

ADMINISTRATIVE PANEL DECISION

Tado GmbH v. Irene LOUIS
Case No. D2024-1142

1. The Parties

The Complainant is Tado GmbH, Germany, represented by CMS Cameron McKenna Nabarro Olswang LLP, United Kingdom (“UK”).

The Respondent is Irene LOUIS, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <tado-uk.shop> 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 15, 2024. On March 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 18, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 19, 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 March 22, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 notified the Respondent of the Complaint, and the proceedings commenced on March 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 22, 2024.

The Center appointed Alissia Shchichka as the sole panelist in this matter on April 26, 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 manufactures and sells smart home climate control systems under the TADO trademark. Established in 2011, it operates through various retail outlets and distributors across multiple countries, including the United Kingdom, Germany, France, Spain, Portugal, Italy, Ireland, Netherlands, Luxembourg, Belgium, Austria, Switzerland, Poland, Sweden, Denmark, Norway, and the Czech Republic. Global sales revenue for the TADO trademarked goods reached EUR 61 million in 2022.

The Complainant has evidenced to be the registered owner of numerous trademark registrations, including, but not limited, to the following:

- United Kingdom trademark registration No. UK00911184991, registered on April 12, 2013, for the word mark TADO, in classes 9, 35, and 42; and
- German trademark registration No. 302012020023, registered on October 8, 2013, for the word mark TADO, in classes 6, 35 and 42.

The Complainant is also the owner of the domain name <tado.com>, registered on October 16, 1997.

The above trademarks and domain name were registered prior to the registration of the disputed domain name, which was registered on January 26, 2024. At the time of rendering this decision, the disputed domain name resolves to a website selling footwear and displaying the Complainant's trademark. However, the Complainant has provided evidence that the disputed domain name previously used to host a website selling the same products as those marketed by the Complainant. Moreover, on this previous version of the website, the Complainant's logo and photos were displayed.

The Respondent, according to the disclosed Whois information for the disputed domain name, is apparently located in the United Kingdom.

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 asserts that the TADO trademark has achieved global recognition and is well-known.

According to the Complainant, the disputed domain name is confusingly similar to the Complainant's trademark TADO as it incorporates the entire trademark. The addition of the descriptive term "uk" together with a hyphen to the TADO trademark, does not alter the overall impression that the disputed domain name is associated with the Complainant's trademark or prevent the confusing similarity between the disputed domain name and the Complainant's trademark. In respect of the highly descriptive generic Top-Level Domain ("gTLD") ".shop", which forms part of the disputed domain name, the Complainant requests that the Panel disregard it under the first element as it is a standard registration requirement.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since (1) the Complainant has never licensed, contracted, or otherwise permitted the Respondent to apply to register the disputed domain name; (2) the Respondent is not commonly known by the TADO

trademark; and (3) the Respondent is using the disputed domain name to confuse consumers into believing that the old website to which the disputed domain name resolved, was an official website of the Complainant and/or that the Respondent is affiliated with or is authorized by the Complainant.

Finally, the Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith, aiming to attract Internet users for commercial gain by creating confusion with the Complainant's trademark regarding the source or affiliation of the Respondent's both old and new websites. The Complainant argues that the previous website associated with the disputed domain was not a legitimate retail outlet but rather a deceptive attempt to mislead users into believing it was affiliated with the Complainant. Evidence includes identical branding to the Complainant's website, unauthorized use of copyrighted photographs, and the subsequent replacement of the old website with one selling different goods, indicating it was never a genuine business.

The Complainant requests that the disputed domain name be transferred to the Complainant.

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 carries the burden of proving:

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

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate

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 or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is clearly recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, the geographical abbreviation "uk" for United Kingdom, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the TADO trademark or to seek registration of any domain name incorporating the trademark. The Respondent is also not known to be associated with the TADO trademark, and there is no evidence showing that the Respondent has been commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

Based on the available record, the Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademark or service mark at issue. [WIPO Overview 3.0](#), section 2.4.

Indeed, the Panel finds that the Complainant has provided evidence that on the initial version of the website, used by the Respondent before the Registrar took down the site and removed all infringing content, it displayed the Complainant's trademarks, logos, and photos without authorization. The Respondent later altered the website's content. However, according to information provided by the Complainant, even in the initial stages of this second version, the website featured complementary products (boilers) sold by the Complainant. Previous UDRP panels have consistently held that such use of the disputed domain name does not represent a bona fide offering because it capitalizes on the reputation and goodwill of the Complainant's trademark. [WIPO Overview 3.0](#), section 2.9. Further, the use of a domain name for illegal activity, such as claimed impersonation/passing off, cannot confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Finally, the Panel also notes that the composition of the disputed domain name, carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has provided evidence supporting its prima facie claim that the Respondent lacks any 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.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

The Panel finds that the Complainant has established the second element of the Policy.

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.

On the issue of registration, the Panel observes that the Complainant has presented evidence of its well-established reputation, with extensive sales in multiple jurisdictions and significant coverage in major news outlets. These factors, combined with the Respondent's initial use of the website, strongly suggest that the Respondent knew or should have known of the Complainant's trademarks at the time of registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

On the issue of use, 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 trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its websites. Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Although at the time of this decision, the disputed domain name resolves to a website selling products unrelated to the Complainant's business, its previous bad faith use and the lack of explanation for any possible good faith use from the Respondent makes any such use implausible. Thus, the current use of the disputed domain name does not prevent a finding of bad faith.

In this context, the Panel also attaches significance to the fact that the Respondent did not file any Response. The Panel finds that, in the circumstances of this case, the Respondent's registration and use of the disputed domain name constitute bad faith within the meaning of paragraph 4(b)(iv) of 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, <tado-uk.shop> be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: May 10, 2024