impression that the Respondent's website is owned or endorsed by, or affiliated in some way with, the Complainant. The intention appears to have been to enable the Respondent to effectively impersonate the Complainant, and so gain sales of its products by trading off the Complainant's reputation and goodwill in its GROHE marks.

Those circumstances fall squarely within the category of bad faith registration and use described at paragraph 4(b)(iv) of the Policy – by using the disputed domain name, the Respondent has attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's GROHE marks as to the source, sponsorship, affiliation or endorsement of the Respondent's website or of the products offered for sale on it.

That is enough to decide the Amended Complaint in the Complainant's favor.

The Complainant having made out its case on all three of the elements of paragraph 4(a) of the Policy, there will be an order transferring the disputed domain name to the Complainant.

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, <grohesale.com>, be transferred to the Complainant.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: September 8, 2023