Decision for dispute CAC-UDRP-101648

Case number	CAC-UDRP-101648
Time of filing	2021-03-03 00:00:00
Domain names	KSBKY.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	KSB SE & Co. KGaA

Complainant representative

Organization	Convey srl

Respondent

Organization	shang hai kai yu beng ye you xian gong si

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following international trademark registrations of KSB designating China:
- International Registration No. 452821 which was registered on May 22, 1980;
- International Registration No. 662585 which was registered on July 12, 1996;
- International Registration No. 407021 which was registered on April 26, 1974;
- International Registration No. 1466266 which was registered on December 19, 2018;
- International Registration No. 1463039 which was registered on December 19, 2018; and
- International Registration No. 679050 which was registered on July 14, 1997.

The Complainant also holds the domain name registrations which contain the KSB trademark, <www.ksb.com>, <www.ksb.cn> and <www.ksb.com.cn>.

FACTUAL BACKGROUND

The Complainant, KSB SE & Co. KGaA, is a large supplier of pumps, valves and related systems for building services, industry and water transport, waste-water treatment and power plant processes. It was founded in Frankenthal, Germany, in 1871. The mark KSB is the acronym of the Complainant's founders' surnames: Johannes Klein, Friedrich Schanzlin and Jakob

Beckker. Today, the Complainant has a presence globally with its own sales and marketing organizations, manufacturing facilities and service operations. The Complainant employs more than 15,000 people with 190 service centres. The Complainant's second-largest market is Asia Pacific. Outside Europe, the Complainant's biggest production sites are in Brazil, China, India and the USA. Since 1994, the Complainant has set up seven company branches, employing 900 people with more than 30 service centres including in China. The Complainant's official global and local websites in China connect customers to its official sales and service locations.

The disputed domain name, <KSBKY.com>, was registered on May 4, 2011 which resolves to an inactive webpage.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the KSB mark on the basis that the disputed domain name wholly incorporates the Complainant's trademark and the addition the letters "KY" and generic top-level domain name suffix ("gTLD") ".com" are insufficient to avoid the finding that the disputed domain name is confusingly similar to its KSB mark.
The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name. In addition, the Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the KSB mark.
The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent should have known of the Complainant's KSB mark at the time of registration of the disputed domain name. The Complainant also asserts that the Respondent is attempting to attract, for commercial gain, Internet users to the Respondent's website, 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 of a product or service on the Respondent's website.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark 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.
Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:
"(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."
The language of the Registration Agreement for the disputed domain name <KSBKY.COM> is Chinese.

The Complainant requested that the language of the proceeding be English for the following reasons:
(i) the disputed domain name is in English;
(ii) the Respondent deactivated the website after receiving the Complainant's cease and desist letter in English;
(iii) the Respondent is in the sector of import and export of industrial automation products and control components wherein English is the primary language for international relations and business; and
(iv) the proceeding will be put through unnecessary trouble and delay if Chinese were made the language of the proceeding.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: "Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (See Groupe Auchan v. xmxzl, WIPO Case No. DCC2006 0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel agrees that the Respondent appear to be familiar with the English language, taking into account their selection of the English-language trademark and the domain name in dispute. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the KSB trademark. The differences between the disputed domain name and the Complainant's KSB trademark are the addition of the letters "KY" and a gTLD ".com".

It is established that gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877).

The disputed domain name consists of the Complainant's KSB mark and the arbitrary addition of the letters "KY" and a gTLD ".com" which in the Panel's view does not avoid confusing similarity with the Complainant's trademark (see Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd., WIPO Case No. D2015-2333; WIPO Overview 3.0, section 1.9).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the KSB mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate

interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.
The Complainant submitted evidence that it did not authorize or license the Respondent to use the KSB mark (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).
In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain name.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's prima facie case. The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy).

The Complainant has submitted evidence that the disputed domain name resolves to an inactive webpage. It is well established that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding (see WIPO Overview 3.0, paragraph 3.3). The test to apply is that of the totality of circumstances. In doing so we must look to: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case, the evidence shows that the Complainant's mark is distinctive and has attained significant reputation. The strong reputation and distinctive character of the Complainant's mark is evidence that the Respondent is unlikely to have registered the disputed domain name without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain name may be put to. It is also the Complainant's evidence that the Respondent could not have registered the disputed domain name without prior knowledge of the Complainant's mark as the Respondent is a competitor company of the Complainant and the Respondent's name has no connection with the Complainant's KSB mark which was registered long ago. This is another indicator of bad faith on the part of the Respondent (see Boursorama SA v. Estrade Nicolas, WIPO Case No. D2017-1463).

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

The Complainant submitted evidence that they had issued a cease-and-desist letter to Respondent prior to the proceedings. Even though the Complainant never received a response from the Respondent, the Respondent deactivated the website in which the Complainant's counterfeit products and Respondent's products were offered for sale. It is notable that the Respondent's products were in competition with the Complainant's and the Complainant's trademarks were displayed on this website. Based on the particular circumstances of the present case, the Panel draws an adverse inference from the Respondent's failure to submit a response and cease-and-desist letter and that the Respondent was indeed aware of the Complainant prior to the proceedings and specifically targeted the Complainant to disrupt its business and create confusion among unsuspecting Internet users.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain name and the

Complainant's mark, the fact that the disputed domain name is being passively held and the fact that no Response was submitted by the Respondent in response to the Complainant's cease-and-desist letter and to the Complaint, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KSBKY.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2021-04-16

Publish the Decision