

ADMINISTRATIVE PANEL DECISION

Berlitz Investment Corporation v. Phillip Lasiter
Case No. D2024-1926

1. The Parties

The Complainant is Berlitz Investment Corporation, United States of America (“United States”), represented by Adams and Reese LLP, United States.

The Respondent is Phillip Lasiter, United States.

2. The Domain Name and Registrar

The disputed domain name <berlitzdeutschland.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 May 7, 2024. On May 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 8, 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 May 14, 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 May 16, 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 notified the Respondent of the Complaint, and the proceedings commenced on May 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent’s default on June 13, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on June 20, 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 is a Delaware corporation whose licensees provide language instruction services and sell books and other published materials under the BERLITZ mark throughout the world. The Complainant is the proprietor of a number of trademark registrations internationally for its BERLITZ mark, including the following:

- United States Trademark Registration No. 0524786 for BERLITZ (device mark), registered on May 2, 1950, for goods in class 16, claiming a date of first use in May 1878;
- United States Trademark Registration No. 893056 for BERLITZ (word mark), registered on June 16, 1970, for services in class 41, claiming a date of first use in May 1878.

The Complainant operates a business website at the domain name <berlitz.com>.

The disputed domain name was registered on April 15, 2024. At the time of the filing of the Complaint, it resolved to a website featuring the BERLITZ mark, an image of a laptop computer and a classroom of students, the text “Opening Worlds Through Language and Learning for Over 140 Years!” above a button labeled “START LEARNING NOW”. The copyright notice and contact information referenced “Berlitz Deutschland GmbH” and an address in Frankfurt, Germany. At the time of this Decision, the landing page was somewhat simplified but still featured the BERLITZ mark and image of the classroom. The evidence in the record indicates that e-mail exchange (MX) records have been configured for the disputed domain name.

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 it and its predecessors in title have been using the BERLITZ mark directly and through licensees since 1878. Through continuous use and extensive promotion, the BERLITZ mark has become famous and well known among consumers. The Complainant’s licensees have registered many domain names reflecting the BERLITZ mark, including with geographic terms. The disputed domain name reflects the Complainant’s mark in its entirety and the addition of a geographic term only serves to increase confusing similarity. The Respondent is using the disputed domain name to redirect to a website purporting to be the official site for the Complainant’s German licensee, Berlitz Deutschland GmbH, displaying the Complainant’s name and logo. The Respondent appears to be using the disputed domain name in furtherance of a phishing scam, as the website solicits visitors’ personal information. The configuration of MX records is further evidence of such a scheme.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[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”.

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 entirety of the Complainant’s BERLITZ mark is reproduced 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, “deutschland”) may bear on assessment of the second and third elements, the Panel finds the addition of such a 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 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.

The Panel notes there is no evidence that the Respondent has used the disputed domain name in connection with a bona fide offering of goods or services, nor that the Respondent has been commonly known by the disputed domain name. There is no evidence that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name. The use of the disputed domain name reflected in

the evidence does not support an inference that the Respondent was engaged in a legitimate business connected to the disputed domain name. Under these circumstances, the Panel finds that such use does not establish rights or legitimate interests. Moreover, the composition of the disputed domain name, which reflects the Complainant's BERLITZ trademark together with a reference to the Complainant's operations in Germany, carries a risk of implied affiliation to the Complainant that cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

The record contains evidence that the Respondent attempted to pass itself off as the Complainant by creating a website featuring the Complainant's BERLITZ mark. Panels have held that the use of a domain name for illegal activity (here, claimed impersonation of the Complainant's German licensee) 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 Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. The disputed domain name was registered more than a century after the Complainant registered its BERLITZ trademark. The disputed domain name reflects the Complainant's mark plus a geographic term (referring to Germany, where the Complainant's licensee operates a business) and therefore implies a connection to the Complainant. Under these circumstances, the Panel finds that the disputed domain name was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off and possible solicitation of user data in furtherance of a phishing scheme) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that the Complainant has provided evidence that the Respondent has used the disputed domain name to impersonate the Complainant through a website offering services apparently identical to those offered by the Complainant under the Complainant's BERLITZ mark. The Complainant's website invites users to submit their personal information. UDRP panels have held that configuration of MX records can, as in this case, provide additional evidence of the Respondent's bad faith. The Respondent has not attempted to provide a good-faith explanation for such conduct and the Panel does not find it credible that one could exist. On this 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 <berlitzdeutschland.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa /

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: July 4, 2024