

## **ADMINISTRATIVE PANEL DECISION**

**BODUM Intercompany AG and Pi-Design AG v. huai jun zhang, zhanghuai jun**

**Case No. D2024-2051**

### **1. The Parties**

The Complainants are BODUM Intercompany AG and Pi-Design AG, Switzerland, represented by Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is huai jun zhang, zhanghuai jun, China.

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

The disputed domain name <bodumcoffee.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2024. On May 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 20, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainants on May 21, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on June 4, 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 June 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 26, 2024.

The Center appointed Petra Pecar as the sole panelist in this matter on July 1, 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 First Complainant BODUM Intercompany AG (hereinafter: the First Complainant), known under the brand BODUM, is a renowned manufacturer of kitchenware, particularly for coffee. Founded in Denmark in 1944 by Peter Bodum, the company moved to Switzerland in 1978, where it is still headquartered. The First Complainant remains a family-owned business, currently co-owned by Peter Bodum's children, Jørgen Bodum (CEO) and Pia Bodum.

The First Complainant is famous for its French Press coffeemaker, such as the "Chambord". Over time, the First Complainant has expanded its product range to include tea pots, electrical household goods, juicers, coffee grinders, mixers, blenders, cookware, cutlery, storage items, textiles, and other home and office products.

One of the First Complainant's group companies, Pi-Design AG (hereinafter: the Second Complainant) is the owner of intellectual property rights of companies belonging to the Bodum group and the registered holder of the mark BODUM. Amongst others, the Second Complainant owns the following valid mark registrations:

- International word mark Registration No. 908026 for BODUM, registered on October 6, 2005, in classes 1, 3, 4, 6, 7, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 29, 30, 33, 35, 42, and 43 in several jurisdictions, including China; and
- International word mark Registration No. 1305704 for BODUM, registered on March 22, 2016, in classes 7, 8, 9, 11, 14, 16, 21, 24, 25, 30, 35, 36, and 43 in several jurisdictions, including China.

Additionally, the Complainants own numerous domain names incorporating the mark BODUM, such as <bodum.com>, <bodum.jp>, <bodum.coffee>, <bodum.net>, <bodum.eu>, <bodum.kitchen>, <bodum.cooking>, and <bodum.store>. The Complainants promote their products and services through its website "www.bodum.com", which provide to customers worldwide in multiple languages.

The disputed domain name was registered on June 3, 2023, and at the time of the Complaint filing it redirected to a gambling website under "hhh88396.com" in Chinese characters.

The Respondent is located in China.

#### **5. Parties' Contentions**

##### **A. Complainants**

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that the disputed domain name is confusingly similar to the Complainants' marks, as it fully incorporates BODUM and adds the generic term "coffee," which is related to the Complainants' business. Adding the term "coffee" does not distinguish the disputed domain name from the Complainants' marks and may lead the public to associate the disputed domain name with the Complainants' coffee products.

The prior UDRP panels established that adding a generic or descriptive term to a trademark in a domain name does not prevent a finding of confusing similarity. In present case, the term "coffee" is seen merely as

descriptive of the products offered by the Complainants. Therefore, the disputed domain name is highly similar to the Complainants' marks.

The Complainants assert that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainants have found no evidence that the Respondent has any registered marks, trade names, or personal name corresponding to "BODUM". The Respondent's name is not related to "BODUM" in any way. Additionally, the Complainants have not given any license or authorization to the Respondent to use the BODUM mark or the disputed domain name. The mere registration of a domain name does not give the owner a right or legitimate interest in respect of the disputed domain name.

The Complainants argue that the disputed domain name was registered and is being used in bad faith. The Complainants assert that the Respondent should have been aware of the Complainant's prior rights in the BODUM mark when registering the disputed domain name. The BODUM mark is globally recognized and has been in operation since 1944, with marks registered long before the disputed domain name.

The disputed domain name leads to a website where users encounter a "security check" in Japanese. Upon clicking the link, users are redirected to a gambling website under webpage "hhh88396.com". Redirection to a gambling site has been considered bad faith in numerous UDRP cases. Panels have found that using domain names incorporating well-known trademarks to redirect traffic to unrelated or inappropriate sites, such as gambling sites, exploits the trademark's reputation, potentially harming the brand and misleading consumers. Thus, the redirection to a gambling website is evidence of actual use in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **6.1. Procedural Issues**

#### **6.1.1. Consolidation of Multiple Complainants**

Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1, the consolidation of multiple complainants filing a joint complaint against one or more respondents is subject to the discretion of the appointed panel. In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. The Panel finds that the disputed domain name targets BODUM marks owned by the Second Complainant. The Second Complainant is a part of the First Complainant's group. The registration and use of the disputed domain name affects both Complainants, and they therefore have a common grievance against the Respondent. Therefore, the Panel considers that it is fair and equitable and procedurally efficient under the circumstances of the case to permit the consolidation, as the Complainants have a specific common grievance against the Respondent, since their rights are affected by the disputed domain name. Consequently, the Panel allows the Complainants to proceed jointly with their Complaint.

### **6.2. Findings**

As the Respondent did not file a Response to the Complainants' contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainants.

"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", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainants are required to prove each of the following three elements:

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

### **6.3. Substantive Issues**

#### **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 3.0](#), section 1.7.

The Complainants have shown rights in respect of a 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 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 term "coffee", 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.

Furthermore, it is well accepted practice by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). For that reason, the Panel accepts not to take gTLD ".com" when assessing confusing similarity of the disputed domain name.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' 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.

According to the Complainants, there is no association or connection between the Respondent and the Complainants. The Complainants have not granted the Respondent any license or authorization to use or register any domain name incorporating the Complainants' marks. Furthermore, the Respondent has not responded to the Complaint, failing to present any information or factors that could justify prior rights or legitimate interests in the disputed domain name. Under these circumstances, the Respondent's conduct in redirecting the disputed domain name to a gambling website operating under the domain name <hhh88396.com>, displayed in Chinese characters, further supports the lack of legitimate or genuine use. Such redirection to a gambling site suggests an intent to exploit the Complainants' marks for commercial gain, which contradicts any claim to non-commercial or bona fide activities.

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 finds that the Respondent registered and used the disputed domain name in bad faith. The Complainants, with rights established since 2005 in the BODUM mark, provided evidence supporting their claim.

The disputed domain name was registered 18 years later in respect the Complaints' marks. The Panel finds that is improbable that the Respondent was not aware of the BODUM mark since a quick Internet search would reveal the existence of the BODUM mark. The Respondent also used the disputed domain name to intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainants' mark since it leads users to a webpage featuring a "security check" in Chinese characters. Upon interaction, users are redirected to a gambling website under webpage "hhh88396.com". This redirection to a gambling website is considered evidence of bad faith in UDRP cases, as it exploits the BODUM mark's reputation.

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 <bodumcoffee.com> be transferred to the Complainants.

*/Petra Pecar/*

**Petra Pecar**

Sole Panelist

Date: July 15, 2024