

ADMINISTRATIVE PANEL DECISION

Sandvik Intellectual Property AB v. Ruslanbek Dakaev
Case No. D2024-3063

1. The Parties

The Complainant is Sandvik Intellectual Property AB, Sweden, represented by SILKA AB, Sweden.

The Respondent is Ruslanbek Dakaev, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <sandvik-russia.com> is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on July 26, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 30, 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 (Protection of Private Person) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 Complaint in English on August 1, 2024.

On July 31, 2024, the Center informed the parties in Russian and English, that the language of the registration agreement for the disputed domain name is Russian. On August 1, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Russian of the Complaint, and the proceedings commenced on August 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 13, 2024.

The Center appointed Alissia Shchichka as the sole panelist in this matter on September 23, 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 global engineering company, founded in 1862, known for its high-tech products and solutions, with a focus on digitalization, innovation, and sustainable engineering. In 2023, the Sandvik Group employed over 44,000 people, generated revenues of SEK 126,503 million across approximately 170 countries, and held 6,921 patents, supported by R&D investments totaling around SEK 4,803 million. The Complainant, a subsidiary of Sandvik AB, was established in 1986 to provide intellectual property consultancy services.

The Complainant has evidenced to be the registered owner of numerous trademark registrations, including, but not limited, to the following:

- International trademark registration No. 1039878, designating, inter alia, Russia, registered on February 2, 2010, for the word mark SANDVIK, in classes 6, 7, 8, 9, 10, 11, 12, 14, 37 and 38; and
- European Union trademark registration No. 002423531, registered on April 24, 2003, for the word mark SANDVIK, in classes 6 and 7.

The Complainant is also the owner of the domain name <home.sandvik>, registered in 2015, which displays information about the Complainant and its activities.

The aforementioned trademarks and domain name were registered prior to the disputed domain name, <sandvik-russia.com>, which was registered on January 22, 2024. As of the date of this decision, the disputed domain name resolves to an active webpage that impersonates the Complainant, displaying the Complainant's trademark and logo, and offering products purportedly sold by the Complainant.

The Respondent, according to the disclosed Whois information for the disputed domain name, is located in Russian Federation.

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 asserts that the SANDVIK trademark is well-known.

According to the Complainant, the disputed domain name is confusingly similar to the Complainant's trademark, SANDVIK, as it incorporates the entire trademark. The addition of the geographic term "russia" and of a hyphen, does not prevent a finding of confusing similarity. In respect of the generic Top-Level Domain ("gTLD") ".com", which forms part of the disputed domain name, the Complainant requests that the Panel disregard it under the first element as it is a standard registration requirement.

The Complainant asserts that the Respondent lacks any rights or legitimate interests in the disputed domain name for the following reasons: (1) the Complainant has never authorized, licensed, or otherwise permitted the Respondent to register or use the disputed domain name; (2) the Respondent holds no trademarks or trade names that correspond to the Complainant's trademark or the disputed domain name; (3) the Respondent is not known under the disputed domain name; (4) the Respondent has neither used the disputed domain name in connection with a bona fide offering of goods or services, as the domain directs to a website that displays the Complainant's trademark, replicates the Complainant's website design, falsely claims to be an official dealer, and lacks a disclaimer about its non-affiliation with the Complainant, misleading users into believing there is an affiliation. This does not constitute a bona fide use and fails the Oki Data Test; (5) the Respondent has not responded to a cease and desist letter sent by the Complainant, and has failed to provide any explanation for its choice of the disputed domain name; and (6) the composition of the disputed domain name increases the likelihood of confusion with the Complainant's SANDVIK mark, and falsely implies sponsorship or endorsement by the Complainant.

The Complainant argues that the Respondent registered and is using the disputed domain name in bad faith for several reasons: (1) the Complainant's well-known trademarks significantly predate the registration of the disputed domain name; (2) the Respondent should have been aware of the Complainant's trademarks, as evidenced by Google search results conducted the day before the registration; (3) the Respondent's website displays the Complainant's SANDVIK trademark, imitates the Complainant's website, and falsely claims to offer for sale the Complainant's products. This suggests that the Respondent registered the domain to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant and its mark; (4) the registration of a domain name incorporating a well-known trademark raises a strong inference of bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

I. Preliminary issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requests that the proceedings be conducted in English for the following reasons: Firstly, English is commonly used in international disputes and the Complainant has no knowledge of Russian language. Secondly, the disputed domain name uses Roman characters, not Cyrillic, and the disputed domain name includes the English word "Russia". Lastly, proceeding in Russian would require significant translation services, potentially resulting in costs higher than those of the proceedings. Therefore, for efficiency and clarity, the Complainant requests that the proceedings continue in English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the

proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

II. Substantive Issues

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

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

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

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 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 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, "Russia", 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.

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.

The Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the SANDVIK trademark or to seek registration of any domain name incorporating the trademark. The Respondent is also not known to be associated with the SANDVIK trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

The disputed domain name resolves to a website that impersonates the Complainant and falsely advertises the Complainant's purported products.

Furthermore, the website falsely claims to belong to an official dealer of the Complainant and uses misleading phrases such as 'contact us,' aimed at deceiving Internet users into believing that the website is operated by or affiliated with the Complainant when, in fact, it is not. Previous UDRP panels have consistently held that such use of the disputed domain name does not represent a bona fide offering because it capitalizes on the reputation and goodwill of the Complainant's trademark. Furthermore, the use of a domain name for illegal activities, such as impersonation or passing off, cannot confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Finally, the Panel also notes that the composition of the disputed domain name, carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. [WIPO Overview 3.0](#), section 2.4.

Accordingly, the Complainant has provided evidence supporting its prima facie claim that the Respondent lacks any 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.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

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.

On the issue of registration, the Panel observes that the Complainant's rights to the well-known SANDVIK trademarks substantially precede the Respondent's registration of the disputed domain name.

Consequently, the Respondent knew or should have known of the Complainant's trademarks at the time of registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

Further, the mere registration of the disputed domain name that is confusingly similar to the Complainant's well-known trademarks by the Respondent, who is unaffiliated with the Complainant, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Regarding the issue of use, the disputed domain name redirects visitors to a website that impersonates the Complainant or, at the very least, falsely claims to be affiliated with the Complainant as an official dealer, displaying the Complainant's trademarks and promoting products allegedly sold by the Complainant. In the Panel's view, the Respondent has intentionally sought to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks regarding the source, sponsorship, affiliation, or endorsement of its website or the products offered on it. Under paragraph 4(b)(iv) of the Policy, this conduct is evidence of the registration and use of the domain name in bad faith. [WIPO Overview 3.0](#), section 3.1.4

In this context, the Panel also attaches significance to the fact that the Respondent did not file any Response. The Panel finds that, in the circumstances of this case, the Respondent's registration and use of the disputed domain name constitute bad faith within the meaning of paragraph 4(b)(iv) of 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 <sandvik-russia.com> be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: October 7, 2024