

ADMINISTRATIVE PANEL DECISION

WAGO Verwaltungsgesellschaft mbH v. Privacy service provided by Withheld for Privacy ehf / Sascha Steffens, Method Gaming Limited
Case No. DIO2022-0033

1. The Parties

The Complainant is WAGO Verwaltungsgesellschaft mbH, Germany, represented Bardehle Pagenberg Partnerschaft mbB, Germany.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Sascha Steffens, Method Gaming Limited, United Kingdom, represented by Sheridans, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <wago.io> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2022. On July 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 27, 2022, 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 July 28, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 August 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 24, 2022. On August 18, 2022, the Respondent requested an extension to file a response and the response due date was subsequently extended to August 28, 2022. The Response was filed with the Center on August 25, 2022.

The Center appointed William R. Towns, Luca Barbero, and Gareth Dickson as panelists in this matter on October 3, 2022. 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 based manufacturer of components for electrical connections, including components for automation. Founded in the year 1951 with headquarters in Minden, Germany, the Complainant is known for its WAGO brand cage and clamp push-wire connectors, designed to make the splicing process easier without needing tools.

The Complainant employs over 5,800 employees, and has registered its well-known WAGO mark in numerous jurisdictions, including among the following:

- United States of America (“United States”) trademark Reg. 1175910, applied for on October 9, 1979, and registered on November 3, 1981 (registration renewed);
- United States Trademark Reg. 3712256, applied for on June 9, 2008, and registered on November 17, 2009 (registration renewed);
- European Union Trademark Reg. 013011259, applied for on June 18, 2014, and registered on October 17, 2014; and
- International Trademark Reg. 985983, registered on June 9, 2008 (registration renewed).

The disputed domain name was registered on May 12, 2015, according to the public Whois record. The disputed domain name more recently was updated on April 12, 2022. The Respondent appears to be directing the disputed domain name to a website at “www.wago.io”, with a login link and featuring several online video games.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is identical or confusingly similar to the Complainant’s WAGO mark. The Complainant maintains that the top level domain (“TLD”) “.io” generally is not taken into account when assessing the confusing similarity of the disputed domain name to the Complainant’s WAGO mark. The Complainant explains it is the owner of several trademarks protecting its WAGO mark in a number of companies in the field of electrical connections and electronic components, and has registered a substantial number of domain names reflecting its WAGO mark.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent has not registered any trademarks or personal names corresponding either to the Complainant’s WAGO mark or to the disputed domain name, and has neither been licensed nor otherwise authorized to register or use domain names reflecting the Complainant’s WAGO mark. The Complainant concludes in the absence of any license or permission from the Complainant that no *bona fide* or legitimate use of the disputed domain name can be claimed by the Respondent, and that the use of the disputed domain name does not confer rights or legitimate interests.

The Complainant contends that the disputed domain name has been registered and used by the Respondent in bad faith. The Complainant asserts that the Respondent clearly would have been aware of the Complainant's WAGO trademarks when registering the disputed domain name, emphasizing that the Complainant's WAGO trademarks have been registered and used in numerous countries around the world long before the Respondent first registered the disputed domain name.

According to the Complainant, the Respondent registered the identical disputed domain name to create a false impression that the Respondent is working for the Complainant. The Complainant contends there is persuasive evidence that the Respondent sought to exploit the reputation of and fame of the Complainant's WAGO mark in order to mislead potential customers as to non-existing relationships in a classic "bait and switch scenario".

B. Respondent

The Respondent submits that the Complainant has not met the requirement for identity or confusingly similarity pursuant to paragraph 4(a)(i) of the Policy. The Respondent maintains it has a legitimate interest in the disputed domain name, with no history or evidence of any bad faith by the Respondent. The Respondent insists it has not engaged in any pattern of registering domain names corresponding to marks held by third parties. The Respondent asserts that the Complainant may have acted in bad faith in an attempt at reverse domain name hijacking or to harass the Respondent into transferring the disputed domain name.

The Respondent explains that it purchased the disputed domain name in the year 2020 for a significant sum, and emphasizes that its business is in video games, located on the Respondent's website, which the Respondent further asserts has been used with a website since as early as 2015. According to the Respondent, the website provides free resources to gamers to improve their gameplay experience.

The Respondent emphasizes that its interest in the disputed domain name was and still correlates with the widely recognized World of Warcraft game, which features a database of sharable add on elements called "WeakAuras", and is said to be the most popular game of its kind. The Respondent acknowledges that the Complainant holds several registered trademarks for its WAGO mark, used with electrical connections and components, and maintains the WAGO mark is neither identical nor confusingly similar to the disputed domain name.

The Respondent asserts that the disputed domain name incorporates the entirety of the Complainant's WAGO mark, observing that the addition of the TLD ".io" is unusual, not a "normal" situation, and consequently is neither confusingly similar nor identical. The Respondent submits it has rights or legitimate interests in respect of the disputed domain name, and maintains it is using the disputed domain name in connection with a *bona fide* offering of goods and services, providing "Weak Auras" to gamers for the World of Warcraft and building a popular website with significant revenues and substantial global traffic rankings.

6. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the

Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

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

As will be appreciated, these requirements are very similar to the requirements under the Uniform Domain Name Dispute Resolution Policy (the “UDRP”) save that, in particular, it is necessary for the complainant to establish only that the disputed domain name was registered in bad faith or is being used in bad faith.

In view of the close similarity of the requirements of the Policy and the UDRP, therefore, the Panel will draw on the principles established under the UDRP including as expressed under the WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) as appropriate.

Cancellation or transfer of the disputed domain name is the sole remedies provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) of the Policy shifts the burden of production to the respondent to come forward with evidence of a right or legitimate interests in the domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's WAGO mark, in which the Complainant has established rights through registration and use. In considering this issue, the first element of the Policy acts essentially as a standing requirement.¹ The threshold inquiry under the first element of the Policy is largely framed in terms of whether the trademark and the disputed domain name, when directly compared, are confusingly similar or identical. In this instance, the disputed domain name incorporates the Complainant's WAGO mark in its entirety and as such is identical to the Complainant's WAGO mark. TLDs generally are disregarded when evaluating the identity or confusing similarity of the complainant's mark to the domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.² Accordingly, when so disregarded the disputed domain name is identical to the Complainant's WAGO mark.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

¹ See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), paragraph 1.2.

² See [WIPO Overview 3.0](#), section 1.11.

C. Rights or Legitimate Interests

Once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The disputed domain name as previously noted is identical to the Complainant's WAGO mark, and the Panel finds that the Respondent has neither been authorized to use the Complainant's mark nor commonly known by the disputed domain name. The Respondent has directed the disputed domain name to a website related to video games.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name, even if he has acquired no trademark or service mark rights; or
- (iii) the respondent is 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.

Accordingly, the Panel finds the Complainant has failed to satisfy the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered or Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

The Panel concludes that the Complainant has failed to carry its burden of demonstrating bad faith registration or use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy.

The Respondent by all appearances registered and has used the disputed domain name since it was first created on or about May 12, 2015. The Respondent appears to have maintained the disputed domain name primarily to resolve to content related to video games, and without evidence to target the Complainant in some way does not in the Panel's opinion constitute bad faith registration or use. The Complainant otherwise has brought forth no credible or persuasive evidence that the Respondent intentionally registered the disputed domain name seeking to exploit and profit from the Complainant's rights or the rights of other third parties.

Accordingly, and for the reasons discussed under this and the preceding heading, the Panel concludes that the Complainant has failed to satisfy the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Complainant is denied.

/William R. Towns/
William R. Towns
Presiding Panelist

/Luca Barbero/
Luca Barbero
Panelist

/Gareth Dickson/
Gareth Dickson
Panelist
Date: October 22, 2022