

ADMINISTRATIVE PANEL DECISION

Sumitomo Rubber Industries, Ltd. v. Cerys Coates, Victoria Stone, Rebecca Newman, Jake Mistry, Cameron Parkes
Case No. D2024-1346

1. The Parties

The Complainant is Sumitomo Rubber Industries, Ltd., Japan, represented by RITTERSHAUS Rechtsanwälte PartmbB Law Firm, Germany.

The Respondents are Cerys Coates, Victoria Stone, Rebecca Newman, Jake Mistry, and Cameron Parkes, all located in Germany.

2. The Domain Names and Registrar

The disputed domain names <falkeustria.com>, <falkenargentina.com>, <falkenaustralia.com>, <falkenbelgique.com>, <falkenbrasil.com>, <falkenbulgaria.com>, <falkencanada.com>, <falkenchile.com>, <falkencolombia.com>, <falkendanmark.com>, <falkendeutschland.com>, <falkeneesti.com>, <falkenfrance.com>, <falkengreece.com>, <falkenhungary.com>, <falkenisrael.com>, <falkenitalia.com>, <falkenjapan.com>, <falkenkuwait.com>, <falkenmexico.com>, <falkennederland.com>, <falkennorge.com>, <falkenperu.com>, <falkenpolska.com>, <falkenromania.com>, <falkenschweiz.com>, <falkensouthafrica.com>, <falkenspain.com>, <falkensuomi.com>, <falkensverige.com>, <falkenturkey.com>, <falkenuae.com>, <falkenuk.com>, and <falkenuruguay.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2024. On April 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Unknown) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 8, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity

and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on April 11, 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 Respondents of the Complaint, and the proceedings commenced on April 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on May 7, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on May 10, 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, a limited company established in 1917 under Japanese law, is the holding company, inter alia, of Falken Tyre Europe GmbH which – being the European distribution company – is responsible for the website under “www.falkentyre.com”.

The Complainant manufactures and markets, among others, tires for passenger cars, truck/bus, construction vehicles, agricultural vehicles, industrial vehicles, race/rally vehicles and motorcycles.

The Complainant is the owner of a wide range of registered trademarks for or including the mark FALKEN, such as the following:

- the International Trademark Registration number 1027794 for FALKEN (word), registered on December 22, 2008, covering goods in International Class 12 and designating, inter alia, the European Union; and
- the International Trademark Registration number 913896 for FALKEN (figurative), registered on October 27, 2006, covering goods in International Class 12 and designating, inter alia, the European Union.

All the disputed domain names, <falkeustria.com>, <falkenargentina.com>, <falkenaustralia.com>, <falkenbelgique.com>, <falkenbrasil.com>, <falkenbulgaria.com>, <falkencanada.com>, <falkenchile.com>, <falkencolombia.com>, <falkendanmark.com>, <falkendeutschland.com>, <falkeneesti.com>, <falkenfrance.com>, <falkengreece.com>, <falkenhungary.com>, <falkenisrael.com>, <falkenitalia.com>, <falkenjapan.com>, <falkenkuwait.com>, <falkenmexico.com>, <falkennederland.com>, <falkennorge.com>, <falkenperu.com>, <falkenpolska.com>, <falkenromania.com>, <falkenschweiz.com>, <falkensouthafrica.com>, <falkenspain.com>, <falkensuomi.com>, <falkensverige.com>, <falkenturkey.com>, <falkenuae.com>, <falkenuk.com>, and <falkenuruguay.com>, were registered on November 9, 2023.

At the time of filing the Complaint and based on the record, Annexes 8 and 9 to the Complaint, all the disputed domain names were directed to commercial websites having the same structure and being identically designed in the respective national language, displaying the Complainant’s trademark and logo, official product images and photographs, where purported FALKEN products were advertised and offered for sale at discounted prices, and without providing any indication regarding the entity operating such websites or any disclaimer of the lack of relationship with the Complainant.

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 names.

Notably, the Complainant contends that the trademark FALKEN is widely known and enjoys an excellent reputation on the market since it has been used for tires and wheels since 1983 continuously by the Complainant and its distributors around the world; that the disputed domain names are all highly similar to its trademark as they incorporate the trademark FALKEN with additional geographical terms, except for the disputed domain name <falkeustria.com> which incorporates the term "falke" which differs from the FALKEN trademark only by the missing "n" at the end of the word; that the disputed domain names create the false impression that they are sub-domains of the Complainant's main website leading to websites of the Complainant for the specific countries; that the Respondent has no rights or legitimate interests in the disputed domain names; that the Respondent registered and is using the disputed domain names in bad faith to operate fake web shops which give the impression as if they were the Complainant's "official" web shop for the respective country (indicated by the country name of the respective domain name and by the local language used on such websites), displaying, the Complainant's trademark, official product images and photographs from the Complainant's official website, without any imprint or other indication of who operates the website; the products offered on the websites under the disputed domain names are offered at extreme low prices in order to seduce online consumers into concluding an online purchase contract; and that a test purchase conducted by the Complainant's representatives on February 27, 2024 revealed that no products were delivered, but the Complainant received an invoice which does not include the name or contact details of the seller and this further proves that using the fake web shops, the Respondent is only interested in accessing the credit card details in order to cause financial damage to the consumers.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural Issue: Consolidation of Multiple Respondents

The amended Complaint was filed in relation to nominally different disputed domain name registrants. The Complainant alleges that the disputed domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names (i) were all registered on the same day and with the same Registrar; (ii) were created in a similar manner, starting with the Complainant's trademark FALKEN, followed by a geographic term (except for the disputed domain name <falkeustria.com> which contains a misspelling of the Complainant's mark); (iii) were used in the same

manner, resolving commercial websites for online shops, with almost identical content provided in the local language, that reproduces the Complainant's mark, logo, product images and official photographs; (iv) the Respondents listed in the Whols have numerous similarities such as names, email or postal addresses, a pattern of irregularities; and, (v) the Respondents have not objected to the consolidation claims made by the Complainant.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2 Substantive Issues

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain names are 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 the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used 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 names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 recognizable within the disputed domain names. Accordingly, each of the disputed domain names is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, -such as "austria", "argentina", "australia", "belgique" ("Belgium" in French), "brasil", "bulgaria", "canada", "chile", "colombia", "danmark" ("Denmark" in Danish), "deutschland" ("Germany" in German), "eesti" ("Estonia" in Estonian), "france", "greece", "hungary", "israel", "italia", "japan", "kuwait", "mexico", "nederland", "norge" ("Norway" in Norwegian), "peru", "polska" ("Poland" in Polish), "romania", "schweiz" ("Switzerland" in Swiss), "southafrica", "spain", "suomi" ("Finland" in Finish), "sverige" ("Sweden" in Swedish), "turkey", "uae", "uk", and "uruguay", - or a misspelling of the Complainant's mark, may bear on assessment of the second and third elements, the Panel finds the addition of such terms or the misspelling does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.8. and 1.9.

Based on the available record, 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 record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain names in connection with websites promoting and purportedly offering for sale goods identical to those of the Complainant with significant price reductions, reproducing the Complainant's trademark, logo, official product images and photographs, without providing any disclaimer. The Complainant's purchase test further demonstrates that the disputed domain names were used for fraudulent purposes. Panels have held that the use of a domain name for illegal activity (e.g., the sale of alleged counterfeit goods or impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. Noting the impersonating nature of the disputed domain names both in their composition and website content that lacks any disclaimer of the lack of relationship with the Complainant, such use cannot confer rights or legitimate interests upon the Respondent.

Further, the composition of the disputed domain names, which combine the Complainant's trademark with geographical terms, suggests an affiliation with the trademark owner. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, 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 disputed domain names were registered in bad faith, with knowledge of the Complainant and its trademark particularly because of their significant number, the same registration date, and their composition. Furthermore, the use of the disputed domain names enforces such finding.

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.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online 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 respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant's trademark with additional geographical terms, and the websites operated under the disputed domain names display the Complainant's trademark, logo, product images and official photographs, do not contain information regarding the entity operating such websites and have no disclaimer, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused

and believe that the websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for 34 disputed domain names incorporating the Complainant's trademark, definitely constitutes a pattern of abusive conduct and registration of the disputed domain names in bad faith. [WIPO Overview 3.0](#), section 3.1.2.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <falkeustria.com>, <falkenargentina.com>, <falkenaustralia.com>, <falkenbelgique.com>, <falkenbrasil.com>, <falkenbulgaria.com>, <falkencanada.com>, <falkenchile.com>, <falkencolombia.com>, <falkendanmar.com>, <falkendeutschland.com>, <falkeneesti.com>, <falkenfrance.com>, <falkengreece.com>, <falkenhungary.com>, <falkenisrael.com>, <falkenitalia.com>, <falkenjapan.com>, <falkenkuwait.com>, <falkenmexico.com>, <falkennederland.com>, <falkennorge.com>, <falkenperu.com>, <falkenpolska.com>, <falkenromania.com>, <falkenschweiz.com>, <falkensouthafrica.com>, <falkenspain.com>, <falkensuomi.com>, <falkensverige.com>, <falkenturkey.com>, <falkenuae.com>, <falkenuk.com>, and <falkenuruguay.com>, be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: May 17, 2024