

ADMINISTRATIVE PANEL DECISION

AUMA Riester GmbH und Co. KG v. pooria nezam
Case No. D2024-2046

1. The Parties

The Complainant is AUMA Riester GmbH und Co. KG, Germany, represented by Maucher Jenkins, Germany.

The Respondent is pooria nezam, Canada.

2. The Domain Name and Registrar

The disputed domain name <auma-actuator.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2024. On May 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 16, 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 Individual) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 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 May 21, 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 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 Respondent’s default on June 12, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on June 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 Complainant is a German manufacturer of actuators and valve gearboxes, founded 60 years ago. The Complainant employs around 2,800 people in more than 30 locations worldwide. The Complainant operates under the AUMA mark, which it has heavily promoted for at least 25 years.

The Complainant is the owner of multiple registrations for the trademark AUMA in various jurisdictions, including the following:

- AUMA (figurative), International trademark registration No. 1272017, registered on May 15, 2015, for goods in classes 7 and 9, designating various jurisdictions, among which also Iran;
- AUMA (word), International trademark registration No. 1317931, registered on June 28, 2016, for goods in classes 7 and 9, designating various jurisdictions, among which also Iran;
- AUMA (figurative), Canadian trademark registration No. TMA1017637, filed on August 25, 2015, and registered on March 19, 2019, for goods in classes 7 and 9; and
- AUMA (word), Canadian trademark registration No. TMA1017649, filed on August 25, 2015, and registered on March 19, 2019, for goods in classes 7 and 9.

The Complainant is also the owner of the domain name <auma.com>, registered on March 5, 1997, and of <auma.co.in> and <auma.se>, registered on February 28, 2003 and April 25, 2003, respectively. The Complainant also maintains social media accounts featuring the AUMA marks, on Facebook and Instagram.

The Respondent is allegedly located in Canada. The disputed domain name was registered on January 27, 2020, and resolves to a website in Iranian displaying the AUMA trademark prominently accompanied by the Complainant's slogan "Solutions for a world in motion". The Respondent's website displays copyrighted pictures of the Complainant's products and contains the following statement: "if you want to buy all types of AUMA electric actuators and also need various services such as electric actuator repair, installation and maintenance of all types of electric actuators, contact our experts in the selected industry group to assist you in this area". The contact details on the website refer to an Iranian company. Some of the texts appearing on the Respondent's website are the same of those in the Complainant's official website and social media pages. The AUMA branded products promoted for sale on the Respondent's website are allegedly counterfeit. The Complainant received an email from an Iranian customer who asked why the company or individual cited on the website corresponding to the disputed domain name introduces itself as an AUMA agent in Iran and sells "fake equipment" through its website.

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 the disputed domain name is confusingly similar to the Complainant's mark AUMA. The disputed domain name incorporates the AUMA mark and includes the

descriptive word “actuator”, which refers to one of the Complainant’s products. The addition of a descriptive term to the Complainant’s mark in the disputed domain name cannot prevent a finding of confusing similarity.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant does not have any business relationship with the Respondent and the Respondent is not sponsored by or affiliated with the Complainant. The Complainant has not authorized or permitted the Respondent to register domain names incorporating the Complainant’s mark. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. The disputed domain name resolves to a website in Iranian displaying the AUMA trademark prominently, along with the same slogan used by the Complainant. The website also depicts images of various Complainant’s products using copyrighted pictures from the Complainant. The contact details on the website refer to an Iranian company with which the Complainant has no relationship. The website promotes the sale of purportedly counterfeit AUMA products and offers related installation, maintenance, and repair services. Accordingly, the Respondent’s website provides the false impression that the Complainant operates in Iran and that the Iranian company is entitled to sell AUMA products as an affiliated of the Complainant. However, the Respondent is not an authorized reseller or distributor of the Complainant’s products, nor a licensee of its AUMA mark. In the absence of any license or permission from the Complainant to use its trademarks no actual or contemplated bona fide or legitimate use of the disputed domain name can reasonably be claimed. It is apparent that the Respondent intends to profit financially from misled Internet users through use of the disputed domain name.

Lastly, the Complainant maintains that the disputed domain name has been registered and is being used in bad faith. The AUMA mark is widely known internationally, including in Iran, and the Complainant’s goods provided under the AUMA mark are widely publicized. The Complainant has rights on the trademark AUMA in Canada, where the Respondent is allegedly located, and in Iran, since well before the date of registration of the disputed domain name. The registration of the disputed domain name, which fully includes the Complainant’s mark, cannot have occurred by coincidence. Given the fame of the AUMA mark and the contents of the Respondent’s website it is inconceivable that the Respondent would not have known of the Complainant and of its mark before it registered the disputed domain name. The Respondent’s registration of the disputed domain name is clearly exploiting the Complainant’s business reputation and amounts to registration in bad faith.

As far as use of the disputed domain name in bad faith is concerned, the Complainant maintains that such use creates a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of any such website. The use of the disputed domain name prevents the Complainant from being able to engage with these customers. Moreover, the Complainant maintains that the goods promoted for sale on the Respondent’s website are counterfeit goods, and provides a copy of an email from an Iranian customer in support. The offering of counterfeit products damages the Complainant’s reputation. Using the disputed domain name in connection with a fraudulent activity is an indicator of bad faith.

B. Respondent

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

6. Discussion and Findings

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. In particular, the Complainant has shown that it owns registered rights over the trademark AUMA, which predate the disputed domain name.

The entirety of the mark is reproduced and is well recognizable within the disputed domain name. Although the addition of other terms here, “actuator”, may bear on assessment of the second and third elements, given the circumstances of the case, 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. Likewise, the hyphen separating the Complainant’s mark from the descriptive word “actuator” in the disputed domain name has no impact on the finding of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Respondent has no relationship with the Complainant and the Complainant has never authorized the Respondent to make use of its AUMA trademark in the disputed domain name. Nowhere in the case file is there any evidence that could support a finding that the Respondent is commonly known by the disputed domain name. The Complainant’s mark is distinctive and incorporates the additional term “actuator” preceded by a hyphen, which refers to one of the products manufactured by the Complainant and sold under the AUMA mark. 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.

Moreover, the disputed domain name resolves to a website displaying the Complainant’s mark and slogan prominently, and reproducing copyrighted images of the Complainant’s products. On its website, the Respondent is inviting potential customers to purchase AUMA products and to take advantage of associated services such as repair, installation, and maintenance services. The contact details of the website indicate an Iranian company, which is not linked to the Complainant. The AUMA branded products offered for sale on the Respondent’s website are allegedly counterfeit, as indicated in at least one customer’s complaint addressed to the Complainant.

The Panel finds that the disputed domain name and the associated website are highly misleading as the Internet users looking on the Internet for the Complainant’s products and services in Iran could erroneously

believe that the disputed domain name is linked to, endorsed, or sponsored by the Complainant, while in reality it is owned and operated by an unrelated third party.

Panels have held that the use of a domain name for illegal activity such as impersonation/passing off and sale of counterfeit goods 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's trademark is distinctive and is associated with the word "actuator" in the disputed domain name. As this word is strictly related to the Complainant's activity it is clear that the Respondent was aware of the Complainant's mark when it registered the disputed domain name. The registration of a domain name incorporating an inherently distinctive third party's mark along with a descriptive term referring to the main activity of the owner of that mark, without rights or legitimate interests, amounts to registration in bad faith.

Panels have held that the use of a domain name for illegal activity such as impersonation/passing off, or sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Panel notes that the disputed domain name resolves to a highly misleading website containing multiple references to the Complainant and promoting the sale of allegedly counterfeit goods. The website refers to an Iranian company, which could be deemed associated with the Complainant while in the reality it is not. The Panel therefore finds that by using the disputed domain name, 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 mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. In light of this, the Panel finds the Respondent's use of the disputed domain name constitutes bad faith under the Policy.

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 <auma-actuator.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: June 28, 2024