

ADMINISTRATIVE PANEL DECISION

Marcal Hickory LLC v. NameSilo, LLC, Domain Administrator
Case No. D2024-2817

1. The Parties

Complainant is Marcal Hickory LLC, United States of America (“United States”), represented by Soteria LLC, United States.

Respondent is NameSilo, LLC, Domain Administrator¹, United States.

2. The Domain Name and Registrar

The disputed domain name <vondrehle.shop> (the “Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 10, 2024. On July 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 11, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private) and contact information in the Complaint. The Center sent an email communication to Complainant on July 12, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on the same date.

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”).

¹ The Panel notes that the Registrar in its reply to the Request for Registrar Verification stated that the registrant name is “NameSilo LLC, Domain Administrator”, while providing an email address without any apparent connection to the Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on July 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 4, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 5, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on August 8, 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

Complainant is a United States company engaged in the manufacturing of paper products. Complainant owns the trademark VONDREHLE registered with the United States Patent and Trademark Office ("USPTO") on July 4, 2006, for goods in Classes 16 and 21 (the "VONDREHLE Mark"), United States Registration No. 3112015.

On June 28, 2024, Respondent registered the Domain Name with the Registrar. At the time the Complaint was filed, the Domain Name resolved to a functioning website branded as "VONDREHLE" and purportedly selling VONDREHLE paper products.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

With respect to the first element of the Policy, Complainant asserts that it holds registered trademark rights in the United States for the VONDREHLE Mark. Complainant points out that the Domain Name is identical to its VONDREHLE Mark.

With respect to the second element of the Policy, Complainant argues that Respondent has no rights or legitimate interests in the Domain Name because Complainant has not licensed or otherwise permitted Respondent to use the VONDREHLE Mark or to register any domain name incorporating this mark. Furthermore, there is no evidence to suggest that Respondent is commonly known by the Domain Name. Complainant also asserts that Respondent has not used, nor made demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services. Instead, the Domain Name resolves to a website passing off as Complainant, which cannot constitute a bona fide offering.

With respect to the third element of the Policy, Complainant alleges that the Domain Name was registered and is being used in bad faith because the Domain Name is used to host a website that impersonates Complainant, with Complainant's branded products and mimics its official website. Furthermore, the fact that Respondent chose a Domain Name that is identical to Complainant's trademark strongly suggests knowledge of Complainant's rights in the mark at the time of registration. Such conduct, according to Complainant, is indicative of bad faith registration and use under the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Although Respondent did not file a Response, to succeed in this proceeding, paragraph 4(a) of the Policy requires Complainant to prove its assertions with evidence demonstrating:

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

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); and see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows:

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 Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. Ownership of a trademark registration prima facie satisfies that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview, section 1.2. On this point, Complainant has provided evidence that it is the owner of a trademark registration for the VONDREHLE Mark. The Domain Name is identical to the VONDREHLE Mark, except for the ".shop" generic Top-Level Domain ("gTLD"), which is viewed as a standard registration requirement and as such is typically disregarded under the first element. [WIPO Overview 3.0](#), section 1.11. Accordingly, the Domain Name is identical to Complainant's mark in which it has rights for the purposes of the Policy.

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

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainant need only make a prima facie showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); and *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

In this matter, Complainant has alleged that Respondent was not authorized to use the VONDREHLE Mark. Complainant further alleges it granted no rights, permissions, or licenses to Respondent to use Complainant's marks in domain names. Respondent has been properly notified of the Complaint by the Center; however, Respondent failed to submit any response concerning these serious accusations.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted

Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy² or otherwise.

As an initial matter, there is no evidence that Respondent is commonly known by the Domain Name. The Domain Name registration provides registrant details that correspond to the Registrar, NameSilo, LLC. The Panel therefore finds, based on the record and the lack of evidence otherwise, that Respondent is not commonly known by the Domain Name, which is identical to Complainant's VONDREHLE Mark, for the purposes of the Policy.

Respondent cannot claim that its operation on the website at the Domain Name provides legitimate interests because the Panel finds that the Domain Name was likely registered and used to engage in impersonation of Complainant's online retail website, which is not a bona fide offering of goods or services.

[WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent"). Even if the products purportedly sold by Respondent were genuine and actually offered (which is highly unlikely given the circumstances mentioned above), such use of the Domain Name does not meet the requirements set forth in the "Oki Data Test", (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) because the site does not disclose the lack of relationship between Respondent and Complainant. [WIPO Overview 3.0](#), section 2.8.

Lastly, Respondent's use of the Domain Name is not noncommercial or fair use under paragraph 4(c)(iii) of the Policy, given that Respondent is, at best, selling competing products from an online retail website. Such activity does not amount to a fan site, criticism, or other activity that may be considered noncommercial or fair use. Moreover, the composition of the Domain Name carries a risk of implied affiliation with Complainant and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent "knew or should have known" of a complainant's trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#) and [WIPO Overview 3.0](#), section 3.2.2. As detailed above, Respondent registered the Domain Name which is identical to the VONDREHLE Mark long after said mark was initially used and registered. The content of the Domain Name also supports a finding that Respondent was aware of Complainant when it registered the Domain Name. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant's trademark or otherwise create a false association with Complainant.

² The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

As discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant's VONDREHLE Mark, and purporting to sell Complainant's products. These actions amount to bad faith use of the Domain Name by Respondent. See *Identigene, Inc. v. Genetest Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. [D2000-0743](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the complainant's mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

As detailed above, the Panel finds on the record before it that Respondent's intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with the VONDREHLE Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) 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 Domain Name, <vondrehle.shop>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: August 22, 2024