

## **ADMINISTRATIVE PANEL DECISION**

LANXESS Deutschland GmbH v. Warren ESQ, Play Inc.

Case No. D2023-3475

### **1. The Parties**

The Complainant is LANXESS Deutschland GmbH, Germany, represented by Wolpert Rechtsanwälte, Germany.

The Respondent is Warren ESQ, Play Inc., United States of America (“United States”).

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

The disputed domain name <lanxessna.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2023. On August 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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 (Contact Privacy Inc. Customer 0167929615) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 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 amendment to the Complaint on August 18, 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 August 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 28, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on October 4, 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 active in the development, manufacturing and marketing of chemical intermediates, additives, specialty chemicals and plastics.

The Complainant is the registered owner of European Union trademark registration No. 003696581 LANXESS (word) registered on June 27, 2005 for goods in classes 1, 2, 4 and 17; European Union trademark registration No. 006596514 LANXESS (word) registered on February 13, 2009 for goods and services in classes 16, 18, 21, 24, 25, 28, 35, 37, 38, 41, 42, 43, and 45.

The disputed domain name <lanxessna.com> was registered on July 26, 2023. Furthermore, the evidence provided by the Complainant shows that the disputed domain name was used to send an email to third party, while pretending to be an employee of the Complainant, who is active in the field of Procurement, seemingly in order to obtain improper supply of products.

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

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

It results from the Complainant's undisputed allegations that the Complainant is active in the development, manufacturing, and marketing of chemical intermediates, additives, specialty chemicals and plastics.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks and the company name, as the trademarks and the company name "Lanxess" of the Complainant are identically contained at the beginning of the disputed domain name and the ending "-na" will not attract any attention of the consumer, or will be perceived as an insignificant appendix.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent does not use the website, as the website to which the disputed domain name resolves only offers to building a website. In addition, it uses the disputed domain name in the field of interest of the Complainant to appear to be the Complainant itself. In fact, the Respondent requested quotes for multiple products from a Complainant's supplier by email using the email address connected to the disputed domain name pretending to order the products for the Complainant, presumably to obtain the products on the Complainant's account. The Complainant's supplier was confused and therefore sent an email to the Complainant inquiring whether the order was legitimate or an impersonation. Additionally, the name indicated in the email address mentioned above, in whose name the email to the Complainant's supplier was sent, is an existing name of an employee of the Complainant in the United States, who is active in the field of Procurement.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the Respondent claims to be the Complainant or wants to give the impression that he is the Complainant. In fact, it is deliberately trying to obtain products on the Complainant's account by creating a likelihood of confusion with the Complainant's trademarks and employee. The Respondent clearly tried to deceive the Complainant's supplier, otherwise the supplier would not have inquired from the Complainant whether the order was legitimate or not.

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

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

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of trademark registration for LANXESS as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.7.

This Panel shares this view and notes that the Complainant’s registered trademark LANXESS is fully included in the disputed domain name, followed by the letters “na”. Furthermore, it is the view of this Panel that the addition of the letters “na” in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark since the Complainant’s trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did not authorize the Respondent's use of its trademarks or the registration of the disputed domain name.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any relevant allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

In addition, UDRP panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent, e.g., phishing, impersonation/passing off, or other types of fraud (see [WIPO Overview 3.0](#) at section 2.13.1 with further references). It results from the undisputed evidence before the Panel that the disputed domain has been used to send an email to a third party (*i.e.*, Complainant's supplier), while pretending to be an employee of the Complainant, who is active in the field of Procurement, seemingly in order to obtain improper supply of products on the Complainant's account. The Panel considers the evidence as sufficient to support the Complainants' credible claim of illegal activity by the Respondent.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of registration and use of the disputed domain name in bad faith.

This Panel agrees with the approach taken by previous UDRP panels following which the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see [WIPO Overview 3.0](#) at section 3.4).

As explained above, it results from the undisputed evidence submitted by the Complainant that the disputed domain name has been used for sending a fraudulent email in the name of an employee of the Complainant, who is active in the field of Procurement, seemingly in order to obtain improper supply of products on the Complainant's account. In addition, the use of the disputed domain name in such an illegal scheme additionally demonstrates that the Respondent not only knew of the Complainant, its business and marks, but also attempted to pass itself off as the Complainant by the name of an employee the Complainant, who is active in the field of Procurement, in order to obtain improper supply of products on the Complainant's account.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <lanxessna.com> be transferred to the Complainant.

*/Federica Togo/*

**Federica Togo**

Sole Panelist

Date: October 18, 2023