

ADMINISTRATIVE PANEL DECISION

Schaeffler Technologies AG & Co. KG v. 马海燕 (Hai Yan Ma)
Case No. DCC2024-0020

1. The Parties

The Complainant is Schaeffler Technologies AG & Co. KG, Germany, represented by Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is 马海燕 (Hai Yan Ma), China.

2. The Domain Name and Registrar

The disputed domain name <fagbearing.cc> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on August 2, 2024. On August 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 7, 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 (n/a) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 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 amendment to the Complaint in English on August 19, 2024.

On August 14, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On August 19, 2024, the Complainant confirmed English to 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 Chinese and English of the Complaint, and the proceedings commenced on August 20, 2024. In accordance with the

Rules, paragraph 5, the due date for Response was September 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 13, 2024.

The Center appointed Hong Yang as the sole panelist in this matter on September 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 part of the Schaeffler Group, a listed German family-owned supplier to the automotive and mechanical engineering industries with a history dating back to 1946. Currently, the Schaeffler Group employs over 80,000 people at 180 locations worldwide and had a turnover over EUR 10 billion per year. The Complainant has a number of subsidiaries and plants worldwide, including in China where the Respondent is allegedly resided. It manufactures and markets various products in the rolling bearing industry under several brands, including the FAG brand dating back to 1905, with the relevant design regarded as a beginning of the rolling bearing industry.

The Complainant is the proprietor of a portfolio of trademarks containing the wording "fag", covering multiple jurisdictions, including the following: European Union Trademark Registration No. 005562798, registered on November 15, 2007, International Trademark Registration No. 262541, registered on November 23, 1962, and International Trademark Registration No. 966182, registered on July 25, 2007, with the two international registrations both designating several jurisdictions including China.

The Complainant also owns multiple domain names consisting of the mark FAG, including: <fag.com>, registered on March 15, 1998.

The disputed domain name <fagbearing.cc> was registered on August 2, 2011. The evidence submitted by the Complainant shows that, the disputed domain name resolves to a website apparently operated by Eric Bearing Limited, which purportedly offers the Complainant's products under its two brands, FAG and INA, as well as other branded products from other suppliers, all of which are bearing products. The Complainant's two branded products have been arranged at the first places in the respective two lines of product displaying area.

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.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. 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 requested that the language of the proceeding be English for several reasons, including the fact that: (1) the Complainant is unable to communicate in Chinese. Requiring the Complainant to submit documents in Chinese would lead to delay and incur inadequate translation expenses; (2) the disputed domain name itself is written in Latin characters; (3) the content on the website under the disputed domain name is in English, and the Respondent is thus able to communicate in English.

The Respondent had, moreover, been notified by the Center, in both Chinese and English, of the language of the proceeding, and the deadline for filing a Response in Chinese or English. The Respondent did not make any specific submissions with respect to the language of the proceeding, nor did the Respondent file any Response.

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.

6.2 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 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 term, here "bearing", 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.

Moreover, the applicable country code Top-level Domain ("ccTLD") ".cc" in the disputed domain name does not change this finding, since the TLD in a domain name, as a standard registration requirement, is generally disregarded in such an assessment of confusing similarity. [WIPO Overview 3.0](#), section 1.11.

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 that the composition of the disputed domain name itself carries a risk of implied affiliation, where the disputed domain name consists of the Complainant's mark plus the term "bearing", referring to the main type of products marketed by the Complainant. Under such circumstances, panels have held that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Further, available record shows that the Respondent is not affiliated or otherwise authorized by the Complainant or held any registration of the FAG mark anywhere. There is no evidence indicating that the Respondent might be commonly known by the disputed domain name.

The disputed domain name resolves to a website where the Respondent purportedly offers bearing products of various brands, involving at least two of brands from the Complainant, being put in the prominent positions in the product displaying areas, without a prominent and accurate disclaimer regarding the relationship between the Parties. Regarding the possible legitimate offering by resellers or distributors of spare parts, certain requirements must be met which are set by *Okidata Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("Okidata"). In line with the Okidata test, the four main requirements include: 1. "Respondent must actually be offering the goods or services at issue"; 2. "Respondent must use the site to sell only the trademarked goods"; 3. "The site must accurately disclose the registrant's relationship with the trademark owner"; and 4. "The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name".

Applying the Okidata test, the Panel finds that at least two out of the four requirements are not met in the current case. The second requirement is not met as the website under the disputed domain name offers the Complainant's products together with other products under brands from other suppliers. The third requirement is not met as the website does not include any disclaimer/statement demonstrating that it does not belong to or is not affiliated with the Complainant. Therefore, the Respondent's use of the disputed domain name is not in connection with a bona fide offering of goods or services, neither did the Respondent make any legitimate noncommercial or fair use of the disputed domain name.

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 has used, without any license or authorization the Complainant's trademark in full, in the disputed domain name plus the term "bearing" which corresponds to the Complainant's main type of products. The Complainant's trademark FAG is well known in its industry and the Complainant's registration and use of its mark well predates the Respondent's registration of the disputed domain name, so the Respondent knew or should have known of the Complainant's mark at the time of registering the disputed domain name. Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4

There is a clear absence of the Respondent's rights or legitimate interests in the disputed domain name as discussed under the section 6.2.B of the decision. This, combined with the nature of the disputed domain name, also indicates that the Respondent's registration targets the Complainant, which constitutes bad faith.

Available record shows that the disputed domain name resolves to a website displaying at least two brands belonging to the Complainant together with their product images. Moreover, the website under the disputed domain name also offers the same type of products from other brands. Panels have found that such conduct is an indication of bad faith (see *Philip Morris Products S.A. v. Saeed Farahani, Persian Art*, WIPO Case No. [D2022-0238](#); *Intex Recreation Corp. v. RBT, Inc., Ira Weinstein*, WIPO Case No. [D2010-0119](#); *MasterCard International Incorporated v. Global Access*, WIPO Case No. [D2008-1940](#)). Therefore, the Panel is convinced that the Respondent's registration and use of the disputed domain name constitute bad faith under 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 <fagbearing.cc> be transferred to the Complainant.

/Hong Yang/

Hong Yang

Sole Panelist

Date: October 3, 2024