

## **ADMINISTRATIVE PANEL DECISION**

DEUTZ AG v. Александр Капсамун  
Case No. D2024-1037

### **1. The Parties**

The Complainant is DEUTZ AG, Germany, represented by Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is Александр Капсамун, Türkiye.

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

The disputed domain name <enginedeutz.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2024. On March 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 13, 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 amendment to the Complaint on March 14, 2024.

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 March 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 7, 2024. The Respondent sent an email communication to the Center on March 18, 2024.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on April 19, 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 factual findings pertinent to the decision in this case are that:

1. the Complainant is a German engine manufacturer incorporated in 1864;
2. the Complainant has since that time continuously traded under the name, DEUTZ;
3. the Complainant is the owner of, inter alia, International trademark Reg. No. 158231, registered December 17, 1951, for DEUTZ; and
4. the disputed domain name was registered on January 22, 2024,“. The Complainant has provided evidence that the disputed domain name resolved to a website offering parts for engines.

#### **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.

In particular, the Complainant asserts trademark rights in DEUTZ and submits that the disputed domain name is confusingly similar to its trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use its trademark or register any domain name incorporating the trademark. The Respondent has no trademark rights of its own.

Finally, the disputed domain name resolved to a website offering parts for engines. The Complainant submits that the use is in bad faith because the Respondent also sells the goods of the Complainant's competitors.

The Complainant petitions the Panel to order transfer of the disputed domain name.

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

The Respondent did not reply to the Complainant's contentions. However, as mentioned above, on March 18, 2024, the Respondent sent an informal communication, via email, to the Center. The informal communication stated:

“We bought this domain because it was free, without any desire to harm DEUTZ AG in any way. On the contrary, our company sells their products and for convenience we purchased this domain.

If DEUTZ AG does not want us or anyone else to use this domain, then why did they leave it freely available?”

Pursuant to paragraph 10(d) of the Rules “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence.” Here, the Panel accepts the informal communication from the Respondent and considers it, as required, in the Discussion which follows.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. A trademark registered with a national or pan-national authority is evidence of trademark rights for the purposes of the Policy.<sup>1</sup> The Complainant provides evidence of its International registration of DEUTZ and so the Panel finds that the Complainant has established trademark rights.

The disputed domain name adds the term “engine” and the generic Top-Level Domain (“gTLD”) “.com” to the trademark. It is agreed that the gTLD can be disregarded for the purposes of comparing the disputed domain name with the trademark as such is viewed as a standard registration requirement.<sup>2</sup> Further, the addition of the term “engine”, although may bear an assessment bear under the second and third elements, does not prevent a finding of confusing similarity under the first element.<sup>3</sup> The Panel finds that the trademark is recognizable in the disputed domain name and is confusingly similar to the trademark.

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

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant need only make out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, after which the onus shifts to the Respondent to rebut that case by demonstrating those rights or interests.<sup>4</sup>

The name of the underlying domain name registrant as disclosed by the Registrar does not carry any suggestion that the Respondent might be commonly known by the disputed domain name. The Complainant states that it has not authorized use of the trademark and there is no evidence that the Respondent has any trademark rights of its own. The Complainant provides evidence that the disputed domain name resolved to the website, apparently of a Turkish company, Stoparts Ltd, which offered for sale engine parts for various engine makers, including the Complainant. The Complainant submits that:

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<sup>1</sup>See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

<sup>2</sup>See section 1.11.1 of the [WIPO Overview 3.0](#).

<sup>3</sup>See section 1.7 and 1.8 of the [WIPO Overview 3.0](#); see also, *DEUTZ AG v. Registration Private, Domains By Proxy, LLC / Aditya Roshni, Web Services Pty*, WIPO Case No. [D2016-0106](#) making a parallel finding in the case of the domain name <deutzengine.com>.

<sup>4</sup>See, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

“[i]t is a well-known principal of trademark laws all over the world that the manufacturer or retailers of spare parts or engine parts can be entitled to use the trademark of the manufacturer of the original products, but only under certain conditions and within certain limits. The right to use the trademark is, thus, subject to rather strict requirements and limitations.”

As noted above, the Respondent’s informal communication is that it sells genuine, original manufacturer, replacement parts but the Complainant’s argument is that resellers or distributors of spare parts who do not have a direct contractual relationship with the original manufacturer may only use the trademark in a domain name if critical conditions laid down by the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“*Oki Data*”) are satisfied - namely - the Respondent must only sell the trademarked goods and the website must disclose the Respondent’s relationship with the trademark owner.<sup>5</sup>

The Complainant states that there is no relationship between the Parties outside these proceedings and that the *Oki Data* conditions have not been met. The Panel is satisfied this is the case. The evidence provided shows nothing on the resolving website regarding the potential relationship (or lack thereof) between the Parties. What the website does show is that the parts of various competing engine makers are for sale, not just those of the Complainant.

The Panel finds that a prima facie case has been made that the Respondent has no rights or interest in the disputed domain name. The onus shifts to the Respondent. Even taking account of the informal communication, the Panel finds that the Respondent has not discharged the onus and finds the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has satisfied the second limb of the Policy.

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

The Complainant must prove, on the balance of probabilities, both that the disputed domain name was registered in bad faith and used in bad faith.

Further guidance on that requirement is found in paragraph 4(b) of the Policy, which sets out four non-exclusive circumstances, any one of which is taken to be evidence of the registration and use of a domain name in bad faith if established.

The four specified circumstances are:

- “(i) circumstances indicating that the respondent has registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent’s 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 the respondent’s website or location or of a product or service on the site or location.”

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<sup>5</sup>See section 2.8 of the [WIPO Overview 3.0](#).

The Panel notes that the registration of the disputed domain name including the Complainant's trademark with a term relevant to the Complainant supports the awareness of the DEUTZ trademark. Furthermore, the Panel finds that the Respondent has registered the disputed domain name in order to prevent the Complainant from reflecting its DEUTZ trademark in a corresponding domain name.

The Panel finds that the Respondent's conduct falls under paragraph 4(b)(iv) above. The Panel has already found the disputed domain name to be confusingly similar to the Complainant's trademark. The evidence provided by the Complainant indicates that the disputed domain name has been used to resolve to a website offering for sale not only supposedly products of the Complainant but also of its competitor's, which is disruptive to the Complainant's business. In terms of the Policy, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of that website.

The Panel finds that the Complainant has satisfied the third and final 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 <enginedeutz.com> be transferred to the Complainant.

*/Debrett G. Lyons/*

**Debrett G. Lyons**

Sole Panelist

Date: April 21, 2024