

## ADMINISTRATIVE PANEL DECISION

dormakaba International Holding AG v. Jinguo Tao, TaoJinguo  
Case No. D2024-0471

### 1. The Parties

The Complainant is dormakaba International Holding AG, Switzerland, represented by Balder IP Law, SL, Spain.

The Respondent is Jinguo Tao, TaoJinguo, China.

### 2. The Domain Name and Registrar

The disputed domain name <dormakabaaccess.com> is registered with CNOBIN Information Technology Limited (the "Registrar").

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 1, 2024. On February 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2024, 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 (John Doe, "unknown") and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2024, 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 amended Complaint on February 6, 2024.

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 sent the notification to the Respondent of the Complaint, and the proceedings commenced on February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent's default on February 29, 2024.


The Center appointed Petra Pecar as the sole panelist in this matter on March 11, 2024. 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, dormakaba International Holding AG, established through the amalgamation of Dorma Holding and Kaba Group on September 1, 2015, is a distinguished entity in the global market for access solutions. The Complainant maintains a presence in 130 nations and employs an approximate total of 16,000 individuals and is known for its innovative contributions and extensive portfolio of over 1,800 patents. The Complainant is listed on the SIX Swiss Exchange and strategically targets key markets including Europe, North America, Australia, China, and India, with a focus on a diverse array of products such as door hardware and electronic access systems.

The Complainant's mark DORMAKABA, a representation of the merger, is extensively employed throughout the conglomerate's various communication mediums to denote secure and seamless access solutions. In addition to its global presence, the Complainant has established a significant operational footprint in the United States of America, centered around a subsidiary headquartered in Indianapolis, supported by an extensive network of service branches and manufacturing centers.

The Complainant is the owner of the mark DORMAKABA in many jurisdictions, including:

- Hong Kong trademark Registration no. 303957175  registered on November 9, 2016 in classes 6, 7, 9, 12, 19, 20, 35, 37, 40, 42 and 45;
- International Registration no. 1383333  registered on November 8, 2016, in classes 6, 7, 9, 12, 19, 20, 35, 37, 40, 42 and 45, in several countries of the world, including the European Union, the United States of America, Mexico, Colombia, China, Japan, India and Australia;
- International Registration no. 1703724 for DORMAKABA, registered on September 22, 2022, in classes 6, 7, 9, 12, 19, 20, 35, 37, 40, 42 and 45, in China, Philippines, Switzerland and the United States of America; and
- International Registration no. 1492894 for DORMAKABA TRUSTED ACCESS, registered on April 26, 2019 in classes 6, 7, 9, 14, 19, 35, 37, 40 and 42 in China the United States of America and Switzerland.

The Complainant is the owner of the domain name <dormakaba.com>, registered on April 30, 2015, which is in use for the Complainant's official website.

The disputed domain name was registered on August 14, 2023. The disputed domain name used to resolve to a website selling products similar to those sold by the Complainant and displaying the Complainant's logo. At the time of the Complainant's filing it resolved to an inactive website.

The Respondent is purportedly an individual located in China.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that their systematic and strategic deployment of the DORMAKABA mark across various platforms and materials has significantly elevated its recognition and distinction in the market. Through persistent engagement on the "dormakaba TV" YouTube channel, substantial social media

presence, and extensive marketing initiatives focusing on the “dormakaba Trusted Access” concept, they have successfully enhanced the visibility and reputation of their marks. Additionally, the widespread acknowledgment of the Complainant’s marks and the receipt of various industry awards highlight the market’s recognition and respect for their mark within the access solutions sector. The Complainant maintains that the DORMAKABA mark is widely recognized and enjoys enhanced distinctiveness, solidifying their status in the global market.

The Complainant asserts that the disputed domain name <dormakabaaccess.com> is nearly identical to its marks, creating potential consumer confusion. The disputed domain name incorporates the Complainant’s distinctive mark DORMAKABA at the outset, followed by the word “access,” a term relevant to the Complainant’s industry, thereby intensifying the association with the Complainant’s products. This similarity, compounded by the Respondent’s unauthorized use of the Complainant’s marks and visual branding, suggests a misleading connection between the Respondent’s website and the Complainant’s marks. Furthermore, the Complainant argues that the disputed domain name’s structure parallels that of its mark DORMAKABA TRUSTED ACCESS, differing only in the omission of the word “trusted”. The generic Top-Level-Domain (“gTLD”) “.com” does not alleviate the confusion.

The Respondent is engaged in the use of the disputed domain name for the promotion and commercialization of goods identical to those covered under the DORMAKABA mark registration, which includes locks, keys, and door access control systems. Furthermore, the Respondent has incorporated the Complainant’s logo, using the specific color scheme of blue and red on the disputed domain name’s website.

The Complainant asserts that the Respondent has no legitimate rights or interests in the disputed domain name, which hinges on the established recognition and legal protection of the DORMAKABA mark in the United States of America, which the Respondent allegedly used in bad faith to promote similar products without permission. Furthermore, the alleged business address is nonexistent, and the entity “dormakabaaccess.com Store LLC” remains unverified, casting doubt on the Respondent’s legitimacy.

The Complainant asserts that the Respondent has registered and used the disputed domain name <dormakabaaccess.com> in bad faith, infringing on the Complainant’s marks rights. By combining the recognized DORMAKABA mark with the word “access,” the Respondent deliberately misleads consumers to gain unfairly from the Complainant’s reputation. This misconduct demonstrates an intention to confuse consumers and exploit the Complainant’s marks for commercial advantage.

## **B. Respondent**

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

## **6. Discussion and Findings**

As the Respondent did not file a Response to the Complainant’s contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

“A Panel shall 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”, as indicated in paragraph 15(a) of the Rules.

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

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 by the Respondent in bad faith.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark and/or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. The disputed domain name incorporates the Complainant's DORMAKABA mark and is a combination of elements from the Complainant's DORMAKABA TRUSTED ACCESS mark, using the first and last word elements. The omission of the middle element from the DORMAKABA TRUSTED ACCESS mark does not contribute to any differentiation. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Moreover, the ".com" gTLD is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the Complainant, it seems that the Respondent is not associated or connected with the Complainant in any way, and the Complainant has not granted the Respondent any license or authorization to use or register any domain name that includes the Complainant's DORMAKABA mark, and it is a combination or abbreviation of the DORMAKABA TRUSTED ACCESS mark. Moreover, the Respondent has not replied to the Complaint, failing to show any justifiable prior rights or legitimate interests in the disputed domain name. The Panel finds that there is no indication of a possible legitimate use of the disputed domain name. The disputed domain name was used to mimic the Complainant's website, offering similar products and even bearing the Complainant DORMAKABA logo which cannot constitute noncommercial or fair use. There is also no evidence that the Respondent is known under "dormakaba access" name.

Panels have held that the use of a domain name for illegal activity, here claimed impersonation of the Complainant website and marks, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant has provided evidence demonstrating that the DORMAKABA and DORMAKABA TRUSTED ACCESS marks are well-known based on their worldwide presence and social media. The Panel notes that the DORMAKABA mark was registered and used 7 years before the Respondent's registration of the disputed domain name. A quick Internet search would reveal that DORMAKABA is in use. It is apparent that by registering the disputed domain name, the Respondent aimed to exploit the Complainant's marks DORMAKABA and DORMAKABA TRUSTED ACCESS, thereby causing confusion among Internet users and leveraging the Complainant's esteemed reputation, within the meaning of paragraph 4(b)(iv) of the Policy.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

At the time of the Complaint's filing, the disputed domain name resolved to an inactive website.

Panels have found that the non-use of a domain would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademarks, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Complainant provided evidence that the disputed domain name resolved to a website that mimicked the Complainant's website, offering similar products and even bearing the Complainant DORMAKABA logo. The Panel finds that the Respondent registered the disputed domain name to intentionally attempt to attract Internet users by creating a likelihood of confusion with the Complainant's marks for commercial gain.

Panels have held that the use of a domain name for illegal activity, here claimed impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <dormakabaaccess.com> be transferred to the Complainant.

*/Petra Pecar/*

**Petra Pecar**

Sole Panelist

Date: March 25, 2024