

ADMINISTRATIVE PANEL DECISION

Ralf Bohle GmbH v. BaiYumin
Case No. D2023-3497

1. The Parties

The Complainant is Ralf Bohle GmbH, Germany, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is BaiYumin, China.

2. The Domain Names and Registrar

The disputed domain names <schwalbefahrrad.com> and <schwalberabatt.com> (the “Disputed Domain Names”) are registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On August 18, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.¹

The Center verified that 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 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 14, 2023.

¹ The named Respondents in the Complaint are “BaiYumin” and “WhoisSecure”. The Complainant contended that it is most likely that “the disputed domain names are under common control” and requested consolidation of the Complaint against these Respondents. In its verification response, the Registrar confirmed that the Respondent “BaiYumin” is the registrant of the Disputed Domain Names. The Panel refers to the Respondent “BaiYumin” as “the Respondent”.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 18, 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 founded in 1922 operating a business that since 1973 has been manufacturing and selling pneumatic tyres and parts for bicycles and wheelchairs with a presence in more than 40 countries. The Complainant holds a portfolio of registrations for the trademark SCHWALBE, and variations of it, in numerous countries including German Trademark Registration No. 39822240, registered on June 17, 1998, and International Trademark Registration No. 1171528 registered on July 17, 2013.

The Complainant owns several domain names that comprise or contain the trademark SCHWALBE, including the domain name <schwalbe.com> which resolves to its main website.

The Disputed Domain Names were registered on April 6, 2023, and resolved to resolved to active websites that appeared to offer SCHWALBE branded bicycle tyres, parts, and other equipment for bicycles, at heavily discounted prices. The Disputed Domain Names are currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registration for the mark SCHWALBE and variations of it, in several countries, as *prima facie* evidence of ownership.

The Complainant submits that the mark SCHWALBE is well known and that its rights in that mark predate the Respondent's registration of the Disputed Domain Names. It submits that the Disputed Domain Names are confusingly similar to its trademark, because the Disputed Domain Names are comprised of the SCHWALBE trademark with the addition, it submits, of "the additional German-language terms: "rabatt" meaning discount, or "fahrrad" meaning bicycle" ...[which are]..." all closely related to the Complainant's business activity" and that the confusing similarity is not removed by the addition of the generic Top-Level Domain ("gTLD") ".com".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and that none of the circumstances set out in paragraph 4(c) of the Policy apply. It contends that "The Respondents are not affiliated with the Complainant in any way and have not been authorized by the Complainant to use and register its SCHWALBE trademark or to seek registration of any domain name incorporating said mark"...[and]..." has never authorized the Respondents to offer for sale and sell the Complainant's products which"..." circumstances suggest Respondents' illegal activity in the form of selling counterfeit goods."

Finally, the Complainant alleges that the registration and use of the Disputed Domain Names were, and currently are, in bad faith, contrary to the Policy and the Rules having regard to the prior use of the Complainant's well-known trademark, and advances the argument that "the Respondents' registration of the [D]isputed [D]omain [N]ames were made primarily with intention to attract, for commercial gain, Internet users to website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of website or of a product or service on website in accordance with Paragraph 4(b)(iv) of [the] Policy."

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) that the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark SCHWALBE. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected URDP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Names are identical or confusingly similar to the SCHWALBE trademark, the Panel observes that the Disputed Domain Names comprise:

- In the case of <schwalbefahrrad.com> (a) the Complainant's SCHWALBE trademark; (b) followed by the German language word "fahrrad", meaning "bicycle"; (c) followed by the gTLD ".com".
- In the case of <schwalberabatt.com> (a) the Complainant's SCHWALBE trademark; (b) followed by the German language word "rabatt", meaning "discount"; and (c) followed by the gTLD ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11). The relevant comparison to be made is with the second-level portion of the Disputed Domain Names, specifically: "schwalbefahrrad" and "schwalberabatt", respectively.

On conducting a side-by-side comparison of the Disputed Domain Names and the textual components of the relevant trademark, it is apparent that as the relevant mark is incorporated in its entirety and as such is recognizable in each of the Disputed Domain Names, the addition of the words "fahrrad" and "rabatt" respectively, would not prevent a finding of confusing similarity under the first element. This Panel therefore finds that the Disputed Domain Names are confusingly similar to the Complainant's SCHWALBE trademark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

Accordingly, the Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Names. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Names. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends, in summary, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because (i) it is likely that the Disputed Domain Names are being used to

promote and sell counterfeit products; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name SCHWALBE, and has not been commonly known by the name SCHWALBE; (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain; and (iv) that the Respondents webpages bear the Complainant's trademark and content relating to the Complainant's business.

The composition of the Disputed Domain Names, which each consist of the Complainant's trademark together with descriptive German language words does, in this Panel's view, indicate an awareness and targeting of the Complainant with the intention to take unfair advantage of its trademark, which does not support a finding of any rights or legitimate interests.

The Panel notes the evidence that each of the Disputed Domain Names in this proceeding resolved to: "websites seemingly offering SCHWALBE branded bicycle tires, parts and other equipment for bicycles, at heavily discounted prices". Numerous panels have recognized that resellers, distributors, or service providers using a domain name containing a 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. Known as the "Oki Data test", the Respondent fails to meet the criteria as its websites must, and did not, accurately and prominently disclose the registrant's relationship with the trademark holder (see [WIPO Overview 3.0](#), section 2.8). Moreover, the Panel finds that the composition of the Disputed Domain Names, together with the websites they previously resolved to, created a risk of implied affiliation.

Nor do the inactive subsequent webpages represent a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant's mark or capacity to otherwise mislead Internet users. On balance, the Panel is satisfied that a *prima facie* case exists that the Respondent lacks rights or legitimate interests. In view of the evidence that calls for an explanation from the Respondent, and in the absence of a Response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Names have been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Names in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Names and the websites they previously resolved to, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark when it registered the Disputed Domain Names.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of the Complainant's well-known trademark (see [WIPO Overview 3.0](#), section 3.1.4).

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Name some 25 years after the Complainant established registered trademark rights in the SCHWALBE mark.

On the issue of use, the Panel notes that the Disputed Domain Names, both of which correspond to the Complainant's mark with an additional word, resolved to an online website with content targeting the

Complainant's trademark offering possibly counterfeit SCHWALBE branded bicycle tyres, parts, and other equipment for bicycles, for sale. Targeting of this nature with no credible explanation is a common example of use in bad faith as referred to in paragraph 4(b) of the Policy and identified in many previous UDRP decisions (see [WIPO Overview 3.0](#), sections 3.1.4, and 3.2.1). Moreover, as stated previously, the composition of the Disputed Domain Names, together with the websites they previously resolved to, created a risk of implied affiliation.

Further, the evidence is that the Disputed Domain Names are currently is inactive and unconnected with any *bona fide* supply of goods or services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the 'passive holding' doctrine include: (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" (see [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all of these factors are present in this proceeding.

In the absence of any evidence to the contrary, this Panel finds that the Respondent has taken the Complainant's trademark SCHWALBE and incorporated it in the Disputed Domain Names, together with German language words, without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademark for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 Names, <schwalbefahrrad.com> and <schwalberabatt.com>, be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: September 21, 2023