Decision for dispute CAC-UDRP-102313

Case number	**CAC-UDRP-102313**
Time of filing	**2019-01-28 11:00:51**
Domain names	**burkertfluid.com**

Case administrator

Organization	**Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization	**Bürkert Werke GmbH & Co. KG.**

Complainant representative

Organization	**Convey srl**

Respondent

Organization	**pengchengxin**

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various registered trade marks including international trade mark no. 933922 for what is essentially a stylised text mark in respect of the word BÜRKERT in classes 6, 7, 9, 20. That mark was applied for on 16 October 2006 and has proceeded to a number of different territories including China.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is Bürkert Werke GmbH & Co. KG., a German limited partnership company, 100% family owned, and active in the sector of industrial measurement and control technology of fluid and gas. Supplying with its products a wide range of industries (as automotive, biotechnology, chemical industry, electronics, energy, genetic engineering, semiconductor industry, cosmetic, food & beverage and pharma industry, engineering, medical, sanitary engineering, textile industry, packaging and water treatment industry) in 2017 its product sales amounted to 489.9 million euros with an export rate of about 70% with 36 branch offices and over 2.500 employees worldwide.

The Complainant was founded in Germany in 1946 by Christian Bürkert, who began by developing and manufacturing innovative products such as foot warmers, oven controls and thermal control systems for incubators. While these products met the needs of the time, over the years the company increasingly focused on valve technology and soon became an international benchmark for industrial solenoid valves.

The process organization is based on research & development, production, engineering & consulting, delivery, commissioning, training, after-sales-service. The Complainant has 36 branch offices worldwide including 10 in China where the Respondent is based.

The Complainant has registered various domain names consisting of or comprising the word “BURKERT” under several different TLDs, including, inter alia, <burkert.com>, <burkert.com.cn>, <burkert.de>, <burkert.it>, <burkert.fr>, <burkert.net>, <burkert.biz>.
The official websites www.burkert.com and www.burkert.com.cn generate a significant number of visits by Internet users.
The Complainant is also active on the main Social Media, like Facebook, Instagram, Twitter, Youtube and Linkedin.
The disputed domain name (the “Domain Name“) has been used to redirected to a site promoting and offering for sale products purporting to be of the Complainant and of Complainant’s competitors and the Complainant contends that these products are counterfeit.
As soon as the Complainant became aware of the Respondent’s registration and use of the Domain Name, it instructed its representative to address to the owner of the Domain Name a cease and desist letter inter alia requesting the immediate cease of any use of the Domain Name and the transfer of the same to the Complainant.
A cease and desist letter was sent on 13 December 2018, by e-mail to the Domain Name registrant’s known e-mail addresses. Following two reminders on 11 January 2019 and 14 January 2019 the web site was deactivated.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Panel also determines under Paragraph 11 of the Rules, that these proceedings can take place in English notwithstanding that the relevant registration agreement appears to be in Chinese. In this respect, the Panel has taken into account the following:

i. the Domain Name contains Latin characters and the English word “fluid”;
ii. the Domain Name has historically been linked to a website that was at least partially in English;
iii. the Respondent appears to have taken some action in response to a cease and desist letter sent in English.

PRINCIPAL REASONS FOR THE DECISION

The Domain Name can only be sensibly understood as the term "Burkert" combined with the English word "Fluid" and the top level domain ".com". The Complainant is the owner of registered trade marks the predominant element thereof is the word Burkert (albeit with an umlaut over the letter "u"). Given this the Complainant's trade mark is clearly recognisable in the Domain Name and this is sufficient for a finding that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights. The requirements of paragraph 4(a)(i) of the Policy were met.

The Panel notes that Complainant's contention that the Domain Name has been used to sell counterfeit products. Unfortunately this is little more than assertion in the Complainant, and no real explanation is provided as to why this is likely to be the case.

However, the Panel is satisfied that on the balance of probabilities in light of the website material provided by the Complainant that the Domain Name has been used for a website that has promoted competing products (whether or not those competing products are counterfeits) to those of the Complainant and that this was the intention with which the Domain Name was registered. There is no right or legitimate interest in using a domain name in this manner and such registration and use is in bad faith. Accordingly, the requirements of paragraph 4(a)(ii) and (iii) of the Policy have also been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BURKERTFLUID.COM**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2019-03-14

Publish the Decision